

## Phase 1 Final Report on the Review of All Rights Protection Mechanisms in All gTLDs Policy Development Process

24 November 2020

### Status of This Document

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This is the Phase 1 Final Report of the GNSO Policy Development Process (PDP) on the Review of All Rights Protection Mechanisms (RPMs) in All gTLDs, covering RPMs applicable to gTLDs launched under the 2012 New gTLD Program. This Final Report will be submitted to the GNSO Council for its consideration.

### Preamble

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The primary objective of this Final Report is to document the PDP Working Group's: (i) recommendations for new policies or procedures, (ii) recommendations to maintain status quo; (iii) recommendations to modify existing operational practice; (iv) implementation guidance; and (v) associated consensus levels of all final recommendations. This Final Report also documents the Working Group's deliberations, input received on its Phase 1 Initial Report and the Working Group's subsequent analysis, and other pertinent information that provides background, context, and rationale for its final recommendations.

# Table of Contents

<b>1 EXECUTIVE SUMMARY</b>	<b>3</b>
<b>2 PHASE 1 FINAL PDP RECOMMENDATIONS</b>	<b>6</b>
2.1 Introduction	6
2.2 Uniform Rapid Suspension (URS) Final Recommendations	7
2.3 Trademark Clearinghouse (TMCH) Final Recommendations	32
2.4 Sunrise Final Recommendations	39
2.5 Trademark Claims Final Recommendations	50
2.6 Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Final Recommendation	55
2.7 Overarching Data Collection Final Recommendation	58
<b>3 ADDITIONAL MARKETPLACE RIGHTS PROTECTION MECHANISMS</b>	<b>61</b>
<b>4 NEXT STEPS</b>	<b>63</b>
<b>5 BACKGROUND</b>	<b>64</b>
<b>6 APPROACH TAKEN BY THE WORKING GROUP</b>	<b>84</b>
<b>7 ANNEX A – PDP WORKING GROUP CHARTER</b>	<b>90</b>
<b>8 ANNEX B – CHARTER QUESTIONS</b>	<b>100</b>
<b>9 ANNEX C – CONSENSUS DESIGNATIONS</b>	<b>129</b>
<b>10 ANNEX D – WORKING GROUP MEMBERS’ MINORITY STATEMENT ON TMCH FINAL RECOMMENDATION #1</b>	<b>131</b>
<b>11 ANNEX E – WORKING GROUP DOCUMENTS</b>	<b>138</b>
<b>12 ANNEX F – WORKING GROUP MEMBERSHIP AND ATTENDANCE</b>	<b>143</b>
<b>13 ANNEX G – COMMUNITY INPUT</b>	<b>150</b>

# 1 Executive Summary

## 1.1 Background

On 18 February 2016, the GNSO Council voted to initiate the Policy Development Process (PDP) on the Review of All Rights Protection Mechanisms (RPMs) in All gTLDs.<sup>1</sup> On 15 March 2016, the GNSO Council approved the PDP Charter for the review to be conducted in two phases.<sup>2</sup> Phase 1 focuses on reviewing all the RPMs and associated structures and procedures applicable to gTLDs launched under the 2012 New gTLD Program, specifically:

- The Uniform Rapid Suspension System (URS);
- The Trademark Clearinghouse (TMCH);
- The Sunrise and Trademark Claims services offered through the TMCH; and
- The Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP).

Phase 2 will focus on reviewing the Uniform Dispute Resolution Policy (UDRP), which has been an ICANN Consensus Policy since 1999. Please see the “Background” section of this Final Report for summaries of these RPMs.

On 21 April 2016, the Working Group held its first meeting to commence its Phase 1 work and met regularly since that time. Its last meeting was held on 29 October 2020.

## 1.2 Deliberations and Initial Report

The Working Group’s Charter contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This led to the Working Group agreeing, early on in its work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral. Please see the “Annex B - Charter Questions” section of this Final Report for additional details, including the Working Group’s responses to and conclusions for its Charter questions.

On 18 March 2020, the Working Group published its [Phase 1 Initial Report for public comment](#). The Initial Report covered the RPMs applicable to gTLDs launched under the 2012 New gTLD Program. The primary objective of the Initial Report was to solicit input/feedback on the PDP Working Group’s: (i) twenty-six (26) preliminary recommendations; (ii) seventeen (17) specific

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<sup>1</sup> See the approved GNSO Council motion initiating the PDP here: <https://gns0.icann.org/en/council/resolutions#201602>

<sup>2</sup> The Charter of the PDP Working Group is included in the “Annex A - PDP Working Group Charter” section of this Final Report. It can also be downloaded here: [https://gns0.icann.org/sites/default/files/filefield\\_48755/rpm-charter-15mar16-en.pdf](https://gns0.icann.org/sites/default/files/filefield_48755/rpm-charter-15mar16-en.pdf)

questions for community input; and (iii) twenty-four (24) proposals that did not rise to the level of becoming preliminary recommendations. In addition, the Working Group invited input on its six (6) overarching Charter questions.

Following the closing of the public comment proceeding on 4 May 2020, the Working Group carefully reviewed all public comments received from fifth-five (55) contributors (38 from organizations, five from ICANN community groups, and 12 from individuals) in response to its Initial Report, finalized a total number of thirty-five (35) recommendations, and produced this Final Report for the GNSO Council consideration.

The Working Group has classified its recommendations for each of the Phase 1 RPMs into three categories:

1. Recommendations for new policies or procedures;
2. Recommendations to maintain status quo; and
3. Recommendations to modify existing operational practice.

Early on in its work, the RPM Working Group agreed that a thorough and meaningful review of all the Phase 1 RPMs required access to historical data as well as regularly updated data in the future. Although the Working Group engaged in extensive data collection and analysis efforts during its deliberations, it encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the Phase 1 RPMs. Therefore, the Working Group put forward an Overarching Data Collection Final Recommendation, in addition to its recommendations for the Phase 1 RPMs, aiming at addressing this data-related gap.

Some recommendations contain “Implementation Guidance”. Please see the “Phase 1 Final PDP Recommendations” section for details.

Consensus calls on the recommendations contained in this Final Report, as required by the GNSO Working Group Guidelines, were carried out by the Working Group Co-Chairs, as described in the “Annex C - Consensus Designations” section. In summary, 34 out of the total 35 recommendations received full consensus support from the Working Group. Only one out of the total 35 recommendations (i.e., TMCH Final Recommendation #1) received consensus support from the Working Group; some members submitted a joint Minority Statement on this recommendation, which was documented in this Final Report.

For further details about these designations, please see Annex C as well as Section 3.6 of the GNSO Working Group Guidelines.<sup>3</sup> For further details about Working Group members’ different views on the TMCH Final Recommendation #1, please see Annex D of this Final Report.

In developing its Phase 1 final recommendations, the Working Group also discussed recommendations developed by the Competition, Consumer Trust and Consumer Choice Review Team (CCT-RT) and referenced the relevant sections in the Wave 1 Report of the Expedited PDP (EPDP) on a Temporary Specification for gTLD Registration Data Phase 1 Recommendation #27. The results of the Working Group’s review of these efforts are reflected in the final

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<sup>3</sup> See the GNSO Working Group Guidelines here: <https://gns0.icann.org/sites/default/files/file/field-file-attach/annex-1-gns0-wg-guidelines-24oct19-en.pdf>

recommendations. Please see the “Background” section of this Final Report for additional details.

Furthermore, the Working Group provided suggestions, not as a formal recommendation, to improve the implementation of the Approved Launch Program (ALP). These suggestions are documented under Sunrise Question 8(a) in the “Annex B - Charter Questions” section of this Final Report.

This Final Report also includes a summary of the Working Group’s discussion of the additional marketplace RPMs that several Registry Operators and the current TMCH Validation Provider have voluntarily adopted, over and above the mandatory ICANN RPMs.<sup>4</sup> The Working Group did not develop any specific recommendations concerning these RPMs as they are outside the scope of this PDP. Please see the “Additional Marketplace RPMs” section of this Final Report for details

## 1.3 Conclusions and Next Steps

This Final Report will be submitted to the GNSO Council for its consideration and, if approved, forwarded to the ICANN Board of Directors for consideration and potential action in accordance with the ICANN Bylaws.

## 1.4 Other Relevant Sections of this Final Report

For a complete review of the issues, methodologies, and interactions of this Working Group, the following sections are included in this Final Report:

- Summary of Working Group deliberation that includes context for the final recommendations and outcome of the public comment review;
- Working Group’s responses to and conclusions for its Charter questions, including the six (6) overarching Charter questions that the Working Group included in its Initial Report seeking public comments;
- Documentation on the Working Group’s Sub Team approach, data gathering and review efforts, and Charter question refinement work;
- An annex of featured documents and tools that assisted the Working Group’s review of Phase 1 RPMs.

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<sup>4</sup> “TMCH Validation Provider” is the official term to refer to the provider that operates the following functions of the Trademark Clearinghouse: the authentication of contact information and verification of trademark records. This term is used throughout the RPM PDP Phase 1 Final Report. Deloitte has been appointed by ICANN org as the TMCH Validation Provider, which operates the Trademark Clearinghouse verification services that check trademarks submitted for entry into the TMCH against the substantive and other criteria set out in the TMCH Guidelines. The other function of the Trademark Clearinghouse is the storage of trademark records in a database in order to provide information to the new gTLD registries. IBM currently administers and operates the Trademark Clearinghouse database with which Registry Operators and registrars interact, e.g. to offer the Trademark Claims service and the Notifications of Registered Name.

## 2 Phase 1 Final PDP Recommendations

### 2.1 Introduction

The PDP Working Group has finalized a total number of thirty-five (35) recommendations for the GNSO Council consideration. The Working Group expects that the GNSO Council and ultimately the ICANN Board will approve and implement all recommendations set forth in this Final Report, and ICANN org will work closely with an Implementation Review Team (IRT) to ensure that implementation takes place in line with the Working Group's intent.

The Working Group has classified its recommendations for each of the Phase 1 RPMs into three categories:

1. **Recommendations for new policies or procedures:** these recommendations indicate the Working Group's agreement that new policies or procedures are necessary to improve the RPMs launched under the 2012 New gTLD Program, such as to enable fulfillment of the objectives for their creation and enhance their effectiveness in the next new gTLD expansion round.
2. **Recommendations to maintain status quo:** these recommendations indicate the Working Group's agreement that an element of the Phase 1 RPMs and associated structures and procedures is, and continues to be, appropriate, or at a minimum acceptable, to continue in the next new gTLD expansion round.
3. **Recommendations to modify existing operational practice:** these recommendations indicate the Working Group's agreement that modifications to existing operational practices related to the Phase 1 RPMs are necessary to improve their effectiveness, but their underlying structures or procedures do not require changes.

Early on in its work, the RPM Working Group agreed that a thorough and meaningful review of all the Phase 1 RPMs required access to historical data as well as regularly updated data in the future. Although the Working Group engaged in extensive data collection and analysis efforts during its deliberations, it encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the Phase 1 RPMs. Therefore, the Working Group also put forward an Overarching Data Collection Final Recommendation aiming at addressing this data-related gap.

Some recommendations contain "Implementation Guidance", which commonly refers to how a recommendation should be implemented. The Working Group strongly recommends the stated action in the implementation guidance for consideration by the IRT, with a strong presumption that it will be implemented, but recognizes that there may exist valid reasons in particular circumstances to not take the recommended action exactly as described. However, the party to whom the action is directed must make all efforts to achieve the purpose behind the recommended action (as expressed in the Recommendation, agreed policy principles, and contextual language to which the Implementation Guidance is linked, if applicable) even if done through a different course. In all cases, the full implications must be understood and carefully weighed before choosing a different course.

This Phase 1 Final Report states the level of consensus within the PDP Working Group achieved for the different recommendations. In summary, 34 out of the total 35 recommendations received full consensus support from the Working Group. Only one out of the total 35 recommendations (i.e., TMCH Final Recommendation #1) received consensus support from the Working Group; some members submitted a joint Minority Statement on this recommendation, which was documented in this Final Report. Please see the “Annex C - Consensus Designation” section and the “Annex D - Working Group Members' Minority Statement on TMCH Final Recommendation #1” section of this Final Report for details.

The Working Group’s review of the public comments submitted for the Initial Report resulted in the Phase 1 final recommendations. The Working Group used sub groups to review the public comments concerning the preliminary recommendations published in its Phase 1 Initial Report. Sub groups’ suggestions and public comment review outcomes were brought back to the full Working Group for consideration prior to a formal consensus call being conducted, in accordance with the GNSO Working Group Guidelines, on potential final recommendations. Please see the text under the “Public Comment Review” section of each recommendation for additional details regarding whether and how the public comments shaped the final recommendations.

At the plenary level, the full Working Group also reviewed the public comments relating to proposals published in the Initial Report that did not rise to the level of preliminary recommendations, as well as comments pertaining to overarching Charter questions and general input.

In developing its Phase 1 final recommendations, the Working Group also discussed recommendations developed by the Competition, Consumer Trust and Consumer Choice Review Team (CCT-RT) and referenced the relevant sections in the Wave 1 Report of the Expedited PDP (EPDP) on a Temporary Specification for gTLD Registration Data Phase 1 Recommendation #27. The results of the Working Group’s review of these efforts are reflected in the final recommendations presented in this report. Please see the “Background” section of this Final Report for additional details.

As part of its Phase 1 work, the Working Group also looked at a number of additional marketplace RPMs that several Registry Operators and the TMCH Validation Provider had voluntarily adopted, over and above the mandatory ICANN RPMs. However, the Working Group agreed that developing recommendations for these voluntary market mechanisms was outside the scope of this PDP. Please see the “Additional Marketplace RPMs” section of this Phase 1 Final Report for details of the Working Group’s discussion of this topic.

## 2.2 Uniform Rapid Suspension (URS) Final Recommendations

### 2.2.1 URS Recommendations for New Policies and Procedures

**URS Final Recommendation #1**

The Working Group recommends that URS Rule 3(b), and, where necessary, a URS Provider’s Supplemental Rules be amended to clarify that a Complainant must only be required to insert

the publicly-available WHOIS/Registration Data Directory Service (RDDS) data for the domain name(s) at issue in its initial Complaint.

Furthermore, the Working Group recommends that URS Procedure paragraph 3.3 be amended to allow the Complainant to update the Complaint within 2-3 calendar days after the URS Provider provides updated registration data related to the disputed domain name(s).

**Context:**

This recommendation specifically concerns the following parts of the URS Rules and URS Procedure:<sup>5</sup>

- **URS Rule 3(b)(iii):** Provide the name of the Respondent and all other relevant contact information from the Whois record as well as all information known to Complainant regarding how to contact Respondent or any representative of Respondent, including contact information based on pre-complaint dealings, in sufficient detail to allow the Provider to notify the Respondent of the complaint as described in Rule 2(a);
- **URS Procedure paragraph 3.3:** Given the rapid nature of this Procedure, and the intended low level of required fees, there will be no opportunity to correct inadequacies in the filing requirements.

Since the implementation of the European Union’s General Data Protection Regulation (GDPR), personally identifiable information, including a registrant’s contact details, has been masked in the public WHOIS/RDDS data. URS Providers receive the contact information and other relevant WHOIS/RDDS data of the registrants from Registries or Registrars.

In May 2018, the ICANN Board approved a Temporary Specification as an interim measure to bring existing WHOIS obligations in line with requirements of GDPR.<sup>6</sup> In relation to the URS, Section 5.6 of the Temporary Specification obligates ICANN’s Contracted Parties to comply with Appendix D of the Temporary Specification (and, relatedly, Appendix E for the UDRP).

Appendix D states that a Registry Operator “MUST provide the URS provider with the full Registration Data for each of the specified domain names, upon the URS Provider notifying the Registry Operator (or appointed BERO) of the existence of a Complaint, or participate in another mechanism to provide the full Registration Data to the Provider as specified by ICANN.<sup>7</sup> If the gTLD operates as a ‘thin’ Registry, the Registry Operator MUST provide the available Registration Data to the URS Provider [and if] the domain name(s) subject to the Complaint reside on a ‘thin’ registry, the Registrar MUST provide the full Registration Data to the URS Provider upon notification of a Complaint.” In addition, “Complainant’s Complaint will not be

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<sup>5</sup> URS Rules can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>; URS Procedure can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

<sup>6</sup> See <https://www.icann.org/en/system/files/files/gtld-registration-data-temp-spec-17may18-en.pdf>. Following the Board’s adoption of most of the EPDP’s Phase 1 recommendations, an Interim Registration Data Consensus Policy was implemented that requires gTLD Registry Operators and ICANN-accredited Registrars to continue to implement measures that are consistent with the Temporary Specification on an interim basis, pending the full implementation of the final Registration Data Policy (see <https://www.icann.org/resources/pages/interim-registration-data-policy-en>.)

<sup>7</sup> **BERO:** Back-end Registry Operator



deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the URS Rules if such contact information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a 'Doe' Complaint and the Examiner shall provide the relevant contact details of the Registered Name Holder after being presented with a 'Doe' Complaint."

The EPDP Phase 1 recommendations that were approved by the GNSO Council and adopted by the ICANN Board in 2019 included Recommendation #21 that suggested that the RPM PDP Working Group consider whether existing URS requirements needed updating, to clarify that a complainant must only be required to insert the publicly-available RDDS data for the domain name(s) at issue in its initial complaint, and if a complainant should be given the opportunity to update its complaint upon receiving updated data. The EPDP work also included Recommendation #23 and Recommendation #27 that suggested updates be made to existing procedures and rules impacted by the GDPR.<sup>8</sup> The Working Group believes that its recommendation is consistent with the EPDP Phase 1 Recommendations #21, #23, and #27, as well as the analysis in the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report.<sup>9</sup>

During the Working Group's deliberations, MFSD (a URS Provider) suggested amending the URS Procedure paragraph 3.3 in order to enable the Complainant to modify the Complaint within 2-3 days from the disclosure of the full registration data by the URS Provider. FORUM (another URS Provider) also supported the suggestion of manually amending the Complaint after submission.

MFSD commented that without access to the registration data before submission of the Complaint due to GDPR, and without the possibility to amend the Complaint after submission, it may be difficult for the Complaint to satisfy the second and third URS elements.<sup>10</sup> The utilization of URS may decrease because the Complainant may file a UDRP Complaint instead, which can be amended after submission.

Therefore, the Working Group recommends amending the URS Rule 3(b)(iii) and URS Procedure paragraph 3.3 as a result of GDPR implementation. The Working Group further notes that this recommendation maintains consistency with the EPDP Team's Phase 1 recommendations, affirming that a complaint will not be deemed administratively deficient for failure to provide the name of the Respondent and all other relevant contact information if such information of

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<sup>8</sup> **EPDP Recommendation #21:** Requests the GNSO Council to instruct the RPMs PDP Working Group to consider whether to update existing requirements to clarify that a complainant must only be required to insert the publicly-available RDDS data for the domain name(s) at issue in its initial complaint, and whether the complainant may be given the opportunity to file an amended complaint upon receiving updated RDDS data. **EPDP Recommendation #23:** Defines requirements for URS/UDRP to ensure the procedures continue to function given other EPDP recommendations. **EPDP Recommendation #27:** Recommends that updates be made to existing policies to ensure consistency with the EPDP recommendations. Please see the full text of this recommendation in the "Background" section of this Final Report.

<sup>9</sup> See the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report here:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/epdp-phase-1-recommendation-27-18feb20-en.pdf>

<sup>10</sup> The URS requires a trademark owner, or the "Complainant," to show all three of the following elements: (i) The disputed domain name is identical or confusingly similar to a word mark that meets certain criteria; (ii) the registrant of the domain name, or the "respondent," has no legitimate right or interest to the domain name; and (iii) the domain name was registered and is being used in bad faith.

the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant.

**Public Comment Review:**

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation be maintained “as is”.

**URS Final Recommendation #2**

The Working Group recommends that URS Rule 15(a) be amended to clarify that, where a Complaint has been updated with registration data provided to the Complainant by the URS Provider, URS Panelists have the discretion to decide whether to publish or redact such data in the Determination. The Working Group further recommends that each URS party has the right to request that Panelists consider redacting registration data elements from publication as part of the Determination.

**Context:**

This recommendation specifically concerns the following parts of URS Rules:

- **URS Rule 15(a):** The Provider shall publish the Determinations and the dates of implementation on a publicly accessible web site, subject to the considerations in Rule 15 (c) and (d) below. See URS Procedure paragraphs 9.2 and 9.4. The portion of any Determination that a Complaint was brought in bad faith (see Rule 17) shall be published.<sup>11</sup>

This final recommendation, if approved, will change the status quo and permit the filing of an amended Complaint following a Complainant’s receipt of updated registration data from a URS Provider. This will mean that, without further amending the URS (specifically, URS Rule 15(a)), the previously redacted registration data will be published along with the Determination of the Complaint.

The Working Group put forward URS Question #1 in its Initial Report and sought community input as to whether it would be appropriate to also recommend that URS Rule 15 be amended in order to allow for redaction of registration data upon publication of a Determination, and if so in what circumstances.<sup>12</sup>

In agreeing to put out this question for public comments, the Working Group noted the Phase 1 recommendations from the EPDP Team on the Temporary Specification for gTLD Registration Data that are relevant to the RPMs. Specifically, the Working Group considered the GNSO Council’s request that the Working Group consider EPDP Phase 1 Recommendations #21, #23,

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<sup>11</sup> See the complete text of URS Rule 15 here: <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

<sup>12</sup> See URS Question #1 in the RPM PDP Phase 1 Initial Report on pp.31-32:  
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

and #27.<sup>13</sup> Furthermore, ICANN org’s EPDP Phase 1 Recommendation #27 Wave 1 Report suggested that the Working Group reference Purpose 6-PA5 from the EPDP Phase 1 Final Report when making recommendations as to the publication of registration data elements in URS Determinations.<sup>14</sup> Purpose 6-PA5 references the GDPR FAQ of WIPO, a Uniform Domain Name Dispute Resolution Policy (UDRP) Provider, with regard to publishing registration data elements.

In view of the public comments received and Purpose 6-PA5 in the EPDP Phase 1 Final Report, the Working Group agreed on this new recommendation after extensive discussions.

The Working Group noted that, prior to the EPDP, the standard practice had been for URS Providers to publish the party names in URS Determinations. According to FORUM, registration data published in the URS Determination usually consists of a Respondent’s name, city, state, and country/territory. The Working Group agreed that the decision to publish or withhold registration data in Determinations should not hinge on whether a Respondent prevails or loses. Some members emphasized that publishing such registration data, in particular the party names, in the URS Determination is a matter of public record for accountability and transparency purposes.

However, the Working Group also agreed that there may be exceptional circumstances for redacting the registration data, including party names (e.g., identity theft, use of the information of a minor, revelation of a political dissident, etc.). The Working Group believed that either URS party should be able to raise the specific reason for the Panelists to consider and request publication or redaction of registration data, but it is ultimately up to the Panelist to decide whether publication or redaction is appropriate. The Working Group’s recommended action is consistent with Purpose 6-PA5, which states that “any request to redact a party’s name from a decision should normally be submitted for the panel’s consideration”. The Working Group’s recommended action is also consistent with WIPO’s practice for UDRP decisions, where in a number of UDRP cases, Respondents’ names are redacted in the published Determinations at a Panelist’s discretion.

Some Working Group members also believed that leaving the decision to the Panelists would mitigate potential concerns regarding defaulting Respondents not providing Panelists with reasons for party name redaction.<sup>15</sup> The Working Group’s review of data from over 900 URS cases found that a majority of cases resulted in Default Determinations, meaning that no Response to a Complaint was filed by a Respondent. The Working Group recognized that there was a noticeable number of defaulting Respondents who prevailed in URS proceedings.

#### **Public Comment Review:**

The Working Group recognized that there were strong differences of opinion and a variety of responses to URS Question #1 in the RPM PDP Phase 1 Initial Report. However, the Working

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<sup>13</sup> Please see the full text of EPDP Recommendations #21, #23, and #27 in the “Background” section of this Final Report.

<sup>14</sup> See the full text of Purpose 6-PA5 on p.139 of the EPDP Phase 1 Final Report here:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/epdp-gtld-registration-data-specs-final-20feb19-en.pdf>

<sup>15</sup> Where, at the expiration of the 14-day Response period (or extended period if granted), the Respondent does not submit an answer, the Complaint proceeds to Default status. All Default cases nevertheless proceed to Examination for review on the merits of the claim. See URS Rules 11 & 12: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

Group ultimately agreed to make this new recommendation, which incorporates input from public comments and is consistent with the EPDP Phase 1 recommendations.

**URS Final Recommendation #3**

The Working Group recommends that the URS Rules be amended to incorporate in full Rule #11 of the UDRP Rules regarding “Language of Proceedings”, see:

<https://www.icann.org/resources/pages/udrp-rules-2015-03-11-en>

“(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.”

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that the IRT consider the following:

- Preliminary submissions by either side to the Panel regarding the language of the proceeding should be limited to 250 words, and not be counted against the existing URS word limits.
- The Notice of Complaint should, where applicable, contain a section explaining that the Respondent may make a submission regarding the language of the proceedings.
- If a translation is ordered by the URS Examiner, as long as the original submission meets the word limits in the original language, the translation of the original submission may nominally exceed the prescribed word limit; for the avoidance of doubt, the translation may not introduce new facts or arguments which may be contained in the Language of Proceeding submission.
- The IRT should consider developing potential guidance to assist URS Examiners in deciding whether to deviate from the default language in the context of a particular proceeding. Such potential guidance may take into account the language of the relevant registration agreement (irrespective of whether the domain is registered through a privacy or proxy service or reseller). Such potential guidance could also consider the relevance of other factors, including but not limited to:
  - the language requested by one of the URS parties;
  - the predominant language of the country or territory of the registrant;
  - principles articulated in the relevant section (presently 4.5) of the WIPO Overview;<sup>16</sup>
  - the language used by the registrar and/or predominant language of the country/territory of the registrar, if different from the language of the registration agreement; and

<sup>16</sup> See WIPO Overview Section 4.5 here: <https://www.wipo.int/amc/en/domains/search/overview3.0/#item45>

- the language/script used in the domain name (including the TLD), in particular if it is an Internationalized Domain Name.

**Context:**

This recommendation was developed following the Working Group's review of public comments to URS Preliminary Recommendation #9, as well as URS Individual Proposal #34, which did not rise to the level of becoming a preliminary recommendation, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>17</sup> This recommendation specifically concerns the URS Rule 9.<sup>18</sup>

The Working Group noted that currently, the URS Rules (Rules #4 and #9 of the URS) only require that the Notice of Complaint be translated into the predominant language used in the registrant's country or territory, not the Complaint itself, which is currently required to be in English only. The Working Group agreed that this can put Respondents who do not understand English at a disadvantage in the process.

Nevertheless, the Working Group noted that FORUM and MFSD assign an Examiner who speaks the same language as the Respondent and also provide translations of notices, templates, and Determinations in the language of the Respondent.

FORUM informed the Working Group that it did not have significant issues identifying the predominant language of the registrant's country/territory. FORUM researches what the predominant language is in Respondent's physical location based on the registration information provided by the Registry by visiting various websites that curate information regarding predominant languages by country/territory. FORUM also confirms the language based on the language used in the Respondent's response (if no response, the default option is to use English in the URS proceeding).

However, when the domain subject to a URS Complaint has been registered via a privacy or proxy service, FORUM has difficulty in helping Examiners determine the language to be used unless that information is relayed to them. FORUM provides the Notice of Complaint in English and the predominant language of the country or territory where the Proxy Service is located (very often Spanish). While the location of the privacy or proxy service will determine the language of that service, which may be relevant, the language in the location of the privacy or proxy service may be different from the language of the Respondent. A privacy shield is rarely lifted in a URS proceeding, and this makes it impossible for FORUM to determine the language likely spoken by the registrant.

Furthermore, if the Respondent resides in a region that has multiple predominant languages, research is needed to determine which language should be used. In some multilingual countries/territories, the percent split of the population speaking each one of the multiple predominant languages is negligible.

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<sup>17</sup> See the full text of the URS Preliminary Recommendation #9 on p.30 and URS Individual Proposal #34 on pp. 68-69 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>18</sup> URS Rules can be downloaded here: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

Therefore, the Working Group agreed that by having the language of the registration agreement determine the language of the administrative proceeding, registrants will have the opportunity to select a registration agreement in the language of their choice, and thereby be able to fairly participate in the URS. The Working Group further agreed that this final recommendation will help provide URS Examiners a more definitive method to decide which language should be used for URS proceedings, irrespective of whether the domain is registered through a privacy or proxy service or reseller, or whether multiple predominant languages are spoken in the Respondent's physical location. Such clarity will help enhance the predictability for users involved in the URS proceeding while preserving Examiners' discretion to deviate from the default language where appropriate.

