Adobe Connect chat transcript for Thursday, 30 March 2017

Michelle DeSmyter 2:Dear All, Welcome to the IGO-INGO Access to Curative Rights Protection Mechanisms Working Group call on Thursday, 30 March 2017 at 16:00 UTC.

Michelle DeSmyter 2:Meeting

page: <u>https://urldefense.proofpoint.com/v2/url?u=https-</u>

3A community.icann.org x B8TRAw&d=DwICaQ&c=FmY1u3PJp6wrcrwll3 mSVzgfkbPSS6sJms7xcl4I5cM&r=8 WhWIPqsLT6TmF1Zmyci866vcPSFO4VS hFqESGe_5iHWGIBLwwwehFBfjrsjWv9&m=NTuVtUjqjYjSq1pcSRZ2x5liW41 M_JglnxE366xnAEA&s=pemTangnTpYAJb96dx3A0b_IFIPgleiFsfn1hqfgrng&e

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George Kirikos:Hi folks.

Petter Rindforth:Hi there!

George Kirikos: Hi Petter. How are you today?

Petter Rindforth: Busy day, and still snow in Stockholm :-)

George Kirikos: A little bit of snow can be nice!

George Kirikos:But, too much is awful.

Dennis Chang:Loved Stockholm in snow last week. Beautiful!

George Kirikos: Where do you reside, Dennis? (I'm in Toronto, so we get 4 proper seasons, including snow in winter) :-)

Dennis Chang:Los Angeles. Visited Stockholm on my way back from Copenhagan.

George Kirikos:Nice....I guess it's sunny all year, for you.

Dennis Chang:let's see. 22 degrees Sunny. today.

George Kirikos: Maybe blast out an email reminder?

Mary Wong:@George, will do

Paul Tattersfield:Hello everyone

George Kirikos:Welcome, Paul.

Lori Schulman:Hi'

Lori Schulman:No sound on phone

George Kirikos:Hi Lori.

George Kirikos:No one's talking at the moment. :-)

Paul Tattersfield: Hi George, did you follow the football? - You were very unlucky in the last minute

Lori Schulman:Now I have sound.

George Kirikos:Echo, echo.

George Kirikos:Someone needs to mute (*6 to mute/unmute).

George Kirikos: I don't know how it compares to other working groups, but overall we've had pretty good attendance from the "core" group members: <u>https://urldefense.proofpoint.com/v2/url?u=https-</u>

3A community.icann.org_display_gnsoicrpmpdp_Attendance-2Blog-2B-2D-2BIGO-2DINGO-2BAccess-2Bto-2BCurative-2BRights-2BProtection-2BMechanisms-2BWorking-

2BGroup&d=DwICaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I5cM &r=8_WhWIPqsLT6TmF1Zmyci866vcPSFO4VShFqESGe_5iHWGIBLwwwehF BfjrsjWv9&m=NTuVtUjqjYjSq1pcSRZ2x5liW41M_JglnxE366xnAEA&s=Si8UXJ IEC5cFUQkJs9mf9GXP4UimNOX7y_D9EVwQuL0&e=

Mary Wong: The Working Group co-chairs have the discretion to reschedule a call if they don't believe a sufficient quorum has been reached.

George Kirikos:Jay Chapman and Paul Keating are often here....maybe just running a little late.

Mary Wong: We have 35 as of today

Paul Tattersfield: I'm planing on submitting comments shortly - I just need to tidy the footnotes

George Kirikos: Up to 36 now, actually.

George Kirikos:<u>https://forum.icann.org/lists/comments-igo-ingo-crp-access-initial-20jan17/</u>

Mary Wong:Oops, thanks George

George Kirikos:Some changes to the recommendations might not be necessary -- might need more elaboration/explanation, though, to enhance the final document.

Paul Tattersfield:about 6 me too comments

Jay Chapman:Forgive my tardiness...hello everyone

George Kirikos:Welcome Jay.

Jay Chapman: hi George

Lori Schulman: That is an important acknowledgement by IGOs

George Kirikos: Is the GAC saying that the "claims notice" should apply to just new gTLDs (i.e. via the TMCH), or would they want it to apply to legacy gTLDs like com/net/org ?

Mary Wong:@George, I believe the GAC advice has consistently been for new gTLDs (and for future rounds). However, the original PDP - and hence ours - covers both legacy and new gTLDs.

