ICANN | GNSO
Generic Names Supporting Organization

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

Status of This Document

Summary

On 15 December 2011, the GNSO Council requested that eighteen (18) months after the launch of the New gTLD Program ICANN staff prepare and publish a Issue Report on the state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to the UDRP and URS. The Council subsequently agreed to extend the timeline for a report by a further six (6) months. This Preliminary Issue Report is the result of that request.

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1 Executive Summary

1.1 Background

In referring to "rights protection mechanisms" (RPMs), this Preliminary Issue Report is concerned with those policies and processes, developed in consultation with the ICANN community, aimed at combatting cyber-squatting and providing workable mechanisms for trademark owners to either prevent or remedy certain illegitimate uses of their trademarks in the domain name system (DNS). The first such mechanism, the Uniform Dispute Resolution Policy (UDRP)[1], has been in effect as an ICANN Consensus Policy[2] since 1999.

A number of additional RPMs were developed subsequently to supplement the UDRP as part of the New gTLD Program, launched in 2012. These additional RPMs are:

   a. The Trademark Clearinghouse (TMCH) [3], which authenticates global rights information, maintains a centralized database of these, and provides this information to registries and registrars during the domain name registration process in all gTLDs launched under the New gTLD Program. Verified data from the TMCH supports the additional protective mechanisms available during the Sunrise and Trademark Claims service periods. [4]

   b. The Uniform Rapid Suspension procedure (URS) [5], which is modeled on the UDRP and aims to provide a trademark holder with a fast and reasonably inexpensive way to obtain the suspension of a domain name that was registered and used in bad faith.

   c. The Post-Delegation Dispute Resolution Procedures (PDDRPs) [6], which provide alternative avenues for a trademark holder who is harmed by a new gTLD registry operator's conduct to obtain redress.

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[1] See https://www.icann.org/en/help/dndr/udrp.
[2] All gTLD registry operators and ICANN-accredited registrars are contractually obliged to comply with Consensus Policies that are developed by ICANN through community consensus. Annex A of the ICANN Bylaws outlines the Policy Development Process that has to be complied with to develop Consensus Policies within the GNSO: https://www.icann.org/resources/pages/governance/bylaws-en/#AnnexA. More specifically, the 2013 Registrar Accreditation Agreement (which is the contract between ICANN and all ICANN-accredited registrars) defines "Consensus Policies" as those policies that are established in accordance with the ICANN Bylaws and due process, and that relate to certain specific topics, including the resolution of disputes relating to the registration of domain names (see https://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#consensus-temporary). All current ICANN Consensus Policies can be accessed here: https://www.icann.org/resources/pages/registrars/consensus-policies-en.
[3] See http://newgtlds.icann.org/en/about/trademark-clearinghouse.
[4] For an updated list of the various periods and their dates, see http://newgtlds.icann.org/en/program-status/sunrise-claims-periods.
[5] See http://newgtlds.icann.org/en/applicants/urs.
[6] . See http://newgtlds.icann.org/en/program-status/pddrp.

The UDRP has not undergone any substantive review since its inception, and a 2011 GNSO community discussion to determine whether or not such a review should be conducted resulted in the GNSO Council's decision that a review should more appropriately be conducted in tandem with one for the new gTLD RPMs[7]. The GNSO Council therefore resolved in December 2011 to request an Issue Report on the state of all RPMs for both existing and new gTLDs, for publication eighteen (18) months following the delegation of the first gTLD in the New gTLD Program. Further to a staff request, the Council agreed to extend the timeline for delivery of a report by six (6) months.

In February 2015, community feedback was solicited for those RPMs developed for the New gTLD Program via a staff paper[8]. The aim of the exercise was to allow ICANN to assess the effectiveness of safeguards in meeting their intended rights protections objectives in the New gTLD Program, and identify areas where additional policy development or implementation improvements might be beneficial. Following the receipt and review of community comments, a revised Rights Protection Mechanism Report was published by ICANN staff in September 2015 (RPM Staff Paper)[9]. In addition to feeding into other review processes to evaluate the operational effectiveness of the New gTLD Program, the analysis and feedback provided by the RPM Staff Paper was explicitly intended to also inform this specific Preliminary Issue Report and the deliberations of the GNSO Council over whether or not to initiate a Policy Development Process (PDP) to review all the RPMs at this time.

In accordance with the GNSO PDP rules, this Preliminary Issue Report is hereby published for public comment. Following review of the public comments received, the Staff Manager will update the Issue Report as appropriate and submit a summary of the comments received together with the Final Issue Report to the GNSO Council.

1.2 Discussion of the Issue

The UDRP has been the subject of a GNSO Issue Report, published in February 2011[10] (prior to the delegation of the first gTLD under the New gTLD Program, which occurred in October 2013). Community feedback in response to this Issue Report was largely to the effect that the UDRP provides a "comparatively quick" and "effective" recourse for disputed second level domain name registrations in the globalized and trans-jurisdictional world of the DNS.[11] The primary conclusion in the Final Issue Report, published in October 2011 and based on a review of the community comments received, was that a review of the UDRP should not be conducted until

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[7] See http://gnso.icann.org/en/council/resolutions#201112.
[8] The initial staff paper and public comments can be viewed here: https://www.icann.org/public-comments/rpm-review-2015-02-02-en.
[9] See https://www.icann.org/news/announcement-2015-09-11-en.
[10] See https://www.icann.org/resources/pages/prelim-report-udrp-2011-05-27-en.
[11] See the Final Issue Report on the Current State of the UDRP (October 2011), Section 5.

eighteen (18) months after the launch of the URS. A review could then be based on data derived from the use of the URS, since it is modeled on the UDRP[12].

October 2013 saw the delegation into the Internet root zone of the first gTLD under ICANN's New gTLD Program[13]. The TMCH opened for submission of trademark records in March 2013[14], while the URS saw its first complaint filed in August 2013[15]. Available data and community feedback relating to these and the other new gTLD RPMs were summarized in the updated RPM Staff Paper, published in September 2015.

It is important to note at the outset that, to date, there has been no overall initiative that has sought to review in combination the effectiveness of all these RPMs in meeting their stated objectives. There is therefore no current, comprehensive policy guidance that covers the topic of the use and effectiveness of RPMs across both the so-called "legacy" gTLDs and those launched under the New gTLD Program, or that can be referred to as a uniform starting point for the future review and evolution of new or more streamlined RPMs that may be more appropriate. This is because the previous work efforts highlighted above each focused on specific RPMs – the October 2011 GNSO Final Issue Report on the then-current state of the UDRP (UDRP Report), and the RPM Staff Paper on those other processes developed for the New gTLD Program. Further, the UDRP is a Consensus Policy, applicable to all gTLDs, whereas the new RPMs were developed to address the overarching issue of trademark protection in connection with the introduction of new gTLDs[16], following community consultations during the process of implementing the New gTLD Program. These new RPMs therefore apply only to gTLDs introduced as part of the New gTLD Program.

The work of any PDP reviewing the RPMs at this time is expected to build on prior ICANN and community work on the development of these RPMs, including the findings and community comments provided to the October 2011 UDRP Report, and the more recent September 2015 RPM Staff Paper.

There are a number of other review efforts underway or planned within the community that may have an impact on the work of the PDP and may help inform the PDP Working Group's deliberations. Therefore, a PDP need not necessarily be expected to be limited to the subjects identified in this Issue Report, and if initiated should take into account the findings from parallel efforts external to the PDP Working Group that may be formed for this effort.

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[12] See the Final Issue Report on the Current State of the UDRP, p.31.

[13] See https://www.icann.org/resources/press-material/release-2013-10-23-en.

[14] 13,261 trademark records were submitted to the TMCH between its launch and the delegation of the first New gTLD (RPM Staff Paper, pp 21-23).

[15] Note, however, that this was filed not against a domain name in a new gTLD but rather in the .pw ccTLD, whose operator had voluntarily adopted the URS: http://www.prnewswire.com/news-releases/facebook-prevails-in-first-uniform-rapid-suspension-system-case-administered-by-national-arbitration-forum-234429801.html.

[16] See, e.g., the Board resolution establishing the Implementation Recommendation Team: https://www.icann.org/resources/board-material/resolutions-2009-03-06-en#07.

1.3 Staff Recommendation

ICANN staff has confirmed that the proposed issue is within the scope of the GNSO's Policy Development Process (see section 2.3).

