



GNSO Review of All Rights Protection Mechanisms (RPMs) in All gTLDs Policy Development Process

Agenda for the session today

1

Overview of the
GNSO Policy
Development
Process (PDP)

2

Overview of this
PDP

3

Status Update & Next
Steps for this PDP

Overview of this PDP

- ⊙ PDP Working Group chartered by GNSO Council to review all existing ICANN trademark rights protection mechanisms (RPMs) in all gTLDs, in two phases

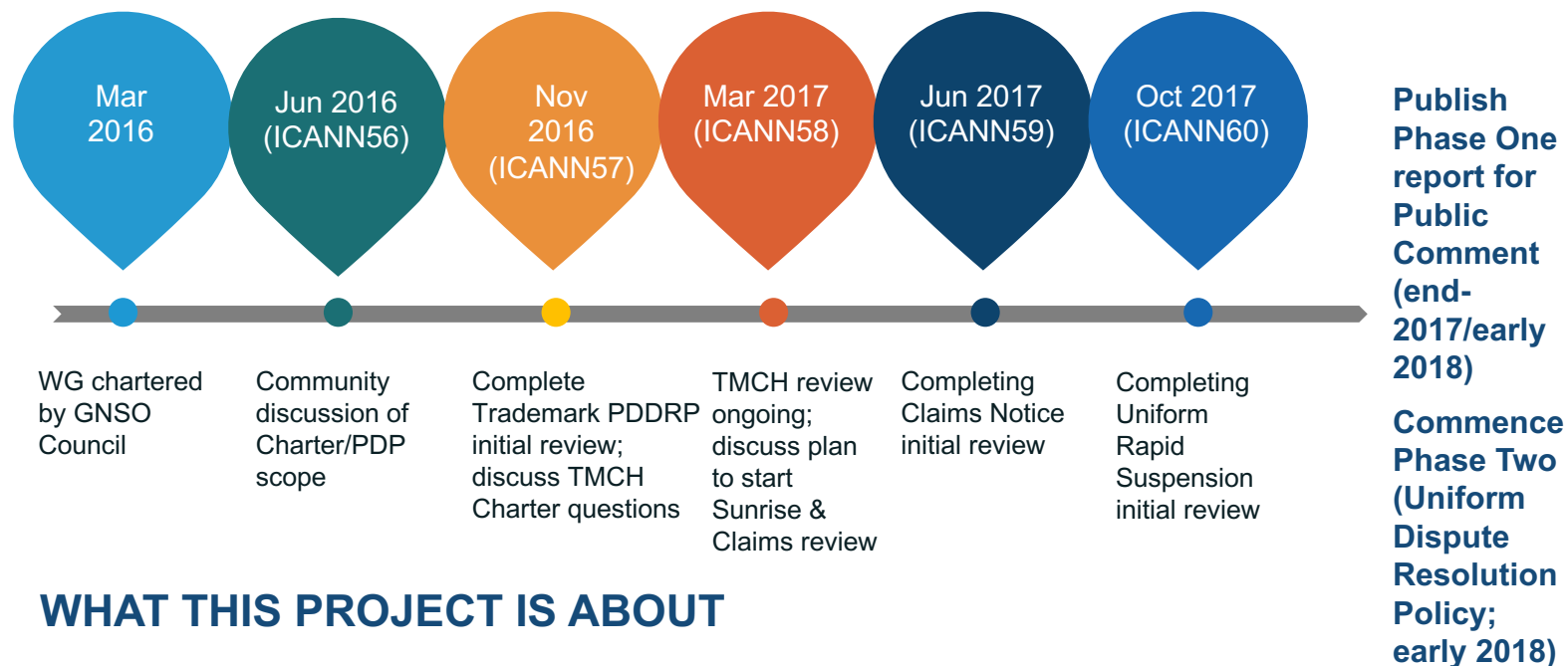
Phase One – all RPMs developed for the 2012 New gTLD Program:

- *Trademark Clearinghouse (TMCH) and associated mandatory RPMs offered through it, i.e. Sunrise Registration Periods and Trademark Claims Notices*
- *Uniform Rapid Suspension dispute resolution procedure (URS)*
- *Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)*

