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HELSINKI – Cross-Community Session: Review of All Rights Protection Mechanisms in All gTLDs  
Monday, June 27, 2016 – 16:30 to 18:00 EEST  
ICANN56 | Helsinki, Finland

PHIL CORWIN:

Okay. Good afternoon. Day one of meeting B is almost over, but we've saved the best for last, of course. This is the cross-community working group discussion to bring everyone in the community up to date on our new working group which is chartered to review all rights protection mechanisms and all Generic Top Level Domains, both the new TLDs and the legacy TLDs. With some overlap in the RPMs and some that are exclusive to the new TLDs. Let me mention before we get to the first slide and talk about the purpose and scope of this working group, after we do the presentation -- and I'm here -- let me mention, I'm Philip Corwin. I'm a GNSO councillor representing the business constituency. I'm joined at the table by J. Scott Evans who's a trademark counsel at Adobe and a long-time member of ICANN, immediately past president of the International Trademark Association and also a member of the business constituency. And by Kathy Kleiman. And both J. Scott and Kathy had a hand in designing the UDRP. They have experience going back further than mine. And Kathy is a private practitioner, practicing in Northern Virginia and the Washington,

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DC area, and a member of the noncommercial users constituency. So we have hopefully -- and we've had very good cooperation and harmony within the co-chairs and this working group so far.

After we do presentations there's five roaming microphones. We're going to take your input. This session is not for debating what the outcome of our PDP should be. This is to inform you on what we're doing, to get some -- if you think there are questions that aren't listed yet or data you want to present, bring that up. And we have another session of the actual working group on Thursday morning, starting bright and early at 8:00 a.m., and that session is our first topic that this working group is looking to which is the post delegation dispute resolution process the PDDRP, for those of you collecting ICANN acronyms. If you don't know that one, you can jot it down.

So what is the purpose of the -- of this session? We're going to discuss the methodology and timelines for this PDP. We're going to obtain the community's input on the data that should be collected and the issues we're going to be analyzing and whether we've -- already have all the questions we should be asking. Are there others that are missing as of now. Why we're conducting this in two phases. The first phase is to review the RPMs created for the new TLD program, and the second phase, which will be starting, as you see, in early 2018, we have a multi-

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year timeline here, will be the first-ever review of the UDRP. The only ICANN consensus policy that's never undergone review. And we'll give you timelines on that and we're going to take your view on the scope of topics and the data to be gathered. And phase one is our main focus today, and the topics in phase one are the trademark clearinghouse, sunrise registrations which trademark owners get if they have marks they've registered in the clearinghouse. Claims notices which are sent to potential registrants of domains that match marks in the trademark clearinghouse and the trademark owner is also notified if those registrations go to completion. The Uniform Rapid Suspension, the URS, and the PDDRP which I just mentioned. And now I'm -- oh, I think I'm still going here. Next slide, please.

Go to the next one. What is the PD -- yes, that's the one. Yeah. This is a relatively new working group. We just kicked off our activities in March of this year. And again, we're going to be two phases. New TLD RPMs phase one. UDRP phase two. In each phase we're going to gauge, based on the objective data that's available, the effectiveness of the rights protection mechanisms. We're ultimately also going to cover the interplay and the complimentary roles that these RPMs play too, and we're going to fully understand their functioning and effectiveness. And the overarching issue for this working group is whether or not the RPMs collectively fulfill the purposes for which they were

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created or whether additional policy recommendations are needed, including to clarify and unify policy goals. Also, we're always going to be considering whether the processes provide adequate, substantive, and procedural due process to all the parties that are involved.

So who's taking this next one? Handing off to my co-chair Kathy Kleiman who will continue the decision.

KATHRYN KLEIMAN:

Hi, everyone. I'm Kathy Kleiman, and I run the internet law and policy practice of Fletcher, Heald & Hildreth in the Washington, DC area. That's the oldest telecommunications firm in the United States.

And I'm very pleased to be here with my co-chairs, J. Scott Evans and Phil Corwin, and we're beginning a long process. We're still at the very beginning of a long process with this working group, and we're glad you're here to help us with our first public input.

I want to do something that we did in the last working group. I want to ask who's members, who's observers, who's guests. So if you're a member of the working group, could you raise your hand. Outstanding. If you're an observer of the working group, which I'll just let people know, if you don't know, a member actively participates, comes to the meetings. Observers follow

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on the list what we're doing and have the opportunity to become active members if they'd like. So if you're an observer of the working group, could you raise your hand. Great. Thank you. And if you're a guest, coming and listening to us. Terrific. We really appreciate your being here. And I'm going to ask one more question which we certainly didn't ask in the last working group which was on a totally different subject. If you had a hand in creating any of the rights protection mechanisms that is we're going to discuss today, which include the trademark clearinghouse, the Uniform Rapid Suspension, the UDRP, the Uniform Dispute Resolution Policy, could you raise your hand. Great. Great. Big smiles as people take credit for having created things that are now -- that now exist in a lot of ways we created from whole cloth, sometimes 15 years ago with the UDRP.

Okay. So it's my pleasure to take us through these slides which are the rights protection mechanisms that we're reviewing. And in a bit of a counterintuitive process, but one that's been thoroughly discussed and agreed to, we're going to do the oldest policy last. So we're going to do the Uniform Dispute Resolution Policy in phase two. So we're not dealing with the UDRP here.