If a PDP to review all the RPMs is launched, the previous 2011 collation of community comments concerning a possible review of the UDRP and the more recent compilation of feedback concerning provider and user experiences with the new RPMs collectively provide a useful list of issues through which the PDP can be framed and chartered. Because a potential PDP can result in changes to a longstanding ICANN Consensus Policy and possible uncertainty in the future operations of the UDRP or the new RPMs, and because there are other ongoing review efforts that may yield useful information for a PDP, staff has included in this Preliminary Issue Report a number of additional factors to be considered in deciding whether or not to initiate a PDP (see Section 3). Staff has also suggested several ways in which the work of the PDP Working Group can be organized in order to facilitate an effective outcome (see Section 4.2.2), and a list of specific issues for consideration in a PDP, derived from topics identified by the community in response to the UDRP Report and the RPM Staff Paper (see Section 3.2.2.3).

Three possible options for work to be initiated by the GNSO in respect of reviewing the RPMs are set out below. Staff invites community feedback as to which of the three options – or possibly another, better course of action – would be the most appropriate way forward for the GNSO at this time.

The first option is to initiate a PDP to review all the RPMs[17] in all gTLDs, subject to the factors and according to the suggestions for organizing the work of a PDP Working Group that are listed in this Preliminary Issue Report. A successful outcome of the PDP would address those issues considered most appropriate for policy development work, based on the list included in this Preliminary Issue Report and PDP Charter. The PDP should build on the work and substantial community input provided to the UDRP Report and the RPM Staff Paper. The PDP Working Group should prioritize at an early stage the understanding of how the RPMs work in combination and review relevant reports and literature (including from external sources) that can help shed light on any shortcomings or gaps in one, some or all of the RPMs that may warrant substantive change. In addition, the PDP Working Group should take into account any related review efforts (such as the recently launched TMCH Review and the Competition, Consumer Trust and Consumer Choice Review) in developing their final recommendations.

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[17] Note that this Preliminary Issue Report does not include consideration of the Legal Rights Objection (LRO) procedure by which a rights holder may file an objection during the application period of a new gTLD, on the basis that the applied-for string infringes the rights holder's legal rights. The LRO procedure was developed as a protective measure at the top level, to implement an existing GNSO policy governing the New gTLD Program, specifically Recommendation 3 of the GNSO's 2007 Final Report on policy recommendations for the New gTLD Program, which states that "[s]trings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law" (see http://gnso.icann.org/issues/newgtlds/pdp-dec05-fr-parta-08aug07.htm).

Under this first option, while the outcome of the related reviews should form part of the PDP Working Group's deliberations, it would be the Working Group that determines the appropriate time for doing so. While this option has the advantage of being the same model as is used by the GNSO for its other PDPs, its relatively open-ended approach may not be the most suitable in this context, where even without the related review efforts a full PDP to review all the RPMs would likely be a complex and lengthy one already. When the reviews are factored in, it is apparent that it would be helpful if more specific guidance were provided to the PDP Working Group when launching the PDP.

A modified version of the first option can therefore be considered as an alternative. This second option would still proceed with a PDP to review all the RPMs in all gTLDs, but there would be a mandatory requirement in the Working Group Charter requiring the Working Group to review its timeline and overall Work Plan when the output from the Competition, Consumer Trust and Consumer Choice (CCT) Review is made available. This "built-in" process checkpoint could result in the Working Group pausing its then-current work in order to analyze the potential impact of the CCT Review results, or possibly even altering the scope or direction of its work (which decision should be taken in consultation with the GNSO Council).

There are at least two reasons why staff is highlighting this more specific possible option for the community's consideration at this time. First, as already noted, a full PDP to review all the RPMs in all gTLDs is likely to be a complex process and it will be necessary for the PDP Working Group to determine, at an early stage, whether it would be more appropriate to focus first on the UDRP or on the new RPMs. It is not possible to foresee at this time what stage of work the PDP will be at when the results of the CCT Review are released. The CCT Review is mandated by ICANN's Affirmation of Commitments with the United States government and it has been tasked with examining the workings of the RPMs developed for the New gTLD Program. It is possible that the CCT Review outcome could include policy-related suggestions for the GNSO regarding the new RPMs (although not the UDRP), and it would therefore be reasonable, in launching a PDP that includes a review of the new RPMs, to allow expressly for this possibility at the outset. However, drawbacks of this second option could include a possible loss of Working Group momentum if there is a change of priorities during the PDP, and frustration on the part of Working Group members at having to alter course or pause in their work as a result (e.g. if work is then ongoing on UDRP review).

A third option would be to conduct a policy review of all the RPMs in two phases, with the initial phase being a review only of the RPMs developed for the New gTLD Program. This can be done through an additional Charter category or task for the PDP Working Group on New gTLD Subsequent Procedures, if that PDP were to launch[18], or if not, then via a PDP limited to those RPMs. The second, subsequent phase of work would be a review of the UDRP, based on the concerns specific to its scope that were raised in the 2011 GNSO Issue Report and any additional

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[18] A Preliminary Issue Report for a potential PDP on this subject is currently out for public comment, closing on 8 November 2015: see https://www.icann.org/public-comments/new-gtld-subsequent-prelim-2015-08-31-en.

relevant topics derived from the first phase of work concerning the RPMs developed for the New gTLD Program.

One benefit of this two-pronged approach is better alignment of the timing of the work on reviewing the new RPMs with the operational reviews of the New gTLD Program[19] (including the CCT Review) and, conceivably, a new PDP on New gTLD Subsequent Procedures. It may also be noteworthy that this second phase of work can be accomplished through one of the GNSO's newly adopted procedures for an Expedited PDP (EPDP), as the UDRP issue will have been the subject of an Issue Report and thus may be considered sufficiently scoped[20]. Further, in light of the current workload of the GNSO and the resulting demand on staff and community resources, "staggering" the work of reviewing all the RPMs may allow for more meaningful participation by all interested parties. However, one significant drawback to this approach is the fact that community consideration of the more general overarching issue concerning the comprehensiveness of all the RPMs as a set of aggregate protections for trademark holders in all gTLDs, as well as the issue of whether any of the new RPMs should be considered Consensus Policies like the UDRP, will necessarily be postponed to the second phase of work. .

This Preliminary Issue Report has been published for public comment to allow for community input on information that may be missing from the Preliminary Issue Report, or necessarycorrections or updates to information in the Preliminary Issue Report.

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[19] See http://newgtlds.icann.org/en/reviews.

[20] The requirements for the new EPDP are spelled out in the Final Report of the GNSO's Policy and Implementation Working Group: http://gnso.icann.org/en/drafts/policy-implementation-recommendations-01jun15-en.pdf. On 28 September 2015, the ICANN Board approved the requisite changes to the ICANN Bylaws that are required in order for the EPDP to be adopted: https://www.icann.org/resources/board-material/resolutions-2015-09-28-en#2.f.

2 Objective

2.1 Submission

This Preliminary Issue Report is submitted in accordance with Step 2 of the Policy Development Process described in Annex A of the ICANN Bylaws.[21]

2.2 Issue

2.2.1 The Proposed Issue Raised For Consideration

As noted above, all the RPMs were developed to provide mechanisms to facilitate the protection of trademarks in the DNS. Where the UDRP was adopted in 1999 and applies to all gTLDs, the additional RPMs developed for the New gTLD Program do not apply to the "legacy" gTLDs and are comparatively new, having been launched less than three years ago. In addition, the UDRP is an ICANN Consensus Policy that is by nature binding on all gTLD registries and registrars, whereas the new RPMs were developed during the implementation period for the New gTLD Program. The UDRP has not been comprehensively reviewed since its inception in 1999. Where the new RPMs are concerned, the findings reported in the RPM Staff Paper were explicitly intended to inform either further policy development or additional implementation work (as appropriate). Should the GNSO Council decide to vote to initiate a PDP following review of public comments to this Preliminary Issue Report and the subsequent Final issue Report, this will represent the first time that all the RPMs have been reviewed by the GNSO.

2.2.2 The Identy of the Party Submitting the Request

The GNSO Council

2.2.3 How that Party is Affected by the Issue

The RPMs that are currently in operation have direct impact on the business operations of Registries and Registrars and provide remedies and recourse for users including Registrants. Therefore, the existence, operation and effectiveness of the RPMs directly affect all of the GNSO's Stakeholder Groups (SGs) and Constituencies (Cs). A review of the RPMs and any updates or changes that may be recommended as a result of a GNSO PDP is likely to also be of

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[21] See: http://www.icann.org/general/bylaws.htm#AnnexA.

key interest to other ICANN Supporting Organizations (SOs) and Advisory Committees (ACs), as RPMs touch on consumer protection and the rights of users in the DNS[22].

2.2.4 Support for the Issue to Initiate a PDP

On 15 December 2011, the GNSO Council passed a resolution requesting that "a new Issue Report on the current state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to, the UDRP and URS, should be delivered to the GNSO Council by no later than eighteen (18) months following the delegation of the first new gTLD."[23] On 29 January, at the request of ICANN staff, the GNSO Council agreed to an extension of the delivery date of the requisite Preliminary Issue Report by six months[24].