Phase Two – the Uniform Dispute Resolution Policy (UDRP)

- ⊙ Ultimately, the PDP will examine the *“overarching question as to whether all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify the policy goals”*.
- ⊙ Objective is also to create a coherent framework for future RPM reviews

Timeline for the PDP – being conducted in two phases



WHAT THIS PROJECT IS ABOUT

This PDP was chartered by the GNSO Council to review all the Rights Protection Mechanisms (RPMs) that are currently in operation

- Phase One focuses on the RPMs created for the 2012 New gTLD Program
- Phase Two on the 1999 Uniform Dispute Resolution Policy (which applies to all gTLDs).

Status Update

- ⊙ **PDP is currently in Phase One** – Working Group elected to begin work with review of the Trademark Post Delegation Dispute Resolution Procedure (TM-PDDRP)
- ⊙ Working Group completed initial review of TM-PDDRP at ICANN57 (Nov 2016)
- ⊙ **Current work**
 - Completing initial review of Trademark Clearinghouse (TMCH)
 - June 2017 - begin review of Sunrise & Trademark Claims RPMs; followed by Uniform Rapid Suspension (URS) dispute resolution procedure
- ⊙ Aim to **complete Phase One by end-2017/early 2018**
 - No projected date set yet for completion of Phase Two and full PDP

The Phase One RPMs:

Provided through the Trademark Clearinghouse (TMCH):

- **Sunrise Registrations**
- **Trademark Claims**

Other RPMs developed for the 2012

New gTLD Program:

- **Uniform Rapid Suspension (URS) dispute resolution procedure**
- **Trademark Post-Delegation dispute resolution procedure (TM-PDDRP)**

All the RPMs to be reviewed in this PDP

Sunrise Period and Trademark Claims Service

Sunrise services provide trademark holders with an advance opportunity to register domain names corresponding to their marks before names are generally available to the public.

The **Trademark Claims** period follows the Sunrise period and runs for at least the first 90 days in which domain names are generally made available to all registrants that are qualified to register domain names within the TLD.

Uniform Rapid Suspension (URS)

The URS was designed as a complement to the UDRP, to provide trademark owners with a quick and low-cost process to suspend domain names based on the same substantive grounds as the UDRP. It applies only to domain names registered in the New gTLDs.

Post-Delegation Dispute Resolution Procedures (PDDRRPs)

The PDDRRPs provide alternative avenues for a trademark holder who is harmed by a new gTLD registry operator's conduct to obtain redress.

Trademark Clearing House (TMCH)

The Trademark Clearinghouse is a global database of verified trademark information to support rights protection processes. Benefits of inclusion include access to Sunrise Period and Trademark Claims Service.

Uniform Dispute Resolution Policy (UDRP)

The UDRP was created in 1999 and provides a uniform, standardized, alternative dispute resolution procedure to resolve disputes concerning who is the rightful holder of a registered domain name. It is applicable to all domains registered in all generic top-level domains (gTLDs).

Background to the Phase One RPMs

- ⦿ June 2008: ICANN Board adopts GNSO Policy Development Process recommendations for the introduction of New gTLDs
- ⦿ Four overarching issues:
 - *Trademark Protection*
 - *TLD Demand and Economic Analysis*
 - *Security and Stability: Root Zone Scaling*
 - *Potential for Malicious Conduct*
- ⦿ March 2009: ICANN Board [resolution](#) requests:

“... an Implementation Recommendation Team comprised of an internationally diverse group of persons with knowledge, expertise, and experience in the fields of trademark, consumer protection, or competition law, and the interplay of trademarks and the domain name system to develop and propose solutions to the overarching issue of trademark protection in connection with the introduction of new gTLDs.”
- ⦿ IRT publishes [Draft Report](#) for public comment (April 2009) and [Final Report](#) (May 2009)
- ⦿ *Further community work – including by the GNSO [Special Trademark Issues \(STI\)](#) team and in later versions of the Applicant Guidebook – resulted in the current set of RPMs*