What we are dealing with is the new rights protection mechanisms created for the new gTLDs. There was a sense in the ICANN community that we were facing a new set of

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challenges with the new gTLDs, especially rolling out many gTLDs at the same time, and that we needed a special set of mechanisms to work with that process. And so that's where the -- the boxes on the left come up. I'm going to start with the orange box, the trademark clearinghouse. And just as people know, but many people might not, that this is a global database of verified trademark information and it supports trademark rights and it's used for some of the other processes that we're going to discuss. So if you have a registered federal mark or court validated mark, you can put it in the trademark clearinghouse and it will be used for the new gTLDs, for different processes.

I'm going to the blue box next because this is two of the processes that use the marks in the trademark clearinghouse. The first is the sunrise registration period. And sunrise services provide trademark holders whose trademarks are in the trademark clearinghouse with advanced opportunity to register their domain names corresponding to their marks before the domain names are available to the public. So that's the sunrise period.

The second trademark claims use that we discuss is the trademark claims. You'll sometimes see it as TM claims. The trademark claims notification services.

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So the trademark claims period follows the sunrise period and runs for at least the first 90 days in which domain names in the new gTLDs are available to the general public. A trademark claims notice is sent to a potential registrant whose domain matches that of the trademark record in the trademark clearinghouse. And the registrant then has the chance to decide whether, after reading the notice, they want to go forward with the registration of the domain name or whether they don't. And if the registrant goes forward and registers the domain name, then the trademark owner is notified at the address they've given to the trademark cleaning house at the email address. And I notice Paul McGrady is here, and he and I drafted the trademark claims notice a number of years ago.

And so now moving to the yellow box. So let's say a domain name goes in and you feel it is an infringement of your trademark. Then you can use either the UDRP which, of course, exists, the Uniform Dispute Resolution Policy, or this new policy, the Uniform Rapid Suspension Dispute Resolution Procedure. This is and was designed as a complement to the UDRP and it provides trademark owners an even quicker and lower cost mechanism for suspending the domain name. On basically the same substantive grounds as the UDRP. The burden of proof and the remedies are not the same as the UDRP. You can't transfer domain name and the burden of proof is higher because

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this was designed as a really -- a really fast abuse mechanism. If it's really, really clear-cut abuse, and that was the term we used when we were drafting it, clear-cut abuse, use the URS. If there are -- if it's more complicated than that, the UDRP is probably the place to go. Or at least that was the reasoning as we created these mechanisms.

So moving on to the gray box, which is the trademark post-delegation dispute resolution procedure, this one is really interesting because it's never been used. This is a challenge to the top-level domain itself by a trademark owner who can -- who asserts that the registry operator is affirmatively engaged in trademark infringement at the top or second-level domain of the gTLD.

We are currently exploring this. We invite you to join us on Thursday morning where we will be talking about this in greater detail.

We're starting -- of all of these new gTLD RPMs, we're starting with the trademark PDDRP.

And then Number 5 is the one we have lived with for so many years, uniform dispute resolution policy. I see Brian Beckham here with us from the World Intellectual Property Organization.

Brian, do you want to wave?

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He runs this dispute policy. This was created in 1999. It provides an uniform standardized alternative dispute resolution procedure to resolve disputes concerning to resolve disputes concerning who is the rightful owner of a registered domain name.

This is applicable to all top-level domains. This is both legacy, .COM, .ORG, .NET, .JOBS as well as the new gTLDs. And, again, we will be getting to the UDRP in phase 2, but right now we're talking about phase 1.

So let me hand this over to J. Scott to talk about this phase that we're in.

J. SCOTT EVANS:

So we decided to start with the PDDRP because it hadn't been used and we thought it was a good way for us warm into the work, is to start with this particular process.

And so we have already begun this process during our conference calls. We've had several calls.

One of the first things we did was we had a presentation by staff on what exactly the mechanism is and what the burdens of proof are and what you have to do to show to be successful. Since we have no cases, we just basically went through the policy and discussed it because we have a lot of people who are

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participating. We have, like, I think, about 120 or so active participants. And some of them have never been involved in a working group, and some of them have never used or utilized any of these mechanisms. So we want to make sure that they understand what they are as we discuss them.

We also then brought in some providers that actually have set up the infrastructure to run these mechanisms in the event anyone should ever bring a claim. So we had someone from, I believe it was, the National Arbitration Forum. We had someone from -- well, WIPO submitted written responses. And then, I think, the Asian dispute resolution folks out of Asia, Hong Kong, they also provided written responses which we went over with the group.

And we had certain questions that were in our charter, but that's a non-exclusive list of questions.

So if there's anyone on the working group or during this session today or during our session on Thursday that thinks we should be considering something else, if there's some sort of data that we should pay attention to or know about, we invite you to let us know because we want to be as inclusive as we can as we have these discussions.

One of the things you need -- the issues that we're going to be grappling with, so you know what we're dealing with -- and this

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is will be for the PDDRP, but it will also be for all the other mechanisms as well -- is, you know -- is this mechanism -- this applies to all of them. Is the mechanism we might be discussing serving the purpose for which it was designed? That's a question we're going to consider with all of them.

If it is, fine. If it isn't, does it need to be changed in some way, either fundamentally on a substantive level or procedurally or some way that would make it more effective? And, if so, what those would be? And we would recommend that to the community. That would be an outcome.

Or should it not apply at all? Should we just get rid of it because it's not serving its purpose? Should there be something different, totally different, that takes care of the purpose?

And then lastly, should it also be applicable on some of these to legacy gTLDs as well, not just on the TLDs that were created in the first round?

