

To: GNSO Council Leadership; RPM WG Council Liaison

Dear Council Leaders and RPM WG Liaison:

We write in our capacity as Co-Chairs of the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group (WG).

As we begin our review of the Trademark Clearinghouse (TMCH), some fundamental confusion and disagreement on substance and procedure have arisen between the co-chairs; we note that such confusion and disagreement is shared by members of the WG. As we were unable to resolve these questions on a 90-minute call held with staff on Friday, August 9th and a 90-minute WG session Wednesday August 15th, and as Council Leadership and the Liaison have asked to be apprised on our ability to work cooperatively and cohesively and to maintain our timeline, we are bringing them to your immediate attention and seeking near-term guidance to facilitate our forward progress.

The issues in conflict are these:

Baseline document – Brian Beckham and Philip Corwin believe that our reference point for analyzing and considering recommendations for proposed modifications to RPMs and the TMCH is the final version of those RPMs and the TMCH as codified in the New gTLD program Applicant Guidebook (AGB). We note that ICANN Staff shares this assessment. Kathy Kleiman, however, believes that our reference point should be the 2009 Special Trademark Issues Review Team (STI) Report (which notably, included Minority Statements on several of the relevant provisions applicable to our work) and that it constitutes “policy” due to its subsequent reference in the December 2009 GNSO Council Resolution adopting the overall package of recommended RPMs and the TMCH (<https://gns0.icann.org/en/council/resolutions#20091217-2>) and the Board resolution that followed (<https://www.icann.org/resources/board-material/resolutions-2010-03-12-en#6>). The STI Review Team was formed by the GNSO Council in 2009 and comprised a cross-section of GNSO Stakeholder Group and Constituency representatives (<https://gns0.icann.org/en/council/resolutions#20091028-3>), including Ms. Kleiman and Mr. Paul McGrady.

Question to Council Leadership and Liaison: Should the final version of the Applicant Guidebook or the STI Report constitute our baseline document for RPM and TMCH review purposes?

Standard for recommending changes – The answer to this question is dependent on the answer to the first. Ms. Kleiman believes that if the WG reaches consensus agreement that any provision of the AGB differs materially from a related provision of the STI Report this should be regarded as an indication that implementation differs from policy and should automatically result in a recommendation that the rule revert to the STI recommendation for subsequent rounds. Mr. Beckham and Mr. Corwin agree with ICANN Staff that the STI Report does not

constitute policy; while they agree that the STI Report and other background materials can be usefully referenced by the WG (and indeed spent the entirety of a recent call refreshing the WG on the STI Report), they believe that any recommendation to alter any provision of the RPMs and TMCH as codified in the AGB and having been implemented by Contracted Parties and service providers for several years now must be supported by consensus agreement within the WG on what the change should be, and we should not revert automatically to STI Report language based upon a finding that the RPMs and TMCH as in the AGB differ materially from an STI recommendation.

Question: Should there be an reversion of the text of the RPMs and TMCH to STI Report language if the WG identifies aspects of the final AGB versions of the RPMs and TMCH which are materially different from the STI Report, or must the WG reach consensus agreement to make a specific change to current AGB language (including reversion to an STI recommendation, if so agreed)?

Note here that our previous work on the URS, Sunrise Registrations, and Claims Notices took the general approach of referencing the AGB codified RPMs as the default starting point.

Status Update

By way of status update, we have recently completed our review of the Trademark Claims and Sunrise RPMs – this review produced a few targeted recommendations (in some cases merely affirming the status quo) and questions on which we will seek specific community input.

We are now commencing a final review of the Trademark Clearinghouse (TMCH) and expect to revisit work done on the Uniform Rapid Suspension system (URS) over the next few months.

We believe this puts us on track for issuing an Initial Report in Q1 of 2020 and based on our current workplan, a Report on Phase 1 of our work for the Council's consideration in Q2 of 2020.

The remainder of this letter states the views of Brian and Philip, which is also that of WG support staff, while also noting Kathy's divergent position.

Historical RPM policy work

As part of the GNSO's work on the Introduction of New Top-Level Domains, the Protecting the Rights of Others Working Group (PRO WG) was convened. Because the PRO WG failed to produce specific policy recommendations, as far as Intellectual Property is concerned, the GNSO's Final Report on Introduction of New gTLDs of 2007 recommended that "Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law."

The actual black-letter text of the RPMs (Claims Notices, Sunrise registrations, the URS, and the PDDRP) we are reviewing are not themselves drawn from the text of GNSO and Board-approved

PDP consensus recommendations,¹ but are rather “implementation details” of the above-quoted broad policy recommendation.²

This implementation was informed by the Implementation Recommendation Team (IRT) and Special Trademarks Issues review team (STI),³ and is codified in the Applicant Guidebook (AGB). While a December 2009 GNSO Council Resolution endorsed the STI report, the final language of the AGB regarding RPM details was developed over a 4-year period run by ICANN Staff with substantial additional community input. Against this background, are RPMs are “Consensus Policies” as that term is understood in ICANN’s Registry Agreement? By way of contrast, any consensus recommendations made by this Council-chartered RPM Review WG that are subsequently approved by Council and the Board may become Consensus Policies if that is the recommendation of the WG.

Our Charter does not mention the STI Recommendations or AGB, but does state that we “shall maintain a close working relationship with [the SubPro WG]” and we note that the SubPro WG has been referring to the AGB as its baseline document. (It is noted that in reviewing the URS and other prior RPM work, we have used the AGB as our baseline document.)

Further Consideration for Council

By way of reminder, our Charter states that “the overarching issue [to be considered is] whether or not all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify the policy goals.”

It does not mandate the WG to assess compliance with the STI Report.

In addition, both the Preliminary as well as the Final Issue Report that the GNSO Council voted on to charter our WG specifically note that the 2012 RPMs were developed in the course of implementation of the New gTLD Program, as “the result of a process of community consultation through various iterations of the Applicant Guidebook [and thus] 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” (in contrast to the UDRP). One of the general questions that our Charter requires the WG to consider is whether these RPMs should, like the UDRP, become Consensus Policies applicable to all gTLDs.

It is Mr. Beckham and Mr. Corwin’s understanding that in the absence of consensus recommendations, the status quo will remain in place, i.e., no changes will be made to the existing RPMs and TMCH as reflected in the final version of the AGB. Again, we note that Ms.

¹ Even so, some Working Group members seem to be of the view that these RPMs are “Consensus Policies” under ICANN’s Registry Agreement.

² A more detailed chronology of relevant actions and source documents relating to the TMCH that has been provided to the RPM WG is attached for the Council’s reference.

Kleiman's position differs and that she believes any materially contrary AGB provision should revert to the STI recommendation, and that failure to do so undermines the core of the multistakeholder policy development process. (We note there was at one point a "policy and implementation" WG convened, but that its status is unclear.)

*For clarity, **all** co-chairs are collectively of the view that even if the status quo for these RPMs would be the AGB-codified RPMs and TMCH, the work of the STI can usefully inform our WG discussions; and that the WG is free to recommend changes in the AGB provisions, including reversion to an STI recommendation. The difference is over what constitutes our baseline starting point, and the process for recommending changes.*

Thank you in advance for your consideration and any response you are able to provide. Please do not hesitate to contact us if we can provide additional background or information. We would be happy to get on a call with Council Leadership and our WG Liaison to discuss this matter if you believe that would be helpful.

Sincerely,

Brian Beckham
Philip Corwin
KathrynKleiman