

**IGO-INGO Access to Curative Rights Protection Mechanisms Working Group
TRANSCRIPT**

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Attendees:

George Kirikos - Individual
Petter Rindforth – IPC
Phil Corwin – BC
Kristine Dorrain- Individual
Mason Cole – RySG
Val Sherman - IPC
Osvaldo Novoa – ISPCP
Paul Tattersfield – Individual
Jay Chapman – Individual
Jim Bikoff – IPC
Kathy Kleiman - NCUC
Mike Rodenbaugh - IPC

Apologies:

Imran Ahmed Shah – NCUC

ICANN staff:

Mary Wong
Steve Chan
Berry Cobb
Terri Agnew

Terri Agnew: Good morning, good afternoon and good evening. This is the IGO INGO Access to Curative Rights Protection PDP Working Group call on 4 March 2015.

On the call today we have Petter Rindforth, Mason Cole, George Kirikos, Jay Chapman, Val Sherman, Philip Corwin and Kristine Dorrain. Joining us a little

later in the call will be Jim Bikoff and David Heasley. I show apologies from Imran Ahmed Shah.

From staff we have Mary Wong, Steve Chan, Berry Cobb, and myself, Terri Agnew. I would like to remind all participants to please state your name before speaking for transcription purposes. Thank you very much and back over to you, Phil.

Phil Corwin: Well good morning, afternoon or evening to all of you. And thank you for joining our first meeting since our face-to-face in Singapore. I hope everyone got back without too much hassle and has certainly recovered from jet lag by now.

We had the roll call. Are there any updates to statement of interest before we plunge into the meat of this meeting? Okay hearing none and seeing no hands raised, I think staff is going to give us a short recap of the Singapore face-to-face based on the surveys that were turned in there and since. Do we have something to put up on the screen on that or is staff just going to report?

Mary Wong: Hi, Phil. This is Mary from staff. We don't have a document ready but we can just give a very brief report orally. Basically we just want to thank everybody for taking the time either in person or remotely to participate for as long as you could. And we also wanted to thank people for responding to the survey.

So basically the survey show, of the people that responded, and I would say that was probably two-thirds of the folks who participated at the meeting, that everyone who responded thought that the meeting was very useful. The responses ranged from 5 to 7 on the 1 to 7 scale in the response form, if you'll remember. So that was good to know because it would be helpful as we report back to the GNSO Council on the success of this pilot project.

The other thing is that we did get some good suggestions from a few people as to how to better run these things in the future including the possibility of

having a camera or some sort of video on the people who are physically in the room to help equalize things with the remote participants. So we're going to take all of those suggestions back.

And finally, I wanted to add also that we as staff have followed up on what we think from our notes all the outstanding requests and follow-up items from that meeting noting that no decisions were made at the meeting, although there was some points of agreement.

If there had been some attempt at making decisions obviously we would have to take those back to the broader group. But for now we are looking at follow-up items and we've already started sending on one or two of those.

So, Phil, that was our recap and update. I don't know if you or others had any other points to add or questions?

Phil Corwin: Thanks for the report, Mary. All I would add is that I found the ability, the face-to-face meeting afforded an ability to continue to work on issues and until we got to a natural stopping point on them, which was much better than, you know, sometimes in these hour calls we have to drop things when another 20 minutes would let us get to a more natural finish point.

The one other lesson I took away, which is coming up in another working group I'm on which is looking at possible face-to-face meeting in Buenos Aires is that if I had to do it again I'd prefer to schedule it on the Friday before the meeting rather than the Friday after when people were pretty exhausted.

I don't know if the Singapore meeting will be typical but I found that a particularly demanding meeting in terms of timing demands. It may have been the jet lag too but to do a full day focused meeting after six days of other meetings was a bit much. Any other comments on the face to face before we move on?

Hearing none, the next item staff will give us an update on the international law research. They prepared an outline for experts in this area that the co-chairs have had a chance to review and edit. So why don't we have an update on that? And when we can get into the heart of the meeting, I see we have Kristine Dorrain with us, or do we still have Kristine?

Terri Agnew: And I believe she was having some audio difficulties with her Adobe Connect...

((Crosstalk))

Phil Corwin: Okay, well we hope she can make it back for the next portion on UDRP and URS. Who's going to update us on where things stand on getting guidance regarding the scope of and the limits on sovereign immunity for IGOs?

Mary Wong: Phil, that would be me, Mary again. So...

Phil Corwin: I thought it might be.

Mary Wong: Although this is something that Steve Chan has worked a lot on certainly in terms of liaising with one of the experts that we have identified and contacted. So this is one of the follow-up items from the Singapore face-to-face meeting where, as you will recall, we started our substantial discussion of the sovereign immunity issue and very quickly realized that it would be very much more helpful to our continuing deliberations if we actually had some input and information, in fact, about the scope and operation of sovereign immunity as an international law principle.

Certainly and specifically with respect to how IGOs use that, benefit from that as well as any limitations that might apply either generally or in relation to IGOs in this specific context.