2.3 Scope

Based on the recommendations above, the launch of a dedicated policy development process (PDP) to consider at least the issues identified in this Preliminary Issue Report has been confirmed by the General Counsel to be properly within the scope of the ICANN policy process and within the scope of the GNSO.

2.4 Report

In accordance with the GNSO PDP rules, the Staff Manager will publish the Preliminary Issue Report for public comment in order to allow for Community input on additional information, or the correction or updating of any information provided so far. Following review of the public comments, the Staff Manager will update the Preliminary Issue Report and submit a summary of the comments received together with the Final Issue Report to the GNSO Council for its consideration and potential action.

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[22] Staff notes that both the GAC and the ALAC submitted comments to the 2011 Preliminary Issue Report on the Current State of the UDRP. Both Advisory Committees had then cautioned against launching a review of the UDRP at that time, with the GAC further commenting that such a review might be more appropriately done in light of community experiences with the RPMs developed for the New gTLD Program.

[23] See http://gnso.icann.org/en/council/resolutions#20111215-1.

[24] See http://gnso.icann.org/en/meetings/minutes-council-29jan15-en.htm.

3 Background

3.1 Process Background

The question of who legally has rights to, or is the legitimate holder of, a domain name can be open to dispute. Since the Internet is a global resource and domain name holders are dispersed among numerous different jurisdictions, finding an effective, enforceable and reliable process to resolve rights disputes across various jurisdictions is not an easy undertaking. Over time, ICANN has developed a number of dispute resolution policies and procedures that attempt to address this issue and provide enforceable remedies for certain types of disputes concerning domain name registrations. These policies are essentially alternative dispute resolution procedures to court litigation that nevertheless do not preclude the initiation of legal proceedings in the appropriate jurisdiction. In relation to domain name disputes concerning the registration and use of legally protected trademarks, the Uniform Dispute Resolution Policy (UDRP) is the longest standing alternative dispute resolution procedure.[25] In general, community feedback to date would seem to indicate that most believe the UDRP to be an effective and expedient alternative to more time consuming and expensive court litigation, and that the UDRP is viewed as reliable, predictable and consistent. However, the very effectiveness of the UDRP with regard to disputes in the global DNS has meant that court resolutions of such disputes are rarely sought. [26]

As a result of the New gTLD Program, several new rights protection mechanisms (RPMs) were also developed to mitigate potential risks and costs to trademark rights holders that could arise in the expansion of the new gTLD namespace, and to help create efficiencies for registration service providers among gTLD launches. These new mechanisms were developed in the course of implementation of the New gTLD Program. They are the Uniform Rapid Suspension dispute resolution procedure (URS), the Trademark Clearinghouse (TMCH) and the associated availability through the TMCH of Sunrise periods and the Trademark Claims notification service, and the Post-Delegation Dispute Resolution Procedures (PDDRPs).[27] Where the UDRP and URS cover trademark-related disputes arising over an actual domain name that has been registered in the second level of a gTLD (i.e. they are so-called "curative" mechanisms), the TMCH and the services provided using TMCH-verified data such as Sunrise and Trademark Claims are intended

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[25] For a complete background overview on the development of the UDRP see the UDRP Report, pp. 7-9.
[26] The responses to the UDRP Questionnaire that was distributed to the UDRP service providers as part of feedback to the UDRP Report indicate that, to the providers' knowledge, very few UDRP decisions are appealed to a court (e.g. one case, or .1% from the Asian Domain Name Dispute Resolution Centre, "fewer than five" per year from the NAF, and none from the Czech Arbitration Court). It should be noted, however, that providers may not receive notice of all appeals or challenges in court: see UDRP Report, p. 14 footnote 23.
[27] For a complete background overview on the development of these rights protection mechanisms, see the RPM Staff Paper, pp. 15-19.

to facilitate trademark owners' ability to prevent registration of domain names matching their marks (i.e. these are so-called "preventative" mechanisms).

Prior to the launch of the New gTLD Program, on 3 October 2011 ICANN staff had published a Final Issue Report on the current state of the UDRP. The recommended course of action in that UDRP Report was not to initiate a PDP at the time, but to hold off launching any such PDP until after the new URS had been in operation for at least eighteen (18) months.

Subsequently, on 15 December 2011, the GNSO Council requested that ICANN staff prepare and publish a new Issue Report on the current state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to the UDRP and URS. This Preliminary Issue Report is being published for public comment as the result of that GNSO Council request.

3.1.1 Uniform Dispute Resolution Policy (UDRP)

The UDRP was created in 1999 to resolve disputes concerning disputes over entitlement to domain names registered at the second level of the DNS. It is an ICANN Consensus Policy that is applicable to all gTLDs, including those launching under the New gTLD Program. The universal and uniform operation of the UDRP is based on two documents: first, the Policy that sets out its scope, relief, and basis for mandatory administrative proceedings that may be brought within its ambit; and secondly the Rules that set out the procedural requirements that must be followed in such a proceeding.

To date the UDRP has not been amended and no complete substantive review of the UDRP has taken place, although the policy has been adapted to accommodate new malpractices (such as phishing, pay per click and mousetrapping[28]) that emerged after ICANN's adoption of the policy in 1999. The UDRP Report concluded that in general the UDRP is functioning well and that there has been well over 30,000 cases decided by experienced UDRP panelists – with only "the rarest of the tens of thousands of UDRP decisions successfully challenged in Court."[29] It is noteworthy that a majority of the public comments to that Preliminary Issue Report requested that the "UDRP should be untouched."[30] However, many commenters also pointed out several ways in which they thought the procedural aspects of the UDRP could be improved[31] while a few commenters believed that the UDRP should indeed be reviewed[32]. Policy-related questions that may be relevant in reviewing the UDRP derived from the community feedback are summarized in Section 3.2.2.3.1 below.

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[28] UDRP Report, p.13.
[29] UDRP Report, p.14.
[30] UDRP Report, p.23.
[31] URDP Report, Annex 2.
[32] UDRP Report, p.15.

3.1.2 Uniform Rapid Suspension (URS)

The URS was designed as a complement to the UDRP, and is intended to provide trademark owners with a quick and low-cost process to act against those infringing on their intellectual property rights and to combat cybersquatting. In this respect, the substantive grounds upon which a trademark holder would file a complaint under the URS are essentially similar to those under the UDRP[33]. Much like the UDRP, trademark holders may initiate a URS proceeding by electronically filing a complaint with a URS provider. The fees associated with a URS proceeding range from USD300 - 500. Procedurally, once a trademark holder files a URS complaint, the registry operator immediately locks the domain against changes. The provider then notifies the registrant against whom the complaint has been filed, who has fourteen (14) days to submit a response. The remedy for a successful URS complaint is the suspension of the domain name for the balance of the registration period, with the complainant's option to extend that period for one additional year.[34]

In addition to the differing remedies available to a successful complainant under the UDRP (i.e. cancellation or transfer of the domain name) and the URS (i.e. suspension of the domain name), another area where the URS differs substantially from the UDRP is that of the standard of proof required to succeed on a claim. Where under the UDRP the complainant must prove her case through a preponderance of the evidence, under the URS there must be clear and convincing evidence – the reason for this is that, as a complement to rather than a substitute for the UDRP, the URS was expressly designed to apply only to clear-cut cases (often colloquially referred to in this context as "slam dunk" cases).

Community feedback provided on the URS in response to the initial RPM Staff Paper indicates that it can achieve "positive results in certain limited cases [as it] is quick, inexpensive and caters to those who have slam-dunk cases or are indifferent towards the suspension of the name solution, perhaps due to the fact they are unable to register that name"[35]. Nevertheless, a number of commentators also expressed reservations and concerns about the current scope and operation of the URS, including the standard of proof, the remedy provided, the time periods for response and use of the appellate mechanism. These are summarized in Section 3.2.2.3.2 below.

