30 November 2015

Comments of NCSG to Preliminary Issue Report on a Policy Development Process to Review All Rights Protection Mechanisms in All Generic Top-Level Domains

These comments of the Noncommercial Stakeholders Group (NCSG) address three key aspects of the Preliminary Issue Report:
 a) the organization and order of the evaluation,
 b) the scope of the reviews to take place and whether the rights of all stakeholders are reflected in the scope and goals set out, and
 c) the substantive issues and questions to be asked and evaluated.

 We appreciate the opportunity to comment.

a) Organization and Order of Evaluation

In Section 1.3 of the Preliminary Issue Report, Staff suggests three different approaches to the organization and order of evaluation of the Uniform Dispute Resolution Policy (UDRP) adopted in 1999) and the Rights Protection Mechanisms (RPMs) adopted in 2012 for the New gTLD roll-out program. We would like to strongly suggest a fourth approach: evaluate the UDRP first and RPMs second.

Why? The UDRP is the oldest consensus policy of ICANN and the one we understand the best. We have studied it the most, and it has the longest history of implementation and decisions. While we agree that the work of the UDRP should be staggered, we think it is the trunk of the tree from which all other trademark rights protection mechanisms have grown. It works to embody the principles and purposes of our work in balancing trademark rights and the traditional fair use and free speech/freedom of expression rights of all others. We cannot really examine the other rights protection mechanisms until we stabilize foundation, which is the UDRP review.

Work should therefore be staggered, but the UDRP should come first, not second. Further reasons include:

1. The UDRP created the principles from which the URS and Trademark Clearinghouse (TMCH) were negotiated. Are those principles valid and strong? Do they need to be revised? Assessing the Uniform Rapid Suspension (URS) and Trademark Clearinghouse (TMCH) put the cart before the horse – we should assess the strength of foundation – before checking its higher and newer levels.

2. The roll-out of New gTLDs is still in progress. We expected to be finished by this point, but many New gTLDs are still in contracting and others are still in contention. Key Sunrise and Trademark Claims periods are yet to be undertaken, and data about the roll-outs of all New gTLDs would be helpful. We will have a fuller data set if we wait for more New gTLD introduction.

Accordingly, we ask for UDRP first, and its RPM New gTLD offshoots second.

b) Scope & Breadth

This Preliminary Issues Report tells us (the readers/commenters) repeatedly that it will rely heavily and extensively on "the 2011 GNSO Issue Report" and additional RPM materials.

But the 2011 GNSO Issue Report of the UDRP is half a decade old! That's centuries in terms of Internet time, and if used, the UDRP Review will be missing:

1. Major UDRP decisions of 2011-2015 (thousands of decisions)
2. The entire overlap of the New gTLDs and their RPMs with the UDRP (one of the key criteria of evaluation in this "Review of All Rights Protection mechanisms"
3. The benefit of the Arbitration Forums self-reviews, including the *WIPO Advanced Workshop on Domain Name Dispute Resolution, May 2015*, in which inconsistencies of decisions, including in the free speech/freedom of expression area were candidly discussed and contemplated.
4. Recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN (note the many, many sessions on Human Rights, including by the Cross Community WG and the GAC in Dublin, and the discussions in the CCWG on IANA transition Accountability stream).

The UDRP Issues Report must be updated to include the UDRP work of the last half decade.

Further, all discussions of the Scope must include more than the needs of trademark holders.

We ask for fairness and balance in the representation of the goals of the upcoming UDRP and RPM evaluation process. On Page 17 of this Preliminary Issues Report, the goals are framed in a one-sided way:

"to inform and to clarify the scope of the analysis to follow, as to whether or not all the RPMs   collectively can be said to achieve the intention of providing sufficient protection to trademark   holders in both existing and new gTLDs, or if further changes may be required."

But the protection of trademark holders **must take place within the fuller context of whether the rights and protections they seek are consistent with national law and public policy**.

By way of example, the owner of the National Football Team in Washington DC, Dan Snyder, certainly does not think that the trademark laws are providing

sufficient protection to him and his longstanding US federal trademark for the "Redskins." His longstanding and valuable US federal trademark for Redskins was recently canceled by US court for disparagement of Native Americans. Public policy considerations consistent with trademark law took effect to eliminate his federal trademark rights.

Under all national laws, trademark holders rights are limited and the rights of others are balanced. Including the rights to:
1. Use generic and descriptive words in new and novel ways
2. Use their last names, in all ways legal under law (which includes major protections in this area), and
3. Use geographic words that accurately mark where an organization, business or individual is located.

Reflecting such a balance has **always been part of the goals of the UDRP and RPMs since their formulation and adopted by the ICANN Community** and must continue in the upcoming process. It is a fundamental responsibility of ICANN to reflect that fairness and the public interest values which must be balanced.

We ask that the full balance of the goals of this review process be clearly laid out at *each and every opportunity,* not just in the introduction*.*

Finally, we ask that this UDRP review not be treated as an Expedited PDP, absent the much more extensive evaluation which in our view it requires at this juncture. This is an evaluation of our very first consensus policy – one adopted very quickly by ICANN and without many of the Stakeholder Groups that exist today. This is an evaluation of a sixteen year old consensus policy, and a review years in the making. Let's give it the full and careful consideration that it deserves.

c) Potential Issues for Review in a PDP (Questions to be asked of the UDRP, URS and TMCH)

We seek to add questions to the specific UDRP, URS and TMCH list, and to offer an initial question/issue/category which we find lacking:

1. Addition of a New Potential Issue for Review in the PDP: Are the processes being adopted by Providers of UDRP, URS, and TMCH services fair and reasonable?