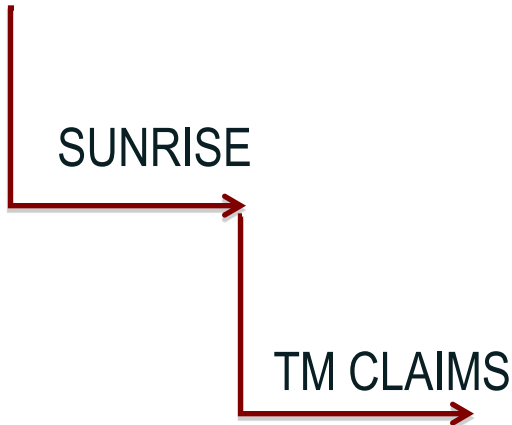
**** The RPMs designed for the New gTLD Program are intended to operate throughout the lifecycle of a gTLD ****

**REGISTRY
LIFECYCLE**

TLD STARTUP  ONGOING OPERATIONS



TM CLEARINGHOUSE



 UDRP
URS

 POST-DELEGATION
DISPUTE PROCESSES

The Trademark Clearinghouse (TMCH)

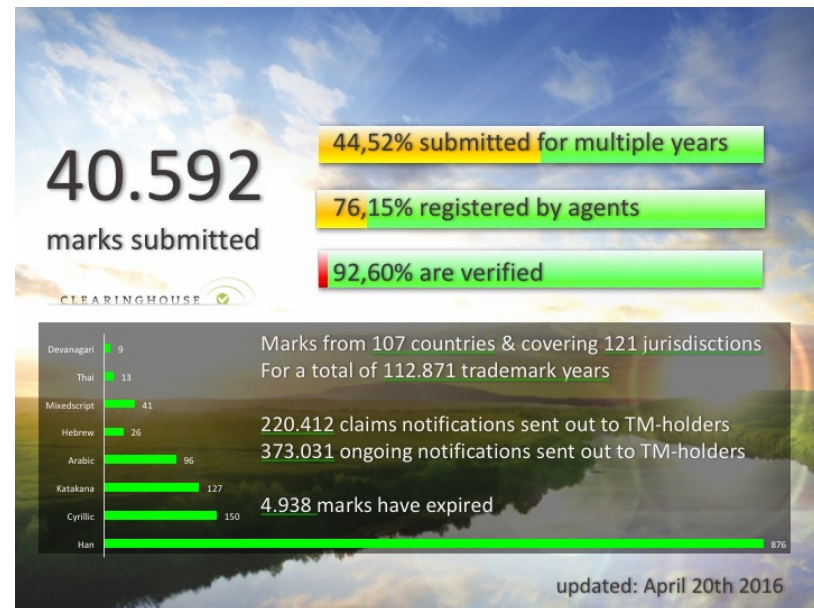
I. The Trademark Clearinghouse (TMCH)

⦿ What is it?

