

Review of All Rights Protection Mechanisms in All gTLDs Phase 1 Final Report

GNSO Council Webinar

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Agenda

- ⦿ Background
- ⦿ Overview
- ⦿ Recommendations to Maintain Status Quo
- ⦿ Recommendations to Modify Operational Practice
- ⦿ Recommendations to Create New Policies and Procedures
- ⦿ Recommendation for Overarching Data Collection

Background

About

March 2016: GNSO Council chartered the two-phased PDP

Phase 1

RPMs applicable to gTLDs launched under the 2012 New gTLD Program

- Uniform Rapid Suspension (URS) dispute resolution procedure
- Trademark Clearinghouse (TMCH)
- Sunrise and Trademark Claims offered through the TMCH
- Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP)

24 November 2020: Submitted Phase 1 Final Report to GNSO Council

Phase 2

**UDRP
(ICANN Consensus Policy
since 1999)**

**GNSO Council to form
charter drafting / scoping team
(ADP: 1-3 months)**

Next Steps

Step 1

- **GNSO Council considers recommendations and Final Report**, and if approved send Recommendations Report to the ICANN Board
(Sections 7 & 8, *Bylaws Annex A and GNSO PDP Manual*)

Step 2

- **Public comment proceeding** on GNSO Council-approved recommendations
(Section 3.6, *Bylaws on Notice & Comment on Policy Actions, before Board consideration*)

Step 3

- **ICANN Board considers recommendations and Final Report**
(Section 9, *Bylaws Annex A*)

Step 4

- If Board adopts recommendations, **Board normally also directs ICANN org to begin implementation** and **GNSO Council generally forms IRT** to advise org

Overview

Summary

35 Total Phase 1 Recommendations

34 achieved “Full Consensus” & 1 achieved “Consensus” (TMCH Final Rec #1)

9

Recommendations
to Maintain the
Status Quo

10

Recommendations
to Modify Existing
Operational Practice

15

Recommendations to
Create New Policies &
Procedures

1

Recommendation for
Overarching Data
Collection

Recs to Maintain Status Quo

TMCH

- “TM+50” rule
- ”Exact Match” rule
- **NOT to limit the Scope of Applicability of Sunrise & Claims RPMs** for trademarks containing **dictionary term(s)**

Trademark Claims

- **Mandatory Claims Period** (also cover the Limited Registration Period)
- ”Exact Match” rule (exact matching criteria for the Claims Notice)



Sunrise

- **Mandatory Sunrise Period** (exception for those who receive exemptions pursuant to Spec 13 .Brand TLDs & Section 6 of Spec 9 Registry Operator Code of Conduct)
- **Requirements for the Sunrise Period**
- Availability of Sunrise registration only for **identical matches**
- **NOT to limit the scope of Sunrise Registrations** to the categories of goods/services for which trademark was registered
- **NOT to create a challenge mechanism** relating to Premium/Reserved Names
- **NO mandatory publication of the Reserved Names lists**



Recs to Modify Existing Operational Practice



URS

- Providers to send notices to Respondent **after Registry/Registrar has forwarded registration data**
- ICANN org, Registries, Registrars, and Providers to take steps to **ensure contact details are up to date**
- Providers to require that **Examiners document their rationale in sufficient detail**
- IRT reviews **implementation issues with respect to Registry Requirement 10** in the “URS High Level Technical Requirements for Registries and Registrars”
- **Remove “Technical” in title** of “URS High Level Technical Requirements for Registries and Registrars”

TMCH

- Validation Provider primarily responsible for **educating rights-holders, domain name registrants, and potential registrants about its services**; IRT to work with Validation Provider and consider **enhancing existing educational materials, with additional attention to registrants**
- Database Provider must **maintain industry-standard levels of redundancy and uptime**



Recs to Modify Existing Operational Practice (Cont.)



Sunrise

- **SDRP not intended to allow challenges to Sunrise registrations on grounds of invalid Trademark Record**; Registry Operator to **immediately suspend domain name registration** to allow registrant to file challenge under the TMCH's dispute resolution procedure

Trademark Claims

- Maintain current requirement to send the Claims Notice before a registration is completed; **ICANN org can work with Registrars to address all relevant implementation issues**
- **Revise language of Trademark Claims Notice to improve the understanding of recipients**; reflect more **specific information about the trademark(s)** for which it is being issued, and communicate its **meaning and implications**



Recs for New Policies and Procedures (URS)

GDPR (aligns with EPDP recs)

- Complainant must **only be required to insert publicly-available WHOIS/RDDS data** in Initial Complaint; **allow update** to Complaint within **2-3 calendar days**
- **URS Panelists** have discretion to decide whether to **publish/redact registration data** in the Determination; **URS party** has the right to request **redaction**
- Clearly **define what “Default Period” means**; registrant **must not change public and non-public registration data elements during the Default Period**