To be clear, the Working Group noted that URS providers would not be required to provide translations of pleadings (only the Notice of Complaint), so they would not bear additional costs (the pleadings need to be provided by the parties in the appropriate language, subject to panel discretion as per the URS' flexibility). Any panel order for translation would need to be carried out by the parties.

Nevertheless, FORUM noted that in the context of URS proceedings, other than fulfilling obligations per URS Procedure paragraph 4.4, it does not have contact with Registrars unless absolutely necessary to obtain registrant data unavailable from the Registry for whatever reason.<sup>19</sup> In those rare instances when FORUM was forced to contact a Registrar for information, days were typically added to the process and 50 percent of the time FORUM encountered some resistance to the request as it did not relate to a UDRP proceeding.

In addition, the Working Group also notes that ADNDRC communicates with Respondents only in English and is consequently non-compliant with URS Procedure paragraph 4.2 and URS Rule 9(e). Although most of its Examiners speak additional languages other than English, language skills do not seem to be a factor in its assignment and rotation of the Examiners. ADNDRC reported that it has not encountered a situation where the Respondent did not understand English.

**Public Comment Review:**

Based on public comments received, the Working Group agreed that URS Individual Proposal #34, which served as the origin of this recommendation and implementation guidance, received wide support. The Working Group noted that, in essence, this recommendation seeks to apply the UDRP framework to determine the language of the proceeding in the URS. Although the URS Preliminary Recommendation #9 also received strong support from public comments, the Working Group agreed that this final recommendation should replace that preliminary recommendation.

In its deliberations of public comments, the Working Group discussed two different viewpoints about the language of the URS proceeding. One is that there should be an effort to enable respondents to be notified and have the proceeding in their own language as identified by the

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<sup>19</sup> URS Procedure paragraph 4.4: The URS Provider shall also electronically notify the Registrar of record for the domain name at issue via the addresses the registrar has on file with ICANN.

provider; another is to use the language of the registration agreement, unless decided otherwise by the Examiner. Ultimately, the Working Group agreed to recommend the approach based on the second viewpoint, which is consistent with the UDRP rules for the language of proceedings. The Working Group also adopted several suggestions raised in public comments on URS Preliminary Recommendation #9 to provide potential guidance to assist URS Examiners in deciding whether to deviate from the default language in the context of a particular proceeding. This potential guidance is noted in the fourth bullet and its sub bullets in the implementation guidance text.

Furthermore, FORUM suggested that the potential guidance can also include a list of ICANN sanctioned websites to review for the most accurate language data, a table of researched and approved languages for countries/territories with multiple languages, and/or guidance on what an acceptable percentage of population in a country/territory speaking certain language is to determine a language predominant.

**URS Final Recommendation #4**

The Working Group recommends that the URS Rule 4(b) and URS Procedure paragraph 4.2 be amended to require the Provider to transmit the Notice of Complaint to the Respondent in English and translate it into the language of the Registration Agreement.

The Working Group further recommends that it be mandatory for URS Providers to comply with URS Procedure paragraph 4.3 and transmit the Notice of Complaint to the Respondent via email, fax, and postal mail.

**Context:**

This recommendation specifically concerns the following parts of the URS Rules and URS Procedure:

- **URS Rule 4(b):** The Notice of Complaint to the Respondent shall be transmitted in English and shall be translated by the Provider into the predominant language used in the registrant's country or territory, as determined by the country(ies) listed in the Whois record when the Complaint is filed.
- **URS Procedure paragraph 4.2:** Within 24 hours after receiving Notice of Lock from the Registry Operator, the URS Provider shall notify the registrant of the Complaint ("Notice of Complaint"), sending a hard copy of the Notice of Complaint to the addresses listed in the Whois contact information, and providing an electronic copy of the Complaint, advising of the locked status, as well as the potential effects if the registrant fails to respond and defend against the Complaint. Notices must be clear and understandable to registrants located globally. The Notice of Complaint shall be in English and translated by the Provider into the predominant language used in the registrant's country or territory.
- **URS Procedure paragraph 4.3:** The Notice of Complaint to the registrant shall be sent through email, fax (where available) and postal mail. The Complaint and accompanying exhibits, if any, shall be served electronically.

The Working Group recommends that the Provider shall translate the Notice of Complaint to the Respondent into the language of the registration agreement. This final recommendation

maintains consistency with the URS Final Recommendation #3, which concerns the language of proceeding. As registrants will have the opportunity to select a registration agreement in the language of their choice, the Working Group agreed that this final recommendation will help offer URS Providers a more definitive and predictable method to decide which language should be used for translating the Notice of Complaint, irrespective of whether multiple predominant languages are spoken in the Respondent's physical location or whether the domain is registered through a privacy or proxy service or reseller.

In addition, the Working Group discovered non-compliance issues with ADNDRC (a URS Provider), which did not: 1) translate the Notice of Complaint into the predominant language used in the registrant's country or territory per the current URS Procedure paragraph 4.2; and 2) transmit the Notice of Complaint via fax and postal mail per URS Procedure paragraph 4.3.

Nevertheless, the Working Group noted that URS Providers are unable to use courier services to deliver mail to P.O. box addresses. FORUM and MFSD also reported that mail, fax, and email to Respondents were sometimes not delivered.

Furthermore, in light of GDPR implementation and one of its effects that URS Providers now rely on the Registries and Registrars to forward non-public contact information and other relevant WHOIS/RDDS data of the registrant (as noted in the context of URS Final Recommendation #11), the Working Group believes that this recommendation does not contradict the EPDP Phase 1 Recommendations, especially Recommendations #23 and #27 which suggested updates be made to existing procedures and rules impacted by the GDPR, as well as the analysis in ICANN org's EPDP Phase 1 Recommendation #27 Wave 1 Report.<sup>20</sup>

**Public Comment Review:**

The Working Group discussed a suggestion raised in public comments regarding the Provider translating the Notice of Complaint into the language of the Registration Agreement. The Working Group ultimately adopted this suggestion to maintain consistency with URS Final Recommendation #3.

**URS Final Recommendation #5**

The Working Group recommends that the URS Procedure paragraph 6.2 be amended to: (i) clearly define what "Default Period" means; and (ii) state that the registrant shall not change the public and non-public registration data elements related to the disputed domain name(s) during the Default Period.

The Working Group further recommends deleting the text "the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use" from URS Procedure paragraph 6.2, and incorporating it in other appropriate section(s) in the URS Procedure as factors which an Examiner may take into account in determining whether there was registration and use in bad faith.

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<sup>20</sup> Please see the full text of these EPDP Phase 1 recommendations as well as the Wave 1 Report in the "Background" section of this Final Report.



**Implementation Guidance:**

For consideration of the IRT, the Working Group suggests that the deleted text may be incorporated in URS Procedure paragraph 5.9 and/or 8.1.<sup>21</sup>

**Context:**

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposal #1, which did not rise to the level of becoming a preliminary recommendation but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>22</sup>

This recommendation specifically concerns the following parts of the URS Procedure:

- **URS Procedure 6.2:** In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. During the Default period, the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use and will also be prohibited from changing the Whois information.

The Working Group agreed that the current language of URS paragraph 6.2 needs to be amended in order to address technical issues and maintain consistency with the EPDP Team's Phase 1 recommendations.<sup>23</sup>

The Working Group found that there is no definition of the phrase "Default Period" in its sole occurrence in the URS Procedure paragraph 6.2; and this term is not defined anywhere else in the URS Rules, URS Procedure, or other URS related documentations. Based on the definition of the word "Default" pursuant to URS Rule 12(a), the Working Group understood that the Default Period starts when a URS case enters Default and ends when the Examiner issues a Default Determination.<sup>24</sup> For sake of clarity, the Working Group recommends that "Default Period" be clearly defined in URS Procedure paragraph 6.2.

The current language of URS Procedure paragraph 6.2 includes the phrase "Whois information". ICANN Org's EPDP Phase 1 Recommendation #27 Wave 1 Report suggests that the Working Group consider recommending an update to URS Procedure paragraph 6.2 to clarify that a registrant shall not change the public and non-public registration data elements subject to URS

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<sup>21</sup> See the full text of the URS Procedure paragraphs 5.9 and 8.1 here:

<http://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

<sup>22</sup> See the full text of the URS Individual Proposal #1 on pp. 57-58 of the RPM PDP Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>23</sup> Please see the full text of the EPDP Phase 1 recommendations #21, #23, and #27, as well as reference to the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report in the "Background" section of this Final Report.

<sup>24</sup> URS Rule 12(a): If at the expiration of the 14-day Response period (or extended period if granted), the Respondent does not submit an answer, the Complaint proceeds to Default. In case of Default, the Provider shall appoint an Examiner to review the Complaint for a prima facie case, including complete and appropriate evidence. See full text of the URS Rule 12 here: <http://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

proceedings during the Default Period.<sup>25</sup> The Working Group agreed with this suggestion and is making a recommendation accordingly.

The Working Group also recommends replacing the use of the passive voice in the phrase “will be prohibited” in URS Procedure paragraph 6.2 with the active voice, to provide direct instruction to the registrant, as no one but the registrant and its webhost can change the public and non-public registration data elements.

Furthermore, the Working Group agreed that a registrant’s action of changing website content can be taken into consideration by the Examiner, as to whether it might be further evidence of bad faith. Some Working Group members noted there may be legitimate or legal reasons for the registrant to update the content of a website, and some websites embed dynamically generated ads and social media feeds. Therefore, the Working Group recommends moving the prohibition against changing website content for domain names subject to URS proceedings to the appropriate section(s) in the URS Procedure as behaviors to be considered by the Examiners, who should make all reasonable inferences when finding bad faith.

**Public Comment Review:**

Based on the public comments received, the Working Group noted that URS Individual Proposal #1, which served as the origin of this recommendation, received general support with some opposition mostly from individual commenters. However, commenters also voiced preferences as between the two options indicated in the original proposal. The Working Group’s final recommendation attempts to bridge the gap between the two options while maintaining consistency with the EPDP Team’s Phase 1 recommendations.

**URS Final Recommendation #6**

The Working Group recommends that the URS Rule 6(a) be amended to clarify that each URS Provider shall maintain and publish a publicly available list of Examiners and their qualifications through regular updating and publication of their Examiners’ curriculum vitae (CV).

The Working Group further recommends that the URS Procedure paragraph 7 be amended to add a requirement that each URS Provider shall publish their roster of Examiners who are retained to preside over URS cases, including identifying how often each one has been appointed together with a link to their respective decisions.

**Implementation Guidance:**

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group has developed the following implementation guidance:

- As URS Providers cannot compel Examiners to provide updates or verify if there are changes to each Examiner’s qualifications and professional affiliations, URS Providers shall be required to request that Examiners update their CV’s as prescribed, keep their CV’s current and submit any updates to the Provider;

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<sup>25</sup> See the ICANN Org EPDP Phase 1 Recommendation #27 Wave 1 Report here:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/epdp-phase-1-recommendation-27-18feb20-en.pdf>

- It will be sufficient to satisfy the objective of providing public visibility of Examiner rotations if a Provider's website provides a mechanism or function where one can search for those URS decisions that a specific Examiner presided over.

**Context:**

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposals #26 & #27, which did not rise to the level of becoming preliminary recommendations, but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>26</sup>

This recommendation specifically concerns the following parts of the URS Rules and URS Procedure:

- **URS Rule 6(a):** Each Provider shall maintain and publish a publicly available list of Examiners and their qualifications;
- **URS Procedure paragraph 7.3:** Examiners used by any given URS Provider shall be rotated to the extent feasible to avoid forum or examiner shopping. URS Providers are strongly encouraged to work equally with all certified Examiners, with reasonable exceptions (such as language needs, non-performance, or malfeasance) to be determined on a case by case analysis.

In examining the URS Providers' websites, the Working Group found that some URS Providers did not seem to publish all of their Examiner's CV's. As URS Rule 6(a) only requires the Provider to list the Examiner's qualifications, the Working Group agreed that this rule should be clarified to expressly require publication of a current CV of the Examiner, which will help inform the URS parties and other stakeholders involved in the URS proceeding of the Examiner's suitability for appointment in a URS proceeding.

Based on input from FORUM, the Working Group acknowledged that it may not be possible for URS Providers to compel Examiners to update their CVs, or actively keep track of professional/career related changes of their Examiners such as to make determinations on whether any particular CV is or is not current. As implementation guidance, the Working Group agreed that the Providers be required to request that Examiners update their CVs as prescribed, keep their CV's current, and submit the latest versions once updated.

The Working Group also noted that the current URS Procedure does not adequately provide the public with visibility into the rotation of Examiners to determine to what extent such Examiner appointments are random or well distributed. The Working Group found that while most URS Providers already publish their roster of Examiners, they may not take the further step of identifying the number or frequency of their appointments, or linking to their respective decisions beyond the general publication of all URS decisions. Therefore, the Working Group further recommends that the URS Providers shall make their roster of Examiners publicly searchable based on the decisions of URS cases that they preside over. This is to ensure that the Examiner rotation, as required in URS Procedure paragraph 7.3, can be confirmed by the public.

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<sup>26</sup> See the full text of the URS Individual Proposals #26 and #27 on pp. 64-65 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

The Working Group noted that FORUM, one of the URS Providers, offers a decision search function on its website -- decisions can be filtered by the URS cases and specific Examiners who presided over these cases; each decision can be displayed in response to a search based on the name of the Examiner. As implementation guidance, the Working Group agrees that it will be sufficient to satisfy the objective of this recommendation if a Provider's website already provides such a mechanism or function similar to FORUM's (i.e., one can search for URS decisions that an Examiner presided over).

**Public Comment Review:**

Based on the public comments received, the Working Group noted that URS Individual Proposals #26 and #27, which served as the origin of this recommendation, received wide and similar levels of support. Due to the close relationship between these two proposals, the Working Group agreed to put forward a recommendation which consolidates these two proposals in sequence. In addition, based on public comments from FORUM, the Working Group agreed to add implementation guidance language to provide practical flexibility with regard to implementing this recommendation for consideration by the IRT.

**URS Final Recommendation #7**

The Working Group recommends that the URS Rule 6 be amended to add a requirement that each URS Provider shall publish an effective Examiner Conflict of Interest (COI) policy that the Provider reasonably enforces against any Examiners who violate such policy.

**Context:**

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposal #28, which did not rise to the level of becoming a preliminary recommendation but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>27</sup>

This recommendation specifically concerns the following parts of the URS Rules:

- **URS Rule 6(b):** An Examiner shall be impartial and independent and shall have, before accepting appointment, disclosed to the Provider any circumstances giving rise to justifiable doubt as to the Examiner's impartiality or independence. If, at any stage during the URS proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Examiner, the Examiner shall promptly disclose such circumstances to the Provider. In such event, the Provider shall have the discretion to appoint a substitute Examiner.

The Working Group had diverging opinions on the adequacy of the current rules as regards to handling conflicts of interest for URS Examiners. On the one hand, some members believed that currently there is no known COI policy for Examiners, let alone one which applies across all Providers; accordingly, Examiners are left to determine for themselves what constitutes a

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<sup>27</sup> See the full text of the URS Individual Proposal #28 on pp. 65-66 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

conflict of interest which must be disclosed pursuant to URS Rule 6(b). Thus, these members believed that Examiners would generally appreciate having such guidance in place, as would parties who could then feel more confident in knowing when an Examiner is and is not required to disclose a conflict or recuse himself or herself in a URS proceeding.

On the other hand, some Working Group members questioned the necessity of this recommendation. They agreed that in general there are already policies that appropriately prevent conflict of interest pursuant to URS Rule 6(b). They understood that each URS Provider implements its own individually-developed COI policy (akin to supplemental rules), so there is some variation among each Provider.<sup>28</sup> Thus, these members agreed that there is no need to develop a universal COI policy for all Providers, noting that all URS Providers already implement conflict of interest measures. The Working Group further agreed that it is not necessary or practical for the Working Group to develop a universal COI policy that can gain consensus support within the PDP timeframe.

Based on public comments received, the Working Group ultimately agreed that every URS Provider should publish an effective Examiner COI policy that the Provider reasonably enforces against any Examiner who violates such policy. The Working Group noted that while FORUM, one of the URS Providers, does not currently publish its COI policy, it does not have an issue making that policy public.

**Public Comment Review:**

Based on public comments received, the Working Group noted that URS Individual Proposal #28, which served as the origin of this recommendation, received general support but with some opposition. The Working Group took into account the opposing opinions to the original individual proposal and agreed to remove the sentence “The ‘Conflict of Interest Policy’ should be developed by the Working Group and applied to all Providers” when developing the final recommendation text. While the Working Group sought public comment on the suggested elements of the proposed universal COI policy for Examiners as well as existing COI policies that can serve as examples, the Working Group received very limited input.

**URS Final Recommendation #8**

The Working Group recommends that the ICANN org establishes a compliance mechanism or mechanisms to ensure that URS Providers, Registries, and Registrars operate in accordance with the URS rules and requirements and fulfill their role and obligations in the URS process.

The Working Group recommends that such compliance mechanism(s) should include an avenue for any party in the URS process to file complaints and seek resolution of noncompliance issues.

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<sup>28</sup> Both FORUM and MFSD’s Examiners have voluntarily disclosed conflict of interest, but no instance of a conflict presenting itself after an Examiner has accepted a case. ADNDRC’s Examiners have not voluntarily disclosed any conflict of interest, but no issue was raised. URS Providers have different methods to seek confirmation from Examiners on their impartiality or independence (FORUM - [Neutral’s Oath](#); MFSD - email & checkbox on [Determination Form](#); ADNDRC - email)

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that the IRT consider:

- Investigating different options for potential compliance mechanism(s), such as ICANN Compliance, other relevant department(s) in ICANN org, a URS commissioner at ICANN org, a URS standing committee, etc.
- Developing metrics for measuring performance of URS Providers, Registries, and Registrars in the URS process.

**Context:**

The Working Group discovered non-compliance issues with URS Providers, Registries, and Registrars.

There were cases where certain URS Providers did not: 1) translate the Notice of Complaint into the predominant language used in the registrant's country or territory per URS Procedure paragraph 4.2 and URS Rules 9(e); 2) transmit the Notice of Complaint via fax and postal mail per URS Procedure paragraph 4.3; and 3) list and maintain the backgrounds of all of their Examiners as required by URS Rule 6(a).<sup>29</sup>

Some Registries delayed in fulfilling or did not fulfill their obligations relating to locking, unlocking, and suspension of disputed domains; some URS Providers reported such non-compliance to ICANN.

URS Providers and Practitioners reported difficulty in getting Registrars to coordinate with Registries to implement a settlement, which typically involves a transfer of the domain registration at the Registrar level. Problems with Chinese Registrars to implement Determinations were also reported.<sup>30</sup>

The Working Group agreed that ICANN org should proactively or reactively monitor the practices of URS Providers, Registries, and Registrars in the URS process, and establish a compliance mechanism or mechanisms for any stakeholder in the URS process to raise complaints.

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<sup>29</sup> **URS Rule 6(a):** Each Provider shall maintain and publish a publicly available list of Examiners and their qualifications.

**URS Rule 9(e):** The URS Procedure paragraph 4.2 specifies the languages in which the Notice of Complaint shall be transmitted...The Provider is not responsible for translating any documents other than the Notice of Complaint.

**URS Procedure paragraph 3.3:** Given the rapid nature of this Procedure, and the intended low level of required fees, there will be no opportunity to correct inadequacies in the filing requirements.

**URS Procedure paragraph 4.2:** Within 24 hours after receiving Notice of Lock from the Registry Operator, the URS Provider shall notify the Registrant of the Complaint ("Notice of Complaint"), sending a hard copy of the Notice of Complaint to the addresses listed in the Whois contact information, and providing an electronic copy of the Complaint, advising of the locked status, as well as the potential effects if the Registrant fails to respond and defend against the Complaint. Notices must be clear and understandable to Registrants located globally. The Notice of Complaint shall be in English and translated by the Provider into the predominant language used in the Registrant's country or territory.

<sup>30</sup> URS Rules 16(a) stipulates that if, before the Examiner's Determination, the Parties agree on a settlement, the Examiner shall terminate the URS proceeding

The Working Group agreed that its intent is not to create redundant compliance mechanism(s) that already exist in ICANN org. The Working Group is aware that ICANN org has established practices for enforcing compliance of their contracts by Registries and Registrars. The Working Group also learned from public comments that there is an existing ICANN compliance mechanism related to certain aspects of the URS -- e.g., a URS Complaint Form that Internet users and Providers can use to submit to ICANN org concerning a Registry Operator's non-compliance to enforce a URS action/decision (e.g., lock or suspend a domain name subject to the URS).<sup>31</sup>

However, the Working Group believes that there is still a lack of clarity/understanding with regard to how the existing compliance mechanism(s) work at ICANN and how to enforce compliance of contracted parties when they fail to fulfill their obligations in the URS process. There is also a lack of clarity/understanding with regard to enforcing compliance of URS Providers. The Working Group identified areas where non-compliance of Providers did not seem to be acted upon by ICANN org. ICANN org's public comment confirmed that enforcing compliance against Providers falls outside the scope of its current Compliance process.

The Working Group agreed that ICANN org has the obligation to enforce compliance of URS Providers. The Working Group acknowledged that ICANN Compliance is responsible for enforcing contractual agreements with Registries and Registrars, but compliance enforcement against Providers may be different as they are non-traditional contracted parties. While acknowledging that ICANN org's Memorandums of Understanding (MoUs) with Providers are enforceable, the Working Group agreed that MoUs and contracts may require different enforcement mechanisms. Furthermore, the Working Group noted that its recommendation does not specifically require ICANN Compliance to enforce compliance against URS Providers; some other relevant ICANN org department(s) may be responsible for enforcing compliance against Providers (e.g., Procurement, Legal).

Based on public comment review, the Working Group agreed that there is an underlying desire/common sentiment calling for consistency, predictability, and implementability for the compliance mechanism(s). Due to the lack of clarity mentioned above, the Working Group agreed to revise its preliminary recommendation text, recommending that "the ICANN org establishes a compliance mechanism or mechanisms". This language may provide more flexibility for implementation, parsing the roles/responsibilities of the various stakeholders involved in the URS process who have different legal relationships with ICANN org.

As the Working Group is unsure which specific mechanism(s) would be appropriate, it recommends that the future IRT investigate different options. In addition, the Working Group recommends that the IRT review ICANN org's practice to ensure that the contracted parties operate in accordance with the URS rules and requirements and fulfill their role and obligations in the URS process. However, the Working Group noted that the IRT is not asked to review all previous URS compliance cases as part of the implementation for this recommendation.

#### **Public Comment Review:**

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<sup>31</sup> URS Complaint form: <https://forms.icann.org/en/resources/compliance/registries/urs/form>

The Working Group also sought public comment on any additional compliance issues, as well as suggestions for enhancing compliance in the URS process.<sup>32</sup>

The Working Group agreed that the non-compliance issues identified in public comment seemed generally consistent with the non-compliance issues the Working Group uncovered during its deliberations. Public comment responses also reinforced the Working Group's view that the current existing compliance mechanism(s) at ICANN org seem unclear and insufficient.

The Working Group noted ICANN org's existing compliance mechanism(s) and the question regarding whether additional compliance mechanisms are needed, or whether only the existing ones should be enforced. Ultimately, the Working Group agreed to provide more flexibility for implementation by revising its text to provide for "a compliance mechanism or mechanisms" and requesting that the IRT investigate different options for appropriate compliance mechanism(s) to hold accountable all stakeholders involved in the URS process.

**URS Final Recommendation #9**

The Working Group recommends that a uniform set of educational materials be developed to provide guidance for URS parties, practitioners, and Examiners on what is needed to meet the "clear and convincing" burden of proof in a URS proceeding.

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that the educational materials should be developed in the form of an administrative checklist, basic template, and/or FAQ. Specifically, the Working Group recommends that the educational materials should be developed with help from URS Providers, Practitioners, Panelists, as well as researchers/academics who study URS decisions closely. The Working Group suggests that the IRT consider the following:

- 1) reaching out to the broader multistakeholder community, including Providers/experts, to assist ICANN org and the IRT to develop those educational materials;
- 2) ICANN org should bear the cost; and
- 3) translations of the resulting materials should be provided.

**Context:**

About half of the Practitioners who responded to the Working Group survey agreed that there should be "more guidance provided to educate or instruct practitioners on what is needed to meet the 'clear and convincing' burden of proof in a URS proceeding" in light of the different laws around the world.

The Working Group noted that two of the three URS Providers did not strongly support the issuance of an Examiners Guide, at least, to the extent that the guidance is to provide direction or examples as to the distinction between clear-cut and more difficult cases.

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<sup>32</sup> See URS Question #2 in the in the RPM PDP Phase 1 Initial Report on pp.32-33:  
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>



Therefore, the Working Group recommends that the uniform set of guidance, or “educational material”, should not extend to providing Examiners with specific directions as to what is, and is not, a clear-cut case. It may be preferable to develop the educational material that is more in the nature of an administrative checklist, basic template, and/or FAQ, rather than a substantive document such as WIPO’s UDRP Overview.<sup>33</sup>

In addition, the Working Group recommends that the educational materials be developed in collaboration with experienced parties in handling URS proceedings (i.e., Providers, Practitioners, Panelists) and researchers/academics who study URS decisions closely.

**Public Comment Review:**

The Working Group sought public comment on the need to develop educational materials (see URS Question #4 of the Initial Report).<sup>34</sup>

Based on its review of public comments, the Working Group agreed to revise its preliminary recommendation text to include 1) the broader multistakeholder community, including Providers/experts to develop the educational materials with the support of ICANN Org; 2) a preference for ICANN org to bear the cost; and 3) the need to provide translations.

The Working Group also noted that this final recommendation addresses the need to develop materials for URS parties and practitioners/Examiners, while URS Final Recommendation #10 is intended to address the need to develop materials only for URS parties. Because they have a substantially different focus, the Working Group agreed that it will be preferable to separate the two recommendations.

**URS Final Recommendation #10**

The Working Group recommends that clear, concise, easy-to-understand informational materials should be developed, translated into multiple languages, and published on the URS Providers’ websites to assist Complainants and Respondents in URS proceedings. Such informational materials should include, but not be limited to the following: 1) a uniform set of basic FAQs, 2) links to Complaint, Response, and Appeal forms, and 3) reference materials that explain the URS Providers’ services and practices.

**Context:**

URS Providers vary in terms of the amount of guidance and instructions they provide to Complainants and Respondents in the various stages of URS proceedings. For example, FORUM provides a PowerPoint Demo with step-by-step instructions. MFSD references specific URS Rules, URS Procedure, and Supplemental Rules in detail. ADNDRC seems to only provide the Complaint, Response, and Appeal forms. The Notice of Complaint from FORUM and MFSD includes instruction to the Respondent about the steps and what to expect in the URS proceedings. FORUM’s case coordinator also assists Respondents on an individual basis via phone or email.

<sup>33</sup> See WIPO’s UDRP Overview here: <https://www.wipo.int/amc/en/domains/search/overview3.0/>

<sup>34</sup> See URS Question #4 on p.33 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

FORUM reported that some Respondents did not file a Response as they did not know how to proceed, regardless of the materials provided by FORUM. FORUM also reported that it has received some Respondent complaints regarding its online filing portal.

Therefore, this recommendation seeks to assist future URS Parties in URS proceedings. However, the Working Group did not have a position as to whether the uniform set of basic FAQs should be developed by the ICANN org, the three URS Providers jointly, or some other entity. Therefore, the Working Group sought public comment on this resource-related implementation question (see URS Question #6).<sup>35</sup>

Based on the public comment review of URS Question #6, the Working Group suggested that the future IRT consider the following additional details in developing the uniform set of basic FAQs for URS parties:

- ICANN org should primarily bear the cost of developing the FAQs.
- The IRT, which typically consists of community volunteers with support by ICANN org staff, can reach out to URS Providers if they are not represented on the IRT, as well as other additional interested parties outside the IRT for input.
- Providers could share any existing materials with the IRT as a starting point for developing the FAQs.
- ICANN org staff can hold the pen and prepare the materials with input from members of the IRT and other interested parties.
- There should be public comment opportunities for the public to provide input for the draft FAQs.
- The FAQs should not address the question as to what constitutes a clear and convincing standard of proof (this topic is addressed by a different set of education materials as proposed in URS Final Recommendation #9).

**Public Comment Review:**

Based on its review of public comments, the Working Group agreed to include additional details provided by commenters in response to URS Question #6, which should be considered by the Implementation Review Team (IRT) to develop the uniform set of basic FAQs for URS parties.

## 2.2.2 URS Recommendations to Maintain Status Quo

None

## 2.2.3 URS Recommendations to Modify Existing Operational Practice

**URS Final Recommendation #11**

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<sup>35</sup> See URS Question #6 on p.34 of the RPM PDP Phase 1 Initial Report:  
<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

The Working Group recommends that URS Providers send notices to the Respondent by the required methods after the Registry or Registrar has forwarded the relevant WHOIS/RDDS data (including contact details of the Registered Name Holder) to the URS Providers.