So those are the things and the issues that we're going to be looking at with regards to this policy.

So we invite you to -- you know, let us hear from you so we know.

We would love to hear from you, you know, during the sessions and our face-to-face meetings, but you will also have an

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opportunity, once we make our decision, we will be presenting it to the public, our recommendations, and you have a chance to file comment on that and give us feedback on that and we will adjust accordingly, if we believe that we get input that needs to be adjusted to, and then our final report will have taken that in and will come out.

So I -- you should know that we're going to have to -- because this group is handling various mechanisms, there are other groups that are currently looking at things within the ICANN community within the new gTLD process that are going on right now that we're coordinating with.

We've created liaisons to work with those other working groups and you see up on the screen here we're working and coordinating with the new gTLD subsequent procedures group. We're also working with the competition, consumer choice, and consumer trust working group. And then there is a specific independent review going on specific to the trademark clearinghouse that we will be coordinating with as well.

So we are trying to work with all of these groups. We've created liaisons that can let us know where they are in their work, they can stay abreast of where we are in our work, so that we can coordinate and make sure that we're all going forward in a coordinated fashion.

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So now let me quickly take you through -- go up a couple of slides to our estimated time line, so you know.

Welcome to ICANN! Nothing's going to happen quickly!

It's going to be about a two-year process. We're going to take the first year to go through all the new gTLD mechanisms, and you can see up here a rough time line of where everything is going to fall.

But you can see that we probably -- we don't at this point see ourselves getting to the UDRP until the beginning of 2018. And that's just because we have so many other mechanisms to go through.

And of course this is like everyone -- everything else. This is our plan. So it could accelerate or it could decelerate. So far, we're making very good progress and things have been moving on at a pretty good clip. I don't think we've had any substantial waylays or delays that we think have derailed us at this point but we've only been rocking along since probably March. So -- but just to let you know, that's where we are.

We have conference calls every week for an hour, and we've had very vibrant discussions, both in the chat and on line. They only last an hour. And we do rotate our calls in different time frames so that we can hopefully get those in Europe and those in Asia to

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participate with us as well and not always have to be up in the middle of the night. We try to rotate that to be fundamentally fair to our committee members that are outside of the North American time zone.

So there's our time line. I think it's pretty clear. I think these slides will be available, won't they, on the Web site?

So I'm going to turn it over to Phil so he can talk about the community input.

PHILIP CORWIN: Okay.

J. SCOTT EVANS: Oh, I'm sorry. Kathy. I can't see the "K" at the top.

KATHRYN KLEIMAN: Okay. So now we're going to talk about the type of community feedback, the type of input we're looking for, on the rights protection mechanisms that we're reviewing in Phase 1.

Next slide, please.

So I am not going to read all these questions, but the first thing that we're doing is reviewing the trademark clearinghouse, and so what we're looking for here, what we're looking for from our

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members, what we're looking for from the public is: What are your questions about the trademark clearinghouse?

And not only what are your questions, what are your issues, what are your concerns, what are your experiences, but also -- and it's really a separate type of question -- what type of data would you like us to gather from the trademark clearinghouse? What should we be looking at? What should we be asking them in order to help us with the evaluation ahead?

What should we be trying to collect?

So I'll read a few of our questions and then we're actually going to open the microphones, and we'll talk about that process in a second.

So I'll just read a few of them, not all of them, to kind of spark the thinking about the trademark clearinghouse.

So, should further guidance on verification guidelines exist for different categories of marks? Should different categories of marks be considered?

Right now, the trademark clearinghouse registers the category of goods and services, but the sunrise period protects it regardless of the category of goods and services in which a new gTLD may fall.

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Is the protection of the trademark clearinghouse too broad? Is the trademark clearinghouse providing too much protection for those with a trademark on a generic or descriptive dictionary word? Should trademark plus 50 be reversed?

And then the third one, are legitimate noncommercial, commercial, and individual registrants losing legitimate opportunities to register domain names in new gTLDs?

This is some of the questions of the trademark clearinghouse. I know people have a lot more. So we're going to open up the microphones.

Mary, are the individual mics shut off on the desks or are those on for this session?

UNKNOWN SPEAKER: (Off microphone.)

KATHRYN KLEIMAN: Okay. We're just using the roving microphones, and what you do is you raise your hand. There are different zones that the microphones will be in. We'll start with Zone 1, which is over here (indicating), so if you're in Zone 1 and you have a question, raise your hand.

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So again, questions for the trademark clearinghouse, data we might want to gather.

Zone 2 is fine, too.

VIDUSHI MARDA:

Thank you. I'm Vidushi Marda from the Center for Internet and Society.

I wanted to bring up the issue of looking at whether the trademark clearinghouse effectively balances the rights of rights holders versus normal Internet users and whether the trademark clearinghouse creates a tendency to perpetuate the status quo or does it give us avenues that are procedurally and substantively fair so as to balance the rights of rights holders and Internet users?

We've begun looking at it through our work with the CCWP HR, which is the cross-community working party on human rights, where we created initial scoping on particular cases in which these issues have arisen, and I think it would be interesting to build on that work and maybe have a database of -- that -- a more exhaustive database to look into this issue. Thank you.

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**KATHRYN KLEIMAN:** So before you give up the microphone, what would you need for that more exhaustive database? What type of data are you interested in or do you think we should be interested in?

**VIDUSHI MARDA:** I think data, for example, looking at how many cases have helped existing rights holders, how many cases have helped Internet users that do not own the rights at the time that they come to the trademark clearinghouse.