So as Phil noted, staff prepared a background document and a list of specific questions that we can share with the working group. But we wanted to get that done quickly because we did want to get experts and to get their views back to you as quickly as possible so as not to hold up the work of this group.

Essentially what we did was we did a bit of research on the sovereign immunity principle, some of the treaties and customary practices surrounding sovereign immunity including in the treaty that some of you may know as the Vienna Convention on the Law of Treaties.

And based on that, we came up with a series of specific questions related to the work of this group. And fortunately, our IANA department has worked with a couple of experts on the dot-Int registration which is also one of the topics that we spoke of in our face-to-face. So we have reached out to the international law expert that has worked previously with IANA on this issue given that he is also someone who has expertise and experience in the IGO area.

He has responded initially quite favorably and we are hopeful that he will be able to provide us with helpful substantive input within the next week or two. And obviously then we would want the working group to review his response and potentially ask further questions or decide on the next appropriate step.

So, Phil, that's where we are on the international law/sovereign immunity point.

Phil Corwin: Well, thank you. And of course that's a critical issue for us because as we move toward completion of our work we've got IGOs making a claim in regard to the appeals process, they can never, ever be subject to a national court or national laws for any purpose. And to the extent we got into this issue in Singapore we found out that even for nation states there are limits to sovereign immunity.

So we're going to have to figure out exactly what we believe the valid scope of sovereign immunity is to move further down the path for deciding how to deal with that issue. So were there any other comments on the sovereign immunity issue before we get into the UDRP URS comparison? I see that Kristine is back with us to help in that exercise. So other comments on sovereign immunity?

Kathy Kleiman: Yeah, Phil, this is Kathy.

Phil Corwin: Okay, Kathy.

Kathy Kleiman: Can we find out the name of the - first, apologies for joining late. Can we find out the name of the expert Mary is talking about?

Phil Corwin: Mary, do you have that information? Is that available? Yeah, go ahead. And thanks for raising your hand.

Mary Wong: Not at all. And thanks for the question, Kathy, I was actually just typing a reply in chat but essentially we have contacted him and he's a very experienced person but until we hear affirmatively from him that he's able to provide us with the input and so forth I think it might be easier for us to hold back on that information until then very we hope to hear back from him within the next day or two definitely.

And obviously if there are names of experts that folks would like us to reach out to please let us know as well.

Phil Corwin: Okay so he's not the only potential expert we would look to here. So if other people have ideas please get them into us. Other comments. And if you have comments or questions please raise your hand if you're in the chat room to help out your moderator.

Seeing none why don't we, just to set the stage, we're considering whether IGOs and - should have access to the existing RPMs, which are the UDRP and the URS, or whether we need a new curative rights process for some reason.

And while we are biding time on sovereign immunity we thought that useful-- some of us are familiar with the primary differences between UDRP and URS because we are involved in the lengthy debates on the creation of the URS in the Applicant Guidebook for new TLDs. Some of you may not be as familiar, it's probably all worth a reminder of the key differences and similarities and also maybe perhaps a look at how the URS has been faring with new TLDs.

The one thing I'll mention before - and is Kristine going to take us through this chart that we have?

Jim Bikoff: Phil, before Kristine does can I make a comment? It's Jim Bikoff.

Phil Corwin: Yeah, I let you comment in a minute, Jim. The key thing I wanted to point out, and then we will let others jump in, is that a key fundamental difference in terms of their fundamental nature is that the UDRP is a consensus policy of ICANN which requires all registries and registrars to comply with it.

Whereas the URS was an implementation detail of a policy principle in the new TLD program to protect trademarks and other intellectual properties. So it doesn't have the same status right now as the UDRP.

And whether it should be common consensus policy will probably be considered if there's a PDP on the RPMs including the UDRP following the delivery by staff of an issues report on the new rights protection mechanisms and that delivery date was pushed back with consent from the GNSO Council until October 30 of this year.

So we're going to have an issue report this fall on how the new RPMs are doing. There's already a staff report out now available for comment, and I may mention that, but that's not the issues report that would set up a potential PDP. So I'm going to stop talking there, let Jim talk and then Kathy has her hand up, and then we will get into going through the comparison chart. So, Jim, go ahead and then Kathy.

Jim Bikoff: Yeah, thank you Phil. I just want to say George had raised on an email earlier today about two issues that are on the chart that we had submitted earlier. And he's right in both; on been no express length limit, what we intended there was that there is no express length limit dictated by the rules of the UDRP but there are limits provided by each of the providers so that, as he pointed out, so that you have to look to the individual providers.

We should have probably asterisked that and put in since there are now multiple providers of UDRP decisions, we should have put in that you have to look to each provider for the length.

And on the second point, he's absolutely right also, it's - the legal proceedings can be initiated either prior to, during or after the proceeding is commenced so that those are two things that can be corrected. And other than that, I think I've said what I wanted.

Phil Corwin: Okay. And, Kathy, your comment please or question.

Kathy Kleiman: Actually as long as we're discussing the details I'll defer my comment for a little bit; it's more a big picture comment.