Complaint Mechanism(s)

- ICANN org to **establish a compliance mechanism(s)**, including an avenue for any party in the URS process to **file complaints and seek resolution**

Language

- **Incorporate in full Rule #11 of UDRP Rules** regarding “Language of Proceedings”
- Provider must **translate Notice of Complaint into the language of the Registration Agreement**

Education

- **Uniform set of educational materials** for guidance on what is needed to meet the “**clear and convincing**” **burden of proof**
- **Informational materials to assist Complainants and Respondents**, including FAQs, forms, reference materials to explain Providers’ services & practices

Examiner

- Provider **maintains and publishes list of Examiners and their qualifications (CVs)**; identify **how often each one has been appointed and link to their decisions**
- Provider publishes and reasonably enforces an **effective Examiner Conflict of Interest Policy**

Recs for New Policies and Procedures (Other RPMS)

Sunrise

- Registry Agreement for future new gTLDs to 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 or restricting brand owners' reasonable use of the Sunrise RPM**

Trademark Claims

- Current mandatory Claims Period remain uniform for all gTLDs in subsequent rounds, **with exception for those exempted pursuant to Spec 13 .Brand TLDs & Section 6 of Spec 9 RO Code of Conduct**
- Trademark Claims Notice to be **delivered both in English and the language of the registration agreement**

TM-PDDRP

- Multiple disputes filed by unrelated entities **against the same Registry Operator** may be **initially submitted as a joint Complaint**, or may, at the discretion of the Panel, **be consolidated upon request**

TMCH [did not achieve “full consensus”]

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;
- b. Word marks validated by a court of law or other judicial proceeding;
- c. or 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

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 (a) or (b))

TMCH Validation Provider(s), registry operators and other third parties may provide **ancillary services to intellectual property rights-holders**; these other forms of intellectual property **must be held in a separate ancillary database**



Minority Statement on TMCH Final Rec #1

Important to note that minority statement **did not oppose the primary thrust** of the recommendation, but had concerns over a **single definition**:

- ❖ “Word Marks” not satisfactorily defined, thereby enabling the continued misapprehension of the scope and applicability of the TMCH by the TMCH Validation Provider
- ❖ Absence of a satisfactory definition of “Word Mark” will likely contribute to the continuation of the erroneous TMCH Validation Provider practices, which violate the fundamental promise that the TMCH would not expand rights but would rather only recognize existing rights
 - e.g. inclusion of Text-Plus Marks
- ❖ Problem compounded by unwarranted lack of transparency of the TMCH database



Recommendation: Overarching Data Collection

- ❑ For future new gTLD rounds, **ICANN Org to collect** the following data on at least an **annual basis** 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**;
 - 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**.
- ❑ 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**
- ❑ 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**
- ❑ ICANN org to also collect data concerning **trademark owners' and registrants' experience with the RPMs** that can be provided to future RPM review teams



Recommendations to Maintain Status Quo

TMCH Final Recommendation #2

The Working Group considered the following aspects of the TMCH:

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.

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).

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.

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.

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.

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.

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.

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 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.

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.

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.

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 paragraph 4.

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.

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.

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.

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".

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.

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.

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.

Sunrise Final Recommendation #8 (Cont.)

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 recordals 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.⁶³

Sunrise Final Recommendation #8 (Cont.)

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.

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.

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:

Trademark Claims Final Recommendation #6 (Cont.)

- 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.

Recommendations to Create New Policies and 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 paragraph 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).

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.

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 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.”

URS Final Recommendation #3 (Cont.)

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.

URS Final Recommendation #3 (Cont.)

- 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;
 - 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.

URS Final Recommendation #4

The Working Group recommends that the URS Rule 4(b) and URS Procedure paragraph 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 paragraph 4.3 and transmit the Notice of Complaint to the Respondent via email, fax, and postal mail.

URS Final Recommendation #5

The Working Group recommends that the URS Procedure paragraph 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 paragraph 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 paragraph 5.9 and/or 8.1.

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 (CV).

The Working Group further recommends that the URS Procedure paragraph 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.

URS Final Recommendation #6 (Cont.)

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 if a Provider's website provides a mechanism or function where one can search for those URS decisions that a specific Examiner presided over.

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.

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.

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.

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.

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 the following: 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.

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).

TMCH Final Recommendation #1 (Cont.)

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.
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.

TMCH Final Recommendation #1 (Cont.)

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;

TMCH Final Recommendation #1 (Cont.)

(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:

(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.

TMCH Final Recommendation #1 (Cont.)

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.

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.

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).

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.”
- 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.

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.

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.

TM-PDDRP Final Recommendation (Cont.)

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; 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.

Recommendation for Overarching Data Collection

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;
- 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.

Overarching Data Collection Final Recommendation (Cont.)

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).

Questions?