I also think questions of procedure. For example, has procedure been followed correctly in all cases. In the case of deviations, why were the deviations caused, who were the deviations helping.

I think it would be interesting to look at that, because we found it hard to find that data and to actually map it out, so I think that would be interesting to look into. Thank you.

**KATHRYN KLEIMAN:** Thank you. Number 5, please.

**LEON SANCHEZ:** Hi. My name is Leon Sanchez and I'm particularly keen of -- of the question on reviewing accessibility for trademark agents in

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developing countries. That's something that definitely should happen.

But I also would like to question whether the trademark clearinghouse should remain a single provider or should we open it to different providers, of course with a central database that should be accessed by the different providers, because I think that opening to new players in the market would also, of course, foster competition and that would lower the barriers of access for different players, especially in developing countries.

So my question would be: Should we consider opening the trademark clearinghouse to more players that could provide the service?

KATHRYN KLEIMAN: That's a very good question. We'll definitely take that under advisement. Thank you.

J. SCOTT EVANS: But I do want to point out that there is an independent review of the -- of the -- that is probably a better issue for them.

I mean, it's certainly something we can note, but what we're -- what we're trying to figure out is if the -- if -- if the -- if the mechanism itself works. We're not really going to delve in too

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deeply into questions like that one, but I do think we can note it and in our coordination we can let that group know that this isn't the first time it's been brought up. It actually was brought up on our call in a chat. Like, one of the first two or three calls we had, that was one of the questions that was asked by one of the participants.

KATHRYN KLEIMAN: So J. Scott, are you suggesting that maybe this comment be taken directly to the subsequent procedures working group?

J. SCOTT EVANS: To the Trade- -- independent review on the trademark clearinghouse --

KATHRYN KLEIMAN: Okay.

J. SCOTT EVANS: -- which is happening and we'll take that forward.

KATHRYN KLEIMAN: And I would suggest also the subsequent --

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J. SCOTT EVANS: Yes.

KATHRYN KLEIMAN: -- procedures working group --

J. SCOTT EVANS: Yes.

KATHRYN KLEIMAN: -- which may be looking at that as well.

J. SCOTT EVANS: Okay.

LEON SANCHEZ: Can I have a quick follow-up?

The reason for this question to be raised is because I believe that the trademark clearinghouse has failed in its objective to address the needs of the developing countries and, therefore, the question.

KATHRYN KLEIMAN: Thank you for the clarification.

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J. SCOTT EVANS: Remote question?

KATHRYN KLEIMAN: Number 2?

J. SCOTT EVANS: We've got a remote question.

REMOTE INTERVENTION: This is David Tait, the remote participation manager, and we've got some questions from the AC room.

First of all, George Kirikos just wanted to point out that some of the data elements that were discussed in the first question have already been collected by the working group.

We then had a question from Jody Kolker: Is there data available for the trademark holder who has recovered a domain that was registered by a user that did not win the trademark?

And that's it at the moment.

J. SCOTT EVANS: You know, I'm not -- I'm not sure I'm understanding the question, but I don't know if that's data that we know if it's available. I mean, I'm certain that there's data that can tell you how many sunrise registrations were sought and obtained and

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how many trademark claims have issued, and there may even be data that tells us how many claims were issued and then how many proceeded on to registration after a claims notice was received, but I don't know if we have data of that nature because it's so specific to one case, and the trademark clearinghouse itself is not an adjudicatory body. It merely sends out notifications and then you qualify for certain protections that are run by the registries themselves, not by the trademark clearinghouse.

So I'm not so sure where we would find that data, but we'll have that note in our transcript and we'll take a look and see if we can parse out --

If you'd like to send a better formulation of your question to the list so we just make sure that we understood you correctly, that would be very helpful. I think it was Jody? Jody.

KATHRYN KLEIMAN: Go ahead.

MATHIEU WEILL: My name is Mathieu Weill. I'm at AfNIC, the ccTLD manager for .FR, and we're also a registry service provider for several gTLDs.

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First of all, thank you to you all members, and especially the co-chairs, for taking on this outstanding work. This is extremely helpful and I appreciate the approach based on facts and data that you're obviously promoting for that review.

My question, the one I'm not seeing in this list on the trademark clearinghouse, is whether you are going to include in your scope the cost/benefit ratio of the trademark clearinghouse.

Part of the efficiency analysis is to assess whether the benefits are consistent with the expected benefits of the policy for the various stakeholders, but also at some point I think it's essential that we raise the question whether the costs for rights holders, for ICANN, for the community are -- are proportionate to this benefit.

And I think I would hope that this could be added in the scope of that review, because to me this is an absolutely essential question. Thank you.

PHILIP CORWIN:

Yeah. Mathieu, that's an excellent question and it's going to be a difficult one to get the data, I think, because --

Well, in some cases, you know, the two principal benefits of the clearinghouse for the trademark owner is, one, the ability to do a sunrise registration to protect their mark, which the

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prerequisite is that you've registered the mark in the clearinghouse, but we know that there are complaints about the pricing by some registries of those sunrise registrations and allegations that the clearinghouse registration is actually being used as a -- a very aggressive pricing mechanism by some registries.

So there's that discontent.

On the other hand, the other benefit is the claims notice, and the benefit there would be to -- to -- when the -- when the potential registrant gets the claims notice, if they intend to infringe, are they basically deterred by the receipt of the claims notice? But I know that at the last meeting in Marrakech, there was a presentation by the group conducting this independent study of the clearinghouse and I asked specifically, "Will you be able to generate any data relating to either the number of infringing attempts to register that were deterred by receipt of the claims notice versus the number of legitimate registration attempts that were deterred where they wouldn't have had a valid claim against them in a URS or UDRP but the registrant simply was scared off by receipt of the claims notice?"