**Context:**

Prior to the GDPR, URS Providers had typically referenced the contact details of the registrants in the WHOIS/RDDS data in order to communicate with and transmit notices to the registrant. Providers also obtained registrant contact information via the Complainant and the registrant's website. Since the entry into force of the GDPR, personally identifiable information has been masked in the public WHOIS/RDDS data. URS Providers now rely on Registries and Registrars to forward non-public contact information and other relevant WHOIS/RDDS data of the registrant before they can send the registrant notices.

In light of GDPR implementation, the Working Group believes that this recommendation does not contradict with the EPDP Phase 1 Recommendations, especially Recommendations #23 and #27 which suggested updates be made to existing procedures and rules impacted by the GDPR, as well as the analysis in ICANN org's EPDP Phase 1 Recommendation #27 Wave 1 Report.<sup>36</sup>

**Public Comment Review:**

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation.

The Working Group noted a suggestion raised in public comment to codify what the URS Provider should do when the Registry/Registrar does not timely provide the WHOIS/RDDS data of the registrant. FORUM informed the Working Group that Registries/Registrars rarely delayed in providing the registrant contact information. When this happens, FORUM contacts ICANN org to contact the Registry/Registrar to acquire the information. If the Registry/Registrar fails to respond after several attempts, historically the Complainant would give FORUM permission to hold off on commencing the case until the information was obtained.

In light of FORUM's input, the Working Group agreed that the recommendation should be maintained "as is".

**URS Final Recommendation #12**

The Working Group recommends that the ICANN org, Registries, Registrars, and URS Providers take appropriate steps to ensure that each other's contact details are up to date in order to effectively fulfill the notice requirements set forth in the URS Procedure paragraph 4.

**Context:**

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<sup>36</sup> Please see the full text of these EPDP Phase 1 recommendations as well as the Wave 1 Report in the "Background" section of this Final Report.

URS Providers' feedback indicated some clerical issues concerning Registry Operators, including:

- Communicating from email addresses different from the contacts present in ICANN's repository;
- Not being responsive to requests for information from URS Providers;
- Delay in sending notifications to the URS Providers regarding the completion of URS actions;
- Not completing URS actions despite notifications and reminders from the Providers, resulting in a need for the Providers to report non-compliance to ICANN;
- Due to GDPR, Registries are inconsistent with respect to how they would like to either receive verification requests or how the Provider should receive the verification from them (e.g., dropbox, zip file with password, web based access); the inconsistency adds a significant amount of time to case handling; a small number of Registries do not respond within the required 24 hours for verification requests.

**Public Comment Review:**

The Working Group noted that this recommendation received overwhelming support from public comments with no objection.

The Working Group adopted a suggestion raised in public comments to revise the original recommendation text to make clear that the various interested parties should be taking affirmative steps to resolve the issues identified in the feedback from URS Providers and ensure that URS Providers, Registries, and Registrars have one another's correct, up-to-date contact details in order to ensure the efficacy of the URS process.

In light of compliance issues identified by the Working Group, the Working Group noted ICANN org's public comment that it has faced difficulties in obtaining accurate/up-to-date contact data from contracted parties. ICANN org's comment reinforced the Working Group's view that this recommendation is necessary. However, the Working Group did not reach agreement as to whether ICANN org should be responsible for enforcing such requirements via its formal contracts with Registries and Registrars, as well as the MoU with Providers.

To gain more information about the clerical issues reported by the Providers, the Working Group also sought public comments from Registry Operators regarding their experience of receiving notices from URS Providers.<sup>37</sup> However, this question received only one substantive response, which seemed to concern an operational issue already dealt with between ICANN org and Providers.<sup>38</sup>

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<sup>37</sup> See URS Question #3 in the in the RPM PDP Phase 1 Initial Report on pp.33:

<https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>38</sup> The only substantive public comment response was from GNSO's Contracted Parties House (CPH), noting the following: "Certain emails have been signed with self-issued certificates, which has led to questions about the legitimacy of those emails among some registry operators". The CPH did not respond to the Working Group's follow-up questions regarding its comment. The Working Group discussed the issues regarding emails signed with self-issued certificates, but it seems that ICANN org and URS Providers have been working to address this operational matter.

**URS Final Recommendation #13**

The Working Group recommends that all URS Providers require their Examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.

**Implementation Guidance:**

As implementation guidance, the Working Group recommends that URS Providers provide their Examiners a set of basic guidance for documenting their rationale for a Determination. The purpose is to ensure consistency and precision in terminology and format as well as ensure that all steps in a proceeding are recorded. Such guidance may take the form of an administrative checklist or template of minimum elements that need to be included for a Determination; specifically and at a minimum, that the relevant facts are spelled out and each of the three URS elements listed in the original language of the Determination are addressed in the Determination.<sup>39</sup>

**Context:**

URS Providers vary in terms of the amount of guidance they provide their Examiners with respect to issuing Determinations. They also vary in the use of a template Determination form. The Working Group reviewed data from over 900 URS cases and found that there are some inconsistencies across Examiners as to whether or not rationale or justifications are provided (and in what detail) for their findings in the issued Determination. The Working Group's case review also indicated that a number of Determinations cited either inadequate or no rationale for the decisions, such that the Working Group believes it necessary to recommend that URS Providers require their Examiners to document their rationale in sufficient detail to explain how the decision was reached in all issued Determinations.

Nevertheless, some Working Group members cautioned against micromanaging and imposing burdensome guidance on panelists, who have limited time and compensation in handling URS cases. The Working Group agreed that Providers should have the discretion to provide their Examiners the basic guidance in a suitable form, so long as such guidance requires the Examiners to document their rationale for a Determination and at a minimum, to spell out relevant facts and address each of the three URS elements listed in the original language of the Determination.

**Public Comment Review:**

Based on its review of public comments, the Working Group agreed to tighten its preliminary recommendation language to clarify that the Determination includes at minimum all the required elements of a decision, such as the facts, rationale, test(s) employed, and conclusions.

**URS Final Recommendation #14**

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<sup>39</sup> The URS requires a trademark owner, or the "Complainant," to show all three of the following elements: (i) The disputed domain name is identical or confusingly similar to a word mark that meets certain criteria; (ii) the registrant of the domain name, or the "respondent," has no legitimate right or interest to the domain name; and (iii) the domain name was registered and is being used in bad faith.

The Working Group recommends that the IRT consider reviewing the implementation issues identified by the Working Group with respect to Registry Requirement 10 in the “URS High Level Technical Requirements for Registries and Registrars” and amend Registry Requirement 10, if deemed necessary.<sup>40</sup>

For clarity, the Working Group notes that this recommendation is not intended to create any transfer remedy for the URS. In addition, the Working Group agrees that as set out in the URS Rules and Procedure, a domain name suspension can be extended for one additional year, and the Whois for the domain name shall continue to display all of the information of the original Registrant and reflect that the domain name will not be able to be transferred, deleted, or modified for the life of the registration.<sup>41</sup>

**Context:**

This recommendation specifically concerns the following parts of the URS Technical Requirement:

- **Registry Requirement 10:** In cases where a URS Complainant (as defined in the URS Rules) has prevailed, Registry Operator MUST offer the option for the URS Complainant to extend a URS Suspended domain name's registration for an additional year (if allowed by the maximum registration policies of the TLD), provided, however, that the URS Suspended domain name MUST remain registered to the registrant who was the registrant at the time of URS Suspension. Registry Operator MAY collect the Registrar renewal fee if the URS Complainant elects to renew the URS Suspended domain name with the sponsoring Registrar.

One-third of URS Practitioners who responded to the Working Group survey on the URS indicated problems with implementing the relief awarded following a URS decision. URS Providers also reported that some Registries and Registrars had difficulty implementing the extension request of the URS Suspension, as they might not understand their roles in the process. Therefore, the Working Group recommends that the future IRT review the implementation issues regarding Registry Requirement 10, and consider whether enhanced education is needed to help Registries and Registrars understand how to implement relief and gain better awareness of the URS process.

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<sup>40</sup> URS Technical Requirements for Registries and Registrars can be downloaded here:

<https://newgtlds.icann.org/en/applicants/urs/tech-requirements-17oct13-en.pdf>

<sup>41</sup> **URS Rule 14(b):** If the Complainant wishes to extend the remedy for an additional year per URS Procedure paragraph 10.3, Complainant shall contact the Registry Operator directly regarding this option.

**URS Procedure paragraph 10.2:** Immediately upon receipt of the Determination, the Registry Operator shall suspend the domain name, which shall remain suspended for the balance of the registration period and would not resolve to the original web site. The Registry Operator shall cause the nameservers to redirect to an informational web page provided by the URS Provider about the URS. The URS Provider shall not be allowed to offer any other services on such page, nor shall it directly or indirectly use the web page for advertising purposes (either for itself or any other third party). The Whois for the domain name shall continue to display all of the information of the original Registrant except for the redirection of the nameservers. In addition, the Registry Operator shall cause the Whois to reflect that the domain name will not be able to be transferred, deleted or modified for the life of the registration.

**URS Procedure paragraph 10.3:** There shall be an option for a successful Complainant to extend the registration period for one additional year at commercial rates.

**Public Comment Review:**

Based on its review of public comments, the Working Group agreed that it should expressly clarify that this recommendation is not intended to create any transfer remedy for the URS. In addition, the Working Group agreed to emphasize that the suspension can be extended for one year, but ownership of the domain name is not transferred to the winning Complainant or another registrar.

Furthermore, the Working Group also sought public comment on whether Registry Requirement 10 should be amended to include the possibility for a winning Complainant to elect another Registrar, which is different from the sponsoring Registrar but accredited by the same Registry, to renew the domain name(s) at issue, and to collect the Registrar renewal fee (see URS Question #5 in the Initial Report).<sup>42</sup> The Working Group agreed that public comments provided no conclusive direction with respect to this question and consequently did not develop a recommendation on this point.

**URS Final Recommendation #15**

The Working Group recommends that the "URS High Level Technical Requirements for Registries and Registrars" document be renamed as the "URS High Level Requirements for Registries and Registrars". The Working Group also recommends that on ICANN org's web page <https://newgtlds.icann.org/en/applicants/urs>, the "URS Technical Requirements 1.0" document be renamed as the "URS Registrars and Registries Requirements 1.0".

**Context:**

This recommendation was developed following the Working Group's review of public comments to URS Individual Proposal #2, which did not rise to the level of becoming a preliminary recommendation but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>43</sup>

The Working Group recognized that the technical document "URS High Level Technical Requirements for Registries and Registrars" also includes the following legal requirements pertaining to the inclusion of a particular text in the Registry-Registrar Agreement:<sup>44</sup>

**4. Registry-Registrar Agreement:**

- The Registry Operator MUST specify in the Registry-Registrar Agreement for the Registry Operator's TLD that the Registrar MUST accept and process payments for the renewal of a domain name by a URS Complainant in cases where the URS Complainant prevailed.

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<sup>42</sup> See URS Question #5 on pp.33-34 of the RPM PDP Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>43</sup> See the full text of the URS Individual Proposal #2 on pp.58-59 of the RPM PDP Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>44</sup> See p.5 of the URS Technical Requirements for Registries and Registrars:

<https://newgtlds.icann.org/en/applicants/urs/tech-requirements-17oct13-en.pdf>

- The Registry Operator MUST specify in the Registry-Registrar Agreement for the Registry Operator’s TLD that the Registrar MUST NOT renew a domain name to a URS Complainant who prevailed for longer than one year (if allowed by the maximum validity period of the TLD).

The Working Group agreed that this minimal change would enhance clarity of the document scope and reduce the risk of confusion among Registries and Registrars, who may be puzzled by the inclusion of requirements with legal implications inside a document with the phrase “technical requirements” in its title. The Working Group also agreed that the title of the same document published on the ICANN org's web page <https://newgtlds.icann.org/en/applicants/urs> needs to be updated for sake of clarity and consistency.

**Public Comment Review:**

Based on the public comments received, the Working Group noted that there was no objection to the URS Individual Proposal #2, which served as the origin of this recommendation. Furthermore, the Working Group noted that the second approach suggested in the original proposal garnered more support among public comment contributors; the GNSO’s Contracted Parties House, which the Working Group particularly sought public comment from with regard to the original proposal, also supported the second approach. Therefore, the Working Group agreed to put the second approach forward as a recommendation for inclusion in its Phase 1 Final Report.

## 2.3 Trademark Clearinghouse (TMCH) Final Recommendations

### 2.3.1 TMCH Recommendations for New Policies and Procedures

**TMCH Final Recommendation #1****Agreed Policy Principles:**

The Working Group recommends that the scope and applicability of the TMCH be clarified and limited in accordance with the following agreed policy principles:

1. Only 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; or
  - b. Word marks validated by a court of law or other judicial proceeding; or
  - 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. This provision is important for the protection of certain marks of international governmental and non-governmental organizations (see Explanatory Note below).
2. “Word marks” include service marks, collective marks, certification marks and word marks protected by statute or treaty, as further limited by Policy Principle #3 below.
3. 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 1(a) or 1(b) above.<sup>45</sup>

4. The TMCH Validation Provider(s), registry operators and other third parties may provide ancillary services to intellectual property rights-holders. To the extent that the TMCH Validation Provider validates and accepts other forms of intellectual property (such as geographical indications) in order to provide such additional voluntary services, these other forms of intellectual property must be held in a separate ancillary database.

**Implementation Guidance:**

The Working Group recommends that the Implementation Review Team (IRT) consider adopting the following language in amending the Module 5 Trademark Clearinghouse of the Applicant Guidebook to reflect the agreed policy principles noted above:

3.2.1 Nothing in this section shall exclude the TMCH Validation Provider and registry operators from offering additional voluntary services to mark holders.

3.2.2 In this section “word mark” includes service marks, collective marks, certification marks, and word marks protected by statute or treaty.

3.2.3 The standards for inclusion in the Clearinghouse in order to be eligible for the mandatory Trademark Claims and Sunrise RPMs are:

- (1) Nationally or regionally registered word marks from all jurisdictions;
- (2) Word marks that have been validated through a court of law or other judicial proceeding;
- (3) Word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion and listed at a national or regional trademark office.
- (4) Subsection (3) does not apply to geographical indications, protected designations of origin, or other quality schemes unless they also satisfy subsections (1) or (2).

3.2.4 The standards for being validated and accepted for the sole purpose of inclusion in ancillary databases to permit the provision of additional voluntary services, but not for the purpose of accessing mandatory Trademark Claims or Sunrise RPMs are:

- (1) Other marks that constitute intellectual property;
- (2) Geographical indications, protected designations of origin, or other quality schemes for distinguishing or indicating the geographic source or quality of goods or services.

3.2.5 Applications for trademark registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings are not eligible for inclusion in the Clearinghouse.

Explanatory Note in relation to word marks protected by statute or treaty:

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<sup>45</sup> The Working Group is using the phrase “quality scheme” in the sense used by the European Union when describing its quality policy: see, e.g.: [https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained\\_en](https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en)

Treaty organizations and non-governmental organizations protected by statute are not always able to register their word marks at a national trademark office. In some jurisdictions their marks are reflected as a “non-registration” (e.g. the 89 series in the United States Patent & Trademark Office) which ensures no one can subsequently register those marks as a trademark or are otherwise listed with the relevant trademark office. Where such word marks are listed with a national or regional trademark office, they must be treated within the Clearinghouse in the same way as a registered word mark or a court validated word mark and must be eligible for Claims and Sunrise.

An illustrative example of a network of societies whose word marks are protected by international treaty and national statutes is the Red Cross, whose signs and emblems are protected by the Geneva Conventions, and which has signs listed, inter alia, in the 89 series at the United States Patent & Trademark Office.

**Context:**

This recommendation was developed following the Working Group’s review of public comments to TMCH Individual Proposals #4 and #5, which did not rise to the level of becoming preliminary recommendations but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>46</sup>

Based on the public comments received, the Working Group agreed to develop a recommendation that consolidates those two TMCH Individual Proposals and clarifies the TMCH requirements in the Applicant Guidebook (AGB). During its deliberation, the Working Group coalesced around the following ideas: (1) mandatory RPMs should only be for trademarks, not other source designations that do not function as trademarks, including Geographical Indications; (2) while such other designations can be entered into an additional/ancillary database maintained by the TMCH Validation Provider, they are not eligible for Sunrise and Claims; and (3) the ability for the TMCH Validation Provider and Registry Operators to offer additional/voluntary ancillary services to such other designations should be preserved (e.g., via an ancillary database).

The Working Group ultimately agreed that the policy principles contained in the recommendation text reflect those ideas and frame the suggested amendments to the Applicant Guidebook (AGB) text in the Implementation Guidance. The Working Group further agreed that its proposed amendment to the AGB text should serve as a starting point; the IRT will have the flexibility/latitude to develop the final language of the AGB. The Working Group noted that the AGB will be subject to extensive community consultation; in the implementation stage, the actual language of the final policy will also be posted for public comment.

**Public Comment Review:**

Based on the public comments received, the Working Group noted that different stakeholders indicated their preference for either the TMCH Individual Proposal #4 or the TMCH Individual

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<sup>46</sup> See the full text of the TMCH Individual Proposal #4 and #5 on pp. 73-76 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

Proposal #5. Due to the similarities between these two proposals, the Working Group agreed to put forward a recommendation which consolidates them based on the agreed policy principles that received cross-community support.

The Working Group considered the comments from Deloitte, the TMCH Validation Provider, which explicitly stated that it has never deviated or overstepped the TMCH guidelines and always had taken into account the requirements and rules defined in the guidebook.<sup>47</sup> However, the Working Group believed that this recommendation is necessary in clarifying the requirements and rules in the AGB, which Deloitte must follow.

### 2.3.2 TMCH Recommendation to Maintain Status Quo

#### TMCH Final Recommendation #2

The Working Group considered the following aspects of the TMCH:<sup>48</sup>

1. Whether the “TM +50” rule should be changed or maintained;
2. Whether the current “exact match” rules should be changed or maintained; and
3. Whether, where a trademark contains dictionary term(s), the Sunrise and Trademark Claims RPMs should be changed such as to be limited in their scope to be applicable only in those gTLDs that pertain to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group’s recommendation for these three questions is that the status quo (i.e. the current rules as applied to the gTLDs delegated under the 2012 New gTLD Program round) should be maintained.

#### Context:

To determine whether there was sufficient support within the Working Group to change the status quo for each of these three topics, the Working Group agreed that the applicable standard should be whether there was “wide support” for any proposed changes.

#### 1. “TM +50”<sup>49</sup>

The current rule allows trademark owners to submit up to 50 “previously abused domain name labels” (i.e. domain names previously held to have been registered and used in bad faith either in a UDRP or court proceeding) into the TMCH in connection with an existing TMCH-recorded mark (i.e. “TM+50”). The Working Group reviewed data from Deloitte (the TMCH Validation Provider) demonstrating the extent that trademark owners had used this rule to submit such abused

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<sup>47</sup> See Deloitte’s comments for the TMCH Individual Proposal #4 in the public comment review tool row #39 here: [https://docs.google.com/spreadsheets/d/1QQt\\_m5qdzoalRDclUED01ur-yJgODCex8bj\\_-aKO7fl/edit#gid=722865735](https://docs.google.com/spreadsheets/d/1QQt_m5qdzoalRDclUED01ur-yJgODCex8bj_-aKO7fl/edit#gid=722865735)

<sup>48</sup> For additional details about the TMCH, please see Trademark Clearinghouse in Module 5 of the gTLD Applicant Guidebook: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

<sup>49</sup> See Section 3 of the TMCH Guidelines for a description of the “TM+50” service and how labels are to be submitted and validated: [https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2\\_0.pdf](https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf)

labels. In the absence of wide support for a change to the status quo, the Working Group recommends that the TM +50 rule be retained as is.

## 2. “Exact Match”

The Working Group’s recommendation on this point is consistent with Trademark Claims Final Recommendation #4: “In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.”

The Working Group had diverging opinions as to whether the current exact match requirement is serving its intended purposes, and whether there is evidence of harm under the existing requirement. The Working Group debated these questions extensively during its deliberations over the Trademark Claims service, which operates off the data in the TMCH. The Working Group deliberation note in a Google Doc (see footnote) provides details of these discussions.<sup>50</sup>

Ultimately, the Working Group believes that the exact match criteria strike an appropriate balance of deterring bad-faith registrations without evidence that good-faith domain name applications were deterred to any substantial extent. As a result, the Working Group agreed on Trademark Claims Final Recommendations #4 and the TMCH Final Recommendation #2, which are consistent with each other.

## 3. “Scope of Applicability of the Sunrise & Claims RPMs to specific gTLDs for trademarks containing dictionary term(s)”

Currently, Sunrise and Trademark Claims RPMs are not limited, in the sense that these RPMs are applicable in all gTLDs launched during the 2012 New gTLD Program round. As such, these RPMs would have been available to owners of trademarks that contain dictionary term(s) regardless of whether the gTLDs are related or unrelated to the categories of goods and services for which the dictionary term(s) within that trademark are protected.

The Working Group had diverging opinions on whether the availability of Sunrise and Trademark Claim services for trademarks that contain dictionary term(s) should be limited to apply only to those gTLDs that pertain directly to the relevant categories of goods and services. In the absence of wide support for a change to the status quo, the Working Group agreed that the scope of the Sunrise and Trademark Claims RPMs should not be modified to limit their application to gTLDs that are related to the categories of goods and services for which the dictionary term(s) within those trademarks are protected.

### **Public Comment Review:**

Based on public comments received, the Working Group clarified the text of its preliminary recommendation on the point pertaining to the unlimited scope of Sunrise and Trademark Claims. However, as noted, the substance of the recommendation remains unchanged.

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<sup>50</sup> See the Google Doc here:

[https://docs.google.com/document/d/10quBC1BnuIM\\_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing](https://docs.google.com/document/d/10quBC1BnuIM_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing)

### 2.3.3 TMCH Recommendations to Modify Existing Operational Practice

**TMCH Final Recommendation #3**

The Working Group recommends that the TMCH Validation Provider be primarily responsible for educating rights-holders, domain name registrants, and potential registrants about the services it provides.

The Working Group also recommends that the IRT work with the TMCH Validation Provider and consider enhancing existing educational materials already made available by the TMCH Validation Provider, with additional attention to providing information that can benefit domain name and potential registrants.

**Context:**

This recommendation was developed following the Working Group's review of public comments to TMCH Individual Proposal #1, which did not rise to the level of becoming a preliminary recommendation but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>51</sup>

The Working Group agreed that the TMCH services benefit multiple stakeholders, so for the TMCH to have successful interactions with the community, it should provide meaningful information about its services. The Working Group further agreed that the TMCH Validation Provider is best positioned to explain its own services and correctly identify the stakeholders it interacts with. It therefore should be primarily responsible for the educational efforts.

Based on public comments submitted by Deloitte, the current TMCH Validation Provider, the Working Group understood that Deloitte has already been providing education on the TMCH, the New gTLD Program, and its associated RPM's since the launch of the TMCH in March 2013. Therefore, the Working Group further suggested these existing educational and outreach efforts be enhanced to benefit current and potential domain name registrants beyond trademark owners in order to serve the fuller community. This suggestion aligns with the Working Group's Trademark Claims Final Recommendation #6 concerning the improvement of the Trademark Claims Notice.

The Working Group adopted the suggestion raised in public comments that the IRT should work with the TMCH Validation Provider and consider enhancing the educational materials. In this regard, the IRT (consisting of community volunteers working in consultation with ICANN org staff) should bear primary responsibility for improving the education materials, to be subsequently published and distributed by the TMCH Validation Provider.

**Public Comment Review:**

Based on the public comments received, the Working Group noted that TMCH Individual Proposal #1, which served as the origin of this recommendation, received wide support. The Working Group adopted a suggestion raised in public comment to clarify that it is the TMCH

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<sup>51</sup> See the full text of the TMCH Individual Proposal #1 on pp.70-71 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

Validation Provider who has the primary responsibility for education. Furthermore, the Working Group adopted another suggestion raised in public comment that the IRT should consider enhancement of educational materials already being made available by the TMCH Validation Provider, with an eye toward also benefiting current and potential domain name registrants.

**TMCH Final Recommendation #4**

The Working Group recommends that the Trademark Clearinghouse database provider be contractually bound to maintain, at minimum, industry-standard levels of redundancy and uptime.

**Implementation Guidance**

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group has developed the following implementation guidance:

- Consider the advisability of requiring that more than one provider be appointed; and
- Review the work of the Implementation Advisory Group that was formed for the 2012 New gTLD Program to assist ICANN org with developing the specifications for and design of the Trademark Clearinghouse.<sup>52</sup>

**Context:**

This recommendation was developed following the Working Group's review of public comments to TMCH Individual Proposal #6, which did not rise to the level of becoming a preliminary recommendation but received sufficient support from the Working Group to be published in the Phase 1 Initial Report for public comment.<sup>53</sup>

This recommendation concerns the operation of the Trademark Clearinghouse Database (currently administered by IBM). Where Deloitte operates the Trademark Clearinghouse validation service that checks trademarks submitted for entry into the TMCH against the substantive and other criteria set out in the TMCH Guidelines, IBM operates the resulting TMCH Database with which Registry Operators and registrars interact, e.g. to offer the Trademark Claims service. In this context, some Working Group members expressed concerns about operational considerations due to there being only a single provider (e.g., one Working Group member noted that several Registry Operators had experienced downtime issues when accessing the TMCH Database).

Based on the wide support received from public comments for the original proposal, the Working Group believed that it is critical that the Trademark Clearinghouse database remains available for access by registries and registrars in order to provide the mandatory Sunrise and Trademark Claims services and, in some cases, additional services such as extended claims periods. Therefore, the Working Group agreed to put forward this recommendation in its Phase 1 Final Report for consideration by the IRT.

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<sup>52</sup> See details about the Implementation Advisory Group here: <https://newgtlds.icann.org/en/about/trademark-clearinghouse/summary-iag-input-26sep12-en.pdf>

<sup>53</sup> See the full text of the TMCH Individual Proposal #6 on p.77 of the RPM PDP Phase 1 Initial Report: <https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

**Public Comment Review:**

Based on the public comments received, the Working Group noted that TMCH Individual Proposal #6, which served as the origin of this recommendation, received wide support. In reviewing the public comments, the Working Group agreed that there was an anecdotal but real report of operational problems related to the TMCH Database, and there was support that the uptime requirements and reliance of the TMCH services should be changed to industry standards.

## 2.4 Sunrise Final Recommendations

### 2.4.1 Sunrise Recommendation for New Policies and Procedures

**Sunrise Final Recommendation #1**

The Working Group recommends that the Registry Agreement for future new gTLDs 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 imposed by ICANN or restricting brand owners' reasonable use of the Sunrise RPM.

**Implementation Guidance:**

The Working Group agrees that this recommendation and its implementation are not intended to preclude or restrict a Registry Operator's legitimate business practices that are otherwise compliant with ICANN policies and procedures.

**Context:**

The Working Group generally agreed that some Registry Sunrise or Premium Name pricing practices have limited the ability of some trademark owners to participate during Sunrise.<sup>54</sup> The Working Group was made aware of cases where certain Registry Operator practices may have unfairly limited the ability of some trademark owners to participate during Sunrise, when pricing set for the trademark owners was significantly higher than other Sunrise pricing or Landrush/General Availability pricing. The Working Group noted that this problem seems sufficiently extensive that it warranted a policy recommendation to address.

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP, the Working Group tried to reach agreement on some possible types of specific Registry conduct that could have the effect of intentionally circumventing trademark owners' use of the Sunrise Period within the meaning of the Registry Agreement provision envisioned in this recommendation, so as to trigger enforcement action by ICANN org (e.g., its Contractual Compliance department). As part of its discussion, the Working Group noted that several public comments to the Initial Report had raised the following examples as non-exhaustive illustrations of such conduct (some of which had also been raised by Working Group members):

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<sup>54</sup> **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Premium Pricing:** second level domain names that are offered for registration, that in the determination of the registry are more desirable for the purchaser and will command a price that is higher than a non-premium name.

- Withholding or self-allocating domain names that correspond to trademarks recorded in the TMCH with the intent of circumventing the use of the Sunrise Period by trademark owners;
- Discriminatory pricing practices clearly designed to effectively prevent the reasonable ability of trademark owners to obtain defensive Sunrise registrations for their marks recorded in the TMCH. In this context, “discriminatory pricing practices” could include extremely high pricing during the Sunrise Period of the domain names that correspond to trademarks recorded in the TMCH followed by significantly lower prices for the same domain names during Landrush or General Availability, such as to evidence an intent to target trademark owners either specifically, or as a general class of registrants, for the purpose of inhibiting access to Sunrise registrations.

