



**WIPO | ADR**

Arbitration  
and Mediation  
Center

# ■ Rights Protection Mechanism Update

**Virtual Cancun  
March 22, 2021**

Brian Beckham, World Intellectual Property Organization

# Agenda

■ RPM Working Group Phase 1

■ RPM Working Group Phase 2

■ IGO Curative Work Track



# RPM WG Phase 1 Final Report

# What is the PDP about? Why is it important?

**March 2016:** GNSO Council chartered the two-phased PDP

## Phase 1

**RPMs applicable to gTLDs launched under the 2012 New gTLD Program**

- Uniform Rapid Suspension (URS) dispute resolution procedure
  - **Trademark Clearinghouse (TMCH)**
- Sunrise and Trademark Claims offered through the TMCH
- Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP)

**24 November 2020:** Submitted Phase 1 Final Report to GNSO Council

## Phase 2

**UDRP**  
**(Consensus Policy since 1999)**

**GNSO Council to form charter drafting / scoping team**

## 35 Total Phase 1 Recommendations

34 achieved “Full Consensus” & 1 achieved “Consensus” (TMCH Final Rec #1)

9

Recommendations  
to Maintain the  
Status Quo

10

Recommendations  
to Modify Existing  
Operational Practice

15

Recommendations to  
Create New Policies &  
Procedures

1

Recommendation for  
Overarching Data  
Collection

# Recs to Maintain Status Quo

## URS

- **“TM+50” rule**
- **“Exact Match” rule**
- **Scope of Applicability of Sunrise & Claims RPMs** to specific gTLDs for trademarks containing **dictionary term(s)**

## Trademark Claims

- **Mandatory Claims Period** (also cover the Limited Registration Period)
- **“Exact Match” rule** (exact matching criteria for the Claims Notice)

## Sunrise

- **Mandatory Sunrise Period** (exception for those who receive exemptions pursuant to Spec 13 .Brand TLDs & Section 6 of Spec 9 Registry Operator Code of Conduct)
- **Requirements for the Sunrise Period**
- Availability of Sunrise registration only for **identical matches**
- **NOT to limit the scope of Sunrise Registrations** to the categories of goods/services for which trademark was registered
- **NOT to create a challenge mechanism** relating to Premium/Reserved Names
- **NO mandatory publication of the Reserved Names lists**

# Recs to Modify Existing Operational Practice

## URS

- Providers to send notices to Respondent **after Registry/Registrar has forwarded registration data**
- ICANN org, Registries, Registrars, and Providers to take steps to **ensure contact details are up to date**
- Providers to require that **Examiners document their rationale in sufficient detail**
- IRT reviews **implementation issues with respect to Registry Requirement 10** in the “URS High Level Technical Requirements for Registries and Registrars”
- **Remove “Technical” in title** of “URS High Level Technical Requirements for Registries and Registrars”

## TMCH

- Validation Provider primarily responsible for **educating rights-holders, domain name registrants, and potential registrants about its services**; IRT to work with Validation Provider and consider **enhancing existing educational materials, with additional attention to registrants**
- Database Provider must **maintain industry-standard levels of redundancy and uptime**



# Recs to Modify Existing Operational Practice (Cont.)



## Sunrise

- **SDRP not intended to allow challenges to Sunrise registrations on grounds of invalid Trademark Record**; Registry Operator to **immediately suspend domain name registration** to allow registrant to file challenge under the TMCH's dispute resolution procedure

## Trademark Claims

- Maintain current requirement to send the Claims Notice before a registration is completed; **ICANN org can work with Registrars to address implementation issues**
- **Revise language of Trademark Claims Notice to make it more understandable / user-friendly**; reflect more **specific information about the trademark(s)** for which it is being issued, and communicate its **meaning and implications**



# Recs for New Policies and Procedures (URS)

## GDPR (aligns with EPDP recs)

- Complainant must **only be required to insert publicly-available WHOIS/RDDS data** in Initial Complaint; **allow update** to Complaint within **2-3 calendar days**
- **URS Panelists** have discretion to decide whether to **publish/redact registration data** in the Determination; **URS party** has the right to request **redaction**
- Clearly **define what “Default Period” means**; registrant **must not change public and non-public registration data elements** during the Default Period

