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Rights Protection Mechanisms (RPMs) and IGO Protections
Session 11(a)

Contents

Session Objective

- Consider the status of the GNSO Rights Protection Mechanisms Policy Development Process (RPM PDP) and in particular the upcoming rechartering of the Work Group for Phase II of the PDF and the planned review of the Uniform Dispute Resolution Procedure.

- Consider the status of new GNSO Policy Development work, as part of a new "IGO Work Track" of the RPM PDP to address the issue of IGO Access to Curative Rights Protection Mechanisms. Refer to the ICANN66 GAC Discussions on this matter (3 November 2019), including the GAC Briefing and material reviewed during in GAC Plenary

Background

The question of who legally has rights to, or is the legitimate holder of, a domain name can be a matter of dispute. Finding effective and enforceable processes to resolve such disputes across the many jurisdictions involved has been one key Internet policy challenge.

Since its incorporation, the ICANN Community has developed several policies and procedures to address various types of disputes. The longest standing such procedure, for disputes related to Trademarks, is known as the Uniform Dispute Resolution Policy (UDRP) and was adopted in 1999.

More recently, as part of the 2012 New gTLD Program, several new rights protection mechanisms (RPMs) were developed to mitigate potential risks and costs to trademark rights holders that could arise in the expansion of the gTLD namespace:

1. The Uniform Rapid Suspension (URS) System,

2. The Trademark Clearinghouse (TMCH) and its associated Sunrise Periods and the Trademark Claims Service

3. The Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP).

The GNSO Council initiated a Policy Development Process to Review of All Rights Protection Mechanisms in All gTLDs (RPM PDP) on 18 February 2016. The PDP Working Group was and chartered to conducted work two phases:

1. Phase 1 to review those applicable to gTLDs launched under the 2012 New gTLD Program
2. Phase 2 to focus on reviewing the Uniform Dispute Resolution Policy (UDRP) which applies to all gTLDs.

RPMs will impact how Subsequent Rounds of new gTLDs are run in the future, phase 1 RPMs, in particular, were developed to mitigate potential risks and costs to trademark rights holders that could arise in the expansion of the new gTLD namespace, and to help create efficiencies for registration service providers among gTLD launches. The review of their effectiveness is important to determine whether those Phase 1 RPMs should continue for future rounds of new gTLDs, and if so, what changes, improvements and/or enhancements need to be made to fulfill the intended objectives of these RPMs.

Issues

As highlighted by the GAC in contributions to the development of the Rights Protection Mechanisms (RPMs) of the New gTLD Program, and in particular the GAC Comments on the Applicant Guidebook (26 May 2011), **overarching concerns** included:

- "*Mitigating the negative impact on the business community arising from the potential substantial and rapid escalation in the incidence of cybersquatting due to the scaling up of the number of gTLDs*"

- The need to "*maximize the level of rights protection afforded to to businesses big and small*" and ensure "*the burden for business stakeholders [...] is minimized*" when using these mechanisms.

In order to advise ICANN on these matters, the GAC formulated proposals with the assistance of national policy experts and drawing on national consultations with relevant stakeholders. Key proposals and advice **with respect to the Trademark Clearinghouse (TMCH) were that:**
- "*There should be no requirement to provide evidence of use for eligibility to be included in the Clearinghouse which would conflict with many national IP legal frameworks.*" Practically, to provide a level playing field for all trademarks in all jurisdictions, proof of use was required for all TMCH entries for a Sunrise, but not Claims Notices.
- In order to monitor the effectiveness of these RPMs, the GAC advised the ICANN Board to conduct a comprehensive post-launch independent review of the Clearinghouse, one year after the launch of the 75th new gTLD in the round, to examine whether changes would be needed as well as whether any unforeseen questions and issues may have arisen from the launch of New gTLDs. This review has now been undertaken.

The RPM PDP WG has also been looking at the general issue of the TMCH's fitness for purpose and efficacy and is expected to make policy recommendations in this regard (as per Relevant Development Section of this briefing) as part of Phase 1 of its work, now in its fifth year with limited progress in bringing stakeholders to consensus and away from long standing positions.