Furthermore, some Working Group members suggested that the IRT consider the following non-exhaustive list of resources raised in public comments, which could provide relevant examples of Registry Operator conduct that may have the effect of intentionally circumventing trademark owners’ use of the Sunrise Period:

- Correspondence from ICANN’s GNSO Business Constituency regarding the rollout of the .sucks new gTLD by Vox Populi Registry (8 May 2015):  
<https://www.bizconst.org/assets/docs/positions-statements/letter-to-icann-dotsucks.pdf>
- Correspondence from the Federal Trade Commission (FTC) regarding the rollout of the .sucks new gTLD by Vox Populi Registry (27 May 2015):  
<https://www.icann.org/en/system/files/correspondence/ramirez-to-jeffrey-27may15-en.pdf>
- Panel Report of ICANN’s Public Interest Commitment Dispute Resolution Procedure (PICDRP) concerning the .feedback registry (17 March 2017):  
<https://www.icann.org/en/system/files/correspondence/ramirez-to-jeffrey-27may15-en.pdf>
- Collated information from RPM PDP Working Group members concerning perceived Sunrise abuse by new gTLD Registry Operators (17 October 2016):  
<https://go.icann.org/collated>

Nevertheless, the Working Group also had diverging opinions on whether registry pricing is within the scope of the RPM PDP Working Group. While some Working Group members expressed concerns about the interplay of Registry pricing with RPMs obligations, other Working Group members pointed to the Registry Agreements that state that registry pricing is not within the scope of the RPM Working Group due to the “picket fence”.<sup>55</sup> Specifically, Section 1.4.1 of

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<sup>55</sup> **Picket Fence:** In its original agreements with ICANN, registries and registrars agreed to comply with “consensus” policies adopted by ICANN provided (i) that such policies did not unreasonably restrain competition and (ii) that the policies related to: 1) issues for which uniform or coordinated resolution is reasonably necessary to facilitate interoperability, technical reliability and/or stable operation of the Internet or domain-name system; 2) registry policies reasonably necessary to implement Consensus Policies relating to registrars; and 3) resolution of disputes regarding the registration of domain names (as opposed to the use of such domain names), and do not unreasonably restrain competition. ICANN’s policy making mission, as described previously, creates a “picket fence” around ICANN’s authority -- ICANN can only mandate registry and registrar compliance with policies affecting issues inside the “picket fence”; ICANN could establish policy and/or best practices affecting issues outside the picket fence, but could not mandate registry and registrar compliance with such policies. Learn more:  
<https://gns0.icann.org/sites/default/files/file/field-file-attach/picket-fence-overview-23jan19-en.pdf>



Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement respectively specify that Consensus Policies shall not prescribe or limit the price of Registry Services and Registrar Services.<sup>56</sup>

Several Working Group members also noted that many trademarks consist of generic dictionary words that have inherent value which can be used by potential registrants (other than the trademark owner) in a non-infringing manner, thus justifying a premium price being charged for the domain name.<sup>57</sup>

Therefore, some Working Group members expressed concerns about or objected to listing those above examples, cautioning that premium pricing level in and of itself may not indicate the kind of conduct that this recommendation is meant to address. Several Working Group members noted that highlighting registry pricing practices could put the Working Group at risk of violating the “picket fence”.

The Working Group also discussed the question of whether there should be an additional enforcement mechanism, apart from actions taken by ICANN Compliance on its own or at the request of an outside party, for addressing such conduct by a Registry Operator. Some members suggested that the IRT should consider developing an enforcement mechanism where discriminatory pricing resulted in bad faith registration of a domain that corresponds to a trademark recorded in the TMCH and subsequent infringement of the trademark after the Sunrise Period. In addition, a small team of Working Group members proposed that the IRT should explore the possibility of a third party challenge mechanism as one of the possible means of enforcement among others (for example, direct enforcement by ICANN Compliance), provided that any such third party challenge mechanism should also include appropriate safeguards for Registry Operators. However, this small team proposal did not receive wide support and received significant opposition in the Working Group. As such, the Working Group did not reach agreement on the question of an additional enforcement mechanism to supplement enforcement actions taken by ICANN Compliance.

#### **Public Comment Review:**

Based on public comments received, the Working Group agreed that it should try to develop additional implementation guidance on this topic, including a non-exhaustive list of clarifying ideas/examples of registry conduct that may have the effect of intentionally circumventing

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<sup>56</sup> Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement state the following: “In addition to the other limitations on Consensus Policies, they shall not prescribe or limit the price of Registrar Services”. See page 43 of the Base Registry Agreement (updated 31 July 2017): <https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.pdf> and page 57 of the 2013 Registrar Accreditation Agreement: <https://www.icann.org/en/system/files/files/approved-with-specs-27jun13-en.pdf>.

<sup>57</sup> One Working Group member noted that based on the empirical research of Barton Beebe & Jeanne C. Fromer, 81.3% of the most commonly used English words were single-word registered trademarks in the US; for registrations at EUIPO, the corresponding number is 69.4% for English; the results are similar for French, German, Italian, and Spanish. See “Are We Running out of Trademarks?”, 131 Harv. L. Rev. 945, pp.981-82 (2018) and “Coping with Trademark Depletion in a Global Economy: A Comparative Empirical Study of the United States and the European Union (draft)” at pp.3, 24.

mandatory RPMs, particularly the Sunrise Period used by trademark owners. As described above, the Working Group did not agree on the specific form of implementation guidance or examples for inclusion. Despite the divergence of opinions on implementation guidance, the actual policy recommendation received wide support among Working Group members. Ultimately, the Working Group agreed to leave it to the IRT to determine what forms of Registry Operator conduct would constitute a violation of this recommendation such as to trigger enforcement action by ICANN org, should the Registry Agreement contain a prohibition on such conduct.<sup>58</sup>

## 2.4.2 Sunrise Recommendations to Maintain Status Quo

### **Sunrise Final Recommendation #2**

In the absence of wide support for a change to the status quo, the Working Group recommends that the mandatory Sunrise Period should be maintained for all new gTLDs, with the sole exception of those gTLDs who receive exemptions pursuant to Specification 13 .Brand TLD Provisions and Section 6 of Specification 9 Registry Operator Code of Conduct of the Registry Agreement (or their equivalent in the next new gTLD expansion round).<sup>59</sup>

### **Context:**

The Working Group had diverging opinions on whether the Sunrise Period should continue being mandatory or should become optional. Trademark and brand owners supported the Sunrise Period continuing to be mandatory. The Working Group noted that there were 64,000+ Sunrise registrations across 484 gTLDs as of August 2017.

Some Registry Operators indicated that they would prefer an option to choose between offering Sunrise or Trademark Claims services. The Working Group also noted that, where these are offered by a Registry Operator, trademark and brand owners may view blocking services such as Domains Protected Marks List (DPML) and DPML Plus as viable alternatives to the Sunrise Period.<sup>60</sup>

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<sup>58</sup> See community input regarding the Sunrise abuse in responses to Sunrise Question #2 in the public comment review tool here:

<https://docs.google.com/spreadsheets/d/1xMehg9o44bdz85ry0LvhzoOaKdmJ6SwlrLneMx0lxc/edit#gid=581453427>

<sup>59</sup> See **Specification 13 .Brand TLD Provisions** here:

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-specification-13-31jul17-en.pdf>;

The exemption language in **Section 6 of Specification 9 Registry Operator Code of Conduct** is as follows: "Registry Operator may request an exemption to this Code of Conduct, and such exemption may be granted by ICANN in ICANN's reasonable discretion, if Registry Operator demonstrates to ICANN's reasonable satisfaction that (i) all domain name registrations in the TLD are registered to, and maintained by, Registry Operator for the exclusive use of Registry Operator or its Affiliates, (ii) Registry Operator does not sell, distribute or transfer control or use of any registrations in the TLD to any third party that is not an Affiliate of Registry Operator, and (iii) application of this Code of Conduct to the TLD is not necessary to protect the public interest." See full next of the Specification 9 here:

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.html#specification9>.

More information about the Specification 9-exempted TLDs can be found here.

<sup>60</sup> Donuts inc. offers the DPML and DPML Plus programs as additional solutions that protect brand's trademarks and prevent cybersquatting. With these programs, trademark owners can block registrations of validated trademarks without requiring defensive purposes in each of Donuts' 241 TLDs. Learn more: <https://donuts.domains/what-we-do/brand-protection>

Some Working Group members voiced concerns about the continuation of the mandatory Sunrise Period, based on the potential for abuse by trademark owners due to the TMCH's acceptance of non-standard character claim marks and common/dictionary words, as well as the broad scope of registration within the TMCH. However, the Working Group concluded overall that there is currently inadequate evidence to validate this concern.

**Public Comment Review:**

The Working Group noted that there was wide community support for exempting dot Brand TLDs, whose Registry Agreement with ICANN org include Specification 13 which does not require them to run a mandatory Sunrise Period. Public comments received also clarified that those TLD Registries who receive exemptions pursuant to Section 6 of Specification 9 in the Registry Agreement are also not expected or required to run a mandatory Sunrise Period.

Consequently, the Working Group agreed to clarify its recommendation to ensure that Specification 13/dot Brand TLDs and Specification 9-exempted TLDs, who do not allow third-party registrations, are exempted from running the mandatory Sunrise Period. For further clarity, the Working Group notes that this recommendation is intended to apply to all subsequent versions of Specification 9 and Specification 13, to the extent that these specifications mean that exempted Registry Operators do not have to run a mandatory Sunrise Period.

**Sunrise Final Recommendation #3**

The Working Group recommends that the current requirement for the Sunrise Period be maintained, including for the 30-day minimum period for a Start Date Sunrise and the 60-day minimum period for an End Date Sunrise.

**Context:**

The Working Group noted two types of Sunrise Periods, which both require a total of 60 days at a minimum:<sup>61</sup>

1. **Start Date Sunrise:** The Registry must give 30-day notice before commencing the Sunrise. Once the Sunrise starts, it must run for 30 days at a minimum.
2. **End Date Sunrise:** The Registry can announce the Sunrise as late as the day the Sunrise starts, but must run the Sunrise period for 60 days at a minimum.

Since most Registry Operators to date have run an End Date Sunrise, the Working Group focused its work on reviewing the Start Date Sunrise.

The Working Group generally agreed that the current 30-day minimum after the Start Date Sunrise Period starts appears to be serving its intended purpose. Some Working Group members believe that there are unintended results, such as complications when many TLDs are launched simultaneously for the Start Date Sunrise for 30 days. To address this unintended consequence,

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<sup>61</sup> See reference here: [https://icannwiki.org/Sunrise\\_Period](https://icannwiki.org/Sunrise_Period)

one Working Group member proposed to increase the notification period, but the proposal did not receive wide support.

The Working Group had diverging opinions on whether there are benefits observed when the Start Date Sunrise Period is extended beyond 30 days after the Period starts; some Working Group members believe that there are disadvantages when it is extended beyond 30 days. Nevertheless, the Working Group generally agreed that the existing ability of Registry Operators to expand their Sunrise Periods does not create uniformity concerns that should be addressed by this PDP.

**Public Comment Review:**

While the Working Group noted that a public comment contributor suggested eliminating the less used Start Date Sunrise, which seemed to be a new perspective, the Working Group agreed that the status quo of the two types of Sunrise Periods should be kept and the recommendation be maintained “as is”.

**Sunrise Final Recommendation #4**

In the absence of wide support for a change to the status quo, the Working Group recommends that the current availability of Sunrise registrations only for identical matches should be maintained, and the matching process should not be expanded.

**Context:**

The Working Group had diverging opinions on this matter.

The Working Group members who supported the expansion of the matching criteria believed that the current exact match system is limiting. Other Working Group members opposed the expansion due to concerns including, but not limited to: 1) costs associated with the expansion, 2) potential deterrence to good-faith registration, 3) limited current usage of “expanded match” via abused labels, and 4) existing issues related to TMCH’s acceptance of non-standard character claim marks and common/dictionary words, and the broad scope of registration within the TMCH.

The Working Group ultimately concluded that the availability of Sunrise registrations only for identical matches should be maintained.

**Public Comment Review:**

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained “as is”.

**Sunrise Final Recommendation #5**

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In the absence of wide support for a change to the status quo, the Working Group does not recommend limiting the scope of Sunrise Registrations to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse.

**Context:**

The Working Group had diverging opinions on whether the scope of Sunrise Registrations should be limited to the categories of goods and services for which the trademark in question is actually registered and put in the TMCH.

On the one hand, some Working Group members supported limiting the scope of Sunrise Registrations for reasons such as the potential gaming opportunities during the Sunrise Period due to the TMCH's acceptance of non-standard character claim marks and common/dictionary words, as well as the broad scope of the TMCH.

On the other hand, some Working Group members opposed limiting the scope of Sunrise Registrations in this way for reasons including, but not limited to: 1) the uncertainty regarding the scope and extent of abuses of the Sunrise Period; 2) the potential issues/problems if such limited scope were to be implemented; and 3) Registry Operators' existing capability to limit the scope of Sunrise Registrations.

**Public Comment Review:**

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained "as is".

**Sunrise Final Recommendation #6**

In the absence of wide support for a change to the status quo, the Working Group does not recommend the creation of a challenge mechanism relating to Registry Operators' determinations of Premium and/or Reserved Names.<sup>62</sup>

**Context:**

The Working Group had diverging opinions on whether Registry Operators should be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name. The Working Group noted that Premium Names and Reserved Names are very different, and Premium Names are not clearly defined due to the multiple pricing tiers set by Registry Operators.

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<sup>62</sup> **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Reserved Name:** All registry operators are required by their Registry Agreement (RA) to exclude certain domain names from registration in a TLD. These reserved names include strings that are for Country Code Top Level Domains (ccTLDs), ICANN-related names (such as "ICANN"), IANA-related names (such as "example"), country and territory names, international and intergovernmental organizations, and names that the registry operator can use in connection with the operation of the TLD.

Some Working Group members supported the idea that ICANN org establish a uniform challenge mechanism and proposed a set of implementation guidance. Additionally, some Working Group members believed that ICANN org should require Registry Operators to create a release mechanism in the event that a Premium Name or Reserved Name is challenged successfully.

However, some Working Group members opposed establishing such a challenge mechanism for reasons including but not limited to the following: 1) the effect on restricting Registry/Registrar's name lists and pricing; 2) impact on Registry Operators' ability to operate their platforms; 3) increased workload for Registry Operators and Registrars to handle challenges; 4) unpredictable consequences such as the potential violation of applicable law/ICANN policies and security/stability concerns; and 5) gaming by trademark owners.

To address those concerns, some Working Group members attempted to refine certain elements of the proposed challenge mechanism, introduce a less formal challenge mechanism, or leverage existing mechanisms. However, there was ultimately no wide support for the creation of a challenge mechanism in any shape or form.

**Public Comment Review:**

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained "as is".

**Sunrise Final Recommendation #7**

In the absence of wide support for a change to the status quo, the Working Group does not recommend mandatory publication of the Reserved Names lists by Registry Operators.

**Context:**

The Working Group had diverging opinions on whether Registry Operators should be required to publish their Reserved Names lists.

Some Working Group members noted several possible registry concerns if Registry Operators were required to publish their Reserved Names lists, including but not limited to: 1) potential legal violations and security risks; 2) revelation of the confidential business plans of the Registry Operators; and 3) practical problems related to the publication.

Other Working Group members noted that requiring publication of the Reserved Names lists could solve a number of problems that had been raised by trademark owners and registrants.

**Public Comment Review:**

Public comments pointed out that certain Registry Operators reveal information about whether a second-level string is reserved by the Registry via a Whois lookup. However, this is not a universal practice. For those Registry Operators that do not provide such information, there is no record of the reserved second-level strings in the Whois lookup (e.g., when attempting to register a domain name that has been reserved by the Registry Operator, the registrant gets a generic message "name is not available" in the Whois lookup).

While the Working Group did not agree to a recommendation requiring all Registry Operators to reveal the information that certain second-level strings are reserved in the Whois lookup, the Working Group nevertheless agreed to highlight this voluntary option for Registry Operators to consider as a means to address the information gap experienced by registrants.

The Working Group therefore encourages trademark owners to contact the Registry Operator and/or the Registrar to enquire about the reason(s) for not being able to register certain domain names in Sunrise. Registry Operators and/or Registrars have the option to reveal whether a second-level string is reserved by the Registry, and the trademark owners have the opportunity to negotiate the release of the domain name for Sunrise registration.

### 2.4.3 Sunrise Recommendation to Modify Existing Operational Practice

#### **Sunrise Final Recommendation #8**

##### **Agreed Policy Principles:**

The Working Group agrees that the TMCH dispute resolution procedure should be the primary mechanism for challenging the validity of the Trademark Record on which a registrant based its Sunrise registration.

While the Working Group agrees that the Sunrise Dispute Resolution Policy (SDRP) allows challenges to Sunrise registrations related to Registry Operator's allocation and registration policies, it is not intended to allow challenges to Sunrise registrations on the grounds that the Trademark Record on which the registrant based its Sunrise registration is invalid.

The Working Group therefore recommends that, once informed by the TMCH Validation Provider that a Sunrise registration was based on an invalid Trademark Record (pursuant to a TMCH dispute resolution procedure), the Registry Operator must immediately suspend the domain name registration for a period of time to allow the registrant to challenge such finding using the TMCH dispute resolution procedure.

##### **Implementation Guidance:**

The Working Group suggests that the IRT consider incorporating the following requirements to amend the Applicant Guidebook (AGB) to reflect the above-noted policy principles.

1. The new version of the AGB should include the TMCH dispute resolution procedure for challenging the validity of trademark records entered into the TMCH. This procedure is currently published at: <https://www.trademark-clearinghouse.com/dispute#3.3>. ICANN org should ensure that its contract for the provision of TMCH services makes the publication and operation of the TMCH dispute resolution procedure a requirement for the TMCH Validation Service Provider.

2. Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5 of the AGB be amended to remove grounds (i) and (iii) for the SDRP.<sup>63</sup>
3. The Trademark Clearinghouse Model of Module 5 of the AGB be amended to include a new Section 6.2.6, with suggested language as follows – “The Registry Operator will, upon receipt from the TMCH of a finding that a Sunrise registration was based upon an invalid TMCH record (pursuant to a TMCH dispute resolution procedure), immediately suspend the domain name registration for a period of time to allow the registrant to challenge such finding using the TMCH dispute resolution procedure. As a point of reference, Registry Operators in their applicable SDRPs will describe the nature and purpose of the TMCH dispute resolution procedure and provide a link to the relevant resource on the TMCH Validation Provider’s site.”

Note: Registry Operators should continue to have the option to offer a broader SDRP to include optional/additional Sunrise criteria as desired.

**Context:**

The SDRP is a mechanism that a Registry Operator must provide to resolve disputes regarding its registration of Sunrise registrations.<sup>64</sup> According to the Section 6.2.2 and 6.2.4 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB), the SDRP allows challenges to Sunrise registrations related to Registry Operator’s allocation and registration policies on four non-exhaustive grounds, including on the grounds that the registered domain name does not identically match the Trademark Record on which the Sunrise-Eligible Rights Holder based its Sunrise registration.<sup>65</sup> All Registry Operators with Sunrise periods are required to develop a SDRP mechanism in accordance with Section 2.3.5 of the RPM Requirements.

Furthermore, the Working Group noted that the TMCH dispute resolution procedure was created in the time between when the AGB was written and the TMCH requirements were established. The TMCH dispute resolution procedure is used for challenging a decision of the TMCH Validation Provider that a Trademark Record was valid on the grounds that the Trademark Record has been incorrectly verified.

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<sup>63</sup> In this recommendation, some of the terms are capitalized in accordance with the terms used in the AGB. These terms include but are not limited to: “Trademark Clearinghouse Model of Module 5”, “Sunrise Registration”, “TMCH Validation Provider”, “Trademark Holder”, and “Trademark Agent”.

<sup>64</sup> Section 6.2.2 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook states the following: “Sunrise Registration Process. For a Sunrise service, sunrise eligibility requirements (SERs) will be met as a minimum requirement, verified by Clearinghouse data, and incorporate a Sunrise Dispute Resolution Policy (SDRP).” Section 6.2.4 states the following: “The proposed SDRP must allow challenges based on at least the following four grounds: (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; (ii) the domain name is not identical to the mark on which the registrant based its Sunrise registration; (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; or (iv) the trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received.” See pages 296-297 here: <https://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf>

<sup>65</sup> Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB) can be found here <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>



As a result of the creation of the TMCH dispute resolution procedure, two of the AGB requirements for Registries operating the SDRPs are moot, specifically grounds (i) and (iii) of Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5:

- (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty;
- (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty.

Due to the aforementioned grounds (i) and (iii), the current SDRP procedure allows challenges to the recordal of marks in the TMCH that underlie Sunrise registrations by engaging with the Registry Operator. However, it is the TMCH Validation Provider's role to confirm that the information submitted by a Trademark Holder or Trademark Agent (on behalf of a Trademark Holder) is accurate and that the Trademark Record meets the eligibility requirements for inclusion in the Clearinghouse. In any event, the Registry Operator is not the best-placed party to adjudicate challenges to the validity of Trademark Record in the TMCH due to the fact that the Registry Operator is reliant on trademark eligibility information provided by the TMCH.

Therefore, this recommendation seeks to eliminate the non-functional parts of the current SDRP requirements and codify the current practice in the next version of the AGB for future new gTLDs.

In addition, the Working Group had difficulty determining whether SDRPs are serving the purpose(s) for which they were created, as each TLD has its own SDRP and there is scant analysis of the SDRP decisions across all new gTLDs. Some Working Group members believe that the limited access to the TMCH and the lack of trademark information to identify whether a complaint is well-grounded makes it difficult to challenge a registration via the SDRP. The Working Group deliberated on some additional proposals that sought to address the access to the TMCH, SDRP decisions, and domain names registered during the Sunrise Period. None of these proposals received wide support.

**Public Comment Review:**

The Working Group adopted a suggestion raised in public comment to refine the recommendation and its contextual language, clarifying the distinction between the two dispute resolution procedures in question -- the TMCH dispute resolution procedure and SDRPs.

Furthermore, the Working Group adopted another suggestion raised in public comment that, instead of deleting a Sunrise registration immediately after learning that it was based on an invalid Trademark Record in the TMCH, the Registry Operator suspends the domain name for a period of time in order to provide the registrant a fair opportunity to challenge such findings, using the TMCH dispute resolution procedure.

## 2.5 Trademark Claims Final Recommendations

### 2.5.1 Trademark Claims Recommendations for New Policies or Procedures

#### **Trademark Claims Final Recommendation #1**

The Working Group recommends that the current requirement for a mandatory Claims Period should continue to be uniform for all types of gTLDs in subsequent rounds, including for the minimum initial 90-day period when a TLD opens for general registration, with the exception of those gTLDs who receive exemptions pursuant to Specification 13 .Brand TLD Provisions and Section 6 of Specification 9 Registry Operator Code of Conduct of the Registry Agreement (or their equivalents in subsequent new gTLD expansion rounds).<sup>66</sup>

#### **Context:**

The Working Group generally agreed that where the Registry Operator has not obtained an exception, the Trademark Claims period, including for the minimum initial 90-day period when a TLD opens for general registration, should continue to be uniform for all types of gTLDs in subsequent rounds.

In addition, the Working Group generally agreed that Registries should have a certain degree of flexibility, based on a suitable business model, to have the option to extend the Claims Period. The Working Group noted that Registry Operators already operate the Claims Period in varying lengths beyond the minimum initial 90-day period.

#### **Public Comment Review:**

The Working Group noted that there was wide community support for exempting dot Brand TLDs, who have Specification 13 in their Registry Agreement with ICANN org, from running the mandatory Trademark Claims Period. In addition, based on public comments received, the Working Group agreed to clarify that gTLD Registries, who receive exemption pursuant to Section 6 of Specification 9 in the Registry Agreement, are also not expected or required to run the mandatory Trademark Claims Period. Under the current policy, Specification 13/dot Brand TLDs and Specification 9-exempted TLDs are required to run the mandatory Trademark Claims Period.

Therefore, the Working Group recommends amending the existing policy to clarify that Specification 13/dot Brand TLDs and Specification 9-exempted TLDs, who do not allow third-party registrations, are exempted from running the mandatory Trademark Claims Period. While the Working Group noted that there was some community support for exempting “highly regulated” TLDs, it ultimately concluded that such TLDs should not be exempted from running the mandatory Claims Period.

#### **Trademark Claims Final Recommendation #2**

<sup>66</sup> For more information about Specification 13 and Section 6 of Specification 9, please see the footnote of Sunrise Final Recommendation #2.

The Working Group recommends that delivery of the Trademark Claims Notice be both in English as well as the language of the registration agreement. In this regard, the Working Group recommends:

- Changing the relevant language in the current Trademark Clearinghouse Rights Protection Mechanism Requirements on this topic (Section 3.3.1.2) to “...registrars **MUST** provide the Claims Notice in English and in the language of the registration agreement.”<sup>67</sup>
- The Claims Notice **MUST** include a link to a webpage on the ICANN org website which contains translations of the Claims Notice in all six UN languages.

**Context:**

The Working Group generally agreed that the current requirements regarding translations of the Claims Notice do not seem effective in informing domain name applicants of the scope and limitation of trademark holders’ rights.

The current TMCH RPM requirement (Section 3.3.1.2) states: “The Claims Notice **MUST** be provided by the registrar to the potential domain name registrant in English and **SHOULD** be provided by the registrar to the potential domain name registrant in the language of the registration agreement” (bold for emphasis).

The Working Group noted that some Registrars do not translate the Claims into all of the languages that they use when conducting business with new gTLD registrants. As the Working Group agreed that the Claims Notice has inadequacies and shortcomings in the English language in which it was initially drafted, it follows that the notice is unlikely to be more comprehensible among recipients who do not speak English or are not native speakers.

**Public Comment Review:**

The Working Group adopted a suggestion raised in public comment and replaced “should” with “must” in the second bullet point in its final recommendation text.

## 2.5.2 Trademark Claims Recommendations to Maintain Status Quo

**Trademark Claims Final Recommendation #3**

The Working Group recommends, in general, that the current requirement for a mandatory Claims Period, including the minimum initial 90-day period when a TLD opens for general registration, be maintained.

The Working Group further recommends that if a Registry Operator offers a Limited Registration Period, the Registry Operator must maintain the current requirement pursuant to RPM Requirements Section 3.2.5 and provide the Claims Services during the entire Limited

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<sup>67</sup> See the Trademark Clearinghouse Rights Protection Mechanism Requirements here:  
<http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

Registration Period in addition to the minimum initial 90-day Claims Period when the TLD opens for general registration.<sup>68</sup>

**Context:**

The Working Group generally agreed that where there is a Claims period, it should be mandatory. The Working Group also generally agreed that the mandatory Claims period should be neither extended nor shortened. The Working Group noted that many trademark and brand owners are in favor of extending the Claims Period, while many other stakeholders (e.g., Registries, Registrars, and non-trademark owner registrants) are opposed to any extension and in favor of shortening the Claims Period. The Working Group ultimately came to an agreement to maintain the status quo of the minimum initial 90-day Claims period when a TLD opens for general registration.

In addition, the Working Group generally agreed that Registries should have a certain degree of flexibility, based on a suitable business model, to have the option to extend the Claims Period, provided this does not involve shortening the Claims Period. The Working Group noted that Registry Operators already operate their Claims Period in varying lengths beyond the minimum initial 90-day period.

**Public Comment Review:**

The Working Group adopted a suggestion raised in public comment to expressly refer to the RPM Requirements Section 3.2.5 and confirm in the recommendation language that where a Registry Operator offers a Limited Registration Period after Sunrise and prior to General Availability (GA), Trademark Claims Period must operate throughout, in addition to the first 90 days of GA.

**Trademark Claims Final Recommendation #4**

In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.

**Context:**

The Working Group had diverging opinions on whether:

- The exact match requirement is serving the intended purposes of the Trademark Claims service;
- There is evidence of harm under the existing system of exact match;
- The matching criteria for the Claims Notice should be expanded.

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<sup>68</sup> RPM Requirements Section 3.2.5 states: "If Registry Operator offers a Limited Registration Period, Registry Operator MUST provide the Claims Services during the entire Limited Registration Period in addition to the standard Claims Period. For the avoidance of doubt, the first ninety (90) calendar days of General Registration must employ the Claims Services, regardless of any other registration period prior to the start of General Registration." See p.10 here: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-14may14-en.pdf>

The Working Group deliberation note in a Google Doc (see footnote) provides details of these discussions.<sup>69</sup>

The Working Group believes that the exact match criteria strike the appropriate balance of deterring bad-faith registrations without clear evidence that good-faith domain name applications are substantially deterred. The Working Group agreed that the balance can be enhanced by a well-crafted Claims Notice that appropriately notifies prospective registrants about a potential problem with their chosen domain name, employs clear/concise/informative language, and avoids a potential overflow of false positives. Therefore, instead of proposing any changes to the matching criteria for the Claims Notice, the Working Group proposed Trademark Claims Final Recommendation #6.

**Public Comment Review:**

The Working Group agreed that public comments did not raise any new or material perspectives, facts, or solutions. The Working Group also agreed that there was no widespread or substantial opposition to this recommendation. Therefore, the Working Group agreed that the recommendation should be maintained “as is”.