Phil Corwin: Okay.

Kathy Kleiman: But I wasn't sure if Jim - I don't want to cut Jim off from going through more of the details here because that's what we're sitting here looking at on this, which is great, thank you.

Phil Corwin: Okay. All right so now we've got the chart to go through. I see a question - a comment from Kristine that she wasn't warned - maybe she's not supposed to be taking us through, it's Jim's chart. I'm not sure if staff intended to take us through it for Jim or whoever but we can get started. And we've got about 30 minutes to go through this and discuss it. And, Mary and Kathy, is your hand still up? If not please lower it.

Mary Wong: Phil, this is Mary from staff. Just to say that, yes, this was prepared by Jim, and thank you for the comments and clarifications. Jim says Kristine is on the call she is prepared to talk about the differences between the two procedures. So we can handle it whichever way the group might feel is most appropriate or effective.

Phil Corwin: Yeah, and I think - thanks Mary. I don't really care who leads a discussion on this. But I think Kristine can be most helpful because NAF is one of the two accredited providers of URS arbitrations, the other one being that Asian Domain Name Dispute Resolution Center. So who is going to take us through this chart? Is there going to be Mary? Is it going to be Jim?

Jim Bikoff: This is Jim, Phil. I'm happy to defer to Kristine.

Phil Corwin: Does Kristine want to do it?

Kristine Dorrain: And this is Kristine, and I am willing to. Yes, I'm perfectly willing to.

Phil Corwin: Okay, I realize it would be difficult for Jim because he's only on the audio so he can't see what's on the screen.

Jim Bikoff: No, I can. I have it on the screen in front of me but I am happy to let Kristine walk us through.

Phil Corwin: Oh okay, because I didn't see you listed in the chat room but that's fine.
Okay, Kristine, let's go.

((Crosstalk))

Phil Corwin: After you.

Kristine Dorrain: All right, this is Kristine from NAF so we will walk through the chart as provided on the screen. So with respect to the elements of the claim, URS and UDRP are very similar. The primary difference between the two is in Number 1. So Numbers 2 and Number 3 are basically in-substantive changes so we are - for URS the bad faith requirement eliminates the plural option, and for URS it eliminates - a change is all references from respondent to registrant in the URS. So those are the substantive differences on elements 2 and 3. So the main difference is in Element Number 1.

And so really the main difference is a complainant must hold a registered word mark, and that's really the key difference when the policies are compared. So in the UDRP it's very vague. The domain names are identical or confusingly similar to a trademark or service mark in which the complainant has rights, and analysts interpret that to mean whatever the specific jurisdiction would count as rights. So if that jurisdiction recognizes common-law rights or what some places just simply call registered or unregistered rights, that is - UDRP analysts find that is a sufficient to pass the hurdle of policy paragraph 4a(1).

URS is different in that the complaint it is required to hold a word mark, and it needs to be a valid registered mark, and it has to have current use. And so there's sort of a three-pronged peace there. And now we don't want to overlook B and C, which is the validated through court proceeding or specifically protected by statute or treaty, specifically for this specific purpose.

Although to date there have not been any URS cases that have relied on a trademark under either B or C, they've only relied on A to my knowledge which is the valid national or regional registration. We do get some questions about whether or not the word mark is actually a requirement. So that's the key difference.

So I think that that, Section C, specifically protected by statute or treaty, is very beneficial to the, you know, the topic at hand. So I'm not sure, Phil, you know, other than highlighting the differences and similarities, do you want me to pause so we can discuss...

((Crosstalk))

Phil Corwin: Yeah, I want to do a quick pause at the end of each section for people to have comments. My very quick comments are, one, the specificity for the - the requirement for a valid national or regional registration and current use, I think that's part of the whole URS is designed to be four black-and-white situations and not where anything is gray that might take additional time for the examiner to ferret out including the standing.

And, thank you, I had forgotten that this treaty language was in here and that would certainly seem to be applicable to the Paris Convention. So it doesn't mean that IGOs don't have standing in a UDRP, just that their ability to have standing is much clearer in the URS elements.

Kristine Dorrain: Yeah, and I would add to that further - this is Kristine from NAF again - two things, one is that what I found in my review of the URS is that they URS tended to codify what was already the UDRP practice in most cases. So it took sort of the majority views, and it codified them.

So under UDRP we have seen examples of trademarks that were validated through court proceedings. We've seen examples of trademarks that were specifically protected by statute or treaty. So I think - I think that we know that

URS has adopted the actual practice of the UDRP. So I think that's interesting.

The other thing to point out is that, and maybe this is relevant for further discussion, is that when it comes to use, use is a requirement and it has to be proven one of two ways. Either the complainant can submit the SMD file directly from the trademark clearinghouse that says they've had their trademark validated for use.

The other way is to independently submit the type of data that would establish use. So basically the same sort of information that the trademark clearinghouse would be looking at would be reviewed by the examiner in that specific case as well. So that's something to think about as well with respect to the URS.

Phil Corwin: Okay, and I see hands up from Petter and then Kathy so, Petter.