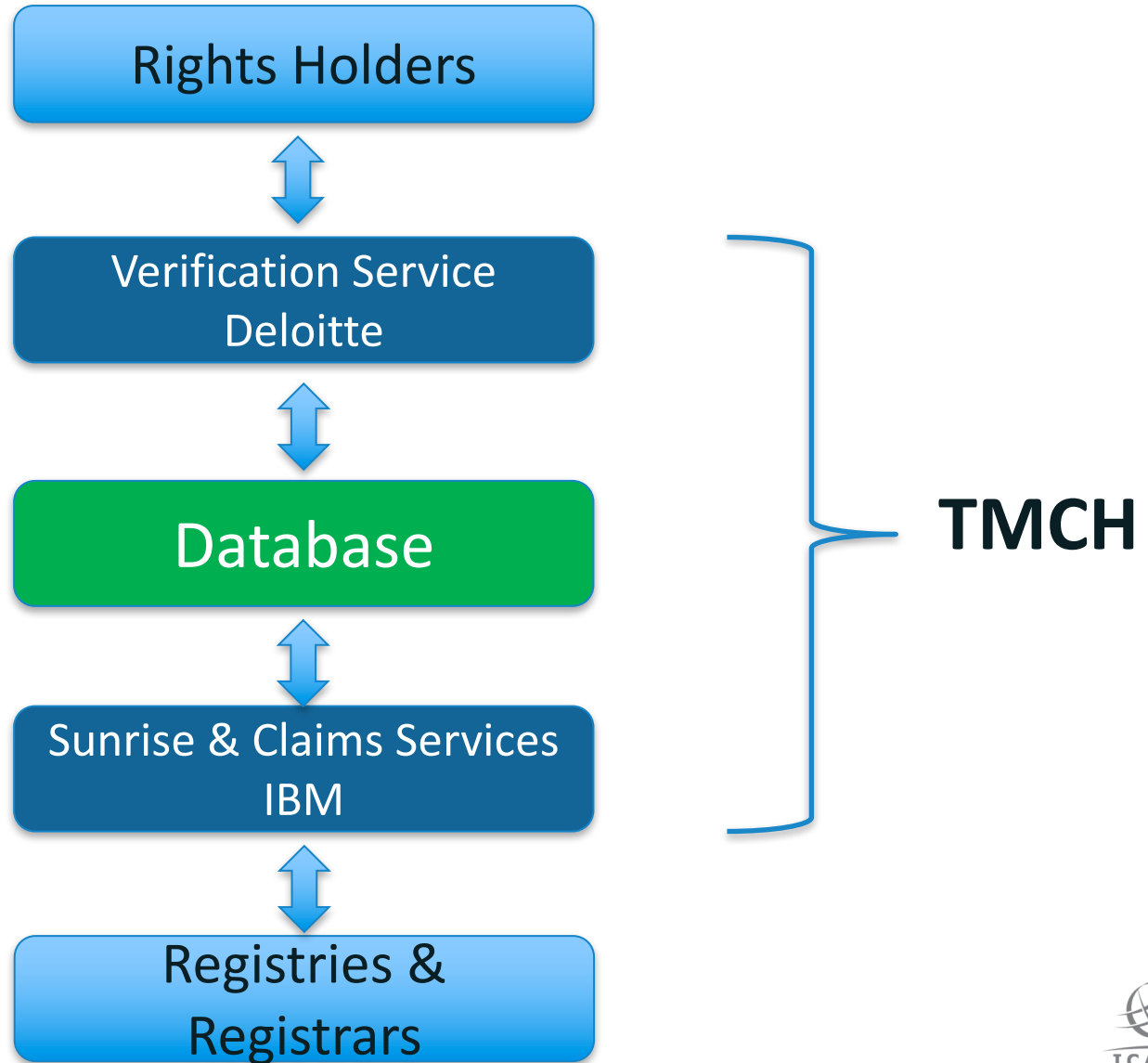
- ✓ Global database of verified trademark information
- ✓ Supports Sunrise Registrations & Trademark Claims notice service
- ✓ Verifies trademark data received – does not adjudicate or create TM rights

⦿ Key statistics:

- ✓ **90%** of submissions verified and included into TMCH
- ✓ **92%** of verified submissions had marks verified for proof of use
- ✓ As of February 2017, over **40,000 marks from over 120 jurisdictions** had been submitted



Trademark Clearinghouse Functions



Who can apply?

- ⦿ Either a trademark holder or its agent (who submits and maintains the information on the TM holder's behalf, and receives notices related to Sunrise and TM Claims)

What types of marks are accepted?

- ⦿ Nationally or regionally-registered TMs (on primary register)
- ⦿ Marks protected by statute or treaty in effect at the time the mark information is submitted to the TMCH
 - *May include geographical indications and designations of origin*
- ⦿ Court-validated marks (court of law or other national judicial proceeding)
 - *May include unregistered (common law) marks and well-known marks*
- ⦿ Other marks that constitute intellectual property and that meet a registry's individual requirements

Updated Data from Deloitte (TMCH Verification Provider) – as of February 2017

42051 total trademark records submitted:

- 38172 successfully verified
- 27228 successfully verified to minimum Sunrise eligibility

41937 nationally or regionally registered trademarks submitted

- 38093 successfully verified

16 court-validated marks submitted

- 4 successfully verified

98 marks protected by statute or treaty submitted

- 75 successfully verified

Number of Previously Abused Labels (“TM+50”):

- 209 cases, 375 labels

Sunrise Registrations through the TMCH

II. Sunrise Registration Periods

Overview:

