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Michael Karanicolas
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Paul Keating
Paul McGrady
Paul Tattersfield
Petter Rindforth
Phil Marano
Philip Corwin
Renee Fossen
Sean McDonald
Steve Levy
Theo Geurts
Zak Muscovitch

On Audio only: Brian Beckham, Rebecca Tushnet

Guest Speakers: Doug Isenberg and John Berryhill

Apologies: Elizabeth Featherman, Shiva Kanwar, Sara Bockey, Susan Payne

Staff:

Julie Hedlund
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Terri Agnew:Welcome to the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group on Wednesday, 13 December 2017 at 18:00 UTC for 90 minutes.

Terri Agnew:agenda wiki page: https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_pwxyB&d=DwlCaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVvk3Kh_LwuQq_S_qtpilZUtB4&s=RwlTL1t2GK2JGFbllHWYdmvl_dSA2eFmZQzqh3j4WOW&e=

George Kirikos:Hi folks.

Maxim Alzoba (FAITID):Hello all

Maxim Alzoba (FAITID):I have a minor update to my SOI , moved UCTN CWG to past working groups

Steve Levy:Hi all!

claudio:hey Steve

Michael R Graham:Morning all!

Kristine Dorrain - Amazon Registry Services:I hear a lot of static

George Kirikos:Static on Kathy's line.

Terri Agnew:static is on Kathy's line

Philip Corwin:Much static

Griffin Barnett:also hearing static on Kathy's line

John Berryhill:Is it pronounced "gigalaw" or "jigalaw"?

David McAuley:fair amount of static

Doug Isenberg:@John: Like gigabyte (hard "g") in GigaLaw

Jothan Frakes (DNA):Guh like "Golly"

George Kirikos:Can the slides be unlocked, so we can scroll back?

Mary Wong:@George, we suggest waiting till the presentation is done, to allow for focus on the topics being discussed by our guests.

Mary Wong:@Doug, yes - we should have made it clear that we meant as a "requirement" for new gTLDs rather than as contractual adoption or by ccTLDs. Apologies for that.

claudio:yes, those registries voluntarily added URS to their contracts

Petter Rindforth:Agree - I prefer when complainant's provides more "traditional" documentation as proof of use

David McAuley:better yes

Griffin Barnett:much better

Terri Agnew:much better line Kathy

Kathy Kleiman:tx!

Steve Levy:Are we here to discuss the background and rationale for the policy or simply discuss the rules and procedures themselves?

George Kirikos:It's a big potential disadvantage for registrants whose native language isn't English, also for TM holders in non-English countries.

Philip Corwin:How rapidly is the complaint translated?

George Kirikos:https://urldefense.proofpoint.com/v2/url?u=https-3A__ntldstats.com_&d=DwICaQ&c=FmY1u3PJp6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVvk3Kh_LwuQq_S_qtpilZUtB4&s=PMuLkmSP4tD6U17m3TSUsA1FS0qjwyZG_OWDeKj12E&e= shows some stats.

Philip Corwin:...Where translation would be warranted based on registrant's domicile.

Mary Wong:The rule was developed during the implementation period; I believe this question was raised during a prior Working Group call. Staff will go back and retrieve the specific background.

Steve Levy:This is all quite interesting but we only have 90 mins to get through our speakers' presentation. My understanding was that today's presentation was simply explanatory of the URS and its rules. If we want to take deep dives into the issues behind the policy I feel that should be tabled for another day.

Mary Wong:@Phil, this next slide should answer your question

Ivett Palovics:Complaint is not to be translated according the rules.

Ivett Palovics:Only Notice of Complaint should be in the language of the domicile of the Respondent.

Mary Wong:As Ivett noted, translation is NOT of the Complaint, but of the Notice. And there are other language rules for Responses to Complaints.

Ivett Palovics:And also Response form is sent in the language of the Notice.

George Kirikos:"predominant language" in a country might be very problematic, as compared to Official Languages. e.g. English dominates in Canada, but French is also an official language.

Mary Wong:The Rules specifically provide that "The Provider is not responsible for translating any documents other than the Notice of Complaint."

George Kirikos:Under the Hague Convention, when serving a lawsuit in a foreign domicile, it has to be translated, by the way.

George Kirikos:(in the PUPA.com lawsuit, we had the lawsuit translated into Italian, for example)

Philip Corwin:OK, thx for clarifying

Greg Shatan:Agree with Steve Levy. We should hear from Doug and John based on their experience with URS, not dwell on policy questions that may not have even come up in the URS.