Petter Rindforth: Thanks. Petter here. Yes - I mean, we have discussed previously that there may be other reasons why we were not - come to any conclusions specifically when it comes to the URS and focus on what to do with the UDRP when it comes to IGOs.

But to me it seems that the IGOs seems to be more or less already covered by the URS, if we talk about how to read (unintelligible) 1c specifically protected by a statute or treaty, it affects - that we have the Paris Convention. And also when you're talking to IGOs and when you also see the protection that they have when it comes to national legislation it's not transferred is to stop anyone else from using it in the bad faith.

And so here again the URS there is no transfer of the domain names, it's just to stop it, which also actually covers what the IGOs really want to have from these dispute resolutions. So again it seems that if you read this freely but

still in the - in a legal way it seems that it's already more or less covered by the URS today. Thanks.

Phil Corwin: Yes. Okay, Kathy.

Kathy Kleiman: That's interesting what Petter just said that we might not even need to review the URS in terms of what we're looking for. I did want to point out for those of us who drafted - helped to draft the URS we considered it very different than the UDRP. And wanted to especially bring notice to the defenses to the claims.

In drafting that the defenses to the claim for the URS are much more fleshed out, one might say, than the UDRP. And in many ways relies on the UK defenses that had been enumerated and that we referred to and frankly probably plagiarized in order to put them into the URS.

And the URS - and I wanted to mention on the big picture, as was discussed earlier that the URS is really intended - the URS doesn't apply to dot-com, dot-org, dot-net, dot-gov, dot-edu, anything, it is for - it was designed as a special protection for the rollout of new gTLDs for trademark owners and for the others that are protected.

But it was kind of a very quick and dirty evaluation. I'm not sure if the URS gives IGOs really the place for the kind of evaluation that we are talking about here.

You know, we've talked about when the trademark office looks at - say the US trademark office has a registration of an IGO name, they're supposed to really look at if there's kind of a confusion or misleading, there's an evaluation there that may be much more appropriate in the UDRP than the URS given all the limits on the URS both in terms of scope and (unintelligible). Hope that made some sense. Thanks.

Phil Corwin: Okay. All right, Kristine, let's move onto evidence of bad faith. Hello? Kristine, you look...

Kristine Dorrain: Oh yeah, I'm so sorry.

((Crosstalk))

Kristine Dorrain: I muted myself.

Phil Corwin: Yes, we all do that.

((Crosstalk))

Kristine Dorrain: This is Kristine. I'm sorry. Yes so on the first four factors for evidence of bad faith under URS are verbatim from the UDRP. They're exactly the same. So it's the same be registered or acquire the domain name primarily for the purposes of selling, renting or transferring it to the complainant who is a trademark owner, for valuable consideration in excess of documented out-of-pocket costs. So that's identical.

The way it's characterized on this chart the only difference is actually the UDRP doesn't even use the word "registrant" it uses the word "you" so that's - but other than that that's the only difference.

Number 2 is what we call prevent and pattern which is the registrant registered the domain name to prevent the trademark owner or service mark from reflecting the mark in a corresponding domain name provided that registrant has engaged in a pattern of such conduct. That's identical to between the two policies.

The registration of the domain name primarily for the purpose of disrupting the business of a competitor, again identical. And then using the domain name the registrant has intentionally attempted to attract for commercial gain

Internet users to Website or other online location by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondents or registrant's Website or location of a product or service on that Website or location.

So those are the identical pieces. Now that URS (unintelligible) and other possible additional (unintelligible) of bad faith which is sort of holding a large portfolio of domain names is not bad faith, trading them for profit is not bad faith unless given the circumstances the panel finds otherwise.

So it codifies which is absolutely true under the UDRP, that's what panels have found under the UDRP, it's the majority view. And so this first possible addition of bad faith codified something that's true under the UDRP as well even though it's not specified.

And then the second thing is that just simply having traffic and earning money and revenue is not per se bad faith as well, however it could be abusive given the conduct and given the circumstances so both of those are well-established under the UDRP even if they are not codified in the UDRP.

Phil Corwin: Okay.

Kristine Dorrain: The - yes.

Phil Corwin: Were you done? I thought you were.

Kristine Dorrain: With that section, yes.

Phil Corwin: Yeah, let's stop there. A quick comment, the possible additional issue of bad faith I believe I had some role in getting them in their back in the debate at the time. But I'm just curious, Kristine, since those are both elements that wouldn't be obvious whether the registrant owns lots of domain names or whether the domain is parked and is monetizing traffic comment have those

issues ever come up in a URS action or are they more properly the kind of gray area that would require switching it over to a UDRP?

Kristine Dorrain: Well so far that URS cases that we've seen to date have generally not had a lot of activity on them at all. I mean, there's been very little parking, very little sort of pay per click, very little use at all with these domain names. Either they are sitting idle or they have sort of a (unintelligible) page, so they're not generally - they're not generally earning money at this point.