3.1.3 Trademark Clearinghouse (TMCH)

The TMCH is a global database of verified trademark information intended to support other rights protection processes such as Sunrise registrations and the Trademark Claims service. It opened for submission of trademark records in March 2013. Benefits of recording a trademark

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[33] For a side-by-side comparison of the URS and the UDRP, see RPM Staff Paper, p.92-99.
[34] See, generally, RPM Staff Paper, pp. 90 et seq. For more details, see the URS provisions: http://newgtlds.icann.org/en/applicants/urs.
[35] RPM Staff Paper, p. 104.

with the Clearinghouse include access to Sunrise registration with new gTLD registries. This involves an initial period of at least thirty (30) days before domain names are offered to the general public. The Clearinghouse also supports a Trademark Claims service that runs for at least the first ninety (90) days of general registration. During this period, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. If the notified party nevertheless goes ahead and registers the domain name, the TMCH will send a notice to those trademark holders with matching records in the Clearinghouse, informing them that someone has registered the domain name. The TMCH accepts and verifies information on the following types of intellectual property rights: (i) nationally or regionally registered trademarks; (ii) court-validated marks; and (iii) marks protected by statute or treaty (such as geographical indications or designations of origin).[36] The RPM Staff Paper noted that: "Between March 2013 and May 2015, the Clearinghouse verified and accepted for inclusion 32,667 nationally or regionally or registered trademarks, 42 trademarks protected by statute or treaty, and two court-validated trademarks."[37]

Community feedback provided on the TMCH in response to the initial RPM Staff Paper indicated certain concerns with the operational effectiveness of the TMCH[38]. In addition, commenters raised a number of substantive questions concerning the scope of the TMCH, including the treatment of design marks, questions concerning the requirement to provide proof of use of the trademark, and the test of an identical match between the trademark and a register-able domain name. These are summarized in Section 3.2.2.3.3below.

3.1.4 Sunrise Periods

The verified data in the TMCH is used to support Sunrise services, which allow trademark holders an early opportunity to register domain names corresponding to their marks before domain names are made generally available to the public. The RPM Staff Paper explains that "New gTLD registries are required to offer a Sunrise period of at least 30 days. This can occur in line with one of two options: (i) In the case of a Start-Date Sunrise, the Registry Operator must provide the 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. (ii) In the case of an End-Date Sunrise, the Registry has no advance notice requirement; however, the Registry Operator 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 registries who have launched to date have offered an End-Date Sunrise."[39] New gTLD registry operators are also obliged to maintain a Sunrise Dispute

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[36] See generally the RPM Staff Paper, Section 3. For the actual TMCH guidelines see http://trademarkclearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf.
[37] RPM Staff Paper, p.27.
[38] RPM Staff Paper, p. 52.
[39] RPM Staff Paper, p.54.

Resolution Policy, which allows for challenges to Sunrise registrations related to the registry operator's allocation and registration policies, including on the grounds that the domain name that was registered does not match the trademark record on which the Sunrise-eligible rights holder based its Sunrise registration.

Community feedback provided on the Sunrise period in response to the initial RPM Staff Paper indicated that some community members would welcome clarity on issues such as the treatment of premium names and the reservation and release of reserved names by a registry operator. These questions and suggestions are summarized in Section 3.2.2.3.4 below.

3.1.5 Trademark Claims Service

The Trademark Claims period follows the Sunrise period and runs for at least the first ninety (90) days of general registration in which domain names are made available to all registrants who are able to register domain names within the particular gTLD. During the Trademark Claims period for a gTLD, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. "The Claims Notice is intended to provide clear notice to the prospective domain name registrant of the scope of the Trademark Holder's rights."[40] Should the notified party nevertheless proceed to register that domain name, the relevant trademark holder with a matching record in the TMCH is then notified of the registration.

Extensive community feedback was provided on the Trademark Claims service in response to the initial RPM Staff Paper. Some of the substantive topics addressed by commenters include the premise of an identical match to trigger a notice, the limited applicability of the service to Abused Domain Name Labels, and the possibility of extending the period of the service. These comments are summarized in Section 3.2.2.3.5 below.

3.1.6 Post-Delegation Dispute Resolution Procedures (PDDRPs)

The Post-Delegation Dispute Resolution Procedures (PDDRPs), unlike the UDRP and URS, are dispute resolution processes that address a new gTLD registry operator's conduct rather than alleged bad faith registration of a second level domain name by a registrant. Of the current three PDDRPs, only the Trademark PDDRP is intended to address trademark-related issues in the registry; the Registration Restriction DRP (RRDRP) and the Public Interest Commitments DRP (PIC-DRP) were not specifically designed as RPMs for the same purpose, although they can serve this function in certain limited circumstances[41].

As of the date of publication of the initial RPM Staff Paper, no valid complaints had been filed under any of these PDDRPs and as such, most of the community felt unable to provide any

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[40] RPM Staff Paper, p.75.
[41] RPM Staff Paper, p. 111-112.

useful feedback although some suggested that a review would be appropriate when more data becomes available. In consequence, unlike the other RPMs analyzed in this Preliminary Issue Report, no data or specific prior community input is available for consideration in determining whether or not a PDP on all RPMs should be initiated at this time.

3.1.7 Relevant Selected ICANN Documentation and Reports

- Protecting the Rights of Others Working Group: Final Report, June 2007

- Implementation Recommendations Team: Final Report, May 2009

- GNSO Special Trademark Issues Review Team: Report and Recommendations, December 2009

- The Current State of the Uniform Domain Name Dispute Resolution Policy: Final Issue Report, October 2011

- Staff Paper on Rights Protection Mechanisms in the New gTLD Program: Revised Report, September 2015

- Metrics compiled on the new RPMs collected for the Competition, Consumer Trust and Consumer Choice Review: https://www.icann.org/resources/reviews/cct/metrics#rights %20protection%20mechanisms

- Nielsen Global Consumer Survey, Phase One: https://www.icann.org/news/announcement-2015-05-29-en

In addition, a variety of external sources were consulted for further background. These include the 2011 WIPO 2.0 Overview of WIPO Panel Views on Selected UDRP Questions[42], a number of academic papers and reports, and the public comments referenced in the UDRP Report and the RPM Staff Paper.

3.2 Discussion of Potential Issues to be considered in a PDP to Review All the Existing RPMs in All gTLDs

3.2.1 Possible Outcomes and Basic Objectives of a PDP

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[42] See http://www.wipo.int/amc/en/domains/search/overview2.0/.

A potential Rights Protection Mechanisms Policy Development Process (RPM PDP) would, at a minimum, review the existing RPMs (including the UDRP) and build on the community's collective experiences of their application, effectiveness and other relevant matters. It is important to note that the scope, rules and procedures underlying the existing RPMs will remain fully applicable unless a GNSO PDP were to propose amendments to one, some or all of the existing policies (and corresponding rules), or recommends the creation of replacement mechanisms. The outcomes of a potential RPM PDP Working Group may include:

- Developing new or additional RPMs (which could also include recommending the development of new or additional procedural requirements[43]);

- Clarifying, amending or overriding existing RPMs (which could include not only situations where particular changes are recommended to a RPM but possibly also scenarios where the PDP does not result in the recommendation of substantive changes to a RPM but rather making certain needed clarifications (e.g. in the applicable language of a RPM));

- Recommending the supplementing of existing, or the development of new, procedural requirements for any existing RPMs (which may more appropriately be performed by an Implementation Review Team convened for the purpose, following adoption of the PDP recommendations); or

- Recommending neither substantive nor procedural changes to any existing RPMs, nor the creation of new RPMs

A review of the prior work done by ICANN that is clearly relevant to considering any potential review of the RPMs at this time (i.e. the UDRP Report and the RPM Staff Paper) would seem to demonstrate that there are no simple problems for which there is a clear and immediate remedy. As such, one basic objective of any RPM PDP that may be initiated as a result of this round of community consultation would be to build on the prior work that has already been done in order to conduct a more detailed review that focuses on the substantive policy rationales and consequent issues raised for and by each RPM, with possible further analysis of the underlying procedural rules as necessary to fulfill that objective. Such a detailed review would ideally be conducted at a very early stage of a PDP, to better 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[44].

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[43] It is envisaged that the actual creation of specific rules implementing any policy recommendations made by the PDP Working Group will be the role of an Implementation Review Team, convened to work with ICANN operational staff.
[44] This exercise would, however, necessarily be postponed to a later stage of work should the decision be made to adopt the third option outlined by staff in this report.

3.2.2 The Fundamental Questions to be Analyzed in a PDP

All the RPMs discussed in this Preliminary Issue Report were designed to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally recognized trademarks. The genesis of the UDRP lies in the discussions around the US Government's January 1998 Green Paper, which noted (among other topics) that "[f]or cyberspace to function as an effective commercial market, businesses must have confidence that their trademarks can be protected. On the other hand, management of the Internet must respond to the needs of the Internet community as a whole, and not trademark owners exclusively." This called for development of a "balanced and transparent process, which includes the participation of trademark holders and members of the Internet community who are not trademark holders, to … develop recommendations for a uniform approach to resolving trademark/ domain name disputes involving cyberpiracy (as opposed to conflicts between trademark holders with legitimate competing rights)"[45]. Following initial work from the World Intellectual Property Organization (WIPO) and policy development work in the Domain Names Supporting Organization (DNSO), the precursor to what is now the GNSO, the ICANN Board approved the UDRP on 24 October 1999[46].

