

CCT-RT DISCUSSION PAPER WORKSHEET

HIGH LEVEL QUESTION 1:

Topic 1: Has the New gTLD Program put mechanisms in place to improve trustworthiness in the DNS? Description of the Rights Protection Mechanisms "RPMs"

OWNER: David Taylor

Date: 28/10/2016

SUB-QUESTIONS:

1. What mechanisms existed prior to the new gTLD program?
2. What new mechanisms were created or put in place for the new gTLD program?

FINDINGS:

Other than action before the Courts, the RPM that existed prior to the 2012 new gTLD expansion was the UDRP. The Uniform Domain Name Dispute Resolution Policy (UDRP) is an alternative dispute resolution procedure adopted by ICANN on 26 August 1999 that applies to all generic Top Level Domains (gTLDs). It was clear as early as 2009 that the trademark community had strong concerns that this mechanism alone would be insufficient to protect trademark rights sufficiently with a much wider opening of the DNS.

At the 2009 ICANN Mexico City Open Meeting, ICANN Board Chair Peter Dengate-Thrush said, "The Board has clearly heard and believes strongly that the concerns of trademark holders must be addressed before this process is opened for applications. The Board went on to establish the Implementation Recommendation Team (IRT).

The IRT was formed by ICANN's Intellectual Property Constituency in accordance with the 6 March, 2009 ICANN Board resolution (<http://www.icann.org/en/minutes/resolutions-06mar09.htm>). The resolution was in response to the request by the community seeking solutions for potential issues for trademark holders in the implementation of new gTLDs. The team reflected experiential and geographic diversity and is comprised of 18 members and two alternates.

The resulting recommendations report on Trademark Protection Issues identified several proposed solutions, including the IP Clearinghouse, Globally Protected Marks List and associated Rights Protection Mechanisms, and standardized pre-launch rights protection mechanisms, the Uniform Rapid Suspension System; Post delegation dispute resolution mechanisms; WHOIS requirements for new TLDs; and use of algorithm in string confusion review during initial evaluation.

After the final report of the IRT was published there was a continued review of the IRT recommendations by the Community and the resulting mechanisms proposed were:

- The Uniform Rapid Suspension System (URS)
- Post-Delegation Dispute Resolution Procedures (PDDRPs)
 - o The Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)
 - o Registry Restriction Dispute Resolution Procedure (RRDRP)
 - o Public Interest Commitments Dispute Resolution Procedure (PICDRP)
- The Trademark Clearinghouse (Sunrise and Claims Service)

In addition there were specific processes put in place concerning the filing of objections to new gTLD applications themselves:

- String Confusion Objection
- Limited Public Internet Objection
- Community Objection
- Legal Rights Objection

Below ~~I have described~~ the mechanisms are described in greater detail:

Description of the RPMs

1. UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY (UDRP)

The Uniform Domain Name Dispute Resolution Policy (UDRP) is an alternative dispute resolution procedure adopted by ICANN on 26 August 1999 that applies to all generic Top Level Domains (gTLDs), including legacy gTLDs (such as .com, .net, .info) as well as new gTLDs, and certain country code Top-Level Domains (ccTLDs) that have adopted it. To be successful under the UDRP, a complainant must demonstrate by preponderance of the evidence, the following three requirements: (i) the domain name registered by the respondent is identical or confusingly similar to a trade mark or service mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith.

A procedure under the UDRP takes approximately 2 months, from the filing of a complaint to a decision. Costs for filing a complaint under the UDRP range between USD 1500 for 1 to 5 domain names (single-member panel) and USD 4000 for 1 to 5 domain names (three-member panel), excluding lawyers' fees. The remedies available under the UDRP are limited to the transfer or cancellation of a domain name. No damages are awarded and there is no appeal mechanism in place. A decision is generally implemented after 10 business days following the notification of the decision, unless court proceedings are initiated in a court of competent jurisdiction.

UDRP complaints are filed electronically with an ICANN-approved dispute resolution provider. To date, the following providers have been approved by ICANN: the Asian Domain Name Dispute Resolution Centre (ADNDRC), the Forum (NAF), World Intellectual Property Organization (WIPO), the Czech Arbitration Court Arbitration Center for Internet Disputes (CAC) and the Arab Center for Domain Name Dispute Resolution (ACDR).

2. UNIFORM RAPID SUSPENSION SYSTEM (URS)

The Uniform Rapid Suspension System (URS) is an alternative dispute resolution procedure launched in 2013 that was originally designed for clear-cut cases of cybersquatting under new generic Top Level Domains (gTLDs), although it has been voluntarily adopted by a handful of ccTLDs and "sponsored" TLDs (such as .pw, .travel, .pro and .cat). The substantive requirements under the URS are similar to those under the UDRP, although the required burden of proof is heavier ("clear and convincing evidence", as opposed to "preponderance of the evidence"). A complainant must thus prove the following 3 requirements: (i) that the domain name is identical or confusingly similar to a word mark: (a) for which the Complainant holds a valid national or regional registration and that is in current use; or (b) that has been validated

through court proceedings; or (c) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed (1.2.6.1 of the URS); (ii) that the registrant has no rights or legitimate interests in the domain name; and (1.2.6.2 of the URS) and (iii) the domain name was registered and is being used in bad faith (1.2.6.3 of the URS). Complaints are limited to 500 words. The URS is intended for the most clear-cut cases of cybersquatting and so it is generally not appropriate for domain name disputes involving more complex, genuine contestable issues (such as fair use).

The only remedy available under the URS is the suspension of the domain name, as opposed to the transfer or cancellation (which are remedies available under the UDRP).