So that analysts have not specifically, in the ones I've reviewed, they've not specifically discussed these exact issues. I will say that the - in the sort of very controversial email (unintelligible) email URS cases that people tend to be following, some of the panelists have put some stock in the fact that he seems to be stockpiling brand, dot-Email names and believe that that is - but that sort of large portfolio of domain names is bad faith but given the fact that he is primarily registering brands dot-Email.

So they have not talked about sort of just generally, you know, if you're a domainer and you hold a large portfolio of domain names.

Phil Corwin: Right. Let me ask you one more quick follow-up. I'm just curious, you said most of URS cases have involved webpages we're basically nothing was happening, there was limited or no use. If that's the case how does the examiner decide if there was bad faith use if nothing - if there was really nothing at the page?

Kristine Dorrain: Yeah, so the ones where the complainant loses, that is typically the reason is because there is nothing happening on the page yet. At a minimum sometimes they will have put something up there and a panelist will infer that whatever they're doing with it - it's not, you know, good faith.

And then they don't come out and say it but there is a UDRP sort of underlying principle that crops up occasionally called, "no conceivable good

faith use" which is - nobody can conceive of, respondent hasn't put forward any plausible argument of what the heck you're doing with FedEx dot whatever.

And so they would also say that, you know, because you're using it for pay per click and I can't imagine a good faith use, you know, I would find for complainant in that case. But the ones where the complainant has lost have mostly been because the domain name is not being used yet at all.

Phil Corwin: Right. Right, I know a lot of trademark owners kind of have a long list of domains they're watching it if they ever start getting used they might pounce on them with a URS but right now...

Kristine Dorrain: Right.

((Crosstalk))

Phil Corwin: ...think there is any claim yet. Any comments on that section before we move on to defenses to claim? I don't see any hands so let's move onto defenses.

Kristine Dorrain: Okay so again the first three here are verbatim taken from the UDRP. The first three are - they weren't listed under ways respondent could - to prove their own rights and legitimate interests, so they weren't called defenses under the UDRP, it's just called 4(a)2 which was the - you have no - the respondent has no rights or legitimate interest in respect of the domain name.

And then 4(c) gives respondent a list of how to demonstrate your rights to and legitimate interests in the domain name in responding to a complaint. So 1, 2 and 3 here come from that which is if you've made demonstrable preparations to use the name in connection with a bona fide offering of goods or services, either commonly known by their name, even if you don't have a trademark, and if registrant is making a fair use of the domain name without intent for commercial gain to divert customers from or tarnish the trademark.

So those are directly verbatim from the UDRP. Now as Kathy pointed out, then the URS went on and added additional defenses in talking about ways that the examiner can find - or the registrant can also show that they haven't used the domain name in bad faith.

So that's a little different tweak. So rather than saying affirmatively, these are indications of respondents' rights and legitimate interests, the way the URS is worded is that says, these are defenses to bad faith. So it's sort of - I guess to flip sides of the same coin.

So it, you know, kind of a repetition of little bit, the domain name is generic or descriptive and the registrant is making a fair use of it. We've got tribute and criticism sites that are found by the examiner to be fair use. The registrant's holding of the domain name is consistent with an express term of a written agreement entered into by the parties.

And the domain name is not part of a wider pattern or series of abusive registrations because the domain name is at a significantly different type or character to other domain names registered by the registrant. None of these are in the UDRP. And all of these are defenses that have been used in the UDRP even though they're not codified by the UDRP.

I would say that Number 7 is probably the least - the least utilized but certainly there are plenty of UDRP decisions codifying the it URS's for, you know, what's listed here as 4, 5 and 6. So thoughts as far as that - those provisions.

Phil Corwin: Okay so are these the exclusive defenses or is it possible for a registrant to raise another defense that's not on the list?

Kristine Dorrain: Yeah they're all - all the lists of defenses are non-exclusive.

Phil Corwin: So you could...

Kristine Dorrain: In fact, the trading and domain name for profit and holding the portfolio and the sale of traffic up above, if we go back up to - underneath bad faith, those are just considerations for the examiner, those aren't even listed as defenses, those are considerations. And at the numbers 4 through 7 here are listed as defenses; all of it is nonexclusive.

Phil Corwin: And when - I got to ask, I don't recall Number 4 through 7 being in the guidebook, are they in the guidebook? When were these adopted? Have they been adopted in practice? And maybe that's a question for Jim since he created the chart.

Kristine Dorrain: Well 4 through 7 is in the URS itself, it's 5.8 - Section 5.8.

Phil Corwin: Okay, so they're all written in there from the beginning.

Kathy Kleiman: Absolutely.

Kristine Dorrain: Yeah, they've all been in there from the beginning, yeah, 5.8 and 5.9.

Phil Corwin: Okay. Okay. It seems like some of them, again, would require the kind of extra examination that the URS is not designed for, that it starts turning it into a shade of gray case rather than a black and white case. But how do the examiners deal with that?

Kristine Dorrain: Well so far we haven't really seen any defenses like this. The only person who's really aggressively defended themselves is this yo-yo.

Phil Corwin: Okay.