In moving towards the launch of the New gTLD Program, the ICANN Board had acknowledged in 2009 that providing adequate protection for trademark holders in an expanded DNS was one of the overarching issues in the New gTLD Program[47]. Following the submission of a Final Report containing its recommendations by the Implementation Recommendations Team (IRT) that had been formed by the Intellectual Property Constituency at the request of the Board, the GNSO's Special Trademarks Issues team was convened for further consideration of the IRT recommendations. The result of this work was the inclusion of the new RPMs that are discussed in this report, in the final version of the Applicant Guidebook for the New gTLD Program[48].

Since the focus of the 2011 UDRP Report was exclusively on the UDRP and whether or not to review it, and the scope of the recent RPM Staff Paper was on gathering community feedback on the new RPMs created for the New gTLD Program rather than highlighting which issues identified by the community ought to be subject to a GNSO PDP, this means that to date a comprehensive review of all these RPMs has not been conducted. More specifically, there has not been an analysis of whether or not these RPMs are collectively fulfilling the objectives for

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[45] See the Statement of Policy published in Vol. 63, No. 111 (10 June 1998) of the Federal Register: http://www.gpo.gov/fdsys/pkg/FR-1998-06-10/pdf/98-15392.pdf.
[46] The timeline for development and eventual adoption of the UDRP can be viewed here: https://www.icann.org/resources/pages/schedule-2012-02-25-en.
[47] See https://www.icann.org/resources/board-material/resolutions-2009-03-06-en#07 (March 2009 Board resolution setting up the Implementation Recommendations Team to develop appropriate mechanisms to achieve this during implementation of the New gTLD Program).
[48] See RPM Staff Paper for further background on the creation of and community consultations involved in the new RPMs.

their creation as noted above, a question that should be asked independently of any operational and procedural issues surrounding the functionality of the RPMs[49].

Staff recommends, however, further consideration of the following sub-topics and associated questions before commencing a PDP on this topic.

3.2.2.1 Divergent community views on reviewing the UDRP

The UDRP Report reveals two primary divergent views on the topic of whether the UDRP should be reviewed. According to one view, "it is a basic best practice to review all long-standing policies after implementation", whereas the other view was that "a review should not be conducted simply for the sake of form if the policy is generally viewed as being effective and serves the community well."[50] While many commenters to the Preliminary Issue Report had thought that it was not then timely to review the UDRP, a majority had gone further and suggested that the UDRP should remain untouched as a policy framework given its effectiveness, consistency and predictability. The concern was that if a PDP results in changes to the UDRP, this "may adversely affect the reliability and certainty associated with the present interpretation of the UDRP. For example, there may be confusion in the Internet community following a UDRP policy change regarding how to interpret the new policy wording or whether prior published decisions can continue to serve as "precedence"."[51]

Some other commenters noted that while the UDRP has worked well, it is not necessarily perfect. They were therefore amenable to the idea of exploring possible improvements to the procedural aspects of the policy, presumably through changes to the UDRP Rules or development of further Supplemental Rules for providers that would align with the UDRP Rules. However, few other commenters supported conducting a review of the UDRP, including in relation to the question of whether it is indeed fair to respondents.

Based on the public comments received to the Preliminary Issue Report overall, the staff recommendation in the final UDRP Report had been that, in respect of a PDP to review the UDRP, this be initiated only after the URS has been in operation for eighteen (18) months. This is reflected in the GNSO Council's subsequent request for a further Issue Report to be delivered on all the RPMs eighteen (18) months after the delegation of the first gTLD in the New gTLD Program[52]. However, in making the decision whether to move ahead with a PDP to review the RPMs (including the UDRP), the community concerns that are summarized in the UDRP Report on the potential consequences of reviewing the UDRP should be taken into account.

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[49] Many of these were pointed out from the community's perspective in the public comments to the UDRP Report and the initial RPM Staff Paper.
[50] UDRP Report, p.19.
[51] UDRP Report, p.29-30.
[52] http://gnso.icann.org/en/council/resolutions#201112.

Specifically, consideration should be given to the need to differentiate between a review of the Policy itself, and one of the procedures involved in applying the Policy (as noted earlier, this might involve amendments to the prevailing UDRP Rules, or the creation of new Supplemental Rules for providers). Should a PDP be initiated on reviewing the RPMs including the UDRP, the Working Group chartered for the PDP should determine whether and how to distinguish between these tasks as a matter of early priority. Although the PDP Working Group would not be precluded from providing guidance on operational and procedural improvements to a RPM, the actual development of these rules and processes would be more appropriately performed by an Implementation Review Team formed after the adoption of the Working Group's overall policy recommendations.

3.2.2.2 The availability of data and the timing of other relevant review exercises

The UDRP Report contains information and statistics provided by most of the UDRP service providers concerning the number of filings, nature of rulings and other useful data concerning the extent of use and the outcomes of UDRP proceedings[53]. In addition, some providers maintain searchable databases of all UDRP panel decisions[54]. Providers such as the WIPO Arbitration and Mediation Center and the National Arbitration Forum also regularly publish statistics concerning their caseloads and filings[55]. These sources as well as the longstanding nature of the UDRP means that data concerning the UDRP is readily available. Further, as shown by the responsiveness of the various UDRP providers to the 2011 UDRP Report process and other forums of engagement with ICANN, the providers are generally able and willing to provide information and other assistance as may be necessary for analysis and policy work.

The RPM Staff Paper includes a number of charts and statistics illustrating use of the various RPMs in the New gTLD Program, dating to May 2015 (approximately 19 months after the delegation of the first gTLD in the New gTLD Program). In addition, the TMCH service provider maintains statistics on usage of the TMCH[56] while data on the URS can be obtained from the URS service providers. The "newness" of the New gTLD Program compared to the history of the

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[53] See UDRP Report, Annex 3.

[54] See, e.g., WIPO Arbitration and Mediation Center (http://www.wipo.int/amc/en/domains/search/legalindex.jsp), which also maintains statistics at http://www.wipo.int/amc/en/domains/statistics/, the National Arbitration Forum (http://www.adrforum.com/UDRP), the Asian Domain Name Dispute Resolution Centre (http://www.adndrc.org/mten/UDRP_Decisions.php) and the Czech Arbitration Court (http://udrp.adr.eu/adr/decisions/index.php).

[55] See, e.g., WIPO's 2011 paper on "The UDRP and WIPO" (http://www.wipo.int/export/sites/www/amc/en/docs/wipointaudrp.pdf) and the recent release by the National Arbitration Forum (http://www.adrforum.com/news) http://www.wipo.int/amc/en/domains/statistics/

[56] For the TMCH: http://www.trademark-clearinghouse.com/; for the URS: http://www.adrforum.com/URS and http://www.adndrc.org/mten/URS_index.php?st=4.

UDRP means that the data available to evaluate the new RPMs does not match that which is available for the UDRP.

This disparity need not, however, prevent the GNSO from moving forward with a PDP. While postponing a review of the RPMs would doubtless mean more statistics will be available in time, the data currently available would seem to provide a sufficiently rich basis for commencing a review, with the possibility that the PDP Working Group perform a "check" of its work at periodic intervals concerning RPM usage in the new gTLDs (e.g. six months following its inception, the Working Group can request an update on the data currently in the RPM Review Staff Paper from ICANN staff).

Another important consideration concerning the timing of the launch of an RPM PDP is likely to be the coordination of such an effort with other reviews of, or that may be related to, the new RPMs. Of most direct relevance is likely ICANN's commencement[57] of an independent review of the TMCH, which had been requested by the Governmental Advisory Committee (GAC) in its April/May 2011 comments on the Applicant Guidebook for the New gTLD Program[58]. In its request, the GAC had listed several specific topics to be examined as part of the review, including: (1) an assessment of whether non-identical matches can be included in the TMCH (e.g. domain names that include a mark at the beginning or the end of an applied for second level domain, or key terms associated with the goods or services identified by the mark, or typographical variations identified by the rights holder); and (2) consultation with registry operators, registrants and rights holders on the benefits (or otherwise) of extending the Trademark Claims Service beyond the current ninety (90) day period. Notably, these recommendations are similar to some of the comments received in response to ICANN's recent solicitation for input through the initial RPM Staff Paper.

It is important to note that the objectives of the TMCH review include the identification of issues that may be addressed in policy development work. The review is intended to also "help inform the discussion and enable consideration of the rights protection mechanisms available in the domain name space."[59] Care should therefore be taken in a GNSO PDP to engage appropriately with the independent reviewer appointed to evaluate the TMCH and to ensure that the PDP Working Group's timeline and project milestones take the results of the TMCH review fully into account where these raise policy-related issues. It is possible, for instance, that this independent review may reveal additional policy-related topics that would fall appropriately within the scope of the PDP.