Maxim Alzoba (FAITID):and in India .. more than 10 languages .. and majority of the speakers in the language changes with the part of country

George Kirikos:This also affects complainants. So, a Chinese TM holder complaining against a Chinese domain owner needs to file in English??

Theo Geurts:@Maxim, 10+ is rather conservative :)

Maxim Alzoba (FAITID):I meant per region

Theo Geurts:@Maxim, tx

George Kirikos:Is the URS sent by courier, like the UDRP?

George Kirikos:(the notification, rather)

Petter Rindforth:I think the Forum often use Examiners that can understand the language of the respondent, if that is not English

J. Scott:Do either of the panelist have any examples of this being an issue?

Mary Wong:IF there are questions about specific mechanics and processes employed by the Providers, we can compile those and send them on.

George Kirikos:They used to use courier for WIPO -- did they switch to a slower method?

Mary Wong:The co-chairs also plan to invite all the Providers to a subsequent call.

J. Scott:Has any respondent come forward seeking to redress do to lack of notice?

David McAuley:Thanks Mary but please do have a question period at the end of presentation today

Mary Wong:@David, that is the plan so I will watch the clock.

David McAuley:thanks Mary

Paul Keating:QUESTION: Is a late response stating that they did not understand the language of the complaint considered as a valid reason?

Kristine Dorrain - Amazon Registry Services:I

Mary Wong:Note that the URS Procedure (which we covered at ICANN60) sets out some possible grounds for a defense that can be listed in a Response.

Kristine Dorrain - Amazon Registry Services:I've pointed out a few times now that this use of the word "default" is misleading.

George Kirikos:It usually takes more words to rebut a false statement, compared to the words in the false claim.

Maxim Alzoba (FAITID):I am not sure example is correct, it could be undercover police

J. Scott:Question for Doug: Have you ever felt that the word limitation caused you to be unable to set a prima facie case?

John Berryhill:You have some interesting police

Sean McDonald:Without translation of the complaints, how are respondents expected to engage with individual claims?

Kathy Kleiman:Sorry J. Scott, your chat popped up just after we moved on...

claudio:can a single complaint against a single registrant be joined by multiple complainants (consolidation of plaintiffs)?

Kristine Dorrain - Amazon Registry Services:For those who want to see what one iteration of URS looks like, the "instructions" block at the forum's site has powerpoint slides showing how Complaint and Response screens look. https://urldefense.proofpoint.com/v2/url?u=http-3A_www.adrforum.com_URS&d=DwICaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWV3Kh_LwuQq_S_qtpilZUtB4&s=hD7msG43EZ7giPjOMNSAdozseOneXRgbpnSV1_igXn8&e=

George Kirikos:@Sean: there was translation into "predominant" language of the country of respondent; but that can be problematic, as pointed out earlier, e.g. where there are multiple official languages in a country.

George Kirikos:Minority language groups in that country would be at a disadvantage.

Mary Wong:@Claudio, here is what the Procedure says: "One Complaint is acceptable for multiple related companies against one Registrant, but only if the companies complaining are related. Multiple Registrants can be named in one Complaint only if it can be shown that they are in some way related. "

claudio:thxs, Mary

Mary Wong:Para 1.1.3 of the Procedure

Sean McDonald:@George - thanks for the clarification. My understanding was that the notice was translated, but that the complaint was not - which I'd assume means that the respondent would have to translate the complaint in order to refute individual claims.

Mary Wong:@Sean, yes, the Rules require that the Notice be translated, not the Complaint.

George Kirikos:@Sean: actually, you're right, only the notice gets translated.

George Kirikos:See Rule 4(b) of the URS rules.

George Kirikos:https://urldefense.proofpoint.com/v2/url?u=http-3A__newgtlds.icann.org_en_applicants_urs_rules-2D28jun13-2Den.pdf&d=DwlCaQ&c=FmY1u3PJP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVv3Kh_LwuQq_S_qtpilZUtB4&s=8dvzuPPfGx3Y88mqj677TojwTqo2kkaoZNW5e9pwwXBA&e=

Sean McDonald:@George - thanks. It's a potentially minor point - but given Rule 3(iv) & (v) involve evidence and determinations, my questions are about whether a respondent will be able to engage with the facts/interpretations asserted.

George Kirikos:Here's a case that wasn't a 'no-brainer', in my opinion, but was lost in a default (O'Neill is a common surname, domain wasn't being used): https://urldefense.proofpoint.com/v2/url?u=http-3A__www.adrforum.com_domaindecisions_1756360D.htm&d=DwlCaQ&c=FmY1u3PJP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVv3Kh_LwuQq_S_qtpilZUtB4&s=r49XHthsmwC2hjS5BsTm95oZE2f_8TyMD2VcloeYen0&e=

Paul McGrady:Which is very interesting since the ostensible reason that ICANN Staff gave to exclude new market entrants who wanted to be URS providers was that the new market entrants didn't have UDRP experience.

