

Adobe Connect chat transcript for 20 July 2016:

Terri Agnew:Welcome to the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group call held on Wednesday, 20 July 2016 at 16:00

Terri Agnew:agenda wiki: <https://community.icann.org/x/9wWbAw>

George Kirikos:Hi folks.

Elliot Silver:Hi George.

George Kirikos:Hi Elliot. How are you?

Elliot Silver:Doing well, thank you. Yourself?

George Kirikos:I'm fine, thanks. Just multitasking in the background. :-)

George Kirikos:Sounds good, Kathy.

Brian Cimboric:Hello all - I have a conflict that I was not able to move beginning at 12:30pm Eastern. I will participate for the first half but will need to leave then.

Paul Tattersfield:Hi All

Elizabeth Featherman:Hello!

Ankur Raheja:Hello all

Maxim Alzoba (FAITID):Hello All

Philip Corwin:Hi all

J. Scott Evans:I am online, but I am on another call that is running long.

J. Scott Evans:I will join as soon as my previous call signs off.

George Kirikos:It's winter in the southern hemisphere. :-)

George Kirikos:If mediation is added, it should be done on a "without prejudice" basis (i.e. discussions can't then be used in a court action, etc.).

Paul Keating:Kathy, I don't object to mediation but the complainant must provide a formal complaint. Otherwise it becomes a game.

Jon Nevelt:I'm a fan of mediation, but not binding mediation

Mary Wong:On mediation - note that feedback was received from all three Providers on this point as well (please refer to the Tabular Summary and full responses, circulated mid-July).

Ivett Paulovics:Mediation is always confidential and without prejudice.

George Kirikos:Not always, Ivett.

Mary Wong:Provider responses are available here: https://community.icann.org/x/Gx_OAw

Jon Nevelt:non-binding result, but also participation should not be required for the reasons that Greg mentions (if both don't want to be there, it won't be successful)

George Kirikos:Since complainants need to give notice 30 days prior to filing the complaint, the best time to have the mediation is after that notification.

J. Scott Evans:joining now.

George Kirikos:Perhaps there can be a "carrot/stick", i.e. if mediation was offered, but rejected, then the PDDRP costs would be split.

Paul Keating:@Kathy, if not mandatory, the respondent should be able to raise this and the final dispute resolution panel should be able to consider the refusal to mediate as a factor in awarding costs

George Kirikos:+1 Paul. A factor in awarding costs definitely makes sense.

Neda Shahghasemi (Forum):Forum can provide mediation services, however, mandatory mediation might frustrate parties as it adds another layer to PDDRP which is already slightly more complicated than for example a UDRP.

Paul Keating:@Kathy, a full complaint should be required in any event.

Paul McGrady:Sorry for joining late and leaving early. The shifting call times, while necessary, are a hassle on trying to plan scheduling.

George Kirikos:There's a Mandatory Mediation Program in my province of Ontario Canada:

<https://www.attorneygeneral.jus.gov.on.ca/english/courts/manmed/>

Ivett Paulovics:MFSD is not a TM-PDDRP Provider, but URS. MFSD provides also mediation in IP matters, including domain names, which is confidential and without prejudice. It is voluntary and not mandatory.

Georges Nahitchevansky:I am not in favor of binding mediation and agree that a mandatory mediation requirement should not be part of the process. There could be a possible period for mediation, but as others have said, forcing parties into mediation is not a good idea

Ivett Paulovics:MFSD's mediation services are offered online or offline.

Greg Shatan:If a full complaint is required, it would make sense for a full answer to be required as well. (Note that we haven't defined what a regular complaint, a full complaint or a skeletal complaint is.)

Brian Cimboric:I don't think anyone is suggesting binding mediation. mediation is by its nature voluntary and only settles a dispute if both parties agree

George Kirikos:Right, even the PDDRP isn't a binding arbitration, given that either side can go to court at any time.

Mary Wong:The Nominet suggestion came from Paul Keating, I believe.

Paul McGrady:Mediation is inherently non-binding.

J. Scott Evans:Doesn't most mediation result in a binding settlement understanding between the parties?

Ivett Paulovics:@Paul - EU Mediation Directive provides that Member States may implement the Directive requiring mandatory mediation for certain matters.