George Kirikos: Right, thanks Mary.

George Kirikos:At least 1 IGO (namely WIPO) is actively involved in the other working group (dealing with UDRP/URS reform, once we get there).

George Kirikos:reform/review, even

George Kirikos: The list ICANN/GAC created was arbitrary.

Mary Wong: It was based on the .int criteria

George Kirikos:.INT says "Only one registration is allowed for each organization", see: https://urldefense.proofpoint.com/v2/url?u=https-

3A www.iana.org_domains_int_policy&d=DwICaQ&c=FmY1u3PJp6wrcrwl I3mSVzgfkbPSS6sJms7xcl4I5cM&r=8_WhWIPqsLT6TmF1Zmyci866vcPSFO4V ShFqESGe_5iHWGIBLwwwehFBfjrsjWv9&m=NTuVtUjqjYjSq1pcSRZ2x5liW41 M_JglnxE366xnAEA&s=XU8sAYn2ZyLqwovjDV-

1aTAyG2MXi1bhgX2pBjxXoDs&e=

George Kirikos:Yes, the ICANN reserved list for IGOs have multiple reserved strings for some (many) organizations. At least the Article 6ter database is transparent/open.

George Kirikos:Yes=Yet

George Kirikos:Some of the governments (USA) suggested some organizations claim to be "IGOs", but aren't real IGOs!! (she didn't say which ones are fake, though!)

Jay Chapman:exactly Phil

Paul Tattersfield:would it be possible to get a list of those organizations George?

George Kirikos:Even under UDRP, TM rights are territorial. So, a Belgium TM isn't recognized by Canada, but a Belgium TM holder can file a UDRP against a Canadian domain name owner.

George Kirikos:@Paul: she didn't identify which ones she was talking about.

George Kirikos:For the "facilitate continued discussions", are the IGOs going to participate in this WG more than they have to date?

Lori Schulman: IGO participation would be very welcome

Lori Schulman: The absence of the IGO's has hindered the work IMHO Philip Corwin: @Lori--I wouldn't hold your breath ;-)

George Kirikos:Agreed, Lori. We also had 1 GAC member in this IGO (the gentleman from Jamaica).

George Kirikos: It looks like he's become just an Observer now, though (Gary Campbell): <u>https://urldefense.proofpoint.com/v2/url?u=https-</u>

3A community.icann.org pages viewpage.action-3FpageId-

3D48347895&d=DwICaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I 5cM&r=8_WhWIPqsLT6TmF1Zmyci866vcPSFO4VShFqESGe_5iHWGlBLwww ehFBfjrsjWv9&m=NTuVtUjqjYjSq1pcSRZ2x5liW41M_JglnxE366xnAEA&s=_F QfEwN8Qr91XosEdZimjqKAzFpi-hGGi8Q3AEHwqX8&e=

Lori Schulman: I know, no breath holding...but I have emphasized this point at every opportunity

Lori Schulman: If IGO's are not here then my organization is not open to my spending too much more time on this

Mary Wong: At this stage in our work, perhaps we can consider the many public comments submitted (including the +1s) as a form of participation.

Philip Corwin: If ICANN had a sargent-at-arms we culd compel their participation ;-)

George Kirikos:The organizations can still rely on their common law rights, though (i.e. their names), even if not registered in the Article 6ter database. George Kirikos:Standing is such an easy test to meet.

Lori Schulman: Its actually not so easy

George Kirikos:LOL Phil

George Kirikos:For the UDRP, I mean, Lori (not court-level standing). First prong of the UDRP/URS is often called the "standing" test. 99% of the time, that test is passed.

Lori Schulman:that is what we have been grappling with...using a trademark system for adjudicating rights that may not be legally recognized as trademark rigths

Paul Tattersfield:@George its evideencing the non registered rights that makes the work

George Kirikos: Their same position since 2002, Phil.

Lori Schulman:Got it, George

Lori Schulman:Not all jurisdictions recognize common law rights PAUL KEATING:Sorry for being late.

George Kirikos:True, Lori. But, for the UDRP, most panelists aren't sticklers for that level of detail. :-) They care more about the "bad faith" parts of the test.

PAUL KEATING:@Lori, however the UDRP panels traditionally DO recognize common law trademarks.