And the response in both cases from the people conducting the study was, no, we won't be able to generate that data. So in regard to the benefits, we know what the mechanisms are but

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it's going to -- we're not going to evaluate whether the results are satisfactory for both trademark owners and registrants.

J. SCOTT EVANS:

I do want to say one thing, though. In our discussions, I think we have to do some mental parsing here and remember that the trademark clearinghouse is not a rights protection mechanism. It is a database that contains information that is then used in two rights protection mechanisms: The claims notice and the sunrise.

So when we start talking about cost benefit, there are two cost-benefit analyses. One is having a central repository of this information. Is it effective? Is it efficient? Should there be more than one provider that has the ability to do that? Is that affecting price? There's that.

But then there's the question of once you use that information -- and that's the reason we are also going to look at those mechanisms themselves separately, the claims notice and the sunrise position. But we -- they get sort of all subsumed into one when we have these discussions. But they are actually separate things. And when we look at them, we need to keep them separate in our minds because what we're dealing with are different in the problem we're trying to solve.

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One is -- cuts off people, right, to get a domain name because you either get a sunrise and you block someone or you get a claims notice and you may deter someone from going forward. And the other is just -- in my office, saves a paralegal from having to put 15 registrations -- because everyone's going to offer a sunrise to all the separate registries separately because that's what we did in 2008 and that was a mess, right? Because everybody had different requirements. Some people you couldn't staple it. Some people you had to have a certified copy. And so I think we have to realize that when we talk about this, we have to talk about two things. One is the collection of the data and how that data is maintained and whether it should be more than one person. And is that effective and efficient?

And the other is: Then when it's put to use, is that effective and efficient? And those mechanisms, those two separate mechanisms.

I think we had a follow-up from our AFNIC.

MATHIEU WEILL:

Quick follow-up is assessing the costs for each of the parties is central. Of course, the benefits we can always discuss but the costs are available. They should be disclosed for each of the stakeholders because that is part of the evaluation of early mechanism. And I would hope this is brought forward on the

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other topics. It is important that we evaluate whether -- we take that into account when we assess a policy, the cost of a policy. Thank you.

KATHRYN KLEIMAN: Mathieu, just following up briefly, benefits and costs can be interpreted many different ways. And the costs can be both economic and different types of -- other types of costs as well. One we talked about was chilling effects. Through the trademark notice perhaps, somebody might be chilled.

To the extent you can provide us some guidance based on being deeply involved in some of these processes on what the costs would be and how to define them, we'd appreciate that, what we should be looking for in terms of cost. Now or later.

MATHIEU WEILL: Well, what I would be looking at -- first of all, by looking at the TMCH operator and how it's funded, by whom, what amount, what's the unit price, what's the volume. And that's the big -- that's the number one step on the cost that, I think, needs to be part of the evaluation. Thank you.

KATHRYN KLEIMAN: Thank you.

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Further questions on TMCH? I see one from Paul McGrady. I'm sorry. You have been waiting a long time. Thank you.

ANNE AIKMAN-SCALESE: Thank you. It's Anne Aikman-Scalese again from the IPC, and so I will add might bias as a trademark attorney. I actually wanted to make a positive comment regarding the I.P. claims notice. I think it's been very effective for our clients.

And I believe that the trademark clearinghouse has operated in quite an efficient manner. I especially want to commend Vicky Folens. I don't know if she's at the meeting. But they're quite responsive.

And I feel that with respect to the cost assessment that Mathieu was referring to, we also need to look at the cost to the community if, for example, the rights protection mechanism were not in place. I think J. Scott alluded to this a little bit in talking about what would happen if there were no I.P. claims notice, there would be a cost assessment to in particular the business community. And that should also be assessed in any sort of cost assessment, even if it's not a direct cost to contracted parties.

And a question I also have is in terms of evaluating the trademark clearinghouse and its effectiveness and the rights

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protection mechanisms that are associated with that, it's my recollection of the history of the development of these rights protection mechanisms is that they were developed as a basket and as a grouping and they were not developed independently so that in the consensus that was ultimately reached by the community, it was viewed that each of the elements had a part to play.

So as you evaluate each piece independently, I'm curious as to whether the group has a mechanism for treating them again as a group of RPMs, as a unit. Thank you.

J. SCOTT EVANS:

I think that's certainly a question that we will ask ourselves. Because what -- our remit is to decide whether things need to exist, whether they don't need to exist. And I think what you're trying to say is that they were put together -- I think the term at the time was a tapestry of protections. And so they all fit together as this tapestry. If you removed one, then the tapestry wouldn't be complete.

So we will probably -- I would assume, we will be asking ourselves that question if we should recommend that something should be removed or deleted as a protection.

I think Paul had a question.

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KATHRYN KLEIMAN: Right. Let's have one more question -- Are there multiple questions out there? So let's close the queue, and then we'll move to the sunrise registration period after Paul.

PAUL McGRADY: I'm very disappointed because I wanted to say the word "tapestry" first. So that was a big disappointment today.

