

4.3.7 Second-level Rights Protection Mechanisms

- 4.3.7.1 Explanation of Subject

The 2007 Final Report discussed the protection of legal rights of others, but it was seemingly in the context of top-level strings, as described in Recommendation 3:

Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.

Examples of these legal rights that are internationally recognized include, but are not limited to, rights defined in the Paris Convention for the Protection of Industry Property (in particular trademark rights), the Universal Declaration of Human Rights (UDHR) and the International Covenant on Civil and Political Rights (ICCPR) (in particular freedom of expression rights).

However, minimal guidance was provided for Rights Protection Mechanisms (RPMs) at the second-level. RPMs such as the Trademark Clearinghouse (TMCH)¹ and the Uniform Rapid Suspension (URS)² which were developed during the implementation phase of the New gTLD Program and not via policy recommendations or policy development. However, the GNSO had the opportunity to review these proposed RPMs, done via the Special Trademark Issue Review Team (STI)³, which produced endorsements and revisions to the TMCH and URS that were ultimately integrated into the final versions of the protection mechanisms.

While there was limited RPMs guidance in the 2007 Final Report, it should be noted that the Protecting the Rights of Others Working Group (PRO WG) had discussed, "...what additional protections beyond the current terms in the registration agreement and existing dispute resolution mechanisms should be in place to protect the legal rights of others during the domain name registration process, particularly during the initial start up of a new gTLD where there is contention for what Registrants perceive as the "best" names,"⁴ indicating that the need for future work was understood at the time.

- 4.3.7.2 Questions and Concerns Related to Subject

The DG raised a number of concerns related to the RPMs developed to support the New gTLD Program. Members identified concerns regarding the development and implementation of both the TMCH and URS. The DG noted the following issues, comments, and suggestions, taken

¹ Trademark Clearinghouse page: <http://newgtlds.icann.org/en/about/trademark-clearinghouse>

² Uniform Rapid Suspension page: <http://newgtlds.icann.org/en/applicants/urs>

³ STI Project page: <http://gns0.icann.org/en/group-activities/inactive/2010/sti>

⁴ Protecting the Rights of Others Working Group (PRO WG) Final Report: <http://gns0.icann.org/en/drafts/GNSO-PRO-WG-final-01Jun07.pdf>

largely verbatim from group members' comments as found in the working materials of the group on the DG's community Wiki space⁵:

- Trademark Clearing House (TMCH)
 - Customer confusion caused by pre-registration claims notice requirement
 - Alleged abuse of TMCH protection mechanism for generic reservations
 - While the TMCH was introduced in 2013, there remain unresolved issues
 - Lack of input from registries/registrars during development
 - Can the scope, or value, of the TMCH registration be extended, for example, integrating to be used as proof for the UDRP
 - As TMCH recordal is a pre-requisite for qualifying as a .Brand under Specification 13, should the trademark requirement be removed?
 - Are the mandatory pre-registration TMCH notices to registrants necessary?
 - Issues around decision not to allow TM Claims for confusingly similar strings and “mark plus”, where the “plus” is a descriptive term
 - Consider making the TM Claims service a genuinely protective mechanism by giving the TM owner advance notice of registration with a mechanism for objection
 - Rules are insufficiently clear and thus open to interpretation and abuse to circumvent the sunrise. Consideration needed as to whether there should be limits on the number of reserved names, prohibitions against reserving TMCH terms, and/or all subsequently-released names being offered on a sunrise.
 - Consider level of fees, in particular for dotBrand registries who do not run a Sunrise
- Uniform Rapid Suspension
 - Should the URS be expanded beyond suspending the domain, like transferring the domain name to the trademark owner?
 - Consider whether appropriate to dispense with full assessment on merits if the registrant defaults, since de novo review is available
 - Is there a lack of balance between complainant and registrant? For instance, the Complainant cannot correct administrative errors and there is relatively limited financial risk to the registrant.
 - Complainant one year ban for two abusive complaints, possible permanent ban thereafter without appeal process

While there were a number of comments made by members in regards to rights protection mechanisms, it should be noted that there is a pending request from the GNSO Council for a Preliminary Issue Report on RPMs, which may lead to a PDP dedicated to the topic. As such, care should be taken to avoid conflicting work, if the PDP on RPMs is in fact initiated. Public comment received on the Preliminary Issue Report for New gTLD Subsequent Procedures suggested some

⁵ See

https://community.icann.org/download/attachments/49356545/New%20gTLD%20Subsequent%20Procedures_MM6Oct2014.pdf?version=1&modificationDate=1412728208000&api=v2

specific questions and topics that should be considered, though as noted, the potential PDP-WG on RPMs may serve as a more optimal vehicle for resolution:

1. Whether RPMs are working as anticipated;
2. Whether and why trademark owners are avoiding or under-utilizing certain RPMs;
3. Whether registrar and registry practices are interfering with the effective operation of the RPMs, and;
4. Any other issues impacting the use or effectiveness of the RPMs.

The comment highlighted premium names, reserved names, trademark blocks, sunrise pricing and the TMCH, trademark claims services, URS, and post-delegation dispute resolution procedures as areas that should specifically be considered⁶. Any resulting recommendations could result in changes to the base contract, to the application submission process (e.g., Evaluation Questions and Criteria), and other perhaps other areas.

- *4.3.7.3 Relevant Guidance*

- Protecting the Rights of Others Working Group (PRO WG) Final Report - <http://gnso.icann.org/en/drafts/GNSO-PRO-WG-final-01Jun07.pdf>
- Information about the Special Trademark Issue Review Team (STI) - <http://gnso.icann.org/en/group-activities/inactive/2010/sti>
- Information about the Trademark Clearinghouse (TMCH) - <http://newgtlds.icann.org/en/about/trademark-clearinghouse>
- Information about Uniform Rapid Suspension (URS) - <http://newgtlds.icann.org/en/applicants/urs>

- *4.3.7.4 Rationale for Policy Development*

It is critical to note that there is a request for a Preliminary Issue Report on the “current state of all rights protection mechanisms (RPMs) for both existing and new gTLDs, including but not limited to the UDRP and the URS...”⁷, which was published for public comment⁸ in October 2015 and may potentially lead to a PDP on that subject. As such, a potential PDP-WG on New gTLD Subsequent Procedures should consider how efforts should be coordinated to avoid duplication or creation of conflicting work. One possible outcome, as an example, could be that the PDP-WG on RPMs could determine that a particular element of their scope is better addressed by the PDP-WG on New gTLDs, or perhaps the effort is addressed in tandem by the two WGs, although presumably only one WG would be expected to provide policy recommendations on the subject.

⁶ See the full public comment here: <http://forum.icann.org/lists/comments-new-gtld-subsequent-prelim-31aug15/msg00004.html>

⁷ GNSO Council resolution requesting RPMs Preliminary Initial Report: <http://gnso.icann.org/en/council/resolutions#201112>

⁸ See <https://www.icann.org/public-comments/rpm-prelim-issue-2015-10-09-en>

Also of note, in support of the potential PDP-WG on RPMs, ICANN staff has performed RPM review activities in support of the CCT review, which may also help identify areas for policy development or implementation guidance that might be beneficial to consider⁹.

⁹ See <https://newgtlds.icann.org/en/reviews/rpm>