Brian Cimboric:J. Scott - only if the parties agree

Lori Schulman:Mediation is binding if you agree that it is binding. Otherwise, I think that it is presumed nonbinding.

Paul McGrady:We can also go outside of ICANNland for input on this. For example, JAMS is a significant mediation provider in the US who may be willing to be brought into this thought process.

Brian Cimboric:If the parties can't come to a result, then the mediation ends and you proceed to the next step in the process (either lawsuit or arbitration).

Ivett Paulovics:And under EU Directive agreement is enforceable in the 28 Member States.

George Kirikos:What's also good is that mediation can help to narrow the issues in dispute, making any continuing PDDRP less complex.

Paul McGrady:The agreement to mediate may be binding, correct. But the outcome of mediation is inherently not binding. That would be arbitration.

Ivett Paulovics:27 (-1) sorry

J. Scott Evans:Okay. Thanks Paul & Lori.

George Kirikos:Here's the FAQ on Ontario's Mandatory Mediation Program:

https://www.attorneygeneral.jus.gov.on.ca/english/courts/civil/fact_sheet_mandatory_mediation.pdf

J. Scott Evans:Got it.

Mary Wong:@Paul, unless there is a formal agreement reached as a result of the mediation process, right?

Paul Keating:@Kathy, A full complaint is required because the claim must be fully understood, gamesmanship must be avoided AND, most importantly, the provider must be there to provide the structure to the mediation

Paul McGrady:@Mary, no. Mediation is a mechanism to reach settlement or at least agreement on what issues will be left out of arbitration or litigation. Agreeing to the decision of a neutral is not mediation, it is arbitration.

Justine Chew:I agree with Paul

George Kirikos:Page 8 mentions the costs of mediation -- \$600 (CAD) for up to 3 hours.

Steve Levy:Nominet requires a full complaint and response before its 10-day mandatory period

Mary Wong:@Paul, understood; I was just thinking that IF the result of a mediation is more than just what issues are left to adjudicate but is in fact an agreement between the two parties (e.g. a settlement as noted by J Scott), then that would be a binding agreement in that circumstance.

Steve Levy:sorry, mandatory mediation period

George Kirikos:In Ontario, they don't do the mediation until after the first defence is filed.

Paul Keating:sorry but no. I am in a nosy space.

Paul Keating:I can try but in a few minutes.

George Kirikos:(unless the parties agree otherwise)

Paul Keating:yes, that was my suggestion.

Greg Shatan:The parties can agree between themselves as a result of mediation. Indeed, that seems to me the primary goal of mediation.

Mary Wong:So one question for the WG is whether the possible results of a mediation here under the PDDRP might be limited to just agreement on remaining issues (per Paul) and nothing more.

Steve Levy:i've used Nomonet's mediation process a number of times and am familiar with their mediators

Greg Shatan:Paul, nosy or noisy?

Paul McGrady:Having trouble with audio

George Kirikos:Did you find them effective, Steve?

Paul Keating:They run a DRS process that takes place once the complaint and response has been filed. It is thereafter a typical mediation process handled by Nominet. The matter is either resolved or proceeds to decision by a panel.

J. Scott Evans:no Paul

Terri Agnew:@Paul McGrady, we are unable to hear you, please let me know if you need a dial out on the telephone

Lori Schulman: 866-692-5726 RPM

Steve Levy:Nominet charges no fee if the matter is resolved through mediation. Not sure this would translate well to other providers

J. Scott Evans:Both the Forum and WIPO have mediation services and we might get their input on how mediation could be used.

Terri Agnew:Sync is turned on, everyone can scroll themselves

Mary Wong:@Steve, @Paul K - by "resolved" that would include an agreement to settle the matter, so no further proceeding?

Paul Keating:"resolved" can be by 1. complaint withdrawn, 2. settlement (typically purchase of the domain) or 3. decision to forward the claim and response to the panel for formal decision

Mary Wong:Thanks, Paul.

Paul Keating:@Kathy, sorry about audio. I can speak now but I don't believe it is really needed now. Please advise.