I think one of the real -- and this -- I would like for everybody in this room to think about how we solve this problem, because I think this is a -- this is the thorniest problem because how do we parse out what was a bad chill and what was a good chill, right? Because it's not necessarily bad for somebody to see a brilliantly drafted claims notice, right, and say, "Oh, yeah, wow, I shouldn't do that," right? That's not a good idea. Versus somebody who feels like, well, maybe they -- maybe they just abandoned some really good idea that would have been distinguishable from the trademark land, right?

Without actually going through and deducing as a group -- because trying to put ourselves inside that person's head -- does that make sense? I think that's a real issue that we are going to have to struggle with. So if there are any macropsychologists in the room or whatever that have any thoughts, I think we would

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love to hear about that because that to me is tricky, right?  
Thank you.

KATHRYN KLEIMAN:

Absolutely. It's very tricky. Although, based on some preliminary data we've seen, a lot of people are turning back. A lot of people aren't going through with registrations. It's in the millions, we think. We'll get the data. We'll evaluate it. But it's a really good question. And, of course, one of the problems we are trying to avoid was the chilling effect. That's why we drafted so carefully.

So did we draft brilliantly? Should there be other things in the notice? Do people understand what their rights are versus what they're being shown? Do we need more languages? So I think we should be looking. It's a really good point that you're raising, and it's going to be complicated. And we hope people will help us with this, especially --

PHILIP CORWIN:

And just to add to that, obviously on the corporate side, the registrants who have marks in the clearinghouse generally have very good trademark counsel taking care of that or outside law firms, people who understand trademark law. Then there are professional domain investors who understand and don't want

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to violate trademark and generally have good trademark counsel to advise them.

But then there's a great mass of domain registrants, and there may be individuals who want to register a generic word at some new TLD that's trademark for something entirely different than what they're intending to use it for.

But they get that claims notice and they go, "Well, I don't want to get in trouble. And I just wanted to do a \$20 registration, not spend \$500 to consult with a trademark lawyer." And they may abandon what might be a legitimate registration. We have to balance all of this somehow.

J. SCOTT EVANS:

All right. I am just going to -- need to go back one slide. I'm just going to show you the questions that we're considering with regards to the sunrise registration period. And for those of you that don't know what a sunrise registration is because I do see on our poll that we had some beginners in the room, that is a preregistration that is offered to a trademark owner who is -- has a mark that is registered in the trademark clearinghouse that they have shown that they are using, okay? And they get preferential. They get it before the registry goes live. So they get a preregistration. It's usually sold at a premium price.

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And so these are some of the issues that we are considering. But as I've said before, these are non-exclusive. So I'd like now to open it up to the group because we're running on time. I'm not going to read through these. They are there for you.

But does anyone have some information or things that they think we should consider with regards to the sunrise registration process? And we have the roving mics. And this is your opportunity. Again, we're going to meeting on Thursday morning. But on Thursday morning we will be focusing on the PDDRP. So this is the time for you to give us information with regards to the sunrise process.

Anybody have any comment, concerns, things you think we need to pay attention to? We got that one right apparently.

I'm now going to turn this to Kathy who's going to talk about the claims.

KATHRYN KLEIMAN:

Okay. So back to me. The trademark claims notification which we've already touched on under the trademark clearinghouse -- if people want to keep talking about the trademark clearinghouse, raise your hand. We will continue on that as well.

So this is the trademark claims period where a registrant for a new gTLD during general availability will be notified about the

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mark in the trademark claims notice is now mandated at 90 days.

Should the trademark claims period be extended beyond 90 days? Should the trademark claims period apply -- to continue to apply to all new gTLDs? Should we extend it to the next round or rounds of new gTLDs or propose it be extended?

Should the abused domain name label service be continued? And then something we touched on earlier: Does a trademark claims period create a potential chilling effect on genuine registrations? And, if so, how should this be addressed?

That's a sample of some of the questions. Perhaps you've got more or experience with the trademark claims, concerns about it, things you would like us to know about it.

Anybody want to comment on the trademark claims period?

Some of the registries here, anyone want to comment on your experiences with it?

Good. Go ahead.

RUBENS KUHL:

Rubens Kuhl, .BR. I wish to convey one thing that was brought to us by registrars, which is not a policy issue. It's an

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implementation issue of trademark claims. It currently has a very limited, very low validity period, so -- like a few days.

So that actually prevents some of the marketing activities that usually are performed by registrars, like selling preregistrations which can't be done if the window -- validity of the claims period is just too low. So actually claims is currently a pain for contracted parties due to its implementation.

There was nothing in the policy that would create this, and this was just created by ICANN staff, and it hurt us all.

KATHRYN KLEIMAN:

Thank you very much. That's an important comment. Thank you.

Werner.

WERNER STAUB:

Thank you. Werner Staub from CORE. I would like to echo what Rubens just said. Actually, we have a whole list of things that need -- not just should, needs to be improved and generally simplified in the sunrise trademark claims and sunrise process.

It is so difficult to use that people mostly just give up. And, you know, that's not a good -- that's not a good way of offering a solution if it's just too complicated.

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The sunrise processes for the registries did -- the way it was done was too hard to do. People just tried to go a past it and then the real action is just after that.

And the registries with respect to the trademark claims -- even though we would have liked to offer the solutions to the affected parties, we would like to make an effort for them, it's so difficult to use they just say, "Let's just give up." They'll say the details is probably -- it's not the discussion here, but that's just what Rubens suggests as one of those examples. There's many more.

KATHRYN KLEIMAN:

I hope you share some of the details with the working group so we can work on this further.