### 2.5.3 Trademark Claims Recommendations to Modify Existing Operational Practice

**Trademark Claims Final Recommendation #5**

The Working Group recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained.

**Implementation Guidance:**

The Working Group agrees that the IRT needs to recognize that there may be operational issues with presenting the Claims Notice to registrants who pre-registered domain names, due to the current 48-hour expiration period of the Claims Notice.

For clarity, the Working Group notes that this recommendation is not intended to preclude or restrict Registrars’ legitimate business practice of pre-registration, provided this is compliant with the Trademark Claims service requirements.

The Working Group requests that the IRT uses appropriate flexibility and consider ways in which ICANN org can work with Registrars to address all relevant implementation issues (e.g., possibly alter the 48-hour expiration period of the Claims Notice as the IRT deems appropriate), but which will continue to allow legitimate pre-registration programs compliant with RPM requirements to continue.

**Context:**

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<sup>69</sup> See the Google Doc here:

[https://docs.google.com/document/d/10quBC1BnuIM\\_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing](https://docs.google.com/document/d/10quBC1BnuIM_wOyEXH7TttNWEOrDTiPNscgSBd7QFXg/edit?usp=sharing)

The Working Group generally agreed that when there is a Claims Period and the issuance of a Claims Notice is required, the Claims Notice should be sent to potential registrants, who are attempting to register domain names that are exact matches to entries in the TMCH, at some point before the domain name registration is completed.

The Working Group noted challenges reported by some Registrars regarding sending the Claims Notice for pre-ordered names, due to the current 48-hour expiration period of the Claims Notice. Therefore, the Working Group has developed this recommendation to assist the future IRT in considering ways to address this issue.

**Public Comment Review:**

The Working Group agreed with a point raised in public comment that if a Registrar cannot present the Claims Notice before a registration is completed in its pre-registration program, the Registrar is not in compliance with the Trademark Claims service requirement. While noting this operational issue, the Working Group agreed on the need to clarify that its recommendations and guidance do not attempt to prohibit the legitimate practice of pre-registration, as long as it is compliant with RPM requirements.

The Working Group also agreed that the IRT should have flexibility/latitude to facilitate solutions to all relevant implementation issues related to pre-registration. For example, the Working Group agreed that it is the IRT's role to decide whether the 48-hour expiration period of the Claims Notice should or should not be changed.

**Trademark Claims Final Recommendation #6**

The Working Group recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined below. This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing the risk of unintended effects or consequences of deterring good-faith domain name applications.

The Working Group agrees that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal consequences or describing what actions potential registrants may be able to take, following receipt of a notice).

**Implementation Guidance:**

To assist the IRT that will be formed to implement recommendations adopted by the Board from this PDP in redrafting the Claims Notice, the Working Group has developed the following Implementation Guidance:

- The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law;
- The current version of the Claims Notice should be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications;

- The Working Group advises that the IRT use appropriate flexibility and consider whether it believes it will be helpful to solicit input from resources internal and/or external to the ICANN community as the IRT deems necessary and appropriate. Suggested external resources could include academic and industry sources such as the American University Intellectual Property Clinic, INTA Internet Committee, the Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN. The IRT may also, in its discretion, consider input from communications experts, who can help review the Claims Notice for readability purposes and ensure it is understandable to the general public.

**Context:**

The Working Group discussed whether the Trademark Claims service is at least possibly having its intended effect, and generally agreed that the service may possibly have unintended consequences, such as deterring good-faith domain name applications. However, the Working Group could not determine the extent of such deterrence that occurred, if any.

The Working Group generally agreed that, overall, the Claims Notice meets its intended purpose of notifying prospective domain name registrants that the applied-for domain name matches at least one trademark in the Trademark Clearinghouse. However, the Working Group also recognized the shortcomings of the Claims Notice.

The Working Group generally agreed that for some actual and potential registrants, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. Some Working Group members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks).

**Public Comment Review:**

Based on public comments received, the Working Group refined this recommendation to ensure that it accurately reflects the Working Group's deliberations on the intended effect and unintended consequences of the Trademark Claims service.

Furthermore, the Working Group agreed that the IRT should have flexibility/latitude to decide whether it wishes to consult any resources for the revision of the Claims Notice language and if so, from which resources it wishes to solicit input. In this regard, the Working Group adopted a suggestion raised in public comment and revised its recommendation to make it less prescriptive. The Working Group also agreed to include a mention of communications experts, as suggested in public comment, as a potential resource for consideration by the IRT.

## 2.6 Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Final Recommendation

### 2.6.1 TM-PDDRP Recommendation for New Policies or Procedures

**TM-PDDRP Final Recommendation**

The Working Group recommends that Rule 3(g) of the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP) Rules be modified, to provide expressly that multiple disputes filed by unrelated entities against a Registry Operator may be initially submitted as a joint Complaint, or may, at the discretion of the Panel, be consolidated upon request.<sup>70</sup>

This recommendation is intended to clarify the fact that the TM-PDDRP permits the joint filing of a Complaint and the consolidation of Complaints by several trademark owners, even if these are unrelated entities, against a Registry Operator in the case where: (a) that Registry Operator has engaged in conduct that has affected the Complainants' rights in a similar fashion; and (b) it will be equitable and procedurally efficient to permit the consolidation.

To the extent that a TM-PDDRP Provider's current Supplemental Rules may not permit the filing of a joint Complaint or the consolidation of several Complaints, the Working Group further recommends that those Providers amend their Supplemental Rules accordingly.<sup>71</sup>

For the avoidance of doubt, the Working Group notes that:

1. The filing of a joint Complaint or consolidation is to be permitted only where: (i) the Complaints relate to the same conduct by the Registry Operator, at the top or the second level of the same gTLD for all Complaints; and (ii) all the trademark owners have satisfied the Threshold Review criteria specified in Article 9 of the TM-PDDRP;<sup>72</sup> and
2. This recommendation is intended to apply to two distinct situations: one where several trademark owners join together to file a single Complaint, and the other where several trademark owners each file a separate Complaint but request that these be consolidated into a single Complaint after filing.

**Context:**

This recommendation specifically concerns a proposed amendment to the TM-PDDRP Rule 3(g), and a reference to Article 9 of the TM-PDDRP:

- **TM-PDDRP Rule 3(g):** If a PDDRP Complaint is filed against a Registry Operator against whom another PDDRP is active, the parties to both disputes may agree to consolidate. See the Provider's Supplemental Rules regarding consolidation.
- **TM-PDDRP Article 9.1:** Provider shall establish a Threshold Review Panel, consisting of one panelist selected by the Provider, for each proceeding within five (5) business days

<sup>70</sup> Including those under common control, see definition at **TM-PDDRP Article 6**: "For purposes of these standards, "registry operator" shall include entities directly or indirectly controlling, controlled by or under common control with a registry operator, whether by ownership or control of voting securities, by contract or otherwise where 'control' means the possession, directly or indirectly, of the power to direct or cause the direction of the management and policies of an entity, whether by ownership or control of voting securities, by contract or otherwise." More details of the TM-PDDRP can be found here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

<sup>71</sup> The Supplemental Rules of the three TM-PDDRP Providers can be found here - ADNDRC: [https://www.adndrc.org/mten/img/pdf/Supplemental\\_Rules\\_TMPDDRP\\_10-03-2014.pdf](https://www.adndrc.org/mten/img/pdf/Supplemental_Rules_TMPDDRP_10-03-2014.pdf); FORUM: <https://www.adrforum.com/assets/resources/gTLD/Supplemental%20Rules-PDDRP.pdf>; and World Intellectual Property Organization (WIPO): <https://www.wipo.int/export/sites/www/amc/en/docs/supplrulestmpddrp.pdf>

<sup>72</sup> See the Threshold Review criteria in Article 9 of TM-PDDRP on pp.5-6 here: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>



after completion of Administrative Review and the Complaint has been deemed compliant with procedural rules.<sup>73</sup>

The TM-PDDRP was designed to allow a trademark owner to file a complaint against a Registry Operator over certain forms of behavior claiming that one or more of its marks have been infringed, and thereby the Complainant has been harmed, by the Registry Operator's manner of operation or use of the gTLD.

At the top level of the gTLD, the requisite conduct by the Registry Operator must cause or materially contribute to either 1) taking unfair advantage of the distinctive character or the reputation of the Complainant's mark, 2) impairing the distinctive character or the reputation of the Complainant's mark, or 3) creating a likelihood of confusion with the Complainant's mark.

At the second level of the gTLD, the affirmative conduct by the Registry Operator must constitute a substantial pattern or practice of specific bad faith intent by the Registry Operator to profit from: (i) the sale of trademark infringing domain names; and (ii) the systematic registration of domain names in that gTLD that either 1) takes unfair advantage of the distinctive character or the reputation of the Complainant's mark, 2) impairs the distinctive character or the reputation of the Complainant's mark, or 3) creates a likelihood of confusion with the Complainant's mark.

Rule 3(g) of the TM-PDDRP Rules specifically allows for the consolidation of Complaints where, during an ongoing TM-PDDRP proceeding, a second Complaint is filed against the same Registry Operator. The Working Group's recommendation, if approved, will clarify that joint Complaints filed in one single Complaint at first instance, or multiple Complaints by several trademark owners against the same Registry Operator are permitted to be consolidated, even when the Complainants are unrelated entities.<sup>74</sup> However, the Complaints to be submitted jointly/consolidated must relate to conduct by that Registry Operator that affects all the Complainants similarly, and at the same level (i.e. top or second) of the gTLD, and must all have successfully passed the Threshold Review required under the procedure.

At the time the Working Group reviewed TM-PDDRP, and at the time of publication of this Phase 1 Final Report, no Complaints had been brought under the procedure. Although the Working Group discussed a number of possible reasons why the procedure had not been used, as well as possible modifications to the criteria (e.g. whether a standard of willful blindness could be justified based on any observable conduct), it concluded that there was no evidence to clearly demonstrate a single or primary reason. It also concluded that, at this stage, there was insufficient agreement to make substantive changes to the TM-PDDRP.

#### **Public Comment Review:**

While the Working Group noted concerns raised in public comment that this recommendation may impose additional costs and resource burden on Providers, the Working Group agreed that

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<sup>73</sup> Please see the complete text of Article 9 of TM-PDDRP on pp.5-6 here:

<http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

<sup>74</sup> WIPO, one of the dispute resolution providers that administer the TM-PDDRP, submitted a possible mark-up of the Rules that can be used as a starting point for the IRT that will be convened if this recommendation is approved. See details here: <http://www.wipo.int/export/sites/www/amc/en/docs/icann130309.pdf>

such concerns may be misplaced -- as the TM-PDDRP is an expensive process, the consolidation of multiple disputes against the same Registry Operator may provide efficiency and other benefits to counterbalance or outweigh the burden/cost for Providers.<sup>75</sup>

The Working Group agreed that public comments have not raised any new or material perspectives, facts, or solutions. The Working Group also noted this recommendation did not receive any opposition from public comments. Therefore, the Working Group agreed that the recommendation be maintained “as is”.

## 2.6.2 TM-PDDRP Recommendations to Maintain Status Quo

None

## 2.6.3 TM-PDDRP Recommendations to Modify Existing Operational Practice

None

## 2.7 Overarching Data Collection Final Recommendation

### **Overarching Data Collection Final Recommendation**

In relation to the TMCH, the Working Group recommends that, for future new gTLD rounds, ICANN Org collect the following data on at least an annual basis (to the extent it does not do so already) 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;<sup>76</sup>
- 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.

In relation to the Trademark Claims service, the Working Group recommends that, for future new gTLD rounds, ICANN-accredited registrars must provide ICANN Org with periodic reports

<sup>75</sup> The Working Group noted that consolidated complaints against the same Registry Operator may be covered in Providers' supplemental rules to the extent that it may involve additional time and/or fees for TM-PDDRP Providers.

<sup>76</sup> The term “abused label” refers to those labels associated with a verified trademark record in the TMCH that a trademark owner may register, where the domain was the subject of a determination in a prior UDRP case or court decision in which the rights holder prevailed. A trademark owner may register up to 50 such labels. The TMCH Validator examines UDRP Providers' database information and court case documentation to ensure each label submitted meets this criterion: see <https://newgtlds.icann.org/en/announcements-and-media/announcement-11oct13-en>

of the number of Claims Notices that were sent out to prospective registrants not less than every 12 months.

In relation to the URS, the Working Group recommends that 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.

The Working Group further recommends that, in implementing Board-adopted recommendations from the 2018 Final Report of the Competition, Consumer Choice & Consumer Trust Review Team, ICANN org also collect data concerning trademark owners' and registrants' experience with the RPMs that can be provided to future GNSO RPM policy review teams (including result of studies that ICANN org may conduct pursuant to Recommendations #26, if approved by the ICANN Board, and #28).<sup>77</sup>

**Context:**

Early on in its work, the RPM Working Group agreed that a thorough and meaningful review of all the Phase 1 RPMs required access to historical data as well as regularly updated future data. Although ICANN org was able to provide the Working Group with data relating to the RPMs (e.g. lists of delegated gTLDs and the respective dates of each Sunrise and Trademark Claims period, monthly registry reports) and the Working Group also requested and received data relating to the TMCH from Deloitte (e.g. number of validated trademark records and total submissions) as well as from the Analysis Group which conducted an Independent Review of the TMCH, the Working Group encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the RPMs.

The Working Group acknowledged that there are practical difficulties associated with obtaining specific data concerning a possible deterrent effect on potential good faith registrants who receive a Trademark Claims Notice. The Working Group also understands that knowing the number of Claims Notices sent to prospective registrants that were not followed by actual domain registrations is not evidence of a deterrent effect. Nevertheless, the Working Group believes that it will be useful if future RPM review teams are provided with data concerning the number of such notices that are actually sent by registrars.

The Working Group also found that data was not necessarily available in uniform formats (e.g. URS Determinations) and that, to date, except for an ICANN org review of the RPMs in 2015 there have not been any studies done on the RPMs that involved significant data collection and

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<sup>77</sup> **CCT Review Team's Final Report:** <https://www.icann.org/en/system/files/files/cct-final-08sep18-en.pdf>

**CCT Recommendation #26:** "A study to ascertain the impact of the New gTLD Program on the costs required to protect trademarks in the expanded DNS space should be repeated at regular intervals to see the evolution over time of those costs. The CCT Review Team recommends that the next study be completed within 18 months after issuance of the CCT Final Report, and that subsequent studies be repeated every 18 to 24 months". As of September 2020, this recommendation remains in pending status, i.e. it has not yet been approved by the ICANN Board.

**CCT Recommendation #28:** "A cost-benefit analysis and review of the Trademark Clearinghouse (TMCH) and its scope should be carried out to provide quantifiable information on the costs and benefits associated with the present state of the TMCH services and thus to allow for an effective policy review".

analysis. The Working Group's analysis of the URS was largely informed by initial data work undertaken by ICANN org staff and additional detailed research by a Working Group member.

The dearth of data was also noted by the CCT Review Team, which developed a number of final recommendations aimed at addressing this gap. In relation to RPMs, the Working Group believes that future RPM reviews will greatly benefit if the relevant surveys and studies to be undertaken include relevant questions about the RPMs for which useful data can be collected and analyzed.

## 3 Additional Marketplace Rights Protection Mechanisms

### 3.1 Deliberations of Additional Marketplace RPMs

In addition to the ICANN-mandated RPMs (i.e. Sunrise and Trademark Claims services offered through the TMCH, the Uniform Rapid Suspension System and the Trademark Post-Delegation Dispute Resolution Procedure), the Working Group discussed a number of additional rights protection mechanisms that several Registry Operators and the TMCH Validation Service Provider had voluntarily adopted, separate from and in addition to ICANN's requirements.<sup>78</sup>

The Working Group's purpose in looking at these additional marketplace RPMs was not to conduct a policy review, which would have been outside the scope of this PDP. Rather, the Working Group sought to understand the nature and mechanics of these additional mechanisms, as its Charter mandated that the Working Group consider the interplay between the mandatory RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency. This necessarily required the working group to have an appreciation of the wider RPM landscape.

In May 2017, in preparation for the Working Group's discussions about the additional marketplace RPMs, the Working Group Co-Chairs prepared an initial set of questions that were further refined by an Additional Marketplace RPMs Sub Team. The Sub Team's final set of proposed questions were submitted to the full Working Group in September 2017.<sup>79</sup>

Following the GNSO Council's approval of a funding request for professional surveys to be conducted on the Sunrise and Trademark Claims services, the Working Group set up a new RPM Data Sub Team to conduct preparatory work for those surveys. The RPM Data Sub Team reviewed the discussions about the additional marketplace RPMs and used relevant information derived from them to formulate guidance for Analysis Group, who had been contracted to conduct the Sunrise and Trademark Claims surveys in 2018.

Furthermore, following its analysis of public comments received on its Initial Report, the Working Group considered the following question related to the additional marketplace RPMs: "How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?" In reviewing the public comment, the Working Group agreed that it did not collect sufficient data to develop a meaningful answer

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<sup>78</sup> At the time of the Working Group's discussions, these additional marketplace RPMs were offered by the Registry Operator Donuts (which acquired another Registry Operator, Rightside, and took over Rightside's additional RPMs) and Deloitte, the TMCH Validation Service Provider (which was offering its own service as well as the additional RPMs developed by Minds & Machines, a Registry Operator).

<sup>79</sup> See the final set of proposed questions for Additional Marketplace RPMs here:

[https://community.icann.org/download/attachments/69283988/CLEAN\\_Draft\\_Final\\_Additional\\_Marketplace\\_RPM\\_Questions\\_-\\_15\\_September\\_2017.pdf?version=1&modificationDate=1505764402000&api=v2](https://community.icann.org/download/attachments/69283988/CLEAN_Draft_Final_Additional_Marketplace_RPM_Questions_-_15_September_2017.pdf?version=1&modificationDate=1505764402000&api=v2)

to that question. While the Working Group noted that several commenters expressed the desire for the Globally Protected Mark List (GPML) as an additional measure, it agreed not to develop any recommendation with regard to additional mandatory RPMs equivalent to GPML.<sup>80</sup>

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<sup>80</sup> See Rows #31-32 related to the GPML comments in the public comment review tool here:  
<https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhvIOskAILVraWp-88mqzScCti01fw/edit#gid=1227219396>

## 4 Next Steps

### 4.1 Next Steps

This Final Report will be submitted to the GNSO Council for its consideration and potential approval. If approved by the GNSO Council, the Final Report will then be forwarded to the ICANN Board of Directors for its consideration and potential action in accordance with the ICANN Bylaws.

## 5 Background

### 5.1 Issue Background

#### 5.1.1 Issue Overview

The question of who legally has rights to, or is the legitimate holder of, a domain name can be open to dispute. Since the Internet is a global resource and domain name holders are dispersed among numerous different jurisdictions, finding an effective, enforceable, and reliable process to resolve rights disputes across various jurisdictions is not an easy undertaking.

Over time, ICANN has developed a number of dispute resolution policies and procedures that attempt to address this issue and provide enforceable remedies for certain types of disputes concerning domain name registrations. These policies are essentially alternative dispute resolution procedures to court litigation that nevertheless do not preclude the initiation of legal proceedings in the appropriate jurisdiction.

In relation to domain name disputes concerning the registration and use of legally protected trademarks, the Uniform Dispute Resolution Policy (UDRP) is the longest standing alternative dispute resolution procedure.<sup>81</sup> In general, community feedback to date indicates that many believe the UDRP to be an effective and expedient alternative to more time consuming and expensive court litigation, and that the UDRP is viewed as reliable, predictable, and consistent. The effectiveness of the UDRP with regard to disputes in the global DNS has meant that court resolutions of such disputes are rarely sought.<sup>82</sup>

As a result of the 2012 New gTLD Program, several new rights protection mechanisms (RPMs) were also 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. These new mechanisms were developed in the course of implementation of the New gTLD Program. They are the Uniform Rapid Suspension System (URS), the Trademark Clearinghouse (TMCH) and the associated availability through the TMCH of Sunrise and the Trademark Claims Services, and the Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP).<sup>83</sup>

Where the UDRP and URS cover trademark-related disputes arising over an actual domain name that has been registered in the second level of a gTLD (i.e. they are so-called “curative”

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<sup>81</sup> For a complete background overview on the development of the UDRP, see UDRP Report, pp.7-9:

<https://www.icann.org/resources/pages/prelim-report-udrp-2011-05-27-en>

<sup>82</sup> The responses to the UDRP Questionnaire that was distributed to the UDRP service providers as part of feedback to the UDRP Report indicate that, to the providers’ knowledge, very few UDRP decisions are appealed to a court (e.g. one case, or 0.1% from the Asian Domain Name Dispute Resolution Centre, “fewer than five” per year from the NAF, and none from the Czech Arbitration Court). It should be noted, however, that providers may not receive notice of all appeals or challenges in court: see UDRP Report, p. 14 footnote 23.

<sup>83</sup> For a complete background overview on the development of these rights protection mechanisms, see the RPM Staff Paper, pp.15-19: <https://www.icann.org/publiccomments/rpm-review-2015-02-02-en>



mechanisms), the TMCH and the services provided using TMCH-verified data such as Sunrise and Trademark Claims are intended to facilitate trademark owners' ability to prevent registration of domain names matching their marks (i.e. these are so-called "preventative" mechanisms).

Prior to the launch of the New gTLD Program, on 3 October 2011 ICANN staff had published a Final Issue Report on the current state of the UDRP.<sup>84</sup> The recommended course of action in that UDRP Report was not to initiate a Policy Development Process (PDP) at the time, but to hold off launching any such PDP until after the new URS had been in operation for at least eighteen (18) months.

Subsequently, on 15 December 2011, the GNSO Council requested that ICANN staff prepare and publish a new Issue Report on the state of all rights protection mechanisms implemented for both existing and new gTLDs, including but not limited to the UDRP and URS.<sup>85</sup> As a result of that GNSO Council request, the Final Issue Report on a PDP to Review All RPMs in All gTLDs was published on 11 January 2016.<sup>86</sup>

### 5.1.2 Trademark Clearinghouse (TMCH) Background

The TMCH is a global database of verified trademark information intended to support other rights protection processes such as Sunrise registrations and the Trademark Claims service. It opened for submission of trademark records in March 2013.

Benefits of recording a trademark with the Clearinghouse include access to Sunrise registration with new gTLD registries. This involves an initial period of at least thirty (30) days before domain names are offered to the general public.

The Clearinghouse also supports a Trademark Claims service that runs for at least the first ninety (90) days of general registration. During this period, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. If the notified party nevertheless goes ahead and registers the domain name, the TMCH will send a notice to those trademark holders with matching records in the Clearinghouse, informing them that someone has registered the domain name.

The TMCH currently accepts and verifies information on the following types of intellectual property rights: (i) nationally or regionally registered trademarks; (ii) court-validated marks; and (iii) marks protected by statute or treaty (such as geographical indications or designations of origin).<sup>87</sup>

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<sup>84</sup> Download the report here: [https://gns0.icann.org/sites/default/files/filefield\\_27051/udrp-final-issue-report-03oct11-en.pdf](https://gns0.icann.org/sites/default/files/filefield_27051/udrp-final-issue-report-03oct11-en.pdf)

<sup>85</sup> See the GNSO Council resolution related to the request here: <https://gns0.icann.org/en/council/resolutions#201112>

<sup>86</sup> Download the report here: [https://gns0.icann.org/sites/default/files/filefield\\_48411/rpm-final-issue-11jan16-en.pdf](https://gns0.icann.org/sites/default/files/filefield_48411/rpm-final-issue-11jan16-en.pdf)

<sup>87</sup> See generally the RPM Staff Paper, Section 3. For the actual TMCH guidelines see [http://trademarkclearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2\\_0.pdf](http://trademarkclearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf)

Learn More: <https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf>

### 5.1.3 Sunrise Service Background

The verified data in the TMCH is used to support Sunrise services, which allow trademark holders an early opportunity to register domain names corresponding to their marks before domain names are made generally available to the public.

The RPM Staff Paper explains that New gTLD registries are required to offer a Sunrise period of at least 30 days. This can occur in line with one of two options:<sup>88</sup>

- (i) In the case of a Start-Date Sunrise, the Registry Operator must provide the service for a minimum of thirty (30) calendar days prior to General Registration and must provide thirty (30) calendar days' notice prior to the start of the Sunrise period.
- (ii) In the case of an End-Date Sunrise, the Registry has no advance notice requirement; however, the Registry Operator must provide the service for a minimum of sixty (60) calendar days prior to General Registration, and must not use a time-based allocation method (e.g., first come, first served).

The majority of registries who have launched to date have offered an End-Date Sunrise.<sup>89</sup>

New gTLD Registry Operators are also obliged to maintain a Sunrise Dispute Resolution Policy (SDRP), which allows for challenges to Sunrise registrations related to the Registry Operator's allocation and registration policies, including on the grounds that the domain name that was registered does not match the trademark record on which the Sunrise-eligible rights holder based its Sunrise registration.

### 5.1.4 Trademark Claims Service Background

The Trademark Claims period follows the Sunrise period and runs for at least the first ninety (90) days of general registration in which domain names are made available to all registrants who are able to register domain names within the particular gTLD.

During the Trademark Claims period for a gTLD, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information. "The Claims Notice is intended to provide clear notice to the prospective domain name registrant of the scope of the Trademark Holder's rights."<sup>90</sup> Should the notified

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<sup>88</sup> In February 2015, ICANN staff published a draft Rights Protection Mechanisms Review report to solicit community feedback. This report was not a comprehensive review; rather, it was based primarily on community feedback and a small set of sources, including specific topic studies, obligatory reports from Contracted Parties or contractors hired for specific projects, and community comments. See additional details in the "Related Work by the GNSO, the ICANN Community, and the ICANN org" sub section in this section of the Initial Report.

<sup>89</sup> RPM Staff Paper, p.54.

<sup>90</sup> RPM Staff Paper, p.75.

party nevertheless proceed to register that domain name, the relevant trademark holder with a matching record in the TMCH is then notified of the registration.

Learn More: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

### 5.1.5 Uniform Rapid Suspension System (URS) Background

The URS was designed as a complement to the UDRP, and is intended to provide trademark owners with a quick and low-cost process to act against those infringing on their intellectual property rights and to combat cybersquatting.<sup>91</sup> In this respect, the substantive grounds upon which a trademark holder would file a Complaint under the URS are essentially similar to those under the UDRP.<sup>92</sup>

Much like the UDRP, trademark holders may initiate a URS proceeding by electronically filing a Complaint with a URS Provider.<sup>93</sup> The fees associated with a URS proceeding range from USD300-500. Procedurally, once a trademark holder files a URS Complaint, the Registry Operator immediately locks the domain against changes. The Provider then notifies the registrant against whom the Complaint has been filed, who has fourteen (14) days to submit a response.

The remedy for a successful URS Complaint is the suspension of the domain name for the balance of the registration period, with the Complainant's option to extend that period for one additional year.<sup>94</sup>

In addition to the differing remedies available to a successful Complainant under the UDRP (i.e. cancellation or transfer of the domain name) and the URS (i.e. suspension of the domain name), another area where the URS differs substantially from the UDRP is that of the standard of proof required to succeed on a claim. Where under the UDRP the Complainant must prove his/her case through a preponderance of the evidence, under the URS there must be clear and convincing evidence. The reason for this is that, as a complement to rather than a substitute for the UDRP, the URS was expressly designed to apply only to clear-cut cases.

Learn More:

- URS Rules: <https://newgtlds.icann.org/en/applicants/urs/rules-28jun13-en.pdf>

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<sup>91</sup> The UDRP was created in 1999 to resolve disputes concerning disputes over entitlement to domain names registered at the second level of the DNS. It is an ICANN Consensus Policy that is applicable to all gTLDs, including those launching under the New gTLD Program. The universal and uniform operation of the UDRP is based on two documents: 1) the Policy that sets out its scope, relief, and basis for mandatory administrative proceedings that may be brought within its ambit; and 2) the Rules that set out the procedural requirements that must be followed in such a proceeding. For additional details, see the RPM PDP Final Issue Report, p11: [https://gnso.icann.org/sites/default/files/filefield\\_48411/rpm-final-issue-11jan16-en.pdf](https://gnso.icann.org/sites/default/files/filefield_48411/rpm-final-issue-11jan16-en.pdf)

<sup>92</sup> For a side-by-side comparison of the URS and the UDRP, see RPM Staff Paper, p.92-99.

<sup>93</sup> Currently there are three URS Providers: ADNDRC, FORUM, and MFSD.