## Education

- **Uniform set of educational materials** for guidance on what is needed to meet the **“clear and convincing” burden of proof**
- **Informational materials to assist Complainants and Respondents**, including FAQs, forms, reference materials to explain Providers’ services & practices

## Complaint Mechanism(s)

- ICANN org to **establish a compliance mechanism(s)**, including an avenue for any party in the URS process to **file complaints and seek resolution**

## Language

- **Incorporate in full Rule #11 of UDRP Rules** regarding “Language of Proceedings”
- Provider must **translate Notice of Complaint into the language of the Registration Agreement**

## Examiner

- Provider **maintains and publishes list of Examiners and their qualifications (CVs)**; identify **how often each one has been appointed and link to their decisions**
- Provider publishes and reasonably enforces an **effective Examiner Conflict of Interest Policy**



# Recs for New Policies and Procedures

## Sunrise

- Registry Agreement for future new gTLDs to include a provision stating that a **Registry Operator shall not operate its TLD in such a way as to have the effect of intentionally circumventing the mandatory RPMs or restricting brand owners' reasonable use of the Sunrise RPM**

## Trademark Claims

- Current mandatory Claims Period remain uniform for all gTLDs in subsequent rounds, **with exception for those exempted pursuant to Spec 13 .Brand TLDs & Section 6 of Spec 9 RO Code of Conduct**
- Trademark Claims Notice to be **delivered both in English and the language of the registration agreement**

## TM-PDDRP

- Multiple disputes filed by unrelated entities **against the same Registry Operator** may be **initially submitted as a joint Complaint**, or may, at the discretion of the Panel, be **consolidated upon request**

## TMCH *[consensus but minority statement]*

“**word marks**” that meet one of the following requirements **are eligible for the mandatory Sunrise and Trademark Claims RPMs**:

- a. Nationally or regionally registered word marks from all jurisdictions;
- b. Word marks validated by a court of law or other judicial proceeding;
- c. Word marks that are protected by a statute or treaty that is in effect at the time the mark is submitted to the TMCH and that are listed with a national or regional trademark office

**Geographical indications, protected designations of origin, and other signs** protected by quality schemes for distinguishing or indicating the geographic source or quality of goods or services are **not eligible for the mandatory Sunrise and Trademark Claims RPMs** (unless they are also trademarks as defined in (a) or (b))

TMCH Validation Provider(s), registry operators and other third parties may provide **ancillary services to intellectual property rights-holders**; these other forms of intellectual property **must be held in a separate ancillary database**





# Recommendation: Overarching Data Collection

- ❑ For future new gTLD rounds, **ICANN Org to collect** the following data on at least an **annual basis** and make the data available to future RPM review teams:
  - Number of **marks submitted for validation in each category** of marks accepted by the TMCH;
  - Number of **successfully validated marks in each category** of marks accepted by the TMCH;
  - Number of **labels generated** for all successfully validated marks;
  - Number of **abused labels**;
  - Number of **marks deactivated in and removed** from the TMCH;
  - Breakdown of the **scripts/languages represented in a validated and active trademark** in the TMCH; and
  - Number of **cases decided under the TMCH dispute resolution procedure**.
- ❑ For future new gTLD rounds, ICANN-accredited registrars must provide ICANN Org with **periodic reports of the number of Claims Notices** that were sent out to prospective registrants, **not less than every 12 months**
- ❑ ICANN Org explore developing a mechanism, in consultation with the URS Providers, to enable **publication and search of all URS Determinations in a uniform format**
- ❑ ICANN org to also collect data concerning **trademark owners' and registrants' experience with the RPMs** that can be provided to future RPM review teams



# Next Steps

- **GNSO Council considers recommendations and Final Report**, and if approved send Recommendations Report to the ICANN Board  
*(Sections 7 & 8, Bylaws Annex A and GNSO PDP Manual)*
- **Public comment proceeding** on GNSO Council-approved recommendations  
*(Section 3.6, Bylaws on Notice & Comment on Policy Actions, before Board consideration)*
- **ICANN Board considers recommendations and Final Report**  
*(Section 9, Bylaws Annex A)*
- If Board adopts recommendations, **Board normally also directs ICANN org to begin implementation** and **GNSO Council generally forms IRT** to advise org