J. SCOTT EVANS:

Yeah, I mean, I think that demonstrates to us that we need to bring in some registrars and registries to our call and have a discussion with them, a frank discussion with them, about what they've seen in implementation of it and where they think it's been difficult for them. I think that we owe that to the community and to ourselves to do that.

So, Werner, I want to thank you very much for bringing that forward because I certainly hadn't been thinking of the difficulty on an implemented registry or registrar. I'm more thinking

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about the effects on either a trademark owner or a user who couldn't get a name rather than thinking on that. And I think it's good that if we explore those issues.

So I would like us to be able to reach out to you and see if we could set up when we get to talking about that and have that as one of our data points that we bring in is to talk not just about the statistics with how things have been used but also look at the implementation and whether some changes should be made that would make it a more effective solution for everyone.

KATHRYN KLEIMAN: Jordyn Buchanan.

JORDYN BUCHANAN: Thanks. It's Jordyn Buchanan with Google. So I have two related comments. We'll see if they actually come together, or questions.

The first one, just to build on the points that were just recently made about, actually, engaging registries and registrars, I think that's useful not only to understand the sort of costs and burdens on those entities but also in this discussion of chilling effects earlier, thing you could talk to registrars and maybe even like track down users who have been -- who have seen the notices and ask them what was their reaction to it. We don't

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have to guess. We don't have to hire a psychologist to say what might a person think, because these notices have actually been displayed to actual people. So you can, ideally speaking, try to figure out who those people are and ask them their reaction to it. That seems like a much more valuable way to try to understand the reaction than to just sort of speculate about how to interpret other sorts of data other than just talking to -- like, other than getting that directly.

And the related point I was going to make is I think in general what you're hearing from the previous speakers from the registry and registrar side, and this is reflected in some of the questions on both the sunrise as well as claims, is it seems like at times registries and registrars are trying to avoid implementing these mechanisms. You know, many registrars just decided not to offer claims. They would wait until 90 days into a registry's launch period and then they would start offering that particular TLD because it was too complicated to implement.

Some of the questions in sunrise about, like, reserved lists and so on I think also reflect maybe not complexity but costs to the registries that they're trying to mitigate through the use of reserved lists.

So I think one thing you may want to take into account, going back do Mathieu's comment about costs and benefits is are

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these so burdensome at times to the people that are implementing it that they're looking for ways to sort of make their businesses still work by sort of working around them. And if so, then maybe there's a way to reform them to get at the same goals or the same results without necessarily carrying the same costs, and then you might actually find better sort of consistency across all operators with how they're actually implemented if there wasn't this incentive to sort of work around them.

KATHRYN KLEIMAN:

Thank you for your comments, Jordan. I'll echo J. Scott's earlier comment that it sounds like we should be reaching out to registrars and registries and potentially through you to registrants to be asking some of these questions about implementation and effect.

Thank you.

PHILIP CORWIN:

Okay. And now we're going to move on to the final RPM that's going to be reviewed in phase one of our working's proceedings which is uniform rapid suspension.

Why does uniform rapid suspension exist? It exists because at the time when the Applicant Guidebook was drafted and the

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rights protection mechanisms were being considered and created within ICANN, there was, I would say, fear and trepidation in the trademark community that there might be as many as 500 applications for new TLDs. Of course the reality was that there were 1900 applications for 1300 unique TLDs. And there was a feeling that the cost and the response time of the UDRP was excessive for the amount of infringement that might be going on in these new TLDs, especially since the pricing models were not known at the time and since then, we've seen every possible pricing model from different registries for different TLDs.

So uniform rapid suspension was created as a narrow supplement to the existing UDRP, and it was meant to address clear-cut black-and-white cases where, just by looking at the domain name, you would essentially know if infringement was going on.

So the three parts of the acronym. Uniform of course means uniform administration of this rights protection policy across the different providers. And the three providers for the URS accredited by ICANN so far are the National Arbitration Forum located in Minneapolis, Minnesota, U.S.A. And we have in the room the new director the arbitration for NAF. The Asian Domain Name Dispute Resolution Center based in Hong Kong. I don't know if there's anybody here at this meeting from that

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group. And the newest one, just accredited recently, is the IP Dispute Resolution Center in Milan, Italy. And we have two representatives who we just met before the presentation started who are here with us.

So we want to make sure that the policies are administrated uniformly across them.

Rapid means really fast, faster than the UDRP that, from the time of filing to the time of decision, and if there is a decision that there is infringement going on to the remedy, which is suspension of the domain, happens quickly within a matter of just a few weeks, faster than the UDRP. And suspension is the remedy. The remedy is suspension of the domain for the life of the registration period for which it was registered. So if it was registered for one year, it's going to be suspended from the time that the decision is made until the end of that registration period, whatever it is.

Some of the questions that have been raised, and we're not going to read all of them again because they're all here on the screen, and we want to hear from you whether we've -- they're all -- the ones you care about are listed. Is the clear and convincing standard of proof appropriate? There's a difference between the UDRP -- they both require a showing by the complainant of bad faith registration of the domain and use of

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the domain, but the burden of proof is higher for the URS because it's supposed to be black and white, not a shades-of-gray case. So whereas in the UDRP, the complainant has to prove their case by a preponderance of the evidence, for the URS, it's a clear and convincing. It's a higher burden of proof. And is that still appropriate based on what we've seen?

Should the URS allow for additional remedies such as a perpetual block beyond the registration period. Or transfer. Transfer is a very different remedy than suspension. And if there's going to be transfer, then I know on the domain side there's concern about attempted reverse domain hijacking, so we have to look at that if we're going to consider transfer as a remedy.