<sup>94</sup> See, generally, RPM Staff Paper, pp.90 et seq. For more details, see the URS provisions: <http://newgtlds.icann.org/en/applicants/urs>

- URS Procedure: <https://newgtlds.icann.org/en/applicants/urs/procedure-01mar13-en.pdf>

### 5.1.6 Trademark Post-Delegation Dispute Resolution Procedures (TM-PDDRP) Background

Three new dispute resolution procedures were developed for the 2012 New gTLD Program: the Registration Restrictions Dispute Resolution Procedure (RRDRP), the Public Interest Commitments Dispute Resolution Procedure (PIC-DRP), and the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP). Unlike the UDRP and URS, these are dispute resolution processes that address a new gTLD Registry Operator's conduct rather than alleged bad faith registration of a second level domain name by a registrant.

Of the current three PDDRPs, only the TM-PDDRP is intended to address trademark-related issues in the registry; the RRDRP and the PIC-DRP were not specifically designed as RPMs for the same purpose, although they can serve this function in certain limited circumstances.<sup>95</sup>

The TM-PDDRP generally addresses a Registry Operator's complicity in trademark infringement on the first or second level of a New gTLD. At least 30 days prior to filing a formal Complaint, a rights holder must notify the Registry of the alleged infringing conduct and express a willingness to meet to resolve the issue.

Learn More:

- TM-PDDRP Rules: <http://newgtlds.icann.org/en/applicants/agb/pddrp-rules-15oct13-en.pdf>
- TM-PDDRP Procedure: <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>

### 5.1.7 Additional Marketplace Rights Protection Mechanisms Background

In addition to the RPMs that ICANN mandated in the course of the development of the Applicant Guidebook for the 2012 New gTLD Program, several Registry Operators and the TMCH Validation Service Provider voluntarily adopted additional RPMs for those gTLDs they managed or provided services for, that collectively extend the scope of trademark rights protection beyond ICANN's mandatory RPMs. The Working Group agreed to use the phrase "additional marketplace RPMs" to describe these mechanisms.

Some examples of the additional marketplace RPMs include:

- **Protected Marks Lists:** This protection mechanism was first launched by Registry Operator Donuts Inc. It allows trademark holders, as confirmed by the TMCH Database, to block registrations for strings consisting of or containing their brand name or trademark across of the Registry Operator's gTLDs.<sup>96</sup>

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<sup>95</sup> RPM Staff Paper, p.111-112.

<sup>96</sup> For example, see: <http://www.donuts.co/dpml/dpml-overview/>

- **Perpetual Block:** This mechanism allows a registered trademark holder to block any attempts to register a trademarked domain within a particular TLD by making a one-time payment. For example, ICM Registry provides a perpetual blocking option in its .xxx domain space.<sup>97</sup>

## 5.2 Process Background

### 5.2.1 Process Overview

On 18 February 2016, the GNSO Council initiated the PDP on the Review of All RPMs in All gTLDs.<sup>98</sup> On 15 March 2016, the GNSO Council chartered the PDP Working Group to conduct a review of all Rights Protection Mechanisms (RPMs) in all gTLDs in two phases.<sup>99</sup> Phase 1 focuses on reviewing all the RPMs applicable to gTLDs launched under the 2012 New gTLD Program. Phase 2 will focus on reviewing the Uniform Dispute Resolution Policy (UDRP), which has been an ICANN Consensus Policy since 1999. On 21 April 2016, the Working Group held its first meeting to commence its Phase 1 work and has been meeting regularly since that time.

The Working Group's Charter, as approved by the GNSO Council, maps out the deliverables expected in each phase of work and notes the need for the Working Group to track and if appropriate, coordinate its work with other relevant efforts underway (e.g. the Competition, Consumer Trust & Consumer Choice (CCT) Review Team and the GNSO's New gTLD Subsequent Procedures PDP).

In addition, the Charter contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This led to the Working Group agreeing, early on in its work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral.

Finally, the Charter also includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. These overarching Charter questions are described in the "Next Steps" section of this Final Report.

### 5.2.2 Process Milestones

- On 11 January 2016, ICANN organization (ICANN org) published the Final Issue Report on Policy Development Process to Review All Rights Protection Mechanisms (RPMs) in All Generic Top-Level Domains. In the Final Issue Report, ICANN org recommended that the GNSO Council commence a policy development process (PDP) to conduct the policy review

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<sup>97</sup> <https://adultblock.icmregistry.com/>

<sup>98</sup> See the approved GNSO Council motion initiating the PDP here:  
<https://gns0.icann.org/en/council/resolutions#201602>

<sup>99</sup> See the approved GNSO Council motion chartering the PDP Working Group here:  
<https://gns0.icann.org/en/council/resolutions#201603>

of all the RPMs in two phases -- Phase 1 being a review of the RPMs developed for the New gTLD Program and Phase 2 of work a review of the UDRP.

- On 18 February 2016, the GNSO Council initiated the PDP.
- On 15 March 2016, the GNSO Council approved the Charter for the Working Group.
- On 21 March 2016, a Call for Volunteers for the Working Group was issued.
- On 21 April 2016, the Working Group held its first meeting, with Philip Corwin, the initial GNSO Council liaison, acting as the interim Working Group Chair.
- On 24 May 2016, the GNSO Council confirmed the appointment of Kathy Kleiman, Philip Corwin, and J. Scott Evans<sup>100</sup> as Working Group Co-Chairs, and confirmed the appointment of Paul McGrady as the GNSO Council Liaison to the PDP Working Group.
- On 28 May 2016, the Working Group sent outreach letters to solicit early input from each GNSO Stakeholder Group and Constituency and other Supporting Organizations and Advisory Committees.
- In November 2016, the Working Group completed its review of the TM-PDDRP.
- On 6 April 2018, the Working Group completed its initial review of the additional marketplace RPMs.
- On 24 May 2018, the GNSO Council confirmed the appointment of Brian Beckham as an additional Co-Chair, succeeding J. Scott Evans, to join existing Co-Chairs Philip Corwin and Kathy Kleiman.
- On 24 July 2019, the Working Group completed its initial review of the Sunrise and Trademark Claims services.
- On 23 October 2019, the Working Group completed its review of the structure and scope of the TMCH.
- On 6 November 2019, the GNSO Council appointed John McElwaine as the GNSO Council Liaison to the PDP Working Group, replacing Paul McGrady who was term-limited as a GNSO Councillor.
- On 15 January 2020, the Working Group concluded its review of the URS.
- On 4 March 2020, the GNSO Council approved a Project Change Request submitted by the Working Group, reflecting a revised 9th work plan that projects the submission of the Phase 1 Final Report by mid-October 2020.
- On 11 March 2020, the Working Group completed its review of its draft Phase 1 Initial Report.
- On 18 March 2020, the Working Group published its draft Phase 1 Initial Report for public comment.
- On 21 April 2020, the Working Group extended its Phase 1 Initial Report public comment for one additional week, with a new closing date on 4 May 2020.

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<sup>100</sup> J. Scott Evans resigned as Co-Chair effective 02 March 2018.

- On 4 May 2020, the Working Group closed the public comment period for its Phase 1 Initial Report, receiving a total number of fifty-five (55) submissions (38 from organizations, five from ICANN community groups, and 12 from individuals).
- On 8 September 2020, the Working Group completed review and deliberation on all public comments received.
- On 24 September 2020, the GNSO Council approved a Project Change Request submitted by the Working Group, reflecting a revised 10th work plan that projects the submission of the Phase 1 Final Report by late-November 2020.
- On 29 October 2020, the Working Group completed its review of the proposed text of its Phase 1 final recommendations for inclusion in the Final Report, including new additional recommendations developed based on public comments received and reference to the CCT-RT and EPDP Phase 1 recommendations.
- On 29 October 2020, the Working Group completed its review of its draft Phase 1 Final Report.
- From 30 October to 8 November 2020, the Working Group conducted a consensus call on all its Phase 1 final recommendations.
- On 11 November 2020, the Working Group Co-Chairs issued their Consensus Designations of all final recommendations. By the deadline of 12 November 2020, no objection was received from Working Group members to the Co-Chairs' proposed Consensus Designations.
- By 20 November 2020, the Working Group received one Minority Statement from members pertaining to the TMCH Final Recommendation #1 for inclusion in its Phase 1 Final Report. TMCH Final Recommendation #1 was the only recommendation that did not receive full consensus support from the Working Group.
- On 24 November 2020, the Working Group submitted its Phase 1 Final Report to the GNSO Council for review and approval.

### 5.2.3 TM-PDDRP Review Process

- In June 2016, the Working Group commenced its review of the TM-PDDRP, having agreed that this should be the first RPM that it would review for Phase 1 of this PDP.
- In August 2016, The Working Group surveyed the three TM-PDDRP Providers and, based on Working Group discussions of the initial responses received, sought additional feedback from the Providers.
- In September-October 2016, the Working Group discussed a number of potential modifications to the procedure, but due to the fact that no Complaint had been filed, agreed that it was premature to propose substantive changes.
- In November 2016, the Working Group completed its initial review of the TM-PDDRP. It tasked a small team of Working Group volunteers to develop a specific recommendation for a procedural modification to the procedure.

- In January 2017, the small team met to discuss and agree on the procedural modification, which concerned the filing of a joint Complaint by several trademark holders and the consolidation of multiple Complaints against a single Registry Operator.
- In March 2020, the Working Group agreed to publish this specific preliminary recommendation for public comment in its Initial Report.
- On 15 September 2020, following the deliberation on all public comments received, the Working Group agreed to publish this recommendation “as is”, as part of its Phase 1 final recommendations in its Final Report.

#### 5.2.4 TMCH Review Process

- In November 2016, a survey developed by the Working Group’s TMCH Data Gathering Sub Team was distributed to Registry Operators, Registrars and the TMCH Validation Service Provider (Deloitte). Three Registry Operators responded to the survey.
- In December 2016, the TMCH Charter Questions Sub Team completed its work of refining the original TMCH related Charter questions and suggested that the refined questions be grouped into specific categories to facilitate deliberations.
- In March 2017, the Working Group met with Deloitte during the ICANN58 Copenhagen meeting. The Working Group subsequently followed up with Deloitte on a number of data points.
- In July 2017, following initial discussions about specific proposals that had been submitted by individual Working Group members about certain aspects of the TMCH, the Working Group decided to defer further discussions on these topics until it had completed an initial review of the Sunrise and Trademark Claims services.
- On 23 October 2019, the Working Group completed its review of the structure and scope of the TMCH. It agreed on one preliminary recommendation and agreed to publish seven (7) proposals submitted by individual Working Group members, that at this time had not attained sufficient support to be considered Working Group preliminary recommendations, in its Initial Report for public comment.
- On 6 October 2020, following the deliberation on all public comments received, the Working Group agreed to publish a total number of four (4) recommendations pertaining to the TMCH, including three new recommendations originated from the individually submitted proposals, as part of its Phase 1 final recommendations in its Final Report.

#### 5.2.5 Sunrise & Trademark Claims Services Review Process

- In March 2017, the Working Group formed a Sunrise Charter Questions Sub Team and a Trademark Claims Charter Questions Sub Team to refine the original Charter Questions.
- Between April-July 2017, the Working Group discussed a report on an Independent Review of TMCH Services that had been prepared by the Analysis Group and commissioned by ICANN org based on a recommendation from the Governmental Advisory Committee



(GAC). During this time, the Working Group also met with representatives of the Analysis Group to discuss the report.

- In July 2017, following completion of work by its two Sub Teams, the Working Group began to develop a funding request to seek resources for professional surveys it believed were needed, in order to obtain data critical to reviewing the Sunrise and Trademark Claims services. The GNSO Council approved this data request in September 2017.
- In August 2017, as part of its data analysis work, the Working Group reviewed the results of the INTA Cost Impact Survey that had been conducted as part of the CCT Review.
- In October 2017, a new RPM Data Sub Team began to develop guidance, based on the Working Group's identified data needs and the work done to date, for the vendor to develop surveys. These surveys were intended to obtain quantitative and anecdotal evidence from several different target groups (e.g. Registry Operators, Registrars, Trademark and Brand Owners, and Actual and Potential Registrants) related to the Sunrise and Trademark Claims services.
- In May 2018, the Analysis Group, which had been selected by ICANN org as the survey vendor through ICANN org's Request for Proposal process, began working with the RPM Data Sub Team to finalize the surveys.
- In October 2018, at ICANN63 in Barcelona, the Analysis Group presented its findings from the surveys. The Working Group subsequently formed a Sunrise Data Review Sub Team and a Trademark Claims Data Review Sub Team to: 1) analyze the Sunrise and Trademark Claims related data collected to date, and 2) propose preliminary recommendations for consideration by the full Working Group.
- In July 2019, the Working Group endorsed the Sub Team-proposed preliminary recommendations for Sunrise and Trademark Claims.
- On 8 October 2020, following the deliberation on all public comments received, the Working Group agreed to publish a total number of eight (8) recommendations pertaining to Sunrise and six (6) recommendations pertaining to Trademark Claims as part of its Phase 1 final recommendations in its Final Report.

### 5.2.6 Additional Marketplace RPMs Review Process

- In May 2017, the Working Group Co-Chairs proposed an approach by which the Working Group could discuss and understand the scope and mechanics of the various additional marketplace RPMs that were being offered by a number of Registry Operators and Deloitte, the current TMCH Validation Service Provider. The Working Group agreed to form a Sub Team that would review the Co-Chairs' proposed questions and propose a refined set of questions to the full Working Group.
- In September 2017, the Additional Marketplace RPMs Sub Team submitted a final set of proposed questions for the Working Group to consider.
- Also in September 2017, the GNSO Council approved the Working Group's request to contract with a professional services firm to conduct surveys relating to the Sunrise and Trademark Claims services offered through the TMCH. The Working Group formed the RPM Data Sub Team to develop specific guidance for the survey provider.

- In March 2018, the RPM Data Sub Team discussed the work that had been done to date on the additional marketplace RPMs and agreed that most of the questions were already subsumed into the work for the Sunrise and Trademark Claims surveys.
- In April 2018, the RPM Data Sub Team agreed that any remaining questions about the additional marketplace RPMs questions, which the Working Group concludes to have not been addressed by the outcomes of the Sunrise and Trademark Claims surveys, could be sent to Deloitte for additional follow up. In addition, the Sub Team suggested that, following the completion of its review of the Sunrise and Trademark Claims RPMs, the Working Group consider this question: “How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?” This question was placed in the “Next Steps” section in its Initial Report as a topic for the Working Group to return to, following its review of all public comments to the Initial Report.<sup>101</sup>
- On 21 July 2020, during its review of public comments received, the Working Group agreed that it did not collect sufficient data to develop a meaningful answer to the aforementioned question. While the Working Group noted that several commenters expressed the desire for the Globally Protected Mark List (GPML) as an additional measure, it agreed not to develop any recommendation with regard to additional mandatory RPMs equivalent to GPML.<sup>102</sup>

### 5.2.7 URS Review Process

- In December 2017, the Working Group agreed to commence the URS review by grouping the original Charter questions into a list of specific sequential topics. The Working Group also agreed to apply a standard set of high-level questions to the review, as a framework for evaluating and developing preliminary recommendations for the URS.
- In February 2018, three URS Sub Teams (i.e. URS Providers, URS Practitioners, and URS Documents Sub Teams) began their work. The URS Providers and URS Practitioners Sub Teams were tasked to develop, administer, and analyze results of surveys for the current URS Providers and experienced URS Practitioners. The URS Documents Sub Team was tasked with 1) identifying various data sources in addition to what would be sought from the URS providers and practitioners, 2) reviewing and examining specific categories of URS

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<sup>101</sup> This question is related to one of the three (3) general overarching Charter questions -- “General Overarching Charter Question #1: Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?” The Working Group’s Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for the Initial Report, the Working Group also invited input for these overarching Charter questions, which helped inform its overall work toward the Final Report.

<sup>102</sup> See Rows #31-32 related to the GPML comments in the public comment review tool here:

<https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhvIOskAILVraWp-88mqzScCtj01fw/edit#gid=1227219396>

cases, and 3) developing potential recommendations for full Working Group consideration.

- In May 2018, Professor Rebecca Tushnet, a member of the Working Group, presented her individual analysis of URS cases to the Working Group.
- In August 2018, the three Sub Teams discussed their preliminary findings/issues with the full Working Group, as well as their proposals for recommendations and operational fixes and proposed questions for community input. Individual Working Group members were also invited to submit proposals for consideration by the Working Group, in addition to the proposals developed by the three Sub Teams.
- In October 2018 during the ICANN63 Barcelona meeting, the Working Group completed its initial review of the URS, including its initial deliberation on the thirty-four (34) proposals from its three Sub Teams and thirty-six (36) proposals submitted by individual Working Group members. It subsequently conducted a survey to assess the level of support for including each of these individually submitted proposals in the Initial Report for community input.
- Subsequently, in November 2019 during the ICANN66 Montréal meeting, the Working Group agreed that it would need to: 1) conclude its initial review of the URS procedure; 2) consolidate or otherwise finalize the Sub Team proposals to formulate the Working Group preliminary recommendations; and 3) narrow down the number of individual proposals for inclusion in the Initial Report. This work was completed in December 2019 for the Sub Team proposals and January 2020 for the individual proposals.
- On 22 and 27 August 2020, the Working Group referenced relevant sections in the Wave 1 Report of the Expedited PDP (EPDP) on a Temporary Specification for gTLD Registration Data Phase 1 Recommendation #27.
- On 13 October 2020, following the deliberation on all public comments received, the Working Group agreed to publish a total number of fifteen (15) recommendations pertaining to the URS, including five (5) new recommendations originated from the individually-submitted proposals and one (1) additional recommendation as a result of the public comment review, as part of its Phase 1 final recommendations in its Final Report.

### 5.2.8 Public Comment Review Process & Final Recommendation Development

- Following the end of the public comment proceeding of the Phase 1 RPM PDP Initial Report on 4 May 2020, staff began developing a public comment review tool to facilitate the Working Group's deliberation.
- On 19 May 2020, the Working Group formed two sub groups to review the public comments concerning the preliminary recommendations published in its Phase 1 Initial Report (specifically the recommendations pertaining to the TMCH, Sunrise, Trademark Claims, URS, and TM-PDDRP), using the staff-developed tool.
- On 23 June 2020 during the ICANN68 Virtual Meeting, the Working Group began reviewing the public comments relating to proposals published in the Initial Report that did not rise to the level of preliminary recommendations, as well as comments pertaining to

overarching Charter questions and general input, using the staff-developed public comment review tool.

- On 17 July 2020, the two sub groups completed their review of public comments pertaining to preliminary recommendations and forwarded their suggestions and outcomes to the full Working Group for consideration.
- On 6 August 2020, the Working Group completed the initial review of public comments relating to the 24 individually-submitted proposals that did not rise to the level of preliminary recommendations, and agreed to preserve nine of them for a second round of review to consider if they could gain consensus support as Working Group final recommendations, subject to further Working Group discussions about the updated language.
- On 25 August 2020, the Working Group completed the review of public comments pertaining to overarching Charter questions and general input. See the Working Group conclusion of this review in “Annex B - Charter Questions”.
- On 8 September 2020, the Working Group completed the review and deliberation on all public comments received, including the sub groups’ suggestions and outcomes relating to the review of public comments for preliminary recommendations.
- On 1 October 2020, the Working Group completed the review of the staff-proposed overarching data collection recommendation in relation to the TMCH, URS, Sunrise, and Trademark Claims.
- On 8 October 2020, the Working Group concluded its small team efforts to consider developing new additional recommendations based on the review of public comments. This small team effort resulted in one (1) additional recommendation related to the TMCH (see TMCH Final Recommendation #1).
- On 9 October 2020, support staff circulated the draft Phase 1 Final Report for the Working Group’s review and discussion.
- On 13 October 2020, the Working Group completed the review of eight (8) new recommendations originated from individually submitted proposals, which were preserved for a second round of review and discussion by the Working Group.
- On 29 October 2020, the Working Group completed the review of its draft Phase 1 Final Report.

## 5.3 Related Work by the GNSO, the ICANN Community, and the ICANN Organization

### 5.3.1 Related Work Prior to the Initiation of this PDP

Prior to the initiation of this PDP, the GNSO and ICANN org had worked on a number of activities that formed part of the background materials for the scoping and chartering of this PDP.

#### **Implementation Review Team (2009)**

On 6 March 2009, the GNSO Intellectual Property Constituency formed the Implementation Review Team (IRT) in accordance with a 6 March, 2009 ICANN Board resolution. The objective of the IRT was to develop potential, practicable solutions for trademark protections as part of the implementation work for the 2012 New gTLD Program.

The IRT published its Final Report on 29 May 2009, including recommendations for several proposed solutions with respect to:<sup>103</sup>

- An IP Clearinghouse, a Globally Protected Marks List and associated RPMs, and standardized pre-launch rights protection mechanisms such as Sunrise and an IP Claims service;
- A dispute resolution procedure modeled on the UDRP;
- PDDRs;
- Whois requirements for new TLDs; and
- Use of algorithm in string confusion review during initial evaluation.

### **Special Trademark Issues Review Team (2009)**

On 12 October 2009, the ICANN Board sent a letter to the GNSO Council requesting its view on the trademark protection mechanisms that were being proposed for the New gTLD Program.<sup>104</sup> In response, on 28 October 2009 the GNSO Council created the Special Trademarks Issues (STI) Review Team, which included representatives from each Stakeholder Group, the At-Large community, Nominating Committee Appointees, and the Governmental Advisory Committee (GAC). The STI was directed to analyze the staff implementation models of the TMCH and URS that were proposed for inclusion in the Draft Application Guidebook Version 3. On 11 December 2009, the STI Review Team delivered its Report to the GNSO Council describing an alternative proposal to address trademark concerns in the New gTLD Program that was supported by a consensus of its members.<sup>105</sup>

On 17 December 2009, the GNSO Council approved the overall package of recommendations contained in the STI Report. The GNSO Council also directed ICANN staff to publish the STI recommendations for public comment. In March 2010, the ICANN Board passed a resolution directing ICANN staff to analyze the public comments and develop final versions of the TMCH and URS, to be included in version 4 of the Draft Applicant Guidebook.

### **UDRP Issue Report (2011)**

The UDRP has been the subject of a previous GNSO Preliminary Issue Report, published in February 2011 prior to the delegation of the first gTLD under the New gTLD Program.<sup>106</sup> Community feedback in response to this Issue Report was largely to the effect that the UDRP provides a “comparatively quick” and “effective” recourse for disputed second level domain name registrations in the globalized and trans-jurisdictional world of the DNS.<sup>107</sup> The Final Issue Report was published in October 2011 and its primary conclusion was that a review of the UDRP

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<sup>103</sup> See <https://archive.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>

<sup>104</sup> See the ICANN Board letter here: [https://gns0.icann.org/sites/default/files/filefield\\_7272/beckstrom-to-gns0-council-12oct09-en.pdf](https://gns0.icann.org/sites/default/files/filefield_7272/beckstrom-to-gns0-council-12oct09-en.pdf)

<sup>105</sup> See STI's Report here: <https://gns0.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

<sup>106</sup> See the Preliminary Issue Report here: <https://www.icann.org/resources/pages/prelim-report-udrp-2011-05-27-en>

<sup>107</sup> See the Final Issue Report on the Current State of the UDRP (October 2011), Section 5.

should not be conducted until eighteen (18) months after the launch of the URS.<sup>108</sup> A review could then be based on data derived from the use of the URS, since it is modeled on the UDRP.<sup>109</sup>

### **RPM Staff Paper (2015)**

In February 2015, ICANN staff published a draft Rights Protection Mechanisms Review report to solicit community feedback, with the aim of assessing their operational effectiveness to date and to identify topics and areas that can inform future policy work.<sup>110</sup> In September 2015, ICANN staff published a revised Rights Protection Mechanism Report (RPM Staff Paper) following its review of community comments received.<sup>111</sup> The community's suggestions and questions were incorporated into the Final Issue Report for this PDP.

## **5.3.2 Related Work After the Initiation of this PDP**

Under its Charter, the Working Group is required, among other tasks, to take into consideration the work/outcome of the TMCH Independent Review, the CCT Review, and any other relevant GNSO policy development processes, including the EPDP on the Temporary Specification for gTLD Registration Data.

### **Independent Review of the TMCH (2017)**

In 2016, based on a recommendation from the GAC, ICANN commissioned the Analysis Group to conduct an independent review of the TMCH.<sup>112</sup> The firm examined whether domains that relate to, but do not exactly match, trademarks should be considered for use in the Claims period of a new gTLD's lifecycle. The review also explored whether extending the number of days of the Claims service would be of value, as well as measured how frequently trademark holders use the Sunrise period, among other topics. The review identified some additional related topics that could be addressed as part of ICANN's policy development work. As noted above, in 2017 the Working Group met with the Analysis Group and reviewed the report.

### **Competition, Consumer Trust and Consumer Choice Review Team (2018)**

ICANN's CCT-RT conducted a review of the new gTLD program, monitoring and assessing issues of competition, consumer protection, security, stability, malicious abuse, and rights protection for the new gTLDs. As part of its review, the CCT-RT examined the impact of new gTLDs on brand owners, specifically the cost and effort required to protect and police trademarks.<sup>113</sup>

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<sup>108</sup> See the Final Issue Report on the Current Statement of the UDRP here:

[https://gns0.icann.org/sites/default/files/filefield\\_27051/udrp-final-issue-report-03oct11-en.pdf](https://gns0.icann.org/sites/default/files/filefield_27051/udrp-final-issue-report-03oct11-en.pdf)

<sup>109</sup> See the Final Issue Report on the Current State of the UDRP, p.31.

<sup>110</sup> The initial staff paper, public comments, and revised staff paper can be viewed here:

<https://newgtlds.icann.org/en/reviews/cct/rpm>

<sup>111</sup> See <https://www.icann.org/news/announcement-2015-09-11-en>

<sup>112</sup> See the GAC recommendations on page 5-8: <https://archive.icann.org/en/topics/new-gtlds/gac-comments-new-gtlds-26may11-en.pdf>. The revised report of the independent review is available for download via:

<https://newgtlds.icann.org/en/reviews/tmch/revised-services-review-22feb17-en.pdf>

<sup>113</sup> The CCT-RT Final Report can be found via: <https://www.icann.org/en/system/files/files/cct-final-08sep18-en.pdf>.

The sections related to Trademark / RPMs are from pp.10-12, 15, 22-24, 72, 125-140.

The CCT-RT ultimately directed the following recommendations, which are published in its Final Report on 8 September 2018, to the RPM PDP Working Group:

- Recommendation #9: “The ICANN community should consider whether the costs related to defensive registration for the small number of brands registering a large number of domains can be reduced.”
- Recommendation #27: “Since the Review Team’s initial draft recommendation, the PDP Review of All RPMs in All gTLDs Working Group started reviewing the URS in detail and, at the time of writing, their review is ongoing. Given this ongoing review, the Review Team recommends that the Working Group continue its review of the URS and also looks into the interoperability of the URS with the UDRP. The review team encountered a lack of data for complete analysis. The PDP Review of All RPMs appears to also be encountering this issue and this may well prevent it from drawing firm conclusions. If modifications are not easily identified, then the CCT Review Team recommends continued monitoring until more data is collected and made available for review at a later date.”
- Recommendation #28: “A cost-benefit analysis and review of the TMCH and its scope should be carried out to provide quantifiable information on the costs and benefits associated with the present state of the TMCH services, and thus to allow for an effective policy review. Since the review team’s initial draft recommendation, the PDP Review of All RPMs in All gTLDs Working Group has started reviewing the TMCH in detail and ICANN has appointed Analysis Group to develop and conduct the survey(s) to assess the use and effectiveness of the Sunrise and Trademark Claims RPMs. Provided that the PDP Working Group has sufficient data from this survey or other surveys and is able to draw firm conclusions, the review team does not consider that an additional review is necessary. However, the CCT Review Team reiterates its recommendation for a cost-benefit analysis to be carried out if such analysis can enable objective conclusions to be drawn. Such cost-benefit analysis should include, but not necessarily be limited to, looking at cost-benefits of the TMCH for brand owners, registries, and registrars now and going forward, as well as examine the interplay of the TMCH with premium pricing.”

In relation to CCT Recommendation #9, during its deliberations on the Sunrise and Trademark Claims RPMs, the Working Group agreed that matters of pricing are outside the scope of this PDP.

In relation to CCT Recommendation #27, the Working Group agrees that the lack of comprehensive data made it difficult to conduct the initial URS review. However, it was able to collect and analyze sufficient data -- through a combination of surveys, staff summaries of URS cases and metrics, and the URS case analysis of Professor Rebecca Tushnet (a Working Group member) -- to develop a series of final recommendations for the URS. The Working Group is likely to consider the question of interoperability between the URS and UDRP as part of its Phase 2 work.

In relation to CCT Recommendation #28, the Working Group relied largely on Analysis Group’s TMCH independent review, survey results, interactions with the TMCH Validation Provider, and information from a few Registry Operators for both quantitative and anecdotal data. It did not consider if necessary, nor did it have the resources, to conduct a full cost-benefit analysis of the

TMCH. Nevertheless, the Working Group was able to develop a number of TMCH-related final recommendations (including recommendations related to the Sunrise and Trademark Claims services offered through the TMCH).