# Questions?

# RPM WG Phase 2

WIPO Briefing Note for the ICANN Governmental Advisory Committee:  
Continued UDRP stability benefits all ICANN stakeholders

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Protecting brands online helps to mitigate consumer confusion and related harm, curb abusive practices, and provide a stable platform for global economic growth. In the DNS, the UDRP (the Uniform Domain Name Dispute Resolution Policy) is a vital contribution to these collective benefits.

#### The Internet and DNS significantly contribute to the global economy

With 3.2 billion (and growing) estimated Internet users globally, the digital economy increasingly contributes to GDP and promotes innovation and job creation.

- In 2016 brands spent nearly USD 500 billion on advertising globally<sup>1</sup>
- By 2016 the Internet economy of the G-20 was expected to reach USD 4.2 trillion (5.3% of GDP)<sup>2</sup>
- High- and medium-Web SMEs experience significant revenue growth, and generate more jobs<sup>3</sup>

#### Addressing trademark-abusive conduct in the DNS

Even for all of its positive attributes, as with much public technology, the Internet and DNS also bring their share of bad actors. Many of these bad actors target brands and defraud unsuspecting consumers. To combat such practices, the global nature of the Internet requires global solutions.

At the request of the United States Government with WIPO Member States' approval, to address bad actors engaged in "cybersquatting" in 1999 WIPO designed the UDRP. As a global dispute resolution mechanism, the UDRP resolves domain name disputes without a need for expensive court litigation. Through 2017, WIPO has managed almost 40,000 cases with parties from 175 countries.

In many cases, trademark-abusive domain names are also used to perpetuate phishing, fraud, counterfeiting, and employment scams, to distribute malware, or for illegal prescription drugs.

#### Further UDRP benefits

Beyond assisting brand owners in addressing abuse of their trademarks online, the UDRP

- Minimizes burdens on national courts
- Promotes trust, and protects consumers
- Provides predictability for the domain investment aftermarket
- Provides a safe harbor for ICANN Contracted Parties: keeping them out of cybersquatting disputes and courts

As a globally-recognized best practice, and part of WIPO's capacity-building, the UDRP is also the basis for over 75 ccTLD dispute resolution policies in all regions.

#### WIPO as the UDRP's recognized steward

Operating on a not-for-profit institutional basis, WIPO invests in training for Panelists and Parties and produces a globally-used Jurisprudential Overview covering thousands of cases over time.

<sup>1</sup> MAGNA Global Advertising Forecast, [www.magnaglobal.com/wp-content/uploads/2016/12/MAGNA-December-Global-Forecast-Update-Press-Release.pdf](http://www.magnaglobal.com/wp-content/uploads/2016/12/MAGNA-December-Global-Forecast-Update-Press-Release.pdf).

<sup>2</sup> BCG Report: The Internet Economy in the G-20 <https://www.bcg.com/documents/file100409.pdf>.

<sup>3</sup> Id. For example, over a 3-year period in Brazil, 98% of High-Web SMEs added jobs vs 77% for Low-Web SMEs.

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Without such WIPO stewardship, UDRP predictability and DNS stability would be severely undermined.

- WIPO's institutional investment includes a range of further tools, including real-time case statistics and an online searchable Legal Index – both promoting UDRP transparency
- WIPO has initiated e-filing, case language practices, and settlement facilities
  - In support of case language capacity, WIPO as a global provider has managed cases in over 20 languages

#### Risks to the UDRP inherent in ICANN's structure

ICANN, for institutional reasons, has decided to initiate a PDP to review the UDRP and the related new gTLD mechanism, the URS.

This ICANN process carries a serious risk of undermining the UDRP's effectiveness.

Both institutionally and in practice, ICANN process is weighted towards registration interests.

#### An expert-driven UDRP review avoids undermining the UDRP's functioning

Achieving a UDRP net-positive would mean ICANN, as a technical body, giving appropriate weight to WIPO input, experience, and expertise.