- ⦿ Required for each new gTLD = *a minimum period of at least 30 days during which TM holders have an advance opportunity to register domain names corresponding to their marks before names are made generally available to the public*

Key Points:

- ⦿ All Sunrise registrations must be based on eligibility as verified by the TMCH
- ⦿ Registries may establish other restrictions, e.g.:
 - *Trademark date restrictions*
 - *Trademark class of goods/services*
 - *Community-based registration restrictions*
- ⦿ Registries must also have a **Sunrise Dispute Resolution Policy**

Start-Date Sunrise:

- Registry must provide service for a minimum of thirty (30) calendar days prior to General Registration and must provide thirty (30) calendar days’ notice prior to the start of the Sunrise period

End-Date Sunrise:

- Registry has no advance notice requirement but must provide the service for a minimum of sixty (60) calendar days prior to General Registration, and must not use a time-based allocation method (e.g., first come, first served)
- The majority of new gTLD registries appear to have offered End-Date Sunrise periods

Trademark Claims Notifications through the TMCH

III. The Trademark Claims Service

Two types of notices:

(1) To a potential registrant where the domain matches a TMCH record -

- Following the Sunrise Period and for at least the first 90 days of General Registration - potential registrants receive a **TM Claims Notice** if their intended domain name matches a mark recorded in the TMCH
 - Gives notice to a potential registrant of the scope of a TM owner's rights
 - Sample notice: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>
 - TM Claims notice is sent by Registrar in English and in the language of the Registration Agreement

(2) To the TMCH record holder -

- If registrant acknowledges the TM Claims notice and proceeds to register the domain, a **Notice of Registered Name** is then sent to the relevant TM holder
 - This allows the TM owner to take immediate action if she believes rights have been infringed (e.g. URS, UDRP, court action)

The Uniform Rapid Suspension Procedure (URS)

IV. The Uniform Rapid Suspension (URS) Procedure

- ⦿ Complements the 1999 Uniform Dispute Resolution Policy (UDRP) by offering a lower-cost, faster path to relief for clear-cut cases of infringement
- ⦿ Inexpensive (< 500 USD)
- ⦿ For determinations in favor of the complainant: the domain name is suspended and lookups resolve to a URS information site

Complainant has to prove by **clear and convincing evidence** that:

- The relevant registered domain name is identical or confusingly similar to a word mark:
 - i. for which the Complainant holds a valid national or regional registration and that is in current use; or
 - ii. that has been validated through court proceedings; or
 - iii. that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed.
- And that the Registrant has no legitimate right or interest to the domain name
- And that the domain was registered and is being used in bad faith.

Post-Delegation Dispute Resolution Procedures

V. Post-Delegation Dispute Resolution Procedures

- ⊙ Provides parties potentially harmed by a new gTLD registry's conduct an avenue to pursue a complaint about that conduct
- ⊙ Post-Delegation Dispute Resolution Procedures include:
 - ⊙ Trademark Post-Delegation Dispute Resolution Procedure (**Trademark PDDRP**)
 - ⊙ Registration Restriction Dispute Resolution Procedure (**RRDRP**)
 - ⊙ Public Interest Commitments Dispute Resolution Procedure (**PICDRP**)

TM-
PDDRP

- + A Procedure to address trademark rights infringement by a New gTLD Registry Operator
- + Addresses situations where it is believed a Registry Operator is infringing, or actively participating in another's infringement, of trademarks in its gTLD

Background to the PDP:

<https://gnso.icann.org/en/group-activities/active/rpm>

PDP Working Group Charter:

<https://community.icann.org/x/2CWAAw>

Working Group online wiki space (containing recordings and transcripts of all Working Group and Sub Team calls; draft documents and background materials):

<https://community.icann.org/x/wCWAAw>

Engage with the PDP Working Group



Thank you for your feedback!

Reach us at:

Email: policy-staff@icann.org

Website: <http://gnso.icann.org>



twitter.com/icann



facebook.com/icannorg



youtube.com/user/icannnews



linkedin.com/company/icann



soundcloud.com/icann



weibo.com/ICANNorg



flickr.com/photos/icann



SlideShare

slideshare.net/icannpresentations