Regarding the upcoming review of the UDRP as part of Phase 2 of the RPM PDP WG**:**
- In the ICANN51 Los Angeles GAC Communique the GAC stated "*in implementing any such curative [IGO RPM] mechanism, that the UDRP should not be amended*"
- In the September 14, 2011 Letter to GNSO Council Regarding UDRP PDP Issues Report the GAC stated that it "*considers that any review of the UDRP should be conducted in light of community experience with the new gTLD RPMs, and should take full account of ccTLDs' use of the UDRP. While the GAC is not opposed in principle to a review of the UDRP at an appropriate time, the GAC considers that a review at this time would not be appropriate.*"

In the context of this upcoming work, it should be noted that ICANN's Bylaws require:
- 1.2 (a)(iv) "*promote well-informed decisions based on expert advice*"
- 1.2 (b)(i) "*To the extent feasible and appropriate, delegating coordination functions to or recognizing the policy role of, other responsible entities that reflect the interests of affected parties and the roles of bodies internal to ICANN and relevant external expert bodies*"
- 13.1 (a) "T*he purpose of seeking external expert advice is to allow the policy-development process within ICANN to take advantage of existing expertise that resides in the public or private sector but outside of ICANN. In those cases where there are relevant public bodies with expertise, or where access to private expertise could be helpful, the Board and constituent bodies should be encouraged to seek advice from such expert bodies or individuals.*"

- 13.1 (b)(ii) "*In addition, in accordance with Section 13.1(c), the Board may refer issues of public policy pertinent to matters within ICANN's Mission to a multinational governmental or treaty organization.*"

In the face of the risk of "*the loudest voice to influence changes in UDRP policy or procedure which could have far-reaching consequences for ICANN, its contracted parties, and indeed for rights owners and the consumers who depend upon the enforcement of these rights*", a recent contribution by MARQUES (1 February 2019), the European Association of Trade Mark Owners suggested that ICANN:
- "*convenes a small group of experts to gather evidence and information from interested parties including ICANN's Contracted Parties and organizations representing both trademark interests and registrant interests*" to "*identify any priority issues and possible solutions for the current RPM Working Group to take forward*"
- "*Request the World Intellectual Property Organization as the global leader, which was commissioned in 1998 to develop a solution which became the UDRP, to select and chair this independent expert group*" and to "*provide the data-based expertise called for under ICANN's Bylaws*"

Leadership Proposal for GAC Action during ICANN68

With respect to the upcoming rechartering of Phase II of the RPM PDP WG to review the UDRP, the GAC may wish to signal to appropriate parties that the following be taken into account in this process:
- Lessons learned from the current Phase I
- New principles in the GNSO Policy Development Policy 3.0
- The relevant Bylaws provisions (referenced in the Issue section of this briefing)

Relevant Developments

At the ICANN67 meeting in March 2020, the working group completed the review of the draft Phase 1 Initial Report. **In its Phase 1 Initial Report, the PDP Working Group put forward a total of 26 preliminary recommendations for the URS, TMCH, Sunrise and Trademark Claims services, and TM-PDDRP**. The Working Group also **included 17 questions within the initial report related to some of these mechanisms**, for which it sought community input. The Working Group hopes the community input received will allow it to finalize possible recommendations on these topics in its Final Report.

At this time, no formal consensus call has been taken on these preliminary recommendations, but these did receive the support of the Working Group for publication for public comment.

The **Phase 1 Initial Report was published on 18 March 2020 for Public Comment, which was closed on 4 May 2020**. From late May 2020, the working group started reviewing the Public Comments received from fifty-five contributors in order to complete its Phase 1 recommendations.

Two sub teams were formed to conduct concurrent analysis of the extensive comments using a Public Comment review tool.

At ICANN68, the working group is expected to provide an update on its Public Comment review progress during its public session on Tuesday, 23 June. The working group also expects to hold a regular meeting during the ICANN68 week to continue advancing its work.

Current Positions
- ICANN51 Los Angeles GAC Communique
- September 14, 2011 Letter to GNSO Council Regarding UDRP PDP Issues Report
- GAC Comments on the Applicant Guidebook - 26 May 2011

Key Reference Documents
- Phase 1 Initial Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process

Further Information
- RPM in all gTLDs PDP WG Wiki Space
- Final Issue Report - PDP to Review All RPMs in all gTLDs - 11 January 2016

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