Philip Corwin:What is the distinction between 1st and 2nd level complaint? Doesn't any complaint have to allege and document lots of infringing domains?

George Kirikos:The language for 'consolidated complaints' seems slightly different in the UDRP vs. the PDDRP.

Mary Wong:Would we need to distinguish between filing a class action vs joining an action vs consolidating various claims?

Petter Rindforth:That must be up to TM owners to reach out to others

Neda Shahghasemi (Forum):That is correct Kathy

George Kirikos:If the complaints to the ICANN compliance became public, that would help multiple complainants find each other more easily.

Rebecca Tushnet:I agree with Peter Rindforth. That's how most disputes work.

Mary Wong:@Phil - the language in the PDDRP re top and second level infringement is different.
Mary Wong:Viz. For infringement at the top level:Trademark owner must show that Registry Operator's affirmative conduct in its operation or use of its gTLD string (which is identical or confusingly similar to the complainant's mark), causes or materially contributes to the gTLD infringing the complainant's mark
For infringement at the second level:Trademark owner must show that, through the Registry Operator's affirmative conduct, there is a substantive pattern or practice of specific bad faith intent to profit from the sale of domain names that infringe the complainant's trademark

Jon Nevett:Think the PDDRP Rules contemplate consolidation -- 13.3 In the case where either party requests a three-member Expert Panel, each party (or each side of the dispute if a matter has been consolidated) . . .

Steve Levy:I share Paul's experience. Very efficient process (though I once had a case that took nearly 3 mos to complete)

Mary Wong:@Kathy, we will refer to the transcript for the full details. The Notes are intended to capture action items and specific suggestions.

Bradley Silver:I dont what we are talking about is a "class action" in the sense that it is an action brought by one party on behalf of a collective group - where the group is defined by anyone who might have been injured by the particular action. What we are talking about is the concept of consolidating actions brought by specific parties (individual trademark owners) who are directly injured by the activity.

Paul McGrady:@Kathy, J Scott and Mary, if you decide to do a break out work stream on Mediation, I would be happy to lead or co-lead.

Mary Wong:@Bradley, that's what I was wondering - hence my earlier question as to a possible distinction between these various terms (class action, joinder, consolidation).

Mary Wong:Thanks Paul M!

Philip Corwin:Thx for delineating 1st from 2nd level, Mary

Philip Corwin:very helpful statements, paul

George Kirikos:Lots of hands up, in case Kathy isn't watching the Adobe.

Kathy Kleiman:I'm watching George :-)

George Kirikos::-)

Beth Allegretti:Yes, let's call it "consolidation" rather than "class action".

George Kirikos:Consolidation implies there were multiple independent disputes, that were later turned into a single dispute.

Bradley Silver:Agree with Greg regarding the need for a process to allow multiple complainants to show a pattern or practice. (Suggest we avoid using the term "class action" which has different connotation in the context of US law.)

Paul McGrady:By "class action" we mean that there is a single representative for many others similarly situated. That seems to me to be a stretch in these circumstances, since trademarks are very fact specific. Also, it could preclude a filing by a better situated complainant or a better represented complainant. I think multiple complainants is different from class action. I think multiple consenting complainants seems reasonable.

George Kirikos:Class action is a single dispute, where one complainant represents an entire class of complainants. Slight differences.

George Kirikos:+1 Paul McGrady.

Salvador Camacho Hernandez:Yes!

Salvador Camacho Hernandez:+1 Paul McGrady

George Kirikos:The parties need not use mediators provided by NAF/WIPO -- they can agree on someone else.

Paul McGrady:@All, sorry I have to drop off shortly.

Susan Payne: Taking my hand down as Greg is making the point I was going to make - important to also bear in mind that the pattern or practice probably will be across multiple brands and multiple brand owners. Unless you are a brand owner with a huge portfolio and it is your brands which have been targeted a single brand owner may not be able to meet (b) the registry operator's bad faith intent to profit from the systematic registration of domain names within the gTLD that are identical or confusingly similar to the complainant's mark. This systematic registration of such names is unlikely to be targeting a single brand.

