



RPM Review PDP Working Group Meeting

13 July 2016

Continuation of WG Discussion – the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)

Status of work on reviewing the TM-PDDRP

1

Phase One review kicked off with TM-PDDRP

4

WG reviewing Provider responses and will follow up if needed

2

WG sent list of questions to all three Providers

5

WG developing list of concerns and issues requiring further clarification

3

Providers are:

- ADNDRC
- The FORUM
- WIPO

6

WG aims to complete TM-PDDRP review by end-August

Question to Provider

What are the possible reasons for the TM-PDDRP not having been used to date?

Provider Responses

WIPO:

- High-level DRP, non-use doesn't mean it's not needed.
- Substantive reasons and many procedural layers:
 - no willful blindness standard, two-pronged affirmative conduct requirement, burden of proof, remedies, applicability to registrars, ICANN's role in implementation, failure to expressly allow class/joined complaints.

ADNDRC:

- Burden of proof may be difficult to discharge, especially for second level infringements
- Top-level infringements possibly minimized by existence of pre-delegation objection processes, TMCH and SDRP
- Remedies may not be useful for second level infringements

FORUM:

- High substantive standards, particularly at the second level
- Procedure may not be well-known
- Unspecific nature of the remedies.

Question to Provider

Is there an ongoing cost to retain the Procedure even if it is not used?

Provider Responses

WIPO: Case filing fees support case administration.

ADNDRC: Yes - System maintenance; staff training; business development.

FORUM: No.

Question to Provider

Have you received feedback from any trademark owners or registry operators about potential problems or concerns with the Procedure?

Provider Responses

WIPO: Some (along the lines of the topics outlined in response to Q1).

ADNDRC: No.

FORUM: No.

Question to Provider

Have you received any enquiries from potential complainants who nevertheless did not proceed?

Provider Responses

WIPO: See response to Q3.

ADNDRC: Yes, a couple of enquiries regarding the proceedings flow, case filing fee and available remedies but did not hear further from them.

FORUM: Very few enquiries about the general purpose of the TM-PDDRP (what does it do?). On a couple of occasions, parties who were facing a potential loss in a pre-delegation TMCH proceeding enquired about a potential TM-PDDRP filing post-delegation.

Question to Provider

Are you operationally ready should a complaint be filed?

Provider Responses

WIPO: Yes.

ADNDRC: Yes.

FORUM: Yes.

Question to Provider

Have you selected panelists?

Provider Responses

WIPO: Yes.

ADNDRC: Yes.

FORUM: Yes.

Question to Provider

Should mediation be added to the Procedure?

Provider Responses

WIPO:

- Difficult to positively answer given the additional layers to the process that were created.
- Difficult to justify if merely an additional layer - but a mediation component might be useful if it serves to assist the parties in considering tailored settlement options or remedies (or e.g., to supplant the role of the Threshold Review Panel)

ADNDRC:

- Could be an effective means of resolving disputes in a time and cost efficient manner
- Note possible adverse effect on panelist's neutrality after having obtained confidential information from a party during a fruitless mediation.

FORUM:

- Not recommended if mandatory, though an optional step could be considered (but note additional fees if mediation is unsuccessful).
- Does not believe that adding a mediation step will have a significant influence on triggering filings.

Question to Provider

Do you have any additional feedback about the TM-PDDRP at this stage?

Provider Responses

WIPO:

See generally response to Q3; bear in mind that the TM-PDDRP is part of the “tapestry” of protections created for the New gTLD Program.

ADNDRC:

More concrete wordings for available remedies, e.g.:

- Amount of monetary damages or sanctions other than the cost of proceedings
- Actual direct actions by the registry operator contrary to those required under the Registry Agreement

FORUM:

- ICANN Compliance has been influential in controlling registrars and registries: potential filer may not file under TM-PDDRP - goes directly to ICANN Compliance
- Although it has not been used so far, cannot be certain that it is unnecessary
- Solidifying remedies could potentially trigger filings
- Example cases could be helpful to indicate why it hasn't been used so far

SUGGESTIONS:

- WG should also seek feedback from panelists/arbitrators, especially those who have been trained in the PDDRP or who have extensive experience with similar administrative proceedings or arbitration (from ADNDRC and WG members)
- More promotional events can be hosted jointly by ICANN, providers and registry operators (from ADNDRC)

QUESTIONS:

- Do you have any knowledge of why the potential complainants who enquired did not proceed to filing?
- Looking over the PDDRP, are there any requirements that present administrative challenges?
- Do you believe that the lack of use of the PDDRP results from a lack of instances of the abuse it was designed to target, or are there cost or evidentiary elements that discourage potential complaints?

Policy questions for the Working Group in reviewing the TM-PDDRP

(Questions taken from WG Charter and prior WG discussion)

1. Is there a policy-based need to address the goal of the TM-PDDRP?
2. Is it broad enough to cover abuses that were not anticipated when it was developed?
Alternatively, do we still need it?
3. There is an overarching Charter question as to whether the RPMs collectively fulfill the objectives for which they were developed. In this context, are there some policies/procedures that should be carried across all mechanisms (assuming applicability) e.g. costs/fees for the prevailing party? Should the standards be changed to address the full range of conduct that may appropriately be sanctioned by this process?
4. Even if we made no changes to the TM-PDDRP, is there any burden to it remaining available for use should an appropriate case arise? Or would changes make it more useful?
5. Given how much it costs to be a registry operator, is it too easy to bring a TM-PDDRP action?
6. Concerning TMCH/sunrise practices, certain registries charged fees that some considered disproportionately high for trademark owners. Is there any relation between the sunrise registration fees for trademark owners, in particular registries, to the conduct of the registry operator itself that would be relevant to think about in the post-delegation context?
7. Would adding mediation to the PDDRP be advisable?

Additional Issues, Concerns and Clarifications Needed?

POSSIBLE FOLLOW UP TO PROVIDERS:

1. If you have received enquiries from potential complainants, do you have any knowledge of why they did not proceed to filing?
2. Looking over the PDDRP, are there any requirements that present administrative challenges?
3. Do you believe that the lack of use of the PDDRP results from a lack of instances of the abuse it was designed to target, or are there cost or evidentiary elements that discourage potential complaints?