J. Scott:QUESTION: how many of those cases were appealed?

Berry Cobb:From the data staff has collected, we count a total of 28.

J. Scott:From the popular examier.

Berry Cobb:We'll be providing an update to data/charts of URS at the beginning of 2019 as a result of the first review in Abu Dhabi.

Mary Wong:To get at the specific number, it may be necessary to look into all 28 appeal cases to find out who the Examiner was.

Paul McGrady:Its a bit of a catch 22. If the URS cases need to be straightforward, it doesn't follow that examiners need to be steeped in UDRP theory. If the facts of a URS are so complex that an examiner needs to draw on UDRP experience to analyze it, it probably isn't right for a URS. Hmmm.

J. Scott:thanks

John Berryhill:Yes and no. "Straightforward" to whom... My doctor took one look at me and said "shingles", because she's seen a lot of it.

John Berryhill:and, get your shots, folks

Philip Corwin:@Paul--I think the issue is that a case that appears black&white to a novice examiner may be seen as more nuanced one with substantial UDRP experience

Greg Shatan:or vice versa.

George Kirikos:This one looked like a straightforward win for Eli Lilly, but they lost. Hmm. https://urldefense.proofpoint.com/v2/url?u=http-3A__www.adrforum.com_domaindecisions_1733940D.htm&d=DwlCaQ&c=FmY1u3PJP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVv3Kh_LwuQq_S_qtpilZUtB4&s=kf-1IkBkS4GE7EqwgxfDIY2-R3tEmgykArZP0j-oXY0&e=

Paul McGrady:@John - a good point. I suppose we could have an examiner that is so green that he thought a simple case was complex, so that could (in theory) result in more denials than there should be.

Paul Keating:Question: Regarding panel appointment and the propensity to have a small group be appointed to a relatively large percentage of URS cases, can the ADR providers address the process they use to select panelists and explain why John's information indicates a disproportionate selection of panelists?

Paul Keating:Sorry no microphone

Paul McGrady:@George, an interesting case. That URS examiner has UDRP experience. Do you think she reached the wrong decision?

Sean McDonald:Are the determinations translated (in the same vein as notices)?

Zak Muscovitch:@Doug Isenberg, do the fees payable to panelists reasonably compensate them for preparing a proper decision that is of use to subsequent panelists and parties?

George Kirikos:@Paul: yes, I thought that was a slam dunk case for the drug company.

Paul Keating:John's statistics indicated that a small number of panelists were being assigned a disproportionate number of cases.

Mary Wong:Para 7.3 of the Procedure (not Rules): "Examiners used by any given URS Provider shall be rotated to the extent feasible to avoid forum or examiner shopping. URS Providers are strongly encouraged to work equally with all certified Examiners, with reasonable exceptions (such as language needs, nonperformance, or malfeasance) to be determined on a case by case analysis."

Maxim Alzoba (FAITID):what happens in case of 1 panelist?

Paul Keating:We had the same issue crop up with NAF in connection with UDRPs

Maxim Alzoba (FAITID):only one

John Berryhill:34 30 29 22 21 19 18 18 18 18 17 17 17 17 17 16 16 16 16 16 16 16 16 16 15 15 15 15 15 15 15 14 14 14 14 14 14 13 13 12 12 15 4 4 3

John Berryhill:that's the panelist distribution for NAF URS cases

John Berryhill:I had an assistant prepare the data and have not checked it myself yet

Paul McGrady:@George, it looks like that examiner's first UDRP case was in 2006 and she's done dozens and dozens. So, experience in the UDRP won't always save a Complainant from a bad decision. But that losing Complainant can always then file a UDRP complaint or ACPA complaint I suppose.

Renee Fossen:Forum uses a round robin format but language needs can be a driver and I suspect is the case with the examiner that has a higher assignment rate.

Philip Corwin:ICANN's MOU with URS providers requires that they "ensure that each Examiner and each member of an Appeal Panel is properly qualified, including by ensuring that each such person has an understanding of global intellectual property issues as they relate to the Internet". Doesn't require UDRP panelist experience, but at least some understanding of UDRP practice would seem appropriate, especially since URS designed as narrow supplement to UDRP.

claudio:the remedy is only to suspend the domain until the expiration date, upon which the registrant can then renew and use the domain?

