

FOLLOW UP QUESTIONS FOR TM-PDDRP PROVIDERS FROM THE GNSO'S REVIEW  
OF ALL RIGHTS PROTECTION MECHANISMS (RPMS) IN ALL GTLDS POLICY  
DEVELOPMENT PROCESS (PDP) WORKING GROUP

**1. Do you think that the Trademark Post Delegation Dispute Resolution Procedure (TM-PDDRP) in its present form permits or does not permit the filing of a joint complaint by multiple different trademark holders, even against the same registry operator for the same allegedly infringing behavior in respect of different trademarks?**

Mirroring the UDRP Rules, the PDDRP indicates that panels shall render their decision in accordance with the Procedure, Rules, and any rules and principles of law considered applicable.

Drawing on guidance from some 15 years of UDRP cases, insofar as joint complaints are concerned, it is well-accepted that both corporate affiliates, and separate but commonly aggrieved trademark owners, may file a joint complaint. Addressing the latter scenario in the UDRP context, panels have looked at whether the particular facts and circumstances of a case support a claim that:

- (i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion; and
- (ii) it would be equitable and procedurally efficient to permit the joinder.

Given that a panel will not be in a position to address these questions until it is appointed, subject to the panel's ultimate authority on the matter, on receipt of a joint UDRP complaint involving separate but commonly aggrieved trademark owners the WIPO Center would consider whether the above criteria are prima facie satisfied.

We see no reason the PDDRP framework should not also support such approach.

**2. Under your Supplemental Rules, does consolidation of several complaints by the same trademark owner against different registry operators present any procedural limitations? If so, what are these limitations?**

The PDDRP (paragraph 13.3), PDDRP Rules (paragraph 3(g)), and WIPO Supplemental PDDRP Rules (paragraph 12) mention consolidation of cases involving the same registry operator. The PDDRP defines a registry operator as including entities under common control. Therefore, a PDDRP case seeking to consolidate claims against related registry operators under common control is foreseeable.<sup>1</sup>

On the other hand a PDDRP case seeking to consolidate claims against different registry operators would seem to meet a (substantive) limitation insofar as they would not be under common control.

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<sup>1</sup> Supporting this, as described in the WIPO Overview 2.0, panels in UDRP cases proposing consolidation in a case involving nominally different respondents look to whether: (i) there is apparent common control between such registry operators; and (ii) the proposed consolidation would be fair and equitable to all parties.

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**3. Under your Supplemental Rules, is consolidation of several complaints by different trademark owners (including unaffiliated entities) against the same registry operator permitted? If so, what are the limitations?**

Broadly speaking the WIPO Supplemental PDDRP Rules would be applied in connection with the PDDRP Procedure and Rules.

As reflected in the WIPO Overview 2.0, UDRP panels faced with the question of a potential consolidated proceeding look at whether the particular facts and circumstances of each case support a claim that:

- (i) the complainants either have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants' individual rights in a similar fashion; and
- (ii) it would be equitable and procedurally efficient to permit the consolidation.

Given that a panel will not be in a position to assess these questions until after it is appointed, the WIPO Center would assess – subject to the panel's ultimate authority on the matter – on receipt of complaints proposed to be consolidated, whether the above criteria are prima facie satisfied. *In practice however, such complaints are typically filed jointly at first instance (as opposed to being joined after filing).*

We see no reason the PDDRP framework would not support such approach.

**4. What is your view on the proposal to add the express possibility of a joint complaint to the TM-PDDRP and/or your Supplemental Rules? The Working Group notes that one goal of such an option could be to clarify pre-filing and post-filing consolidation of complaints and minimize any administrative burdens of consolidation on Providers while also maximizing efficiency and cost-effectiveness for complainants. If this option is added, what in your view would be the limitations (if any)? If you do not think this would be a useful addition, what are the reasons?**

Noting the approaches outlined in reply to questions 1 and 3 above, while not in our view strictly necessary, adding language to the PDDRP and PDDRP Rules (and WIPO Supplemental PDDRP Rules) to expressly address joint and consolidated complaints may be useful insofar as it could provide clarity to potential filing parties.

We note here that both a joint complaint, and consolidated proceedings involving multiple separate complaints seek to achieve a degree of procedural efficiency. Given that both such scenarios involve a commonality of claims, parties would likely also benefit from reasonable consistency in terms of outcome.

We also note here that the very nature of the PDDRP as a higher-level enforcement mechanism, seeks to address conduct that may well impact multiple trademark owners.

Supporting this notion, the PDDRP speaks of “registration of domain names”, “a pattern or practice of actively and systematically encouraging registrants”, and “infringing registrations” all in the plural.