Kristine Dorrain: Who believes that he is making a legitimate commercial gain, which is not really any of these.

Phil Corwin: Right. Well we're not going to discuss that particular case here.

Kristine Dorrain: Correct, yeah.

Phil Corwin: Kathy has a hand up. Kathy.

Kathy Kleiman: Phil, these were designed to kind of enumerate as - because this was, as you mentioned, kind of a quick and dirty process, the URS was intended to be faster for both sides enumerating - and again, most of the latter defenses here follow that Nominet defenses. Enumerating them just kind of gives a bylaw in that if you're criticizing something that that is a protected, you know, we agreed when these were adopted that that was a protected use.

So here let me just illustrate, for the World Health Organization, a wonderful wonderful organization, please I do not want to go on the record as criticizing them. But others criticized them extensively after Ebola, after the Ebola outbreak in the handling - this isn't me, I'm talking about editorials in the Washington Post that I saw.

Someone can envision a criticism site set up with the letters WHO, and probably some additional letters, and that's where this type of defense might come in. So just wanted to share kind of a real-world example that I saw, you know, fairly recently.

Phil Corwin: Okay. Thanks Kathy. Kristine, why don't we do the next four together, they all seem to be pretty much clerical details, administrative review, registrant response; there are matter of times and words so why do we run through them?

Kristine Dorrain: Okay, yeah.

Phil Corwin: And the...

((Crosstalk))

Kristine Dorrain: So for UDRP...

Phil Corwin: ...says they're all more administrative than substantive.

Kristine Dorrain: Sure. Okay so for UDRP when the complaint comes in, we first check - or actually for both we check - do a quick look at the complaint to make sure it's not bogus and then send a notice to either the registrar in the case of UDRP or the registry in the case of URS to have the domain name locked.

Now the difference is the URS requires the registry to reply to that email and lock within two business days. They UDRP we are waiting for that implementation to be added to the UDRP. I just was part of a working group where we added the requirement to lock to the UDRP because it didn't previously exist, and believe it or not it was causing a controversy.

So what happens is once the domain name is locked the complaint is reviewed for compliance with formalities. And under the URS the formality list is much shorter and so the case generally proceeds along same day. Under UDRP the formality list is longer. The complainant is given five days in which he can come back and amend its complaint to comply with the formalities.

And he can do it as many times as it needs to end up five calendar day period. And if the complainant does not bring the complaint into compliance the complaint is dismissed.

Once the deficiencies are corrected under UDRP or the complaint is found to not be deficient under URS, the court cases commence which means formal notice is served by the provider to either the URS registrant or the respondent under UDRP or URS.

Both policies utilize information in the Whois in determining who to respond - or to send notice to. And then from that moment the clock begins for the registrant to respond. For UDRP the respondent has 20 calendar days from that date of commencement.

There's - other than the possibility of requesting an extension, which is allowed generally under the UDRP but has both providers have sort of - or all the providers have formalized the rules for how you go about getting an extension and how long of an extension you can have, etcetera. Other than that that's the only time that the respondent gets to respond under UDRP.

For URS, the respondent has 14 calendar days to respond. If they do not respond within 14 calendar days the case goes to a panelist to be determined whether or not the complainant has made out their case. The respondent can get a 7 calendar day extension.

Now once - the difference is that once the default determination issues if the decision goes for the complainant the respondent can still respond. They can do so for free for 30 more days after the determination. After that 30 days is up they can still respond for six more months but now they have to pay a fee.

So there's lots of options for the respondent to come back and, you know, protest vis-à-vis the complaint or to protest the default determination. And then those are, you know, different, you know, sort of response options allowed in the URS.

The respondent in URS gets 2500 words and the respondent in the UDRP has no length prescribed by the UDRP or the rules themselves. Each provider gets to set the length. The form has done it with a page limit. Other providers have done it with a word limit. But it's generally everybody gets kind of the same amount of space in order to make their - their arguments.

And then for the examiners the URS provider selects the URS examiners. It is supposed to be done according to the rules under a rotation or at least under the - I don't remember if that's in the rules but it was definitely in the RFP so URS examiners at least with the form are selected by a computer system and (unintelligible) by a computer system and then unless there are considerations of language that need to be brought into bear there. I'm not quite sure how ANDRC does that.

For the UDRP the - a single panelist is the default option but if either party wants to pay extra they can choose a three-member panel. If the - if either part selects a three-member panel both parties get a chance to nominate a panelist. They actually send us a list of three people and we take one from each person's list. And then both get a chance to strike people off the chair list. And that's, I think, how WIPO does it too and ANDRC, that's pretty standard way to choose panelists. So that's the way panelists are selected. And that's the process.

For UDRP the panelist has 20 days to make a - or 14 days to make a decision. For URS the panelist has three days to make a decision except for they have five days in the case of exceptional circumstances if need be. And then the UDRP decisions tend to be reason decisions and they'll tend to be 6, 8, 10 pages long.