Although ICANN org was able to provide the Working Group with data relating to the RPMs and the Working Group also requested and received data relating to the TMCH from Deloitte as well as from the Analysis Group, the Working Group encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the RPMs. The Working Group supported the CCT recommendations seeking to address the challenges posed by the dearth of data; it also found that existing data was not necessarily available in uniform formats (e.g. the various formats used in URS Determinations).<sup>114</sup> Therefore, the Working Group put forward an Overarching Data Collection Final Recommendation aiming at addressing this gap. Please refer to the “Phase 1 Final PDP Recommendations” sections of this Final Report for further details and the Working Group’s initial conclusions regarding these CCT recommendations.

#### **EPDP on Temporary Specification for gTLD Registration Data (2018-Present)**

On 17 May 2018, the ICANN Board approved the Temporary Specification for gTLD Registration Data to facilitate compliance by ICANN’s contracted parties with existing ICANN contractual requirements as well as the European Union’s General Data Protection Regulation (GDPR). The adoption of the Temporary Specification triggered the requirement for the GNSO to complete a consensus PDP within one year. On 19 July 2018, the GNSO Council initiated the EPDP on the Temporary Specification for gTLD Registration Data, to be conducted in two phases.

On 15 May 2019, the ICANN Board adopted most of the EPDP Phase 1 policy recommendations in its Final Report.<sup>115</sup> The GNSO Council referred the following RPM-related recommendations to the Working Group in July 2019:

- **Recommendation #21:** “The EPDP Team also recommends that the GNSO Council instructs the review of all RPMs PDP WG to consider, as part of its deliberations, whether there is a need to update existing requirements to clarify that a Complainant must only be required to insert the publicly-available RDDS data for the domain name(s) at issue in its initial Complaint. The EPDP Team also recommends the GNSO Council to instruct the RPMs PDP WG to consider whether upon receiving updated RDDS data (if any), the Complainant must be given the opportunity to file an amended Complaint containing the updated respondent information.”
- **Recommendation #23:** “The EPDP Team recommends that, for the new policy on gTLD registration data, the following requirements MUST apply in relation to URS and UDRP

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<sup>114</sup> The formatting issue related to URS decisions was also covered in an individually submitted proposal that did not rise to the level of becoming a Working Group preliminary recommendation but was published in the Initial Report for public comment. See URS Individual Proposal #29 on pp.66-67: <https://gns0.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>115</sup> See the EPDP Phase 1 Final Report here: <https://gns0.icann.org/sites/default/files/file/field-file-attach/epdp-gtld-registration-data-specs-final-20feb19-en.pdf>



until such time as these are superseded by recommendations from the RPMs PDP WG and/or policies from the EPDP regarding disclosure:

- Uniform Rapid Suspension (supplemental requirements for the 17 October 2013 URS High Level Technical Requirements for Registries and Registrars and URS Rules effective 28 June 2013)

(1) Registry Operator Requirement: The Registry Operator (or appointed BERO) MUST provide the URS Provider with the full Registration Data for each of the specified domain names, upon the URS Provider notifying the Registry Operator (or appointed BERO) of the existence of a Complaint, or participate in another mechanism to provide the full Registration Data to the Provider as specified by ICANN. If the gTLD operates as a "thin" registry, the Registry Operator MUST provide the available Registration Data to the URS Provider.

(2) Registrar Requirement: If the domain name(s) subject to the Complaint reside on a "thin" registry, the Registrar MUST provide the full Registration Data to the URS Provider upon notification of a Complaint.

(3) URS Rules: Complainant's Complaint will not be deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the URS Rules if such contact information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a Complaint against an unidentified Respondent and the Provider shall provide the Complainant with the relevant contact details of the Registered Name Holder after being presented with a Complaint against an unidentified Respondent.

- Uniform Dispute Resolution Policy (supplemental requirements for the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"))

(1) Registrar Requirement: The Registrar MUST provide the UDRP Provider with the full Registration Data for each of the specified domain names, upon the UDRP Provider notifying the Registrar of the existence of a Complaint, or participate in another mechanism to provide the full Registration Data to the Provider as specified by ICANN.

(2) Complainant's Complaint will not be deemed defective for failure to provide the name of the Respondent (Registered Name Holder) and all other relevant contact information required by Section 3 of the UDRP Rules if such contact information of the Respondent is not available in registration data publicly available in RDDS or not otherwise known to Complainant. In such an event, Complainant may file a Complaint against an unidentified Respondent and the Provider shall provide the Complainant with the relevant contact details of the Registered Name Holder after being presented with a Complaint against an unidentified Respondent."

- **Recommendation #27:** "The EPDP Team recommends that as part of the implementation of these policy recommendations, updates are made to the following existing policies / procedures, and any others that may have been omitted, to ensure consistency with these

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policy recommendations as, for example, a number of these refer to administrative and/or technical contact which will no longer be required data elements:

- Registry Registration Data Directory Services Consistent Labeling and Display Policy
- Thick WHOIS Transition Policy for .COM, .NET, .JOBS
- Rules for Uniform Domain Name Dispute Resolution Policy
- WHOIS Data Reminder Policy
- Transfer Policy
- Uniform Rapid Suspension System (URS) Rules
- Transfer Dispute Resolution Policy

On 18 February 2020, ICANN org published the Wave 1 Report in accordance with the aforementioned Recommendation #27, which provides a detailed assessment of the impact from EPDP Phase 1 policy recommendations on existing ICANN policy and procedures.<sup>116</sup> On 10 March 2020, the GNSO Council received a GNSO support staff’s proposal (entitled “Consideration of Possible Next Steps in Response to EPDP Rec #27 Wave 1 Report”) regarding how to address the items covered in the Wave 1 Report, including a suggested approach based on the assessment of scope and nature of the anticipated changes to existing policies and procedures, such as the URS.<sup>117</sup> The GNSO Council agreed on the suggested next steps as described in the GNSO support staff’s proposal and requested the RPM Working Group to consider if and how the EPDP Phase 1 recommendations are addressed in the URS related recommendations.<sup>118</sup>

On 18 August 2020, RPM Working Group support staff circulated a document that provides further clarification on the relevant sections in the Wave 1 Report as well as the suggested approach to finalize the Working Group’s URS recommendations to maintain consistency with EPDP Team’s Phase 1 recommendations.<sup>119</sup> On 22 and 27 August 2020, the Working Group referenced the relevant sections in the Wave 1 Report. When finalizing its Phase 1 recommendations, the Working Group confirmed that its final recommendations are consistent with the EPDP Phase 1 Recommendations as well as the analysis in the Wave 1 Report. Specifically, the Working Group provided further notes regarding the consistency in the contextual language of the URS Final Recommendations #1, #2, #4, #5, and #11.

Furthermore, ICANN Org’s EPDP Phase 1 Wave 1 report noted the need to make various terminology updates to a number of ICANN policies and procedures regarding WHOIS.<sup>120</sup> In

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<sup>116</sup> See the Wave 1 Report here: <https://gnso.icann.org/sites/default/files/file/field-file-attach/epdp-phase-1-recommendation-27-18feb20-en.pdf>

<sup>117</sup> See the GNSO support staff proposal here: <https://gnso.icann.org/sites/default/files/file/field-file-attach/next-steps-epdp-phase-1-wave-1-rec-27-10mar20-en.pdf>

<sup>118</sup> See consent agenda item 3 here: <https://community.icann.org/x/OOZ1C>

<sup>119</sup> See RPM Working Group support staff’s document here: <https://mm.icann.org/pipermail/gnso-rpm-wg/attachments/20200818/6585de4b/Wave1Rec27-PossibleNextStepsforURS-RPMPDP-0001.pdf>

<sup>120</sup> For more information about the EPDP Phase 1 Wave 1 report, please see the “Background” section of this Final Report.

August 2020, the GNSO Council tasked the EPDP Phase 1 IRT to prepare draft revisions for these updates.<sup>121</sup>

The Working Group agrees that it is necessary to update terminology associated with “WHOIS” in the URS Procedure and Rules as a result of the EPDP on the Temporary Specification on gTLD Registration Data. Consequently, the Working Group agrees that, to ensure uniformity and consistency across all ICANN’s policies and procedures relating to WHOIS, the task of making the necessary terminology updates be undertaken by the EPDP Phase 1 IRT, which has already been charged by the GNSO Council to perform this work for all affected ICANN policies.

The Working Group clarifies that its agreement on any terminology updates made to the URS as a result of the EPDP Phase 1 work does not preclude any subsequent or further terminology updates that may be required as a result of additional policy work, including during Phase 2 of this PDP that will review the UDRP.

Please refer to the “URS Final Recommendations” sub section of the “Phase 1 Final PDP Recommendations” section of this Final Report for further details and the Working Group’s conclusions regarding these EPDP recommendations.

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<sup>121</sup> See the GNSO Council consent agenda 3.2 in the 20 August 2020 meeting here:  
<https://gns0.icann.org/en/council/resolutions/2020#202008>

## 6 Approach Taken by the Working Group

### 6.1 Working Methodology

The Working Group began its deliberations on 21 April 2016. It decided to conduct its work primarily through weekly conference calls, in addition to email exchanges on its mailing list, with further discussions taking place at ICANN Public Meetings when scheduled. All the Working Group's meetings are documented on its wiki workspace, including its mailing list archive, draft documents, background materials, and input received from across the ICANN community.<sup>122</sup>

The Working Group also prepared a Work Plan, which was reviewed and updated on a periodic basis.<sup>123</sup> In accordance with the GNSO's PDP Manual, the Working Group solicited early input from ICANN's Supporting Organizations (SOs)/Advisory Committees (ACs) and the GNSO's Stakeholder Groups and Constituencies, and considered all input received in response (please see the "Annex G - Community Input" section of this Final Report for additional details). The Working Group also reviewed historical documentation relating to the development of the various RPMs during its deliberations.<sup>124</sup>

The Working Group scheduled community sessions at each ICANN Public Meeting that took place after its formation, at which it presented its preliminary findings and/or conclusions to the broader ICANN community for discussion and feedback.

### 6.2 Sub Teams

The Working Group employed Sub Teams as an efficient means of delegating topics or assignments to be completed and conducting the preliminary work. The Sub Teams: 1) refined the original Charter questions; 2) gathered and reviewed data; 3) developed proposed answers to the final agreed Charter questions; 4) assessed proposals submitted by individual Working Group members; 5) formulated preliminary recommendations for review by the full Working Group; and/or 6) review public comments on preliminary recommendations and provide suggestion for consideration by the full Working Group.<sup>125</sup>

The full list of Sub Teams in the RPM Working Group is included below:

- TMCH Charter Questions: wiki - <https://community.icann.org/x/siK4Aw>, mailing list - <https://mm.icann.org/pipermail/gns0-rpm-tmch/>

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<sup>122</sup> Mailing list archive: <https://mm.icann.org/pipermail/gns0-rpm-wg/>; wiki workspace: <https://community.icann.org/x/wCWAaw>

<sup>123</sup> An archive of the Working Group's work plans can be found here: <https://community.icann.org/x/wBeOAw>

<sup>124</sup> Much of the historical records, reports, papers, rules and procedures considered by the Working Group is listed on the Working Group's wiki space. See: <https://community.icann.org/x/4SWAAw>

<sup>125</sup> The original Charter questions which were reproduced in the PDP Charter by the GNSO Council from the unedited community questions submitted to previous ICANN work on RPMs.

- TMCH Data Gathering: wiki - <https://community.icann.org/x/UwSbAw>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-tmch/>
- RPM Data: wiki - <https://community.icann.org/x/eI1EB>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-data/>
- Sunrise Charter Questions: wiki - <https://community.icann.org/x/yIIWBg>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-sunrise/>
- Sunrise Data Review: wiki - <https://community.icann.org/x/y4IWBg>, mailing list - <http://mm.icann.org/pipermail/gnso-rpm-sunrise/>
- Trademark Claims Charter Questions: wiki - <https://community.icann.org/x/psrRAw>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-trademark/>
- Trademark Claims Data Review: wiki - <https://community.icann.org/x/34IWBg>, mailing list - <http://mm.icann.org/pipermail/gnso-rpm-trademark/>
- URS Documents: wiki - <https://community.icann.org/x/zRW8B>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-documents/>
- URS Practitioners: wiki - <https://community.icann.org/x/xBW8B>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-practitioner/>
- URS Providers: wiki - <https://community.icann.org/x/1hW8B>, mailing list - <https://mm.icann.org/pipermail/gnso-rpm-providers/>
- Additional Marketplace RPMs: wiki - <https://community.icann.org/x/s8rRAw>, mailing list - <http://mm.icann.org/pipermail/gnso-rpm-protection/>
- Sub Group A: wiki - <https://community.icann.org/x/VQldC>, mailing list - <https://mm.icann.org/pipermail/gnso-rpms-wg-sga/>
- Sub Group B: wiki - <https://community.icann.org/x/VwldC>, mailing list - <https://mm.icann.org/pipermail/gnso-rpms-wg-sgb/>

## 6.3 Data Gathering and Review

As this PDP is the first time that the RPMs have been subject to a policy review by the ICANN community, to date there has not been comprehensive studies or data collected that measures their effectiveness. The Working Group agreed early on in its work that, in order to fulfill its Charter requirements and effectively review each of the Phase 1 RPMs, it would need to analyze any available data (including data reported by Registry Operators and the various service Providers to ICANN org, as it may have been required by their contracts or other arrangements with ICANN org) as well as gather and examine new data, particularly with respect to the usage of the RPMs that were developed for the 2012 New gTLD Program. Accordingly, the Working Group collected and analyzed data and input from a number of sources, including but not limited to the following items below.

Links to some of these data/input sources are included in the “Annex E - Working Group Documents” section of this Final Report. For a complete record of data/input source documents and materials, please visit the Working Group wiki workspace.<sup>126</sup>

Although the Working Group engaged in extensive data collection and analysis efforts during its deliberations, it encountered challenges in obtaining sufficient quantitative data (as opposed to anecdotal reports) concerning the effectiveness of the Phase 1 RPMs. Therefore, the Working Group also put forward an Overarching Data Collection Recommendation aiming at addressing this data-related gap. See the Overarching Data Collection Final Recommendation in the “Phase 1 Final PDP Recommendations” section.

### 6.3.1 URS Data

- URS Rules, URS Procedure, URS Providers’ Supplemental Rules, URS Technical Requirements, and Memoranda of Understanding (MoU) between ICANN and URS Providers;
- Presentations and materials provided by URS Providers (March 2018), as well as URS Providers’ websites, tools, and platforms;
- URS Providers and Practitioners’ responses to the Sub Team-developed surveys (June/August 2018);
- ICANN Org source materials including:
  - Staff report of URS cases and initial metrics, including claims denied cases, de novo review cases, and cases with final determination (July-August 2018);
  - Competition, Consumer Trust and Consumer Choice Review Team (CCT-RT) Recommendations related to the URS (7 March 2017);
  - Expedited Policy Development Process on Temporary Specification for gTLD Registration Data Phase 1 Recommendations related to the URS (20 February 2019);
  - Special Trademark Issues (STI) Review Team Report (11 December 2009);
- INTA’s New gTLD Cost Impact Survey results (April/May 2017);
- Analysis of URS cases performed by Professor Rebecca Tushnet, a Working Group member (May 2018).

### 6.3.2 TMCH Data

- Final TMCH Framework Document as published in the final version of the Applicant Guidebook (AGB) (4 June 2012);
- Specifications and operational documentation developed for the TMCH, including the TMCH Guidelines, TMCH Operational Requirements, TMCH Functional Specification, TMCH

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<sup>126</sup> See the Working Group wiki workspace here: <https://community.icann.org/x/wCWAaw>

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Database Terms of Service Agreement, Registry/Registrar User Manuals, and information about the Qualified Launch Program & Approved Launch Program;

- Information about the TMCH Provider, eligibility criteria, and submission/validation process published on the TMCH website and ICANN’s new gTLD program microsite;
- Responses from a few registries to TMCH Sub-Team developed survey (December 2016);
- ICANN Org source materials including:
  - TMCH Implementation Assistance Group (IAG) Report (26 September 2012);
  - Final Report of the Implementation Review Team (IRT) convened by the GNSO Intellectual Property Constituency at Board request following identification of trademark protection as an overarching issue for the New gTLD Program(29 May 2009);
  - STI Review Team Report (11 December 2009);
  - Metrics compiled for the CCT-RT (2012-2018);
  - RPM Staff Paper assessing the operations of the various RPMs in 2015 (11 September 2015);
  - Terms and descriptions for design marks and geographical indications (29 April 2017);
- External source materials including:
  - Analysis Group’s Independent Review of the Trademark Clearinghouse (TMCH) Services Revised Report (23 February 2017) and its responses to Working Group questions about that report (June/July 2016);
  - INTA’s New gTLD Cost Impact Survey results (April/May 2017);
  - Data from Deloitte (the TMCH Validation Service Provider) (February 2017) and its responses to Working Group questions (January/April 2017);
- Previous versions of TMCH documentation published in the Draft Applicant Guidebook, explanatory memoranda, and other materials relating to the launch of the 2012 New gTLD Program Round (May 2010-April 2011).

### 6.3.3 Sunrise & Trademark Claims Services Data

- External source materials considered by the Working Group for its TMCH review (see above);
- Responses from registries, registrars, trademark owners, and actual/potential registrants to the Sunrise and Trademark Claims surveys (October 2018)<sup>127</sup>;
- Responses from a few registries to TMCH Sub-Team developed survey (13 December 2016);
- ICANN Org source materials including:

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<sup>127</sup> The surveys were commissioned pursuant to a data request approved by the GNSO Council in September 2017.

- ❑ RPM Staff Paper assessing the operations of the various RPMs in 2015 (11 September 2015);
- ❑ Staff-compiled summary data on Sunrise registrations (based on data reported to ICANN org by Contracted Parties and IBM, which is the TMCH Database Provider) (October 2017);
- ❑ List of New gTLD Registry Operators and relevant dates for each of their Sunrise, Trademark Claims, and other specific approved program periods, maintained by ICANN org and published on the New gTLD Program microsite (2012-Present);
- Articles and posts published on domain industry blogs referenced by Working Group members.

#### 6.3.4 TM-PDDRP Data

- TM-PDDRP Rules (June 2012) and Providers' Supplemental Rules (October 2013-March 2014);
- Responses from TM-PDDRP Providers (WIPO, FORUM, and ADNDRC) to Working Group questions (June/September 2016);
- ICANN community responses to Working Group questions about TM-PDDRP (September 2016);
- Feedback from Working Group members related to Registry conduct within TM-PDDRP scope (October 2016);
- Prior versions of the TM-PDDRP as published in the Applicant Guidebook and public comment summaries/analysis (October 2009-May 2011);
- WIPO's proposal to amend the TM-PDDRP (13 March 2009) and community responses to the proposal (March-December 2009).

#### 6.3.5 Additional Marketplace RPMs Data

- Staff-compiled information on additional marketplace RPMs voluntarily adopted by some registry operators (21 September 2017);
- Responses from a few registries to the survey developed by the TMCH Data Gathering Sub Team (13 December 2016);
- Information shared with the additional marketplace RPMs Sub Team by Donuts, Inc., a Registry Operator offering additional marketplace RPMs, during the ICANN61 Puerto Rico meeting (10 March 2017).

### 6.4 Charter Questions

The Working Group's Charter contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs. This



led to the Working Group agreeing, early on in its work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral.

In addressing the final agreed Charter questions, the Working Group used the Sub Team approach, when it considered this to be appropriate, to develop proposed responses and recommendations. Due to the Working Group's subsequent data analysis, discussions, and agreements, not all of the final agreed Charter questions resulted in specific answers being proposed by the Working Group at this stage. This does not mean, however, that the Working Group did not address the topic or objective of that specific Charter question; rather that the Working Group believes that it has addressed those issues sufficiently via its data analysis and the outcome of its deliberations.

The Working Group's Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for its Initial Report, the Working Group invited input for six (6) overarching Charter questions. The Working Group took the public comments received into account when finalizing its Phase 1 final recommendations and documented its conclusions in addressing these overarching Charter questions.

Please see the "Annex B - Charter Questions" section of this Final Report for additional details.

## 7 Annex A – PDP Working Group Charter

### CHARTER FOR PROPOSED PDP TO REVIEW ALL RIGHTS PROTECTION MECHANISMS IN ALL gTLDs



## Working Group (WG) Charter

<b>WG Name:</b>	TBD	
<b>Section I: Working Group Identification</b>		
<b>Chartering Organization(s):</b>	GNSO Council	
<b>Charter Approval Date:</b>	TBD	
<b>Name of WG Chair/Co-Chairs:</b>	TBD	
<b>Name(s) of Appointed Liaison(s):</b>	TBD	
<b>WG Workspace URL:</b>	TBD	
<b>WG Mailing List:</b>	TBD	
<b>GNSO Council Resolution:</b>	<b>Title:</b>	TBD
	<b>Ref # &amp; Link:</b>	TBD
<b>Important Document Links:</b>	<ul style="list-style-type: none"> <li>• GNSO <a href="#">Working Group Guidelines</a></li> <li>• GNSO <a href="#">PDP Manual</a></li> <li>• The Current State of the Uniform Domain Name Dispute Resolution Policy: <a href="#">Final Issue Report</a>, October 2011 (“UDRP Final Issue Report”)</li> <li>• Staff Paper on Rights Protection Mechanisms in the New gTLD Program: <a href="#">Revised Report</a>, September 2015 (“RPM Staff Paper”)</li> <li>• Metrics compiled on the new RPMs collected for the Competition, Consumer Trust and Consumer Choice Review: <a href="https://www.icann.org/resources/reviews/cct/metrics#rights%20protection%20mechanisms">https://www.icann.org/resources/reviews/cct/metrics#rights%20protection%20mechanisms</a></li> </ul>	
<b>Section II: Mission, Purpose, and Deliverables</b>		
<b>Mission &amp; Scope:</b>		

**Background**

The question of who legally has rights to, or is the legitimate holder of, a domain name can be open to dispute. In relation to domain name disputes concerning the registration and use of legally protected trademarks, the Uniform Dispute Resolution Policy (UDRP) is the longest standing alternative dispute resolution procedure. As a result of the 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, which included certain safeguards to protect registrants who engage in legitimate uses of domain names: the Uniform Rapid Suspension System (URS); the Trademark Clearinghouse (TMCH) and the associated availability through the TMCH of Sunrise periods and the Trademark Claims notification service; and the Post-Delegation Dispute Resolution Procedures (PDDRs).

Prior to the launch of the New gTLD Program, on 3 October 2011 ICANN staff had published a Final Issue Report on the current state of the UDRP. The recommended course of action in that UDRP Final Issue Report was not to initiate a PDP at the time, but to hold off launching any such PDP until after the new URS had been in operation for at least eighteen (18) months. In addition, the September 2015 revised RPM Staff Paper had explicitly noted that some of the concerns identified by the community for consideration as part of a review of the RPMs might be appropriate topics for policy development work.

The UDRP has not been subject to comprehensive review. There has also not been a full review of all the RPMs developed to date by ICANN, to consider whether or not they are collectively achieving the objectives for which they were created.

**Mission and Scope****(a) A Two-Phased Approach**

This PDP Working Group is being chartered to conduct a review of all RPMs in all gTLDs in two phases: Phase One will focus on a review of all the RPMs that were developed for the New gTLD Program, and Phase Two will focus on a review of the UDRP. , by the completion of its work, the Working Group will be expected to have also considered the overarching issue as to 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.

At a minimum, in each Phase of this PDP, the Working Group is expected to first assess the effectiveness of the relevant RPM(s), for which the Working Group should seek the input of experienced online dispute resolution providers and other subject matter experts, as may be appropriate. The Working Group should also consider the interplay between and complementary roles of each RPM in seeking to more fully understand their overall functioning and effectiveness.

In public comments to the UDRP Final Issue Report, the RPM Staff Paper and the Preliminary Issue Report for this PDP, various community groups and participants had identified a number of issues that they considered appropriate for review in a PDP. As such, and following its preliminary assessment of the effectiveness of the relevant RPM(s) in each phase of its work, the Working Group should consider the suggestions that have been made to date by the community regarding improvements or modifications to the RPM(s) in question. These community suggestions are attached to this Charter and they are intended to provide a framework and starting point for the PDP Working Group at the appropriate stage in its work, with further modifications, additions and deletions to be determined by consensus of the Working Group.

#### **(b) Coordination with Other Parallel Efforts**

In the course of its work, the Working Group should monitor the progress of and, where appropriate, coordinate with, other ICANN groups that are working on topics that may overlap with or otherwise provide useful input to this PDP. In particular, this PDP Working Group shall maintain a close working relationship with the Competition, Consumer Trust and Consumer Choice (CCT) Review Team and the PDP Working Group on New gTLDs Subsequent Procedures. To facilitate interaction between the two GNSO PDPs, a GNSO community liaison, who is a member of both PDP WGs, shall be appointed by both Working Groups as soon as both Groups have taken up their work. In addition, the RPM PDP Working Group should also take into consideration the work/outcome of the TMCH Independent Review, the CCT Review, and any other relevant GNSO policy development projects.

In addition to any flexibility provided by the GNSO Operating Procedures, Working Group Guidelines and the PDP Manual, the Working Group should, at the conclusion of Phase One of its work, assess the need for modification to this Charter and, if appropriate, submit a request to the GNSO Council accordingly for the subsequent phase(s) of its work.

In addition, the GNSO Council, as the manager of the policy development process, should be kept informed at all times about coordination efforts with the CCT Review Team and the PDP on New gTLD Subsequent Procedures. In case of conflict between these groups, the Council shall take appropriate action to align work processes if and when necessary.

#### **Objectives & Goals:**

In addition to an assessment of the effectiveness of each RPM, the PDP Working Group is expected to consider, at the appropriate stage of its work, the overarching issue as to 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. If such additional policy recommendations are needed, the Working Group is expected to develop recommendations to address the specific issues identified.

The Working Group is also directed to bear in mind that a fundamental underlying intention of conducting a review of all RPMs in all gTLDs is to create a framework for consistent and uniform reviews of these mechanisms in the future.

#### **Deliverables & Timeframes:**

<p>In addition to the PDP deliverables prescribed in the ICANN Bylaws and the PDP Manual, the Working Group shall provide a first Initial Report to the GNSO Council at the conclusion of Phase One of the PDP. The Report shall be put out for public comment and also inform the GNSO Council about the progress of the Working Group. At a minimum, the Report shall outline the Working Group’s progress and any preliminary recommendations it may have developed with regard to its work in Phase One. The first Initial Report shall also highlight any relevant findings, information or issues that may have emerged during Phase One and any issues or recommendations that the Group believes should be considered by the PDP Working Group on New gTLD Subsequent Procedures, and/or that the Working Group considers relevant to its work in Phase Two.</p> <p>Phase Two of the PDP Working Group shall focus primarily on the review of the UDRP. However, during this Phase the Working Group is also expected to review its first Initial Report, taking into account public comments received, and/or feedback submitted from the New gTLD Subsequent Rounds PDP or other ongoing efforts. Before concluding its work the Working Group shall take into account any relevant developments from the New gTLD Subsequent Rounds PDP WG and/or other relevant ICANN review or policy development work. The Working Group’s second Initial Report shall be completed and published for public comment, as per the PDP Manual. The Working Group shall then review all comments, complete its Final Report and submit it, as per the PDP Manual, to the GNSO Council for its consideration and further action.</p>
<p><b>Section III: Formation, Staffing, and Organization</b></p>
<p><b>Membership Criteria:</b></p>
<p>TBD</p>
<p><b>Group Formation, Dependencies, &amp; Dissolution:</b></p>
<p>TBD</p>
<p><b>Working Group Roles, Functions, &amp; Duties:</b></p>
<p>TBD</p>
<p><b>Statements of Interest (SOI) Guidelines:</b></p>
<p>If a Working Group is formed, each member of its will be required to submit a SOI in accordance with Section 5 of the GNSO Operating Procedures.</p>
<p><b>Section IV: Rules of Engagement</b></p>
<p><b>Decision-Making Methodologies:</b></p>
<p>The PDP Working Group will be expected to adhere to the rules in the GNSO PDP Manual and Working Group Guidelines.</p>
<p><b>Status Reporting:</b></p>
<p>At a minimum, the Working Group should provide periodic updates at appropriate intervals to the GNSO Council, including a first Initial Report at the conclusion of Phase One of its work, and a second Initial Report upon the conclusion of Phase Two (as described above).</p>
<p><b>Problem/Issue Escalation &amp; Resolution Processes:</b></p>
<p>These are expected to be resolved in accordance with the procedures in the GNSO’s Working Group Guidelines.</p>

<b>Closure &amp; Working Group Self-Assessment:</b>			
If a Working Group is formed it will close upon the delivery of a Final Report, unless assigned additional tasks or follow-up by the GNSO Council. A self-assessment of its work will be carried out following the conclusion of the WG's work.			
<b>Section V: Charter Document History</b>			
<b>Version</b>	<b>Date</b>	<b>Description</b>	
1.0			
<b>Staff Contact:</b>	Lars Hoffmann, Mary Wong	<b>Email:</b>	<a href="mailto:Policy-Staff@icann.org">Policy-Staff@icann.org</a>

<b>Translations: If translations will be provided please indicate the languages below:</b>											

#### **ATTACHMENT – LIST OF POTENTIAL ISSUES FOR CONSIDERATION IN THIS PDP<sup>128</sup>**

The issues that are listed here reflect the suggestions that have been made to date by the community regarding improvements or modifications to the RPM(s) in question and should form part of the discussions of the PDP Working Group. The Working Group may decide to address all, some or even additional issues to these.