Lori Schulman: Paul K: Are they doing that for non commonlaw countries? Mary Wong: @Phil, IGO full names will be reserved at the second level -

that was a PDP recommendation adopted by the ICANN Board (currently in

implementation).

Lori Schulman:It's been years since I have handled UDRP work

George Kirikos:France is civil law, right? I'm sure we can find a French

complainant that relied upon a common law right, i.e. unregistered rights. Lori Schulman:Yes, France is civil law.

PAUL KEATING: in teh UDRP context it is sufficient to show rights that would supprot a passing off cliam. That is a far lower standard.

Lori Schulman:Common Law are former UK colonies; US, Canada, Australia, NZ, etc

Paul Tattersfield:@Lori does that matter? Are non common law systems specifically excluded?

Lori Schulman: I don't know. My understanding is that common law rights are only recognized in Common Law jurisdictions

George Kirikos: I found a case, Lori.

George

Kirikos:<u>http://www.wipo.int/amc/en/domains/search/text.jsp?case=D2013</u> -2024

George Kirikos:Does the fact that unregistered trademarks are not recognised as such in France mean that French entities are to be disadvantaged as against entities based in common law countries such as the UK or in civil law countries such as Germany where unregistered trademarks are recognised by statute? The Panel does not think so.

George Kirikos: (and so on) :-)

Lori Schulman:Of course you did. You missed your calling, George. Librarian extraordinaire.

PAUL KEATING:@Phil, are we going to give notice to everyone now? George Kirikos:hehe :-) When I've had litigation, I've helped my own lawyers in finding good precedents that they didn't find.

Mary Wong:@George, @Lori - it may be more appropriate to speak of "registered" and "unregistered" trademarks rather than "common law rights" for the latter.

Paul Tattersfield: Thanks George that is useful

George Kirikos:Yes, Mary.

Lori Schulman: Thanks Mary, agree.

Mary Wong:Regardless, though, the problem Lori noted remains with the UDRP/URS - even unregistered trademarks rely on the Complainant having some form of trademark-type rights.

Petter Rindforth:Compare with .eu ADR: The Complaint shall specify the names in respect of which a right is recognized or established by the national law of a Member State and/or Community law. For each such name, describe exactly the type of right(s) claimed, specify the law or law(s) as well as the conditions under which the right is recognized and/or established. In other words: can be any kind of protected name right in any member state.

Mary Wong:@Petter, yes, so a dispute resolution procedure can conceivably be broader than just trademark rights (registered or otherwise).

George Kirikos:By George :-)

George Kirikos: I think it might have been Bruce Tonkin who gave the WHO Magazine thought experiment.

George Kirikos:Immunity is a defence to an action. It doesn't apply when they're the initiator of the dispute.

George Kirikos:+1 Paul Keating

Paul Tattersfield:exactly they are seeking to use UDRP or URS as a sword to seize assets from third parties as opposed to using UDRP or URS to defend their own assets

George Kirikos:We need to methodically do the work, though, to dot all the i's and cross all the t's.

Lori Schulman:Please remember that the sword is against bad actors. George Kirikos:Alleged bad actors. Even bad actors deserve due process. Lori Schulman:We are not denying due process.

George Kirikos: If it was so easy to identify "bad actors", we need not even have courts. :-)

George Kirikos:36

George Kirikos:37 now.

Paul Tattersfield:Agrreed Lori , however there are better mechanisms than UDRP/URS that can be used for 99% of the bad actors

Lori Schulman:And BTW, there is a case law that says that ADR offers due process. I don't agree with the assumption that only courts provide due process.

George Kirikos:WHO just submitted a "me too" comment.

Lori Schulman:that makes me laugh

Lori Schulman:WIPO comments were quite different from GAS, UNESCO, USG comments

Lori Schulman: I meant GAC. Freudian slip.

Mary Wong:GNSO Council has to approve before it goes to the Board George Kirikos:ADR can be beneficial, but only if both sides consent to it. IGOs want to compel others into a binding process that they've designed ---that's forum shopping.