A URS determination is really brief, it's just supposed to be a quick look at the documents to see if the complainant met its burden, if the respondent submitted anything to show that they, you know, are actually using the domain name in good faith, etcetera and so really those decisions tend to be one, two, maybe three pages at the most.

Phil Corwin: Okay so summing up, URS is faster. The response - the length of the response is limited and there's - only a single examiner, not a - three panel option. Those are the big differences in terms of the administration. Any comments or questions...

Kristine Dorrain: Yeah.

Phil Corwin: ...on this? Seeing no hands let's get into something that's important, which is the standard of proof if you're a complainant, what's the burden of proof for you.

Kristine Dorrain: Yeah, so the burden of proof for URS is stated as clear and convincing evidence that no genuine issue of material fact exists as to any elements of the claim. And that is actually the main reason besides not actually being - having the domain name being used. That's - the second main reason why complainants are losing URS cases is because the panel is not, you know, clearly convinced that there's no genuine issue of material fact.

Under the UDRP standard some of those cases might have been won but under a clear and convincing evidence standard the panelists are not convinced that there is, you know, bad faith use - registration and use.

The URS is much more vague and it says, "The complainant must prove that each of the three elements of the claim is present. A panel shall decide a complaint on the basis of the statements and documents submitted in accordance with policy these rules and any rules and principles of law that it deems applicable."

Very early on a panel, I think a WIPO panel, decided that the burden was simply preponderance of the evidence. And it might even be in like the 2002 or 2003 white paper, I can't remember. I know I've seen it written down several times in many places. But so ultimately that's been the standard that's been adopted.

So chances are more likely than not 51% chance that the respondent is using - or is using the domain name and has registered the domain name in bad

faith and that - and that they have no right and legitimate interest to the domain name.

Interestingly, most panelists provide a little stricter scrutiny, I mean, not officially, of the first element, which is complainant's rights. They want to actually see the trademark, they want to be pretty convinced that complainant has a trademark. So where there's any gray area as to the legitimacy of a complainant's trademark or, you know, the proof for common law trademarks in jurisdictions that accept common law marks. I've noticed the panels actually have a very high standard for that.

So ultimately...

((Crosstalk))

Phil Corwin: Kristine, are you talking about UDRP panels or...

Kristine Dorrain: Yes.

Phil Corwin: Okay. That's that I thought.

Kristine Dorrain: Yeah, well actually for both. I mean, because if you - well because we already say clear and convincing evidence, right, for the URS. And I would say - I would say that a lot of panels apply that level of standard to 4(a)1 in UDRP, to the proof of complainant's mark.

Even though we talk about 4(a)1 under UDRP as a standing issue or as a standing point as far as can complainant get in the door, most panelists are pretty heavily critical of that and make sure that complainants have jumped through all the hoops to establish that they truly do have their trademark rights. So that's just my editorializing on that point I guess.

Phil Corwin: Okay. Do we have comments on the evidentiary burden? I see none. I'm going to exercise some prerogative now and kind of just myself whip through the next two which is basically the - the case is decided a lot faster in URS. The remedy and suspension of the domain name for the remainder of the registration period whereas in UDRP you can either cancel the domain or acquire it through transfer and that was a hotly contested issue in the creation of the URS and one reason the lack of transfer maybe be one reason it's not used as much.

But can we get into appeals because that's directly related to the sovereign immunity issue. We've only got five minutes left here so I want to focus on that in our remaining time.

Kristine Dorrain: Yeah, absolutely. So I just want to back up for a second to the transfer thing. We've had - the single biggest question we've had for URS cases after they close is well now can I go to the respondent and negotiate for a transfer? So I'll just have you know that's our single biggest question.

With respect to appeals so under UDRP there's no second bite at the apple. In fact there's a very well established res judicata principle that you can't go refile another UDRP. So your choice is to go to court or live with the decision.

And you can - as discussed earlier before the meeting started, you can actually file a dispute at any point although many people characterize the exact wording of policy paragraph 4(k) to say that if you want to interrupt the UDRP panel decision and not have it take affect you must file that UDRP complaint within those 10 calendar - or 10 business days after the UDRP decision.

You can file a case at any point. Any court in the world is going to review the UDRP de novo, review the case de novo. But you may not be able to interrupt the transfer if you don't file that court case within those 10 business days.

With respect to URS, though, it specifically says that the URS decision has no precedential affect and should not be construed against anybody in a subsequent UDRP and subsequent court. I mean, it's pretty clear that it's designed to just be a quick and dirty remedy that does not hold any bearing, in fact, I think we're going to have a case - a URS case refiled with us and we can't find anything that allows, you know, that forbids that basically.

So I guess nothing really forbids a URS complainant from coming back again and again and again and filing more, you know, URS cases against the same domain name which is an interesting point. But the URS can be appealed either to the UDRP or to a court. We have had - I don't know the exact number but we've had a handful of appeals under the URS appeal process.

Phil Corwin: And usually the complainant or the registrant doing the appeal?

Kristine Dorrain: The last time I did a review, and it's been a couple of months, it was kind of 50/50.