Less directly associated with a potential RPM review but nonetheless of likely relevance is the Competition, Consumer Choice and Consumer Trust Review, which is part of the overall review

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[57] A Request for Proposals was issued by ICANN on 7 August 2015, closing on 28 August: see https://www.icann.org/news/announcement-2015-08-07-en.
[58] The GAC had requested a post-launch review of the TMCH one year after the launch of the 75th new gTLD in the New gTLD Program: see https://archive.icann.org/en/topics/new-gtlds/gac-comments-new-gtlds-26may11-en.pdf.
[59] See https://www.icann.org/news/announcement-2015-08-07-en.

of the New gTLD Program mandated by ICANN's Affirmation of Commitments with the United States government. An Implementation Advisory Group was formed in October 2013 to evaluate and make recommendations on the metrics for such a review that were initially proposed by the GNSO and the ALAC. Of the sixty-five (65) metrics ultimately recommended by the IAG in September 2014 for the review, the relative incidence of combined UDRP and URS complaints (possibly comparable to UDRP complaints in the "legacy" gTLDs) was identified as a "first priority" metric, with additional recommendations concerning a survey to be conducted on registrant and Internet users' experience with regard to cybersquatting[60], and information to be collected on the quantity of intellectual property claims and cost of domain name policing relating to new gTLDs[61]. ICANN anticipates this review to commence in January 2016, with the goal to complete the work by December 2016[62]. As with the TMCH review, a PDP Working Group reviewing all the RPMs should also monitor the work and outcome of this review group.

Similar to the matter of data availability, the conduct of these other parallel reviews should not, in and of themselves, militate against launching a PDP to review the RPMs at this time[63]. However, any Working Group that is chartered to conduct the PDP will need to, at a minimum, track and consider any relevant output of these reviews as part of its scope and timeline.

3.2.2.3 The list of potential issues for review in a PDP

A review of the community feedback provided to the UDRP Report and initial RPM Staff Paper shows that some members of the community believe there to be a number of issues that are in need either of policy development by the GNSO or that are ripe for review more generally. While some of the issues identified by the community clearly relate to operational problems and possible procedural improvements, some would seem to warrant community consideration of whether they would be appropriate issues for a GNSO Working Group to analyze in a PDP to review the RPMs. Those issues that appear to clearly relate to operational and procedural matters have not been listed in this section, as they would likely fall outside the scope of a GNSO policy review. The remaining issues that are listed here by staff have largely been derived from the public comments provided to the UDRP Report and initial RPM Staff Paper and are being included as issues that may possibly have some policy impact, without any additional comment as to their merits or level of support for inclusion in a PDP charter. These issues would be specific topics to be addressed as part of their Charter by the PDP Working Group, in addition to the more general, overarching issues such as:

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[60] See https://www.icann.org/news/announcement-2015-05-29-en.

[61] The full report and list of metrics can be viewed here: http://newgtlds.icann.org/en/reviews/cct/iag-metrics-final-recs-26sep14-en.pdf.

[62] This is outlined in the Call for Volunteers that was published on 1 October: https://www.icann.org/news/announcement-2-2015-10-01-en.

[63] Note, however, the possibility of alternative approaches to a full PDP as outlined by staff elsewhere in this report.

■   Whether all the RPMs have, in the aggregate, been sufficient to meet their objectives or whether new or additional mechanisms, or changes to existing RPMs, need to be developed; and

■   Whether any of the new RPMs (such as the URS) should, like the UDRP, be Consensus Policies applicable to all gTLDs, and the transitional issues that would have to be dealt with as a consequence.

The community is invited to give feedback and further input on the inclusion or otherwise of these, and any additional topics, in a PDP charter.

3.2.2.3.1 Potential issues concerning the UDRP[64]

■   Are the UDRP's current appeal mechanisms sufficient?

■   Should there be a limit to the time period allowed (e.g. similar to a statute of limitation) for bringing UDRP complaints?

■   Are free speech and the rights of non-commercial registrants adequately protected in the existing policy?

■   Should there be a formal (mandatory) mechanism of early mediation?

■   Are the current time limits of the UDRP (for filing, response, determinations and appeals) adequate?

■   Should there be rules for the appointment of UDRP panels, such as formalized rotations?

■   Under what circumstances (if any) should/could UDRP proceedings be anonymized?

■   Should there be clearer policy guidance on a registrar's obligations if a case is stayed or suspended?

■   Should the possibility of laches be recognized in UDRP proceedings; if so, how can this be expressly addressed?

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[64] This list should is not exhaustive and the final form of the PDP WG charter (if a PDP is initiated) could add to or subtract from this list of potential issues.

3.2.2.3.2 Potential issues concerning the URS[65]

- Should the ability for defaulting respondents in URS cases to file a reply for an extended period (e.g. up to one year) after the default notice, or even after a default determination is issued (in which case the complaint could be reviewed anew) be changed?

- Is the URS' 'clear and convincing' standard of proof appropriate?[66]

- Is there a need to develop express provisions to deal with 'repeat offenders' as well as a definition of what qualifies as 'repeat offences'?

- Should the URS allow for additional remedies such as a perpetual block or other remedy, e.g. transfer or a "right of first refusal" to register the domain name in question?

- Is the current length of suspension (to the balance of the registration period)[67] sufficient?

- Is the cost allocation model for the URS appropriate and justifiable?

- Should there be a loser pays model? If so, how can that be enforced if the respondent does not respond?

- Should the Response Fee applicable to complainants listing 15 or more disputed domain names by the same registrant be eliminated?[68]

3.2.2.3.3 Potential issues concerning Trademark Claims[69]

- Should the Trademark Claims period be extended beyond ninety (90) days?

- Should the Trademark Claims period continue to apply to all new gTLDs?

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[65] This list should is not exhaustive and the final form of the PDP WG charter (if a PDP is initiated) could add to or subtract from this list of potential issues.
[66] See Section 8.2 of the URS Procedure.
[67] See Section 14 of the URS Rules.
[68] See Section 2 of the URS Procedure.
[69] This list should is not exhaustive and the final form of the PDP WG charter (if a PDP is initiated) could add to or subtract from this list of potential issues.

- Should the Abused Domain Name Label service be continued?

- Does a Trademark Claims period create a potential "chilling effect" on genuine registrations, and, if so, how should this be addressed?

3.2.2.3.4 Potential issues for review concerning the Sunrise Period[70]

- Should the availability of Sunrise registrations only for "identical matches" (e.g. without extra generic text) be reviewed?

- Is the notion of "premium names" relevant to a review of RPMs, and, if so, should it be defined across all gTLDs?

- Following from Question 2, should there be a mechanism to challenge whether a domain is a 'premium name'?

- Should there be a specific policy about the reservation and release of "reserved names" (e.g. modification of Section 1.3.3 of Specification 1 of the current Registry Agreement)?

- Should there be a public, centralized list of all reserved trademarks for any given Sunrise period?

- Should holders of Trademark Clearing House-verified trademarks be given first refusal once a reserved name is released?

- Should Sunrise Periods continue to be mandatory? If so, should the current requirements apply or should they be more uniform, such as a 60-day end-date period?

3.2.2.3.5 Potential issues concerning the Trademark Clearing House (TMCH)[71]

[70] This list should is not exhaustive and the final form of the PDP WG charter (if a PDP is initiated) could add to or subtract from this list of potential issues.
[71] This list should is not exhaustive and the final form of the PDP WG charter (if a PDP is initiated) could add to or subtract from this list of potential issues.

- Should there be an additional or a different recourse mechanism to challenge rejected trademarks?

- Should further guidance on the TMCH verification guidelines for different categories of marks be considered?

- Should the TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?

3.2.2.3.6 Additional Questions

- Do the RPMs work for registrants and trademark holders in other scripts/languages, and should any of them be further "internationalized" (such as in terms of service providers, languages served)?

- Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use?

- Have there been abuses of the RPMs that can be documented and how can these be addressed?

- Is there a policy-based need to address the goal of the Trademark PDDRP?

3.2.2.4 Other factors relevant to the decision whether to initiate a PDP

It is important to note that the above-listed issues may not represent the consensus or majority views of the community. The two prior ICANN exercises that summarized the current state of the UDRP and the new RPMs and that gathered community feedback on their workings did not differentiate between issues that were brought forward by large numbers of the community or by individuals. This is not to say that issues brought forward by a single person would not have the support of others nor that it is less important simply because it was highlighted by just one or a few commenters. Given, however, the fact that all the RPMs are existing and functioning mechanisms, and that the UDRP has been acknowledged to be largely successful in its objectives, the question of whether a PDP should be launched to resolve all the issues identified by the community needs to be very carefully considered, to avoid inadvertently creating new problems (e.g. through an overly long or complicated review process, or creating uncertainty about the future scope of certain policies and associated rules). Should the GNSO Council decide to initiate a PDP to address these questions, it will be necessary for the resulting PDP Working Group to first gain a thorough understanding of the current functionality, applicability, and compatibility with other processes of each RPM. Staff believes that this should occur at a very early stage of work in a RPM PDP.