UDRP, URS and TMCH Providers are adopting procedures that change the fees, expand the time of services, add new services, allow additional responses by trademark holders and more. Many refuse to rotate their Panelists, assigning to cases Panelists who have a track record of nearly uninterrupted decisions for trademark holders. It is critical that the RPM Review process understand the procedural rules adopted by Providers and ask the key questions that every supervisory body must:

a. Are the Providers' procedures fair and equitable for all stakeholders and

participants?
b. Are the Providers consulting with all stakeholders and participants in the evaluation, adoption and review of these new procedures?
c. Are the Providers training both the Complainants and the Respondents, and their communities and representatives, fairly and equally in these new procedures?
d. Are Providers exceeding the scope of their authority in any of the procedures they are adopting?
e. Is ICANN reaching out properly and sufficiently to the multi-stakeholder community when such procedures are being evaluated by ICANN at the Providers' request? Is this an open and transparent process?
f. What remedies exist, or should exist, to allow questions about new policies by the Providers offering UDRP, URS and TMCH services, and how can they be expeditiously and fairly created?
g. What changes need to be made to ensure that procedures adopted by providers are consistent with the ICANN policies and are fair and balanced?

2. Specific Potential Issues Concerning the UDRP Review

We list for inclusion the following Issues for evaluation with the UDRP Review

– Recommend that the term "free speech and the rights of non-commercial registrants" be expanded to include "free speech, freedom of expression and the rights of non-commercial registrants" to include rights under US law and the United Nations' Universal Declaration of Human Rights.
– Inclusion of: Are the critical concepts of "fair use" and "fair dealing" fully and accurately reflected in the UDRP (and also URS and TMCH rules)?
– Are generic dictionary words being adequately protected so that they are available for all to use as allowed under their national laws and international treaties? E.g. sun, windows.
– Are last names and geographic places adequately protected so that they are available for all to use allowed under their national laws, e.g, Smith, McDonald, Capitol Hill Cafe, Old Town Deli?
– Now that Reverse Domain Name Hijacking is a regular finding of UDRP panels, indicating that domain name registrants are being abused by complaints brought against them in the UDRP process, what penalties and sanctions should be imposed on Complainants found to be reverse domain name hijackers? How can those penalties and sanctions be aligned so as to be fair, as compared to the loss of a domain name taken from a registrant found to be a "cybersquatter"?
– Are free speech, freedom of expression and the rights of non-commercial registrants **uniformly protected** in existing UDRP (and URS and TMCH) policies and their implementation procedures? As currently phrased, the "potential issue" asks if it is "adequately protected," but where we find differences among Panelists of different countries, we should ask if free speech is "adequately and uniformly protected" – as equity and fairness

lies in both.

– Should defenses be expanded, e.g., as seen in Nominet's policy and the URS?

3. Specific Potential Issues Concerning the URS Review

We list for inclusion the following Issues for evaluation with the URS Review

– Has ICANN done its job in training registrants in the new rights and defenses of the URS?
– Are the expanded defenses of the URS being used and if so, how, when, and by whom?
– What sanctions should be allowed for misuse of the URS by the trademark owner?
– What evidence is there of problems with the use of the English-only requirement of the URS, especially given its application to IDN New gTLDs?
– How can the appeals process of the URS be expanded and improved?

4. Specific Potential Issues Concerning the Trademark Clearinghouse Review, Sunrise Period, and Trademark Claims

We list for inclusion the following Issues for evaluation with the Trademark Clearinghouse Review, Sunrise Period and Trademark Claims:

– Is the protection of the TMCH too broad?
– Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services? Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
– Is the TMCH and the Sunrise Period allowing key domain names to be cherry-picked and removed from New gTLDs unrelated to those of the categories of goods and services of the trademark owner (e.g., allowing "Windows" to be removed from a future .CLEANING by Microsoft)?
– How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
– How can TMCH services be much more transparent in terms of what is offered for ICANN pursuant to ICANN contracts and policies vs. what services are offered to private New gTLD registries pursuant to private contract?
– How can the TMCH provide education services not only for trademark owners, but for the registrants and potential registrants who are equally impacted by their services?

- How quickly can a cancelled trademark be removed from the TMCH database? (note: rejected trademarks and cancelled trademarks are different, with cancelled trademarks involving trademarks that have already been issued).
- What is the chilling effect of the 90 day Trademark Claims process?
- Should Tdmk +50 be reversed?

We note that many of the "potential issues" concerning the Sunrise Period, TMCH and Trademark Claims involve the express reversal of adopted GNSO policy – a reversal of the careful compromises negotiated by the multi-stakeholders of the GNSO who finalized the URS, TMCH, Sunrise and Trademark Claims policies.

Where that is taking place, we ask the Staff to expressly note and flag such a question. For example:
- *Should the STI consensus be reversed to allow* TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?
- *Should the STI consensus be reversed to allow Trademark* claims period to be extended beyond ninety days?
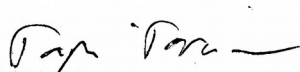
There are important reasons why these policies were reviewed, extensively debated and rejected in the first place. Clear information should be provided and signals issued when a question asks for the setting aside of these important compromises.

5. PDDRP

Given that no proceedings have taken place under the Post-Delegation Dispute Resolution Procedures involving allegations against an entire registry and its gTLD, we have no evidence or record for review and we think it is premature for the review of this policy.

Conclusion

Overall, we appreciate the opportunity to comment and ask that our suggestions, recommendations and concerns be incorporated into the plan, order and issues to be evaluated going forward. Thank you.

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