Phil Corwin: Interesting. Interesting. And you said you had one complainant who just kept coming back hoping that eventually you'd find a panel who would agree.

Kristine Dorrain: Well - yeah so we have - this would be the first time. We had somebody ask us, well we lost our URS, can I refile again? And that's when we just sort of went, oh gosh, don't do that. But of course we didn't say that.

Phil Corwin: Yeah, well they have a - apparently they have a right to based on...

Kristine Dorrain: Apparently.

((Crosstalk))

Phil Corwin: ...language although at a certain point if somebody kept coming back multiple times it would - it certainly seem abusive to me. We're at 2 minutes before the top of the hour. Do the remaining issues here are just what happens to the domain which is it's locked and there's a locking and the fees and the fees are about 1/3 of what they are for a basic - and URS are about 1/3 of what they are in a basic one-panel UDRP.

Do we have any comments on any of this before we wrap up for the day?

Jim Bikoff: Phil, it's Jim Bikoff.

Phil Corwin: Yes.

Jim Bikoff: Maybe Kristine could comment on how many URS cases have been filed so far.

Kristine Dorrain: Well now if I had submitted my February report to ICANN I would know that but I forgot to do that at the end of the month. It's - I think somebody point out that there's 225 posted on our Website so it's probably somewhere in that neighborhood.

Jim Bikoff: Yeah, and I think, Phil, I can just say maybe it's helpful for others, we have a number of clients who have marks registered in the trademark clearinghouse and we've offered them, you know, a critique on either going for URS or UDRP. And in no case has anybody wanted to use the URS mainly because of what Kristine said, the lack of transfer and the issues about possibly the defenses.

Phil Corwin: Right, right. And, yeah, I'm just looking, there was - that recent staff report - the draft report had statistics on URS. Where was that?

Kristine Dorrain: Yeah, I just did a quick - I have a Monday report that gives me the breakdown by month. We've got between 240 and 250 filed total, including open cases.

Phil Corwin: Yeah, that's since the program began so it's a relatively low number I believe that a lot more UDRPs have been filed against new TLDs than URS cases.

Kristine Dorrain: Yeah, at a minimum it's pretty comparable.

Phil Corwin: Okay. And here is - yeah, the - okay. Well I'll stop there. We're at the top of the hour. So did anyone have anything they wanted to bring up before we adjourn and we'll - your co-chairs will have to confer with staff on how we have a useful meeting next week while we're waiting feedback from the legal experts on sovereign immunity although my recollection is that while we fairly well wrapped up the standing issue in Singapore there may be some things we want to go back on that.

And particularly we need to go back on the difference between the IGOs covered by the Paris Convention and the broader group that are not all listed in the Paris Convention but eligible to get dot-Int domains and what - which groups we're dealing with here. But anything else before we wrap up?

Jim Bikoff: Phil. Jim Bikoff again. I assume we haven't gotten any response from the GAC yet.

Phil Corwin: No, I do believe in the GAC communiqué from Singapore there was some very vague language in which they recognize the existence of this group and said something nice about working with us. I don't recall. I know I circulated it right after Singapore. I don't recall the exact language here but it was very general but it was not as interventionist as the LA communiqué language where they were trying to tell the board to direct us to come out with certain conclusions. They backed off a bit.

But in terms of response to our questions we have no formal response from the GAC yet. They had response pre-Singapore that they'd have nothing to say until post-Singapore. But we haven't gotten that yet. And if we - Mary

brought up, you know, should we go back and - some of the groups we haven't heard and remind them that we would still welcome input. And I think that's clearly one we'd like to hear from.

Kathy Kleiman: Phil, this is Kathy.

((Crosstalk))

Phil Corwin: Yes, Kathy. Let's make this...

((Crosstalk))

Kathy Kleiman: I think reminders would be great.

Phil Corwin: Yeah.

Kathy Kleiman: What we're seeing with a lot of the comment - what we're seeing is everyone - a lot of people is, you know, got sick after - in and after Singapore and overwhelmed. We're seeing a lot of the comment deadlines that were due at the end of February have now been extended I think because people weren't responding in the usual way. So I think reminders of what we're looking for would be really timely. I think people have been pretty overwhelmed.

Phil Corwin: Yeah.

((Crosstalk))

Phil Corwin: I know I have. And I know others I know who were in Singapore both were overwhelmed and got sick when they got home and they've been scrambling to catch up ever since.

So at three minutes after the hour, unless someone immediately raises their hand or shouts out, I'm going to adjourn this meeting until - and we will meet

again next Wednesday, March 11. And we'll get out a draft agenda no less than 24 hours before that meeting so you're all aware of what we'll be discussing and have a chance to provide input on that. So with that thank you and good bye and hope the rest of your day goes well.

Jim Bikoff: Thanks.

((Crosstalk))

Kristine Dorrain: Thanks, everyone. Have a great day.

Phil Corwin: Bye, bye.

Terri Agnew: Once again the meeting has been adjourned. Thank you very much for joining. Please remember to disconnect all remaining liens. Have a wonderful rest of your day.

END