On the other hand, the UDRP has never been substantively or comprehensively reviewed. In addition, since the creation of the new RPMs there has not been a single, uniform review of all the RPMs or a consideration of their possible applicability to all gTLDs. There is therefore no clear, consistent framework for analyzing all the RPMs that have been developed to date that can assist with the future review and evolution of such protection mechanisms.

Moreover, as noted previously, the UDRP is an ICANN Consensus Policy that is binding on all gTLD registries and registrars whereas the RPMs that were developed for the New gTLD Program were the result of a process of community consultation through various iterations of the Applicant Guidebook for the Program. They are binding on all new gTLD registries through inclusion in the respective contract each party enters into with ICANN, and through the Registrar Accreditation Agreement for ICANN-accredited registrars. Thus, though achieving the same effect (especially from a registrant's perspective), the means through which these RPMs are binding are not consistent.

It may therefore be helpful as a matter of policy consistency for a PDP Working Group to clarify whether or not RPMs such as the URS – being a dispute resolution process modeled on the UDRP – should be a Consensus Policy. In addition, in exploring this question, the Working Group may need to examine the potential consequences of the URS having the status of a Consensus Policy, especially in relation to the so-called "legacy" gTLDs (i.e. those predating the New gTLD Program). The Working Group may wish also to take note of the fact that several registry operators of these "legacy" gTLDs (e.g. .cat, .pro, .travel) recently agreed to adopt the URS in renewing their registry agreements with ICANN. Thus, where the URS is a standard contractual obligation for all registry operators of the New gTLD registries, this is not the case universally for the "legacy" gTLDs.

Moreover, the PDP Working Group will need to take into account the fact that a different but existing PDP Working Group has already been chartered to examine the question of the URS as a Consensus Policy in a narrower, more specific context. This is the IGO-INGO Access to Curative Rights Protection Mechanisms PDP Working Group, which is examining the question of the protection for the acronyms of international governmental organizations (IGOs) at the second level in all gTLDs. In its charter, the IGO-INGO PDP Working Group was asked to review the question whether the URS should, like the UDRP, be a Consensus Policy. Any potential overlap that may emerge with the work of this PDP Working Group, were a new PDP to review all RPMs be initiated, should therefore be taken into account.

Finally, as was noted in the UDRP Report in 2011, the impact of a new PDP on staff and community resources also needs to be highlighted. While this factor should not be dispositive of the issue of whether or not a PDP is launched, it should be a consideration for at least the PDP Working Group in determining its timeline and prioritizing its work. In this regard staff has outlined in this report three options for consideration by the community on how to move forward with the task of reviewing the RPMs.

4 Staff Recommendation

4.1 General Council Recommendation

4.1.1 Scope Considerations

In determining whether the issue is within the scope of the ICANN policy process and the scope of the GNSO, ICANN staff and the General Counsel's office have considered the following factors:

4.1.2 Whether the Issue is within the Scope of ICANN's Mission Statement

ICANN's mission statement states that ICANN should '[coordinate] the operation and evolution of the DNS root name server system; [and coordinate] policy development reasonability and appropriately related to these technical functions.'[72] The review of existing Consensus Policies as well as the RPMs developed for the New gTLD Program fall within this coordination function of ICANN's.

4.1.3 Whether the Issue is Broadly Applicable to Multiple Situations or Organizations

All the RPMs directly affect Registries, Registrars, as well as other stakeholders such as registrants, rights holders, business and other users. These RPMs are applicable across the DNS and changes to any of these policies would equally affect the parties listed above. Other ICANN Supporting Organizations and Advisory Committees will also likely be interested in the issue and the outcomes of a PDP, given the likely impact of these policies and processes on Internet users and the general public.

4.1.4 Whether the Issue is Likely to Have Lasting Value of Applicability, albeit with the Need For Occasional Updates

The UDRP has been in place since 1999 and the RPMs related to the New gTLD Program have been in operation for approximately two years as of this writing. There has to date been no comprehensive overarching review of all the RPMs in the aggregate. A review of these would have lasting value. Indeed, the potential need to review their effectiveness in light of their policy

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[72] https://www.icann.org/resources/pages/governance/bylaws-en/#I

objectives as well as the potential for necessary updates to some of these RPMs is the primary reason for the GNSO Council's request for this Issue Report.

4.1.5 Whether the Issue Will Establish a Guide or Framework For Future Decision-Making

The review of a long-standing Consensus Policy, the UDRP, would establish an important framework for any future reviews of existing ICANN Consensus Policies. In addition, a policy review of the RPMs developed for the New gTLD Program will guide future reviews of such processes, including in future rounds of gTLD expansion. A PDP could also result in clear and consistent policy frameworks for all RPMs in all gTLDs.

4.1.6 Whether the Issue Implicates or Affects ICANN Policy

Any review that results in proposed changes to the UDRP would affect the existing UDRP, which is an ICANN Consensus Policy.

4.2 Staff Recommendation

ICANN Staff confirms that the issue of reviewing the UDRP as well as all New gTLD-related RPMs is within the remit of the GNSO's Policy Development Process as outlined in the ICANN Bylaws.

Staff notes that a complete review of a longstanding Consensus Policy – as well as a review of new RPMs that were developed specifically for the New gTLD Program – is an unprecedented endeavor for the GNSO. The UDRP is a functioning policy that has been in place for a long time. While a review might be beneficial, the prior ICANN work reporting on its operations did not highlight any one issue as generally being agreed as susceptible to a clear and simple remedy. Similarly, the New gTLD Program RPMs have been in place for over two years and do not seem to have revealed obvious problems for which a straightforward remedy can easily be designed through quick consensus.

Staff notes further that any review of the RPMs need not be based entirely on the list of issues mentioned above. Although it is true that the list is based on extensive community consultation, the issues as identified have not yet been subjected to broad community discussion as to which of them represent actual problems with the policies or, more broadly, an example that the policy in question is clearly falling short of its objectives. Staff also cautions against a "pick and mix" approach to these issues for inclusion in a charter for a possible PDP without further community consultation as to which of them – and any additional questions as may be identified through such consultation – would be appropriate topics to refer to a PDP Working Group. Staff therefore invites community feedback through the public comments on this Preliminary Issue Report on which of the issues noted above would be suited to a PDP reviewing the RPMs in light of the objectives that they were developed to address.

4.2.1 Options Presented for Community Input

In light of the many factors to be taken into account in deciding not only whether, but if so how, to move forward with a PDP, staff has outlined three possible courses of action for the community's feedback.

The first option is to initiate a PDP to review all the RPMs in all gTLDs, subject to the factors and according to the suggestions for organizing the work of a PDP Working Group that are listed in this Preliminary Issue Report. A successful outcome of the PDP would address those issues considered most appropriate for policy development work, based on the list included in this Preliminary Issue Report and the future PDP Charter. The PDP should build on the work and substantial community input provided to the UDRP Report and the RPM Staff Paper. The PDP Working Group should prioritize at an early stage the understanding of how the RPMs work in combination and review relevant reports and literature (including from external sources) that can help shed light on any shortcomings or gaps in one, some or all of the RPMs that may warrant substantive change. In addition, the PDP Working Group should take into account any related review efforts (such as the recently launched TMCH Review and the Competition, Consumer Trust and Consumer Choice Review) in developing their final recommendations.

Under this first option, while the outcome of the related reviews should form part of the PDP Working Group's deliberations, it would be the Working Group that determines the appropriate time for doing so. While this option has the advantage of being the same model as is used by the GNSO for its other PDPs, its relatively open-ended approach may not be the most suitable in this context, where even without the related review efforts a full PDP to review all the RPMs would likely be a complex and lengthy one already. When the reviews are factored in, it is apparent that it would be helpful if more specific guidance were provided to the PDP Working Group when launching the PDP.

A modified version of the first option can therefore be considered as an alternative. This second option would still proceed with a PDP to review all the RPMs in all gTLDs, but there would be a mandatory requirement in the Working Group Charter requiring the Working Group to review its timeline and overall Work Plan when the output from the CCT Review is made available. This "built-in" process checkpoint could result in the Working Group pausing its then-current work in order to analyze the potential impact of the CCT Review results, or possibly even altering the scope or direction of its work (which decision should be taken in consultation with the GNSO Council).