Under the URS a domain name may be suspended in as quickly as 3 weeks from the filing of a complaint. In the event of a favourable decision for the complainant, the domain name is suspended for the remainder of the registration period (which may be extended for an additional year). The website will display a banner stating "This Site is Suspended" but the Whois for the domain name will continue to display the information of the original registrant (except for the redirection of the nameservers). If the decision in favour of the complainant was a judgment by default, the registrant may seek a *de novo* review by filing a response up to 6 months after the notice of default (which may be extended by 6 additional months upon request by the registrant).

In the event the decision is denied, the URS provides for an appeal mechanism based on the existing record.

Costs for filing a URS complaint are around USD 375 (for 1 to 14 domain names).

Only three providers have so far been accredited for the URS: the Asian Domain Name Dispute Resolution Centre (ADNDRC), the Forum (NAF) and MSFD Srl (based in Milan, Italy).

3. POST-DELEGATION DISPUTE RESOLUTION PROCEDURES (PDDRP)

Post-Delegation Dispute Resolution Procedures are rights protection mechanisms that have been designed to provide relief against a new gTLD Registry Operator's conduct (as opposed to a domain name registrant or registrar). There are three PDDRPs:

3.1 The Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) allows a trade mark holder to file a complaint against the Registry Operator for its involvement in trade mark infringement either at the top or second level of a new gTLD.

At the top level, a complainant must demonstrate by "clear and convincing evidence" that "the registry operator's affirmative conduct in its operation or use of a new gTLD that is identical or confusingly similar to the complainant's trade mark, causes or materially contributes to the gTLD doing one of the following: (a) taking unfair advantage of the distinctive character or the reputation of the complainant's trade mark; or (b) impairing the distinctive character or the reputation of the complainant's trade mark; or (c) creating a likelihood of confusion with the complainant's mark" (paragraph 6.1 of the TM-PDDRP).

At the second level, complainants are required to demonstrate by "clear and convincing evidence" that "through the registry operator's affirmative conduct: (a) there is a substantial pattern or practice of specific bad faith intent by the registry operator to profit from the sale of trade mark infringing domain names; and (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, which: (i) takes unfair advantage of the distinctive character or the reputation of the complainant's trade mark; or (ii) impairs the distinctive character or the reputation of the complainant's trade mark, or

(iii) creates a likelihood of confusion with the complainant's trade mark" (paragraph 6.2 of the TM-PDDRP).

If the Registry Operator is found liable by the expert panel, a number of remedies may be recommended, including remedial measures to prevent future infringing registrations; suspension of accepting new domain name registrations in the gTLDs at stake until the violation has ceased or for a set period of time prescribed by the expert; or termination of the Registry Agreement, in extraordinary circumstances, where the Registry Operator has acted "with malice" (paragraph 18 of the TM-PDDRP). Ultimately, ICANN has the authority to impose the remedies it deems appropriate, if any.

To date, ICANN has appointed the following dispute resolution providers to resolve disputes under the TM-PPDRP: the Asian Domain Name Dispute Resolution Centre (ADNDRC), the Forum (NAF), and World Intellectual Property Organization (WIPO).

3.2 **Registry Restriction Dispute Resolution Procedure (RRDRP)**, allows an established institution to file a complaint against a community-based new gTLD Registry Operator for failing to meet registration restrictions set out in its Registry Agreement. For a claim to be successful, a complainant must demonstrate by "preponderance of the evidence" that: "(i) the community invoked by the objector is a defined community; (ii) there is a strong association between the community invoked and the gTLD label or string; (iii) the TLD operator violated the terms of the community-based restrictions in its agreement; (iv) there is a measureable harm to the Complainant and the community named by the objector". The remedies recommended by the expert panel are similar to those prescribed under the TM-PDDRP. Ultimately, ICANN has the authority to decide whether to impose such remedies.

3.3 **Public Interest Commitments Dispute Resolution Procedure (PICDRP)**, allows any person or entity (the "reporter") to file a complaint against a new gTLD Registry Operator for failure to comply with the Public Interest Commitment(s) in Specification 11 of its Registry Agreement. The Reporter must file a "PIC report" with ICANN by completing an online form. The "PIC Report" must (i) identify which PIC(s) form the basis for the report, (ii) state the grounds for non-compliance with one or more PICs and provide supporting evidence and (iii) state how the "reporter" has been harmed by the alleged noncompliance. ICANN may undertake a compliance investigation or invoke a "Standing Panel". If the Registry Operator is found to be not in compliance with its PIC, it will have 30 days to resolve its noncompliance. If the Registry Operator fails to resolve the noncompliance issues, ICANN will determine the appropriate remedies.

4. **TRADEMARK CLEARINGHOUSE (TMCH)**

The Trademark Clearinghouse (TMCH) is a centralized database of verified trademarks from all over the world mandated by ICANN to provide protection to trade mark holders under the new gTLDs. The TMCH performs several important functions, including authenticating and verifying trade mark records, storing such trade mark records in a database and providing this information to new gTLD registries and registrars. The data contained in the TMCH supports rights protection mechanisms such as Sunrise Services (which provide an opportunity to trade mark holders to register domain names corresponding to their trade marks prior to general availability) and the Trademark Claims services (a notification service to domain name registrants and trade mark holders of potentially infringing domain name registrations). Registration of a trade mark with the TMCH is required to be able to participate not only in the Sunrise Period and Trademark Claims services but also in other registry-specific rights protection mechanisms such as domain name

blocking mechanisms such as Donuts' Domain Protected Marks List (DPML) (although it is optional for other RPMs, such as the URS). The TMCH is therefore an important tool to protect trade mark rights under the new gTLD program.

Description of ~~the~~The Objections

To be completed

- String Confusion Objection
- Limited Public Internet Objection
- Community Objection
- Legal Rights Objection

CAUSES:

PRIORITY TO ADDRESS:

RECOMMENDATIONS:

REVIEW:

DRAFT