Is the current length of the suspension for the registration period sufficient? Which is similar to the other question.

There are explicit expanded defenses listed in the URS, which is not the case for the UDRP. While there is guidance from WIPO, in particular, based on usage of the UDRP, there are defenses written right into the URS, and we want to see if they're being used and if they're being used effectively.

Should there be sanctions for abuse of the URS? Particularly repeated abuse by a particular trademark owner. And is the

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existing appeals process for the URS appropriate or should it be expanded and improved in some way?

So that's just a few of the questions we've received from the community to date. But again, these are all nonexclusive. And I'm going to stop at this point and open it up for comments from the audience whether there are additional questions concerning the URS or concerns that you have that are not displayed on this slide that you'd like to bring to our attention now. But again, if you don't bring them up now, we're going to be on each of these RPMs for several months when we reach them in our process, and there will be an opportunity at that time to explore anything you want to.

So....

Bret.

BRET FAUSETT:

Bret Fausett from Uniregistry.

In the early days of the URS, we found that I don't think trademark owners understood it very well because we had some people who won the URS who contacted us and said, "Well, now we'd like to get the name." And we said, "Well, you can't get the name. It's suspended." "Well, then how do we get first in line to

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get it when it comes off suspension?" "Well, you need to calendar that and you need to come back and register it."

And sometimes it was actually their trademark. So you want the trademark owner to get it, but you can't give it to them because it's suspended and there's no mechanism to let them be first in the queue.

So we might want to think about how to perhaps convert the URS to a UDRP or put the trademark owner first in line when the thing comes off of suspension or have some mechanism to get someone the name that they want after they've won the URS.

PHILIP CORWIN:

So, Bret, if I'm -- we've already brought up the possibility of transfer, which brings its own debates, but you're suggesting that we consider whether a winning -- a trademark owner that wins a URS should basically get first dibs on purchasing that domain when the registration period ends. I think that's a good suggestion for us to look at.

Is someone -- I don't see hands raised or people --

J. SCOTT EVANS:

You need to raise your hands so we can bring you a mic. Is there anybody?

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So it's your opinion in the room that we've asked all the questions already that should be addressed by our working group.

Okay. We're still open to suggestions as we proceed.

Yes, one from our new providers right here.

IVETT PAULOVICS: Thank you. As mentioned by Philip --

PHILIP CORWIN: Could you state your name and where you're from just for the record.

IVETT PAULOVICS: Yes, sorry. I'm Ivett Paulovics from -- I'm the URS case manager of MFSD, the third URS service provider recently approved by ICANN.

Obviously we have a natural role, so I can only report what trademark owners ask before filing a URS complaint.

They would like to have -- to see clearly what does wordmark mean, because in URS, you can rely your complaint only on a wordmark. And there are some different interpretations in different jurisdictions what does a wordmark mean.

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I mean, for example, in a composite mark where there is also verbal element, if it can be relied -- if a complaint can be based upon such kind of trademarks or not, because we have seen different decisions from providers where exactly on the same mark, there were two different decisions. In one case, Xaman (phonetic) decided that it should be dismissed because it's a figurative mark, so the complainant cannot base its complaint on it. And in the other case, the domain name was suspended.

PHILIP CORWIN: So what I hear you saying is that different providers for the same mark in a different way.

IVETT PAULOVICS: Yes.

PHILIP CORWIN: So that's a concern we have to look at.

J. SCOTT EVANS: I want to clarify for the record. I didn't hear her say different providers. She said two different panelists handled the same mark differently.

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IVETT PAULOVICS: Yes, yes.

J. SCOTT EVANS: So I don't know if that came from the same provider or -- I don't want to impugn a provider here.

PHILIP CORWIN: On a question like that on the validity of the mark, the panelists should I think have a uniform point of view and not be reaching different decisions, but we'll look forward to your input on that.

IVETT PAULOVICS: Okay. Thanks.

PHILIP CORWIN: Other questions or comments out there on URS?

KATHRYN KLEIMAN: And, Phil, I might add, we're looking for input in general on design marks because there has been controversy on how that's been implemented both by the trademark clearinghouse and the URS. So that's an area open for input, and we hope people will provide it.

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J. SCOTT EVANS:

All right. Any more questions? I'm standing between you and a reception, so I'm just going to go to our last slide real quick and let you know that we're doing data gathering in the first phase, just on the new gTLD RPMs. And here are some links for information that we're seeking and taking in. And we would welcome you to provide us with anything you think we should consider. If you know of any studies yourself that have been done by academics or in your particular jurisdiction something that might be prevalent in your particular region or country that we would need to look at, we welcome you to bring that forward to us. You can contact Mary Wong, who is our staff liaison, or Lars Hoffman, who is another of our staff liaisons, and David Tait, the three. You can find their emails on the ICANN website and send them this information and they will make sure it gets disseminated to the list. Because only working group members can post to our list. So we can't -- you'll have to submit it through staff. So if you do have something you would like us to consider, we ask you to contact us and make us aware of, and it we will certainly consider it. But we are taking in information now and looking at things that we need to gather and we're looking to the community to assist us in any way possible.

So I think with that we're going to be able to give you 10 minutes of your day back. I thank you, everyone, for your participation today and for attending. And remember, if you want to attend

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our working group meeting, which will be an actual meeting of the working group, we'll be working through issues, that's 8:00 here on Thursday morning. Thanks.

[ Applause ]

KATHY KLEIMAN: Thank you.

**[END OF TRANSCRIPTION]**