There are at least two reasons why staff is highlighting this more specific possible option for the community's consideration at this time. First, as already noted, a full PDP to review all the RPMs in all gTLDs is likely to be a complex process and it will be necessary for the PDP Working Group to determine, at an early stage, whether it would be more appropriate to focus first on the UDRP or on the new RPMs. It is not possible to foresee at this time what stage of work the PDP will be at when the results of the CCT Review are released. The CCT Review is mandated by ICANN's Affirmation of Commitments with the United States government and it has been tasked with examining the workings of the RPMs developed for the New gTLD Program. It is possible that the CCT Review outcome could include policy-related suggestions for the GNSO regarding the new RPMs (although not the UDRP), and it would therefore be reasonable, in launching a

PDP that includes a review of the new RPMs, to allow expressly for this possibility at the outset. However, drawbacks of this second option could include a possible loss of Working Group momentum if there is a change of priorities during the PDP, and frustration on the part of Working Group members at having to alter course or pause in their work as a result (e.g. if work is then ongoing on UDRP review).

A third option would be to conduct a policy review of all the RPMs in two phases, with the initial phase being a review only of the RPMs developed for the New gTLD Program. This can be done through an additional Charter category or task for the PDP Working Group on New gTLD Subsequent Procedures, if that PDP were to launch, or if not, then via a PDP limited to those RPMs. The second, subsequent phase of work would be a review of the UDRP, based on the concerns specific to its scope that were raised in the 2011 GNSO Issue Report and any additional relevant topics derived from the first phase of work concerning the RPMs developed for the New gTLD Program.

One benefit of this two-pronged approach is better alignment of the timing of the work on reviewing the new RPMs with the operational reviews of the New gTLD Program (including the CCT Review) and, conceivably, a new PDP on New gTLD Subsequent Procedures. It may also be noteworthy that this second phase of work can be accomplished through one of the GNSO's newly adopted procedures for an Expedited PDP (EPDP), as by that time the UDRP issue will have been the subject of an Issue Report and thus may be considered sufficiently scoped. Further, in light of the current workload of the GNSO and the resulting demand on staff and community resources, "staggering" the work of reviewing all the RPMs may allow for more meaningful participation by all interested parties. However, one significant drawback to this approach is the fact that community consideration of the more general overarching issue concerning the comprehensiveness of all the RPMs as a set of aggregate protections for trademark holders in all gTLDs, as well as the issue of whether any of the new RPMs should be considered Consensus Policies like the UDRP, will necessarily be postponed to the second phase of work.

4.2.2 Recommended Steps in a PDP

Should the GNSO Council decide ultimately to proceed with a PDP (in whichever form) to review all the RPMs, staff recommends that the following steps be followed by the PDP Working Group.

As one of its first steps, the PDP Working Group chartered to perform this task should prioritize the need to understand fully the scope and applicability of each RPM, and how each of the RPMs interact with and supplement one another, in order to gain a more cohesive view of how the RPMs work collectively.

Secondly, the PDP Working Group should review the suggestions that have already been brought forward by the community regarding possible modifications to the UDRP[73] and the new

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[73] These are summarized in Annex 2 of the UDRP Report.

RPMs at an early stage in its work, possibly considering which are more suited to policy review and development work, and which relate to procedural and implementation improvements.

Thirdly, the PDP Working Group should coordinate with, and track the work of, other parallel or ongoing reviews of specific RPMs and relevant projects that may provide useful data or information to the Working Group (e.g. the ongoing GNSO IGO-INGO Access to Curative Rights Protections Mechanisms PDP Working Group, the pending TMCH independent review and the Competition, Consumer Protection and Consumer Trust review).

Finally, in preparing its timeline and project milestones, the PDP Working Group should take into account the availability of and demands on community and staff resources, so as to facilitate timely and effective outcomes of various stages of its work.

5 Next Steps

Following a public comment period, Staff presentation of this Preliminary Issue Report during ICANN54 and discussion among the GNSO and its Stakeholder Groups and Constituencies, Staff will produce a Final Issue Report reflecting the outcome of these discussions and public comments, which will provide the GNSO Council with recommendations on how it may wish to proceed. The GNSO Council will then vote on the staff recommendations, as to whether or not to go ahead and initiate a PDP on RPM review and, if so, whether or not to adopt or amend (e.g. by forming a Drafting Team to review) the Charter appended to the Final Issue Report – a placeholder version of which can be found in the Annex.

6 Annex A – Placeholder Charter

Working Group (WG) Charter

WG Name:	TBD	
Section I: Working Group Identification		
Chartering Organization(s):	GNSO Council	
Charter Approval Date:	TBD	
Name of WG Chair:	TBD	
Name(s) of Appointed Liaison(s):	TBD	
WG Workspace URL:	TBD	
WG Mailing List:	TBD	
GNSO Council Resolution:	**Title:**	TBD
	Ref # & Link:	TBD
Important Document Links:	• GNSO Working Group Guidelines • GNSO PDP Manual • The Current State of the Uniform Domain Name Dispute Resolution Policy: Final Issue Report • Staff Paper on Rights Protection Mechanisms in the New gTLD Program: Revised Report, September 2015 • Metrics compiled on the new RPMs collected for the Competition, Consumer Trust and Consumer Choice Review: https://www.icann.org/resources/reviews/cct/metrics#rights%20protection%20mechanisms	
Section II: Mission, Purpose, and Deliverables		
Mission & Scope:		

Background

The question of who legally has rights to, or is the legitimate holder of, a domain name can be open to dispute. In relation to domain name disputes concerning the registration and use of legally protected trademarks, the Uniform Dispute Resolution Policy (UDRP) is the longest standing alternative dispute resolution procedure. As a result of the New gTLD Program, several new rights protection mechanisms (RPMs) were developed to mitigate potential risks and costs to trademark rights holders that could arise in the expansion of the gTLD namespace: the Uniform Rapid Suspension Dispute Resolution Procedure (URS); the Trademark Clearinghouse (TMCH) and the associated availability through the TMCH of Sunrise periods and the Trademark Claims notification service; and the Post-Delegation Dispute Resolution Procedures (PDDRPs).

Prior to the launch of the New gTLD Program, on 3 October 2011 ICANN staff had published a Final Issue Report on the current state of the UDRP. The recommended course of action in that UDRP Report was not to initiate a PDP at the time, but to hold off launching any such PDP until after the new URS had been in operation for at least eighteen (18) months. The September 2015 revised RPM Staff Paper had explicitly noted that some of the concerns identified by the community for consideration as part of a review of the RPMs might be appropriate topics for policy development work.

The UDRP has not been subject to comprehensive review. There has also not been a full review of all the RPMs developed to date by ICANN, to consider whether or not they are collectively achieving the objectives for which they were created.

Mission and Scope

Staff Note: The final mission and scope will depend on which –if any – of the options provided in the Staff Analysis on how to proceed is recommended in the Final Issue Report. The feedback that the Community provides during the public comment period will be the determining factor in this. However, at a minimum, the Working Group will be expected to consider the overarching issue as to whether or not 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. The list of issues identified for each of the RPMs in the Preliminary Issue Report is expected to be included as specific questions for the Working Group to analyze, with modifications, additions and deletions as determined by the GNSO Council when chartering the Working Group.

Objectives & Goals:

Staff Note: The final objectives and goals will depend on which –if any – of the options provided in the Staff Analysis on how to proceed is recommended in the Final Issue Report. The feedback that the Community provides during the public comment period will be the determining factor in this.

Deliverables & Timeframes:

Staff Note: The deliverables and timeframes will depend on which –if any – of the options provided in the Staff Analysis on how to proceed is recommended in the Final Issue Report. The feedback that the Community provides during the public comment period will be the determining factor in this.

Section III: Formation, Staffing, and Organization

Membership Criteria:

TBD

Group Formation, Dependencies, & Dissolution:

TBD

Working Group Roles, Functions, & Duties:

TBD

Statements of Interest (SOI) Guidelines:

If a WG is formed, each member of its will be required to submit an SOI in accordance with Section 5 of the GNSO Operating Procedures.

Section IV: Rules of Engagement

Decision-Making Methodologies:

Staff Note: The PDP Working Group will be expected to adhere to the rules in the GNSO PDP Manual and Working Group Guidelines. Depending on the final decision as to how to proceed in this instance, further and more specific decision-making methodologies may be included by the GNSO Council.

Status Reporting:

Staff Note: The status reporting will depend on which –if any – of the options provided in the Staff Analysis on how to proceed is recommended in the Final Issue Report. The feedback that the Community provides during the public comment period will be the determining factor in this.

Problem/Issue Escalation & Resolution Processes:

These are expected to be resolved in accordance with the procedures in the GNSO's Working Group Guidelines.

Closure & Working Group Self-Assessment:

If a Working Group (WG) is formed it will close upon the delivery of a Final Report, unless assigned additional tasks or follow-up by the GNSO Council. A self-assessment of its work will be carried out following the conclusion of the WG's work.

Section V: Charter Document History

Version	Date	Description	

Staff Contact:	Lars Hoffman, Mary Wong	**Email:**	Policy-Staff@icann.org

Translations: If translations will be provided please indicate the languages below:											