Having created the UDRP, WIPO through tens of thousands of cases uniquely understands the policy and practical implications of even well-intended UDRP (and URS) "improvements", in substance and in process terms.

With its flexible and forward-looking design, the UDRP remains globally-valued as an up-to-date rights protection tool. Its current design should be preferred to an unwieldy "revised" mechanism that fails in practice.

The ICANN-produced URS is a case study in unwieldy design-by-committee. Serious concerns regarding its efficacy and operational sustainability remain, which are reflected in its underutilization. Without a fully informed process, there is a real risk that the UDRP will go the way of the URS (in which case, regrettably, WIPO would need to carefully examine its continued UDRP investment).

To produce the UDRP in the first place, WIPO provided its UDRP blueprint to ICANN for review and implementation. To consider the future of this unique global dispute resolution mechanism, WIPO would be prepared to provide its expert leadership.

#### The GAC

As the digital economy grows, and ICANN considers future new gTLD rounds, the potential for cybersquatting and consumer harm only increases – making continued UDRP stability all the more important. Any responsible ICANN process should use WIPO's unique substantive UDRP expertise and operational experience.

To preserve the UDRP's vital role in tomorrow's digital economy, GAC support for continued UDRP stability is instrumental. Conveying this support to ICANN would enable brand owners and consumers to continue to rely on the UDRP.

# Protecting consumers in the DNS

- INTA: “Trademarks promote freedom of choice and enable consumers to make quick, confident, and safe purchasing decisions.”
- Protecting brands online helps mitigate consumer confusion and related harms, curb abusive practices, and provide a stable platform for global economic growth
- The UDRP is a vital contribution to these collective benefits
  - ***100+ COVID-related cases***

# Addressing trademark abuse in the DNS

- Bad actors in the DNS target brands and defraud unsuspecting consumers
- The **global nature of the Internet requires global solutions** to combat such practices
- At the request of the US with WIPO Member States' approval, to address bad actors engaged in “cybersquatting” in **1999 WIPO designed the UDRP**
- As a global dispute resolution mechanism, the UDRP resolves domain name disputes **without a need for expensive court litigation**
- **WIPO has managed over 50,000 UDRP cases** for stakeholders from all over the world



# Further UDRP benefits

- Trademark-abusive domain names are also used to perpetuate phishing, fraud, counterfeiting, and employment scams, to distribute malware, or for illegal prescription drugs
- Beyond assisting brand owners in addressing such abuses of their trademarks online, the UDRP:
  - Minimizes burdens on national courts
  - Promotes trust, and protects consumers
  - Provides predictability for the domain investment aftermarket
  - Provides a safe harbor for ICANN Contracted Parties: keeping them out of cybersquatting disputes and courts
- A globally-recognized best practice, and part of WIPO's capacity-building, the UDRP is the basis for over 75 ccTLD dispute resolution policies in all regions



# ICANN Bylaws

- 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) *“The 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.”*

# MARQUES (the European Association of Trade Mark Owners) letter to 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 WIPO 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”*

# How can the GAC help assist UDRP stability?

- Call on ICANN to look to WIPO's unique substantive UDRP expertise and operational experience
  - ICANN Bylaws: “promote well-informed decisions based on expert advice”
- GAC Advice
  - Input to RPM Working Group
- IP Office colleagues: WIPO UDRP Briefing Note

# IGOs

## ■ ICANN 62 Panama

- The GAC advises the ICANN Board to:
  - i. Maintain current temporary protections of IGO acronyms until a permanent means of protecting these identifiers is put into place;
  - ii. Work with the GNSO and the GAC following the completion of the ongoing PDP on IGO-INGO access to curative rights protection mechanisms to ensure that GAC advice on protection of IGO acronyms, which includes the available “small group” proposal, is adequately taken into account also in any related Board decision;

## ■ ICANN 65 Morocco

- The GAC notes a discussion between representatives of the GNSO Council, GAC and IGOs, which was observed by a Board member, concerning the shared hope of agreeing on parameters under which to charter a focused group to produce policy recommendations which address concerns raised over IGO access to a curative dispute resolution mechanism.