Greg Shatan: If we have 200 trademark owners, all of whom have been (allegedly) victimized by a common pattern or practice, we should not require each to be a participant in the process. There are all sorts of issues raised by that requirement, creating a forced club of complainants. However, we would need to require some way to prove that you are (factually) part of the class.

Jon Nevett: Greg, why would all 200 want to file -- they can't get damages

Paul McGrady: @Greg, Class actions have specific defenses, for example that the class representative does not truly represent the whole class. This is an odd cul de sac we are going down that we don't have to go down since multiple consenting complainants solves the problem of efficiency.

George Kirikos: Question: If we allow a class-action approach, and the registry wins a dispute, would that necessarily preclude a 2nd PDDRP? (since the matter would have been deemed determined by the 1st PDDRP)?

Mary Wong: The WG might want to consider pros/cons of introducing litigation-like requirements/definitions/mechanisms into the PDDRP.

Greg Shatan: We don't necessarily need to style this as a full blown "class action".

George Kirikos: A better situated complainant might feel that the issues weren't properly handled in that first PDDRP....

Paul McGrady: We should avoid the term "class action" since it has an independent meaning outside of ICANN land.

Paul McGrady: Bye all. Sorry to have to leave.

George Kirikos: Ok, a "group action", in other words.

Philip Corwin: Excellent discussion and great job chairing, Kathy. regrets that I must depart at this time.

Bradley Silver: @paul Keating, in the real world, IP owners often collaborate in bringing legal actions against a single party, where their rights are being infringed.

J. Scott Evans: While I appreciate Paul's comments, he is ignoring the high burden of proof and the narrow cases that the PDDRP is designed to remedy.

George Kirikos: @Bradly: Yes, especially music/movie copyright infringement.

Mary Wong: ICANN Compliance and GDD provide regular updates on enforcement, rates and complaints etc. to the contracted parties as well as other interested stakeholder groups, I believe.

Maxim Alzoba (FAITID): We might also request that ICANN Compliance accompany it with negative results of escalation too

George Kirikos: Bradley, even.

Mary Wong: As well as a monthly dashboard/report: <https://features.icann.org/compliance>

Statton Hammock: Yes Mary, I was typing this same statement when yours popped up. ICANN Staff briefs regularly on compliance enforcement actions.

Mary Wong: Thanks, Statton.

Statton Hammock: This is an important point, We should not be guessing what is happening with registry and registrar compliance, we can all see what is happening. It's quite transparent, actually.

George Kirikos: Other ways = getting affidavits/evidence from those 3rd parties

Justine Chew: submit as evidence

George Kirikos: Right. One would need more liberal page limits, perhaps, to ensure all that evidence can be submitted.

Jon Nevett:if complainants want to bring a RICO case or a class action, couldn't they just go to a court that is equipped to deal with those kinds of complex litigation?

Greg Shatan:Bottom line: We need a method to bring in all instances that could demonstrate a "pattern or practice," whether or not the complainant is involved in those instances.

Justine Chew:@Mary, please include as action required of WG.

George Kirikos:Question: Should we also allow PDDRP complaints that target multiple TLDs simultaneously, in a single dispute? (e.g. some groups of TLDs share common ownership, e.g. Donuts, Famous Four, etc.)

Mary Wong:@Justine - sorry, what specific action did you mean? Thanks!

Maxim Alzoba (FAITID):@George, it will open door for money extortion

Mary Wong:The document is unsync'ed - please see the last page for this topic.

Justine Chew:@Mary, what you mentioned to be read

Terri Agnew:call for the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group is scheduled for Wednesday, 27 July 2016 at 21:00 UTC for 60 minutes.

Mary Wong:Thanks, Justine - noted!

Paul Keating:thank you all and particularly to Mary for keeping up wiht everything today. :-)

Maxim Alzoba (FAITID):bye all

Steve Levy:Thanks all!

Greg Shatan:George, if there's a common pattern or practice that spans multiple registries, it makes great sense to consolidate them into a single action. The alternative is alarming,....

Paul Tattersfield:thanks all bye

Yuri Chumak:Thank you

Greg Shatan:Bye all!

John McElwaine:bye

Salvador Camacho Hernandez:☺Bye!

J. Scott Evans:thanks and ciao

George Kirikos:Bye everyone.