PAUL KEATING:ok

Petter Rindforth:@Lori - if we talk about WIPO - a number of other IGO's simply replied supporting WIPO's comments

George Kirikos:Here's the GAC

comment: https://urldefense.proofpoint.com/v2/url?u=https-

3A forum.icann.org lists comments-2Digo-2Dingo-2Dcrp-2Daccess-2Dinitial-

2D20jan17_msg00023.html&d=DwICaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkb PSS6sJms7xcl4I5cM&r=8_WhWIPqsLT6TmF1Zmyci866vcPSFO4VShFqESGe_ 5iHWGIBLwwwehFBfjrsjWv9&m=NTuVtUjqjYjSq1pcSRZ2x5liW41M_JgInxE3 66xnAEA&s=kuaT3epyEzWOZC8xHXwQOD5FVEJybvJ7m7Ce4Tc9mp8&e=

George Kirikos: It's 2 pages long.

George Kirikos:That's it.

George Kirikos:Oops, 3 pages, even.

Paul Tattersfield:other entities with the same anacrnyms

George Kirikos:That 3rd parties can use the same acronyms, as long as it's non-infringing.

Mary Wong:+1 George

Lori Schulman: I took it to mean that way Phil described. Can we ask the GAC to clarify?

George Kirikos:But, the IGOs shouldn't be the ones to be determining who is "legitimate", and who is not. e.g. a free speech site criticizing IGOs is protected in the USA, Canada, and other countries.

Mary Wong:@Lori, the WG can request the GNSO Council to include that as a clarifying question in its review of the GAC Communique that is sent to the Board. A draft is being prepared for the Council's 20 April meeting.

George Kirikos:But, IGOs might say "that's not legitimate."

Lori Schulman: I would just like to understand precisely what they mean. Lori Schulman: I am not in favor of rushing though comments.

Paul Tattersfield: I agree Lori

Lori Schulman: I think that the standing would be worked out if there were a separate DRP

Lori Schulman: It might be supplying evidence of the organizing treaty George Kirikos: But, a separate DRP, not grounded in any law, would be creation of brand new law.

George Kirikos: i.e. what is the underlying "legal dispute" that the new curative process for IGOs is attempting to address?

Mary Wong:@George, in 2007 a separate DRP was drafted for consideration that was based on 6ter.

George Kirikos:Right, Mary. But, under Article 6ter, it's NATIONS who are ones with the treaty obligations.

George Kirikos:So, that means it would be the Government of Canada, Government of USA, etc. who would be the complainants.

George Kirikos:But, we know from the State Department letter for

UNIFEM that they said that IGOs should file a TM lawsuit, to enforce rights. George Kirikos:That availability of the courts fulfilled their obligations. George Kirikos:i.e. those were trademark rights, just like the UDRP. George Kirikos:Here was the UNIFEM

stuff: https://urldefense.proofpoint.com/v2/url?u=https-

3A__www.state.gov_s_l_38648.htm&d=DwICaQ&c=FmY1u3PJp6wrcrwll3m SVzgfkbPSS6sJms7xcl4I5cM&r=8_WhWIPqsLT6TmF1Zmyci866vcPSFO4VShF qESGe_5iHWGIBLwwwehFBfjrsjWv9&m=NTuVtUjqjYjSq1pcSRZ2x5liW41M_ JgInxE366xnAEA&s=CME99faBDHf5ORXICJSHN3dHZZo0CBJOHtv-FehE5_0&e=

George Kirikos:". But, as noted in the preceding paragraph, the latter obligation would be met under the laws of general application that the United States has enacted, and it is the responsibility of the party claiming than an infringement has occurred to take action under U.S. law to challenge perceived unlawful use in commerce."

George Kirikos:Also, "For example, the Trademark Act of 1946, as amended, 15 U.S.C. u 1051 et seq., offers the possibility for interested parties to challenge use of marks in commerce based on theories, inter alia, of likelihood of confusion, false association and unfair competition. These laws satisfy U.S. obligations under article 6ter by providing the opportunity for States and international intergovernmental organizations to pursue remedies for the unauthorized use of names and other insignia listed in article 6ter, including in cases involving use on the INTERNET. Responsibility for evaluating potentially infringing use of trademarks and other intellectual property, and for taking enforcement action when deemed appropriate, however, rests with the party whose interests are affected."

Mary Wong:We will send around the draft procedure Petter and I mentioned to the WG by email..

George Kirikos:So, that letter is disagreeing with the notion that they're in a unique category.

Mary Wong:@George, that may be one reason why the USG filed a public comment for our Initial Report - a concern that TM rights not be unduly expanded?