Philip Corwin:URS procedures relating to examiners state: "7.2 Examiners should have demonstrable relevant legal background, such as in trademark law, and shall be trained and certified in URS proceedings. Specifically, Examiners shall be provided with instructions on the URS

elements and defenses and how to conduct the examination of a URS proceeding.7.3 Examiners used by any given URS Provider shall be rotated to the extent feasible to avoid forum or examiner shopping. URS Providers are strongly encouraged to work equally with all certified Examiners, with reasonable exceptions (such as language needs, non- performance, or malfeasance) to be determined on a case by case analysis."

Doug Isenberg:Caution, this is more than 2 years old, but I did look at the issue: "What Happens to a Domain Name After the URS Suspension Expires?" https://urldefense.proofpoint.com/v2/url?u=https-3A_giga.law_blog_2015_08_25_what-2Dhappens-2Dto-2Da-2Ddomain-2Dname-2Dafter-2Dthe-2Durs-2Dsuspension-2Dexpires&d=DwlCaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVvk3Kh_LwuQq_S_qtpilZUtB4&s=KmnJlyjXRQw0u7pJeStzJLPBeN1L-fbP3YYfuhnSQiQ&e=

J. Scott:Question: What about a remedy that suspended for a year and then allowed the Complainant to transfer at the end of this suspension period?

Maxim Alzoba (FAITID):@J Scott, as I understand URS only for those who is not interested in domain, but in prohibition of use

J. Scott:Q: Part 2, or turn the off at the end of suspension with a procedure for a party to turn back on for non-infringing use?

claudio:it appears a non-trivial number of losing registrants are renewing the domain (not re-registering)

John Berryhill:Claudio, I haven't looked, so don't know

claudio:@john, thxs

J. Scott:My part 2 Q is missing the word "domain name"

Maxim Alzoba (FAITID):@Claudio, there is only one year of renewal under the URS rules

claudio:@maxim, can you send link to that

David McAuley:I think we need to look at these questions but am thankful for practitioners views from experience

David McAuley:to help us when we look

Maxim Alzoba (FAITID):it is hidden in tech requirements

David McAuley:Thank you

Maxim Alzoba (FAITID):https://urldefense.proofpoint.com/v2/url?u=https-3A__newgtlds.icann.org_en_applicants_urs_tech-2Drequirements-2D17oct13-2Den.pdf&d=DwlCaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIn-H4xR2EBk&m=LFODbJJaVGQ-6onymfWVvk3Kh_LwuQq_S_qtpilZUtB4&s=N12_E7CWYOgS2Bez7ggj77YQ3tYm94kGe0gwMbtzWzQ&e=

David McAuley:good point @Maxim -

Doug Isenberg:Lost audio

Doug Isenberg:I am off audio, will dial back in ASAP

claudio:@Maxim, thanks for sending that

Maxim Alzoba (FAITID):please add to notes : we need to move Legal requirements from Tech URS document - either to URS rules or to URS process text

Mary Wong:The link to the URS Tech Requirements is included in this set of slides at the end

David McAuley:+1 @ Maxim

Paul McGrady:@John and @Doug, thanks for doing this. I've enjoyed your thoughtful presentation.

John Berryhill:Thank you, Paul

Zak Muscovitch:Indeed. Many thanks.

John Berryhill:I told Mary I would prefer dental surgery to this working group.

David McAuley:+1 @Paul

Paul McGrady:@John - ha!

John Berryhill:Play nice with one another.

Doug Isenberg:Just rejoined, sorry

claudio:@john, come on you love us

Kathy Kleiman:welcome back, Doug

khouloud Dawahi:welcome back @Doug

David McAuley:Thanks to staff indeed and to Doug and John, very helpful

Maxim Alzoba (FAITID):bye all

J. Scott:Thank you all for your time and trouble.

Gaurav Vedi (Dominion Registries):Thanks Everyone !!!

Maxim Alzoba (FAITID):this time of meetings is bit more pleasant

Marie Pattullo:Really appreciate your insights, gentlemen. Thanks.

Philip Corwin:Very grateful for this expert presentation. Thanks Doug and John!

claudio:@mary, can you please send the slides around after the call?

Mary Wong:@Claudio, will do - and we will be posting them on the wiki as well (along with the ones on the Proedure from ICANN60)

claudio:thanks, Mary!

Paul Tattersfield:Thank you Doug & John very informative

claudio:thanks guys

George Kirikos:Bye folks.

Paul Tattersfield:Bye all

J. Scott:ciao

Steve Levy:Bye all!

khouloud Dawahi:thank you all