

LIST OF QUESTIONS ON TM-PDDRP (from RPM Review Working Group call of 8 June 2016)

ANSWERS TO THE QUESTIONS TO BE SENT TO THE PROVIDERS FOR FEEDBACK FROM ADNDRC AND ITS PANELISTS:

- What reasons might there be for the TM-PDDRP to have not been used to date?
 - Burden of proof

Parties to a TM-PDDRP dispute are (a) the trademark holder and (b) the gTLD registry operator.

In the TM-PDDRP mandatory administrative proceeding, a trademark holder as the Complainant claims that one or more of its marks have been infringed, and has thereby been harmed, by (i) the gTLD registry operator's manner of operation or (ii) use of the gTLD.

The Complaint is based either on the ground of a "Top Level" infringement (for example where a gTLD string is identical to a trademark and then the gTLD registry operator holds itself out as the beneficiary of the mark); OR on the ground of a "Second Level" infringement (for example, where a gTLD registry operator has a pattern or practice of actively and systematically encouraging registrants to register second level domain names and to take unfair advantage of the Complainant's trademark to the extent and degree that bad faith is apparent; OR where a gTLD registry operator has a pattern or practice of acting as the registrant or beneficial user of infringing registrations, to monetize and profit in bad faith).
 - Pre-delegation objection, TMCH and SDRP

Probably, instances of a "Top Level" infringement have been minimized by the Pre-delegation objection, TMCH and SDRP. On the other hand, the burden of proof by clear and convincing evidence of an affirmative conduct of a "Second Level" infringement by the gTLD registry operator may be difficult to discharge by the trademark holder.
 - Available remedies

More importantly the remedies available (as set out in paragraph 18 of TM-PDDRP) might not serve any useful purposes to the trademark holder harmed by a "Second Level" infringement. It might be more convenient and cost-effective to the trademark holder to take the usual UDRP or URS directly against the domain name registrant rather than initiating an action against the registry operator under TM-PDDRP.

- Is there any ongoing cost to them in having this procedure available if it is not used?

Yes, the cost is incurred by the follows:

- System maintenance
- Staff training
- Business development

- Have they received any feedback from trademark owners or Registry Operators as to potential problems or other considerations in relation to using the TM-PDDRP?

No.

- Have they received any enquiries from potential complainants who nevertheless decided not to proceed, in particular as to the standards to be applied?

Yes, we have received a couple of enquiries from potential complainants regarding the flow of proceeding, case filing fee and available remedies. However, we did not hear further from them.

- How ready are the Providers in the event that a Complaint is filed?

Being a key forum for resolving domain name disputes, ADNDRC has handled more than 1,800 UDRP cases, 31 URS cases and 4 TDRP cases.

The four Offices of ADNDRC are managed and supported by leading independent arbitration and dispute resolution institutions in Asia which possess the expertise and global resources for handling different kinds of alternative dispute resolution proceedings. For example, all these four institutions maintain panels of globally diverse neutrals for arbitration, domain name dispute resolution, mediation or adjudication. Moreover, staff members at the four offices are experienced in handling domain name dispute resolution proceedings in different languages, including Chinese, English, Korean and other Asian languages. The prime location of the four offices provides excellent hearing facilities for conducting in person hearings or teleconference.

ADNDRC has also endeavoured to promote the use of UDRP, URS and TM-PDDRP in Asia. Since 2005, ADNDRC has organised conferences on domain name dispute resolution annually in different places in Asia, including Beijing, Hong Kong, Seoul and Kuala Lumpur. With the participation of speakers from ICANN, intellectual property lawyers and domain name experts, ADNDRC conferences have been recognised as the

major forum in Asia to discuss salient issues of the domain name dispute resolution. Moreover, staff members of ADNDRC regularly publish articles and deliver presentations on domain name dispute resolution in various occasions.

ADNDRC is ready to handle TM-PDDRP cases.

- Have the Providers identified potential Panelists? (Note: at least one seems to have)

Yes, ADNDRC has identified several experienced Panelists within its list of 176 Panelists from 24 different places of the world. These panelists are renowned experts specialized in intellectual property and domain name dispute resolution. They have been serving as domain name Panelists in UDRP, URS and TDRP proceedings conducted under the auspices of ADNDRC for since 2002. All of these ADNDRC Panel members can be called upon to support the TM-PDDRP proceedings.

For the full list of ADNDRC Panelists, please refer the ADNDRC's website at <http://www.adndrc.org/mten/ListOfPanelists.php>.

- Would adding mediation to the Procedure be advisable?

It could be an effective means of resolving disputes in a time and cost efficient manner following the principle of "Med-Arb", "Arb-Med" or "Arb-Med-Arb". The Panelist appointed could also serve as a mediator during the proceeding with the parties' agreement to mediate. There is no duplication of time and cost in bringing different individuals up to speed with the legal and factual background.

However, it has also been criticized that the adverse effect on the panelist's neutrality after having obtained confidential information from a party without the presence of another party during a fruitless mediation.

If mediation will be introduced to the Procedure, ADNDRC will have no problem in handling the proceedings with the support of the four member organizations. There are more than 2000 mediators on the lists and many of them are also on the list of ADNDRC Domain Name Panelists.

- What other feedback do the Providers have at this stage, given that the TM-PDDRP has not been used and that the first New gTLD was delegated in October 2013?

➤ Available remedies

More concrete wordings under the paragraph 18 of the, i.e. the available remedies, could be used, including but not limited to:

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

ADDITIONAL 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

More promotion events should be hosted jointly by ICANN, providers and registry operators.