George Kirikos:I'm not sure, Mary. I actually wrote an email to the USG person who authored their position, for my own personaly research, to try to get some explanations on their reasoning, but none was forthcoming.

George Kirikos:*personaly = personal

Paul Tattersfield:exactly

George Kirikos:Policy Guidance is comparable to the WIPO overview -- an independent review of standing, through very thorough background research, more than any individual panelist could afford to do on a simple case.

Mary Wong:@Lori, not from ICANN, no.

George Kirikos:Not from ICANN, Lori. But, WIPO has their Overview of Selected Questions.

George Kirikos:I'm not sure if NAF has any independent training manuals that are similar.

PAUL KEATING:@Lori, there is a "policy" which is the Panel Index 2.0 at WIPO

Mary Wong: It seems to staff that the main objection to Policy Guidance is that it merely interprets - and doesn't expand or amend - the existing UDRP grounds.

Mary Wong: The objection being, when it DOES, then it is not appropriate for Policy Guidance.

Petter Rindforth: I presume that at least the most well-known IGO's can claim unregistered but well-known trademark rights for their names (connected to some services)

Petter Rindforth:...without having to refer to Article 6ter

Mary Wong:@Lori, that is indeed one of the USG concerns.

George Kirikos:+1 Paul Keating

Mary Wong:@Paul K, yes, that was one of the problems highlighted during the GAC-GNSO discussions - that communication under 6ter does NOT go

through any examination by WIPO. And the USG pointed out that only some countries do any further examination.

George Kirikos:6ter might be like unreviewed Benelux TMs. But, there are 2 other prongs to the UDRP, so losing the first rarely matters.

Lori Schulman:USPTO does "examine" 6 ter notices before they hit the register

Mary Wong:@George, losing under the first ground pretty much ends the Complaint.

George Kirikos:Almost always, it comes down to the 3rd prong (bad faith), and occasionaly the 2nd prong.

George Kirikos:Yes, Mary. But, it's rarely ever determinative, is my point. George Kirikos:99% of the time, the first prong is met.

Mary Wong: And that is one of the criticisms of it :)

George Kirikos: It's not like the IGO is going to bring up the mark

"UNESCO", for a dispute over "BABIES.com".

Lori Schulman:Got it Paul K.

George Kirikos: It has to have some resemblance to the domain under dispute, that's all.

Paul Tattersfield: Agree Paul so well put

Lori Schulman: I like the idea of 6ter as an element to prove standing not the sole basis

George Kirikos: The ones who want the "strict" interpretation of Article 6tter want the most liberal rules for everything else, ironically.

George Kirikos: (i.e. creating a brand new binding arbitration has no basis in law whatsoever, if they want to stricly interpret things)

George Kirikos:Some of the constituencies will hopefully comment by the end of today.

Lori Schulman: IPC will

George Kirikos: It might take 2 or 3 calls. We need to be systematic.

Mary Wong:Thanks, Phil - that gives us a bit more breathing room to complete the staff summary!

George Kirikos:We can perhaps continue on the list, for some things. Lori Schulman:I like the idea of relying more on the list

Lori Schulman: I am saturated with ICANN calls like many others

George Kirikos:Yes, 90 mins for the RPM on Wednesdays, and 90 mins for IGOs on Thursdays is a kiiller combo.

Petter Rindforth: I think it is easy to go throgh all comments on a

summarized base

Lori Schulman:my head hurts, literally, from the headphones

George Kirikos: Are you in a big office, Lori?

Lori Schulman:no, I am at home most of the time

George Kirikos: (I have it on speakerphone, but muted, then I switch to the handset when speaking)

Mary Wong: The WG has a responsibility to review all comments - though of course that means that all WG members are presumed to have done so; for the actual calls, the WG can elect to focus only on some.

Lori Schulman:but I have people and activities around me

PAUL KEATING:i surrender

Lori Schulman: Mary, right, we have to review all comments

Lori Schulman:But I like Paul's question: How does this affect the report? Jay Chapman:thanks, all

Lori Schulman: We should ask it for every one,

George Kirikos:So, are we going to do outreach to the IGOs one more time?

Lori Schulman:bye

George Kirikos: (i.e. the facilitated discussion?)

Paul Tattersfield:thanks all bye

PAUL KEATING: thank you all. Have great days

Petter Rindforth: Is there anything else than ICANN in this world? George Kirikos: Bye folks.