#### **General:**

- Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?
- Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs, and if so what are the transitional issues that would have to be dealt with as a consequence?
- Whether, and if so to what extent, changes to one RPM will need to be offset by concomitant changes to the others

<sup>128</sup> As the list was derived from various community suggestions in different forums, they are not listed in any particular order of importance nor has staff attempted to analyze the merits, relevance or significance of each issue.

**Potential issues concerning the UDRP:**

- Are the UDRP's current appeal mechanisms sufficient?
- Should there be a limit to the time period allowed (e.g. similar to a statute of limitation) for bringing UDRP complaints?
- Are free speech and the rights of non-commercial registrants adequately protected in the existing policy?
- Should there be a formal (mandatory) mechanism of early mediation?
- Are the current time limits of the UDRP (for filing, response, determinations and appeals) adequate?
- Should there be rules for the appointment of UDRP panels, such as formalized rotations?
- Under what circumstances (if any) should/could UDRP proceedings be anonymized?
- Should there be clearer policy guidance on a registrar's obligations if a case is stayed or suspended?
- Should the possibility of laches be recognized in UDRP proceedings; if so, how can this be expressly addressed?
- Should "or" be introduced instead of "and" in the bad faith requirements?
- Should there be an introduction of a "loser-pays" scenario?
- Should monetary damages be awarded? The UDRP (unlike court proceedings) does not allow this, but there are examples of ccTLD registries now applying monetary damages
- Should the relevant time periods be reduced?
- Should filing fees be lower?
- Should injunctive relief be available?
- Should there be a bad-faith presumption for repeat/serial offenders?
- Should repeat/serial offenders be blacklisted from new registrations?
- Should permanent suspension be added as an additional potential remedy under the UDRP?
- How should the privacy and proxy services which are now frequently used by registrants to shield their identity be more efficiently removed in the course of a UDRP proceeding?
- Should the UDRP be revised to cover challenges to trademark-infringing content even in the absence of trademark infringement in the domain name? Should a failure to respond result in an automatic default victory for the complainant?
- Should a failure to maintain an active credit card with the registrar in order to fulfil any "loser pays" obligations result in an automatic default victory for the complainant?
- Does there need to be a severe penalty to deter Reverse Domain Name Hijacking attempts?
- Major UDRP decisions of 2011-2015 should be taken into account.
- Should the term "free speech and the rights of non-commercial registrants" be expanded to include "free speech, freedom of expression and the rights of non-commercial registrants" to include rights under US law and the United Nations' Universal Declaration of Human Rights?
- Are the critical concepts of "fair use" and "fair dealing" fully and accurately reflected in the UDRP (and also URS and TMCH rules)?

- Are generic dictionary words being adequately protected so that they are available for all to use as allowed under their national laws and international treaties? E.g. sun, windows.
- Are last names and geographic places adequately protected so that they are available for all to use as allowed under their national laws, e.g. Smith, McDonald, Capitol Hill Cafe, Old Town Deli?
- Now that Reverse Domain Name Hijacking is a regular finding of UDRP panels, indicating that domain name registrants are being abused by complaints brought against them in the UDRP process, what penalties and sanctions should be imposed on Complainants found to be reverse domain name hijackers? How can those penalties and sanctions be aligned so as to be fair, as compared to the loss of a domain name taken from a registrant found to be a “cybersquatter”?
- Are free speech, freedom of expression and the rights of non-commercial registrants uniformly protected in the existing UDRP (and URS and TMCH) policies and their implementation procedures? As currently phrased, the “potential issue” asks if it is “adequately protected,” but where we find differences among Panelists of different countries, we should ask if free speech is “adequately and uniformly protected” – as equity and fairness lies in both.
- Should defenses be expanded, e.g., as seen in Nominet's policy and the URS?

**Potential issues concerning the URS:**

- Should the ability for defaulting respondents in URS cases to file a reply for an extended period (e.g. up to one year) after the default notice, or even after a default determination is issued (in which case the complaint could be reviewed anew) be changed?
- Is the URS’ ‘clear and convincing’ standard of proof appropriate?<sup>129</sup>
- Is there a need to develop express provisions to deal with ‘repeat offenders’ as well as a definition of what qualifies as ‘repeat offences’?
- Should the URS allow for additional remedies such as a perpetual block or other remedy, e.g. transfer or a “right of first refusal” to register the domain name in question?
- Is the current length of suspension (to the balance of the registration period)<sup>130</sup> sufficient?
- Is the cost allocation model for the URS appropriate and justifiable?
- Should there be a loser pays model? If so, how can that be enforced if the respondent does not respond?
- Should the Response Fee applicable to complainants listing 15 or more disputed domain names by the same registrant be eliminated?<sup>131</sup>
- Has ICANN done its job in training registrants in the new rights and defenses of the URS?
- Are the expanded defenses of the URS being used and if so, how, when, and by whom?

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<sup>129</sup> See Section 8.2 of the [URS Procedure](#)

<sup>130</sup> See Section 14 of the [URS Rules](#)

<sup>131</sup> See Section 2 of the [URS Procedure](#)



- What sanctions should be allowed for misuse of the URS by the trademark owner?
- What evidence is there of problems with the use of the English-only requirement of the URS, especially given its application to IDN New gTLDs?
- How can the appeals process of the URS be expanded and improved?

**Potential issues concerning Trademark Claims:**

- Should the Trademark Claims period be extended beyond ninety (90) days?
- Should the Trademark Claims period continue to apply to all new gTLDs?
- Should the Abused Domain Name Label service be continued?
- Does a Trademark Claims period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?
- Is the protection of the TMCH too broad?
- Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services? Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
- Is the TMCH and the Sunrise Period allowing key domain names to be cherry-picked and removed from New gTLDs unrelated to those of the categories of goods and services of the trademark owner (e.g., allowing “Windows” to be removed from a future .CLEANING by Microsoft)?
- How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
- How can TMCH services be much more transparent in terms of what is offered for ICANN pursuant to ICANN contracts and policies vs. what services are offered to private New gTLD registries pursuant to private contract?

**Potential issues concerning the Sunrise Period:**

- Should the availability of Sunrise registrations only for “identical matches” (e.g. without extra generic text) be reviewed?
- Is the notion of “premium names” relevant to a review of RPMs, and, if so, should it be defined across all gTLDs?
- Following from Question 2, should there be a mechanism to challenge whether a domain is a ‘premium name’?
- Should there be a specific policy about the reservation and release of “reserved names” (e.g. modification of Section 1.3.3 of Specification 1 of the current Registry Agreement)?
- Should there be a public, centralized list of all reserved trademarks for any given Sunrise period?
- Should holders of TMCH-verified trademarks be given first refusal once a reserved name is released?
- Should Sunrise periods continue to be mandatory? If so, should the current requirements apply or should they be more uniform, such as a 60-day end-date period?

- Whether and how to develop a mechanism by which trademark owners can challenge Sunrise pricing practices that flout the purpose of Sunrise
- Whether more can be done to improve transparency and communication about various Sunrise procedures

**Potential issues concerning the Trademark Clearing House (TMCH):**

- Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
- Should further guidance on the TMCH verification guidelines for different categories of marks be considered?
- Should the TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?
- Should notices to the trademark owner ought to be sent before the domain is registered?

**Additional Questions and Issues**

- Do the RPMs work for registrants and trademark holders in other scripts/languages, and should any of them be further "internationalized" (such as in terms of service providers, languages served)?
- Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?
- Have there been abuses of the RPMs that can be documented and how can these be addressed?
- Is there a policy-based need to address the goal of the Trademark PDDRP?
- Are the processes being adopted by Providers of UDRP, URS, and TMCH services fair and reasonable?
- Are the Providers' procedures fair and equitable for all stakeholders and participants?
- Are the Providers consulting with all stakeholders and participants in the evaluation, adoption and review of these new procedures?
- Are the Providers training both the Complainants and the Respondents, and their communities and representatives, fairly and equally in these new procedures?
- Are Providers exceeding the scope of their authority in any of the procedures they are adopting?
- Is ICANN reaching out properly and sufficiently to the multi-stakeholder community when such procedures are being evaluated by ICANN at the Providers' request? Is this an open and transparent process?
- What remedies exist, or should exist, to allow questions about new policies by the Providers offering UDRP, URS and TMCH services, and how can they be expeditiously and fairly created?
- What changes need to be made to ensure that procedures adopted by providers are consistent with the ICANN policies and are fair and balanced?
- Examine the protection of country names and geographical indications, and generally of indications of source, within the RPMs

- In the light of concrete cases (case law) and from the perspective of owners of protected signs and of marks, which are the identified deficits of the RPMs?
- Assess the benefit of the Arbitration Forums self-reviews, including the *WIPO Advanced Workshop on Domain Name Dispute Resolution, May 2015* [italics in original], in which inconsistencies of decisions, including in the free speech/freedom of expression area were candidly discussed and contemplated
- Are recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?
- Are there any barriers that can prevent an end user to access any or all RPMs?
- How can costs be lowered so end users can easily access RPMs?

## 8 Annex B – Charter Questions

### 8.1 Introduction

The Working Group Charter that the GNSO Council approved contains a list of specific topics and questions that were reproduced verbatim from previous ICANN community consultations on the topic of RPMs.<sup>132</sup> This led to the Working Group agreeing, early on in its Phase 1 work, that it would first need to refine these original Charter questions so as to clarify their intent and ensure that the PDP discussions remain objective and neutral.

The Working Group used the Sub Team approach to conduct an initial refinement of most of the original Charter questions. The final lists of refined Charter questions for these RPMs reflect the initial Sub Team’s work as well as subsequent Working Group discussion on an agreed approach. For the URS, the Working Group agreed to apply standard high-level questions to frame the discussions; as such, there are no final agreed Charter questions for the URS.

In working through data analysis and in-depth discussions, the Working Group agreed that addressing all the topics covered by the original Charter questions did not require specific answers being prepared for all the final agreed Charter questions. In general, the Working Group believes that it has addressed all the specific issues raised by those original Charter questions relating to each of the Phase 1 RPMs via its data analysis and discussions, and its conclusions are reflected in the final recommendations included in this Final Report. The Working Group also believes that it has taken into account the public comments in response to its overarching charter questions when finalizing its Phase 1 final recommendations.

The Working Group did not conduct any formal consensus call on the responses to and conclusions for its Charter questions. However, these responses and conclusions did receive the support of the Working Group for publication in the Final Report. Where applicable, the Working Group has noted where positions within the Working Group differ.

### 8.2 Overarching Charter Questions

The Working Group’s Charter includes several general, overarching questions as well as a number of additional questions that the Working Group is expected to address at the conclusion of Phase 1 or Phase 2 of its work, as appropriate. During the public comment proceeding for its Initial Report, the Working Group invited input for three (3) general and three (3) additional overarching Charter questions.<sup>133</sup>

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<sup>132</sup> The Charter of the PDP Working Group is included in the “Annex A - PDP Working Group Charter” section of this Final Report. It can also be downloaded here: [https://gns0.icann.org/sites/default/files/filefield\\_48755/rpm-charter-15mar16-en.pdf](https://gns0.icann.org/sites/default/files/filefield_48755/rpm-charter-15mar16-en.pdf)

<sup>133</sup> There were other Additional Questions in the original PDP Charter that were subsumed into the Working Group’s discussions over specific RPMs and, as such, these have not been reproduced here.

The Working Group noted the difference between the general overarching Charter questions and the additional overarching Charter questions. The general overarching Charter questions in this section are questions that were reviewed and drafted by the GNSO Council specifically for the Working Group's consideration. The additional overarching Charter questions are the few community questions obtained from prior work on the RPMs which the GNSO Council included, unchanged, in the PDP Charter for the Working Group to refine. The Working Group considered these additional overarching Charter questions during their deliberations but did not further refine or modify them.

The Working Group took the public comments received into account when finalizing its Phase 1 final recommendations, as well as documented its conclusions in addressing these overarching Charter questions (see below).

**General Overarching Charter Question #1**

Do the RPMs collectively fulfill the objectives for their creation, namely "to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?

**Working Group Conclusion:**

Throughout its deliberations of the Phase 1 RPMs, the Working Group was aware of the need to ensure that the RPMs should collectively fulfill the objectives for their creation. Members held a variety of opinions and positions regarding the need for and extent of any changes to the RPMs; the range of views was largely reflected in the public comments.<sup>134</sup> The Working Group believes that its final recommendations pertaining to the TMCH, Sunrise, Trademark Claims, TM-PDDRP, and URS will improve the Phase 1 RPMs such as to enable fulfillment of the objectives for their creation.

**General Overarching Charter Question #2**

**2a.** Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs?

**2b.** If so, what are the transitional issues that would have to be dealt with as a consequence?

**Working Group Conclusion:**

The Working Group agreed that the URS and TM-PDDRP are the only possible new gTLD RPMs that could be candidates for Consensus Policies (it means that ICANN org automatically applies these mechanisms to all Contracted Parties, including legacy TLDs, by way of a general provision about Consensus Policies in their contracts). One Working Group member noted that the Trademark Claims service, in theory, could also apply to legacy TLDs in some capacity.

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<sup>134</sup> See details in the public comment review tool for the General Overarching Charter Question #1 here: <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhviOskAILVraWp-88mqzScCti01fw/edit#gid=872694278>

However, the Working Group discussion of this charter question centered on the URS. Throughout its deliberations of the Phase 1 RPMs, the Working Group had extensive debate about whether the URS should become a Consensus Policy and sought public comments, but it was unable to reach a conclusion.

During the review of public comments for the General Overarching Charter Question #2, the Working Group noted that most comments focused on the URS and mirrored the public comments for URS Individual Proposal #31, which specifically asked the question whether the URS should become an ICANN Consensus Policy.<sup>135</sup> While the Working Group recognized that many large organizations supported the URS becoming an ICANN Consensus Policy, and many individuals opposed this idea, it agreed that public comments did not offer any definitive position but clearly reflected the divergence of positions held by the various interest parties within the Working Group.

In summary, the arguments supporting the URS becoming a Consensus Policy include but not limited to:

- Among the legacy gTLDs that have renewed their Registry Agreement with ICANN org, only .com and .net do not have the URS included in their contract with ICANN; Verisign, the Registry managing .com and .net, advocates for the URS becoming a Consensus Policy.<sup>136</sup>
- The URS in practice has proven viable, efficacious, and fit-for-purpose as a rapid suspension remedy for clear-cut instances of protected mark abuse.
- Since the vast majority of domain registrations and abuses are occurring in legacy gTLDs and not new gTLDs, extending the URS to legacy TLDs will help address DNS abuse, such as trademark infringement, cybersquatting, phishing, pharming, and malware spreading which often use a trademark or facsimile in the domain name as a vector to accomplish.
- The URS is currently the best rapid suspension remedy and complements the UDRP, which often takes a long time to transfer the disputed domain and resolve the issue of abuse.
- There is no substantial evidence that the URS has been abused or applied improperly; there is no evidence that the URS would be used for concerted widespread harassment of registrants, as its remedy is suspension and not transfer of the domain name.

The arguments against the URS becoming a Consensus Policy include but not limited to:

- It is premature to consider this question without knowing the final features of the URS, as the question is silent on whether the URS would maintain its current form, or undergo certain unspecified changes pending ICANN Board approval of the Working Group final recommendations.
- The URS was designed to narrowly focus on new gTLDs; it is not intended for legacy gTLDs.
- The URS has not been frequently used compared to the UDRP.

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<sup>135</sup> See the full text of the URS Individual Proposal #31 on p.67 of the Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>136</sup> The legacy TLDs that have renewed their contract with ICANN and included URS in their Registry Agreements did so through the bilateral contractual negotiation with ICANN org. As of the publication of this Final Report, three remaining legacy gTLDs (i.e., .aero, .name, .post) have not yet renewed their contracts with ICANN org and, as such, are not currently obligated to implement the URS.

- Adopting URS for legacy TLDs would be a non-trivial undertaking, impacting millions of domains under legacy TLDs; it may open the possibility of abuses by trademark owners and increase undue burdens for registrants.<sup>137</sup>
- The URS is not ready for prime time; it needs more robust procedures and improvements.

Public comments provide additional details of these diverging positions, which also reflect Working Group members' views.<sup>138</sup>

The Working Group agreed that the GNSO Council should take into account these issues and concerns during its chartering efforts for the RPM PDP Phase 2, with the consideration of DNS abuse and relationship/interoperability between the URS and UDRP.<sup>139</sup> Some Working Group members suggested that while a number of Phase 1 recommendations seek to enhance the URS in an incremental manner, Phase 2 can potentially discuss "deeper questions" related to the URS to develop meaningful improvements.

### **General Overarching Charter Question #3**

**3a.** Will changes to one RPM need to be offset by concomitant changes to the others?

**3b.** If so, to what extent?

### **Working Group Conclusion:**

Throughout its deliberations of the Phase 1 RPMs, the Working Group was aware that changes to one RPM might require concomitant changes to one or more of the other RPMs. The Working Group reviewed all the Phase 1 RPMs individually and, where relevant, considered the functions and operations of one RPM in relation to other RPM(s). The Working Group also took into account the public comments received on this question.<sup>140</sup> The Working Group believes that its final recommendations collectively comprise a balanced package of needed clarifications and largely operational improvements to the Phase 1 RPMs.

### **Additional Overarching Charter Question #1**

Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?

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<sup>137</sup> Some Working Group members expressed this view based on their observations of Reverse Domain Name Hijacking and unjustified UDRP Complaints pertaining to domains in legacy TLDs

<sup>138</sup> See details in the public comment review tool for the General Overarching Charter Question #2 here: [https://docs.google.com/spreadsheets/d/1QQt\\_m5qdzoalRDclUED01ur-yJgODCex8bj\\_-aKO7fl/edit#gid=1207319881](https://docs.google.com/spreadsheets/d/1QQt_m5qdzoalRDclUED01ur-yJgODCex8bj_-aKO7fl/edit#gid=1207319881); see details in the public comment review tool for the URS Individual Proposal #31 here: [https://docs.google.com/spreadsheets/d/1QQt\\_m5qdzoalRDclUED01ur-yJgODCex8bj\\_-aKO7fl/edit#gid=1207319881](https://docs.google.com/spreadsheets/d/1QQt_m5qdzoalRDclUED01ur-yJgODCex8bj_-aKO7fl/edit#gid=1207319881)

<sup>139</sup> One Working Group member recommended the studies by Richard Roberts at the University of Maryland on what types of domain names are associated with phishing/similar spoofing: [https://www.cs.umd.edu/~ricro/research/publications/ccs19\\_te.pdf](https://www.cs.umd.edu/~ricro/research/publications/ccs19_te.pdf)

<sup>140</sup> See details in the public comment review tool for the General Overarching Charter Question #3 here: <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhvIOskAILVraWp-88mqzScCti01fw/edit#gid=1146484806>

**Working Group Conclusion:**

The need for registrant protections was highlighted during the Working Group's deliberations, and concerns raised by some Working Group members are reflected in the views received in public comments.<sup>141</sup> The Working Group took these concerns into account in finalizing its recommendations pertaining to the TMCH, Sunrise, Trademark Claims, TM-PDDRP, and URS. Although it discussed all proposals received, the Working Group recognizes that its final recommendations may not necessarily address all the registrant protection issues highlighted by members and commenters, as some of the proposals did not achieve consensus among the Working Group members.

**Additional Overarching Charter Question #2**

Is the recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?

**Working Group Conclusion:**

The Working Group noted that, in addition to being text that the GNSO Council included without review or amendment in the PDP Charter, this Additional Overarching Question was submitted before the completion of the community's work on accountability mechanisms in relation to the IANA Stewardship Transition. On 7 November 2019, the ICANN Board approved the Cross Community Working Group on Enhancing ICANN Accountability (CCWG-Accountability) Work Stream 2 Final Report, which contains recommendations for a Framework of Interpretation for Human Rights. As a result, "respect for internationally recognized human rights" is now a Core Value enshrined in the ICANN Bylaws.<sup>142</sup>

The Working Group agreed that all PDP recommendations should be guided by ICANN's Core Values, including human rights considerations. Throughout the Working Group's Phase 1 deliberations, consideration of fundamental human rights such as freedom of expression, due process, the right to property, and the rights to benefit from moral and material interests in intellectual creations were woven into its discussions and development of policy recommendations. The Working Group noted that many public comments also highlighted the need for human rights considerations to be incorporated into the RPM PDP.<sup>143</sup>

**Additional Overarching Charter Question #3**

How can costs be lowered so end users can easily access RPMs?

<sup>141</sup> See details in the public comment review tool for the Additional Overarching Charter Question #1 here: <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhviOskAILVraWp-88mqzScCti01fw/edit?pli=1#gid=1488206926>

<sup>142</sup> See the ICANN Board resolution approving the CCWG-Accountability Work Stream 2 Final Report here: <https://features.icann.org/ccwg-accountability-ws2-%E2%80%93-final-report>

<sup>143</sup> See details in the public comment review tool for the Additional Overarching Charter Question #2 here: <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhviOskAILVraWp-88mqzScCti01fw/edit?pli=1#gid=117855811>



**Working Group Conclusion:**

While the Working Group noted the underlying concerns with respect to registrants' access to RPMs in the Global South, it agreed that public comments have not raised any new or material perspectives, facts, or solutions which the Working Group had not considered in making its recommendations.<sup>144</sup> Therefore, the Working Group decided not to develop any additional recommendation to address the issue of costs to access RPMs.

## 8.3 Uniform Rapid Suspension System (URS) High Level Questions & Review Topics

The Working Group agreed that its review of the URS would be based on the following list of high-level framing questions and specific topics.

High Level Questions
<ol style="list-style-type: none"> <li>1. Has it been used? Why or why not?</li> <li>2. What was the original purpose and is it being fulfilled?</li> <li>3. Bearing in mind the original purpose, have there been any unintended consequences?</li> <li>4. What changes could better align the mechanism with the original purpose/facilitate it to carry out its purpose?</li> <li>5. What was the ultimate outcome?</li> </ol>
URS Review Topic
<p>A. <u>THE COMPLAINT:</u></p> <ol style="list-style-type: none"> <li>1. Standing to file</li> <li>2. Grounds for complaint</li> <li>3. Limited filing period</li> <li>4. Administrative review</li> </ol>
<p>B. <u>THE NOTICE OF COMPLAINT:</u></p> <ol style="list-style-type: none"> <li>1. Receipt by Registrant</li> <li>2. Effect on Registry Operator</li> </ol>
<p>C. <u>THE RESPONSE:</u></p> <ol style="list-style-type: none"> <li>1. Duration of response period</li> <li>2. Response fee</li> <li>3. Other issues (e.g. default procedures)</li> </ol>
<p>D. <u>STANDARD OF PROOF:</u></p> <ol style="list-style-type: none"> <li>1. Standard of proof</li> </ol>

<sup>144</sup> See details in the public comment review tool for the Additional Overarching Charter Question #3 here: <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhvIOskAILVraWp-88mqzScCti01fw/edit?pli=1#gid=1771837429>

<p>E. <u>DEFENSES</u>:</p> <ol style="list-style-type: none"> <li>1. Scope of defenses</li> <li>2. Unreasonable delay in filing complaint</li> </ol>
<p>F. <u>REMEDIES</u>:</p> <ol style="list-style-type: none"> <li>1. Scope of remedies</li> <li>2. Duration of suspension period</li> <li>3. Review of implementation of current remedies</li> </ol>
<p>G. <u>APPEAL</u>:</p> <ol style="list-style-type: none"> <li>1. Appeal process</li> </ol>
<p>H. <u>POTENTIALLY OVERLAPPING PROCESS STEPS</u>:</p> <ol style="list-style-type: none"> <li>1. Potential overlap concerning duration of respondent appeal, review and extended reply periods along the URS process timeline</li> </ol>
<p>I. <u>COST</u>:</p> <ol style="list-style-type: none"> <li>1. Cost allocation model</li> </ol>
<p>J. <u>LANGUAGE</u>:</p> <ol style="list-style-type: none"> <li>1. Language issues, including current requirements for complaint, notice of complaint, response, determination</li> </ol>
<p>K. <u>ABUSE OF PROCESS</u>:</p> <ol style="list-style-type: none"> <li>1. Misuse of the process, including by trademark owners, registrants and “repeat offenders”</li> <li>2. Forum shopping</li> <li>3. Other documented abuses</li> </ol>
<p>L. <u>EDUCATION &amp; TRAINING</u>:</p> <ol style="list-style-type: none"> <li>1. Responsibility for education and training of complainants, registrants, registries and registrars</li> </ol>
<p>M. <u>URS PROVIDERS</u>:</p> <ol style="list-style-type: none"> <li>1. Evaluation of URS providers and their respective processes</li> </ol>
<p>N. <u>ALTERNATIVE(S) TO THE URS</u>:</p> <ol style="list-style-type: none"> <li>1. Possible alternative(s) to the URS, e.g. summary procedure in the UDRP</li> </ol>

## 8.4 Trademark Clearinghouse (TMCH) Final Agreed Charter Questions & Proposed Answers

To facilitate the review of the TMCH structure and scope, the Working Group’s TMCH Charter Questions Sub Team proposed that the original TMCH-related Charter questions be placed in specific categories to facilitate deliberations.

Question #	Final Agreed Charter Question	Proposed Answer
<b>Category 1: Education</b>		
<b>TMCH Question #1</b>	Is the TMCH clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about recordals in the TMCH?	The Working Group considered this question but did not reach a conclusion.
<b>TMCH Question #2</b>	Should the TMCH be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the TMCH is not to be responsible, who should be?	The Working Group discussed this question and agreed to include the TMCH Individual Proposal #1, which argued that the TMCH should be responsible for educating rights-holders, domain name registrants, and potential registrants the services it provides, in the Initial Report for public comment.
<b>TMCH Question #3</b>	What information on the following aspects of the operation of the TMCH is available and where can it be found? (a) TMCH services; (b) Contractual relationships between the TMCH providers and private parties; and (c) With whom does the TMCH share data and for what purposes?	Deloitte, the TMCH Validation Provider, provided information with respect to this question on 26 January 2017 (see Deloitte's response on this document in the footnote). <sup>145</sup> The Working Group concluded that no additional policy recommendation needs to be developed on this topic.
<b>Category 2: Verification &amp; Updating of TMCH Database</b>		
<b>TMCH Question #4</b>	Should the verification criteria used by the TMCH to determine if a submitted mark meets the	The Working Group considered this question but did not reach a conclusion.

<sup>145</sup> Deloitte's response:

<https://community.icann.org/download/attachments/64066042/Deloitte%20responses%20to%20TMCH%20Data%20Gathering%20Sub%20Team%20questions%20-%20Jan%202017.docx?version=1&modificationDate=1485897782000&api=v2>

Question #	Final Agreed Charter Question	Proposed Answer
	eligibility and other requirements of the TMCH be clarified or amended? If so how?	
<b>TMCH Question #5</b>	Should there be an additional or a different recourse mechanism to challenge rejected submissions for recordals in the TMCH?	The Working Group considered this question but did not reach a conclusion.
<b>TMCH Question #6</b>	How quickly can and should a cancelled trademark be removed from the TMCH Database?	The Working Group considered this question but did not reach a conclusion.
<b>Category 3: Breadth &amp; Reach (Scope)</b>		
<b>TMCH Question #7</b>	How are design marks currently handled by the TMCH Validation Provider?	Deloitte, the TMCH Validation Provider, provided information with respect to this question on 5 March 2017 (see Deloitte's response to Q6 on this document in the footnote). <sup>146</sup> In light of Deloitte's response, the Working Group agreed to include TMCH Individual Proposals #2 and #3 in the Initial Report for public comment.
<b>TMCH Question #8</b>	How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH Validation Provider?	Deloitte, the TMCH Validation Provider, provided information with respect to this question on 5 March 2017 (see Deloitte's response to Q7 on this document in the footnote). <sup>147</sup> In light of Deloitte's response, the Working Group agreed to include TMCH Individual Proposals #4 and #5 in the Initial Report for public comment.
<b>TMCH Question #9</b>	Should the TM+50 be retained as is, amended or removed?	In the absence of wide support for a change to the status quo, the Working Group

<sup>146</sup> Deloitte's response to Q6:

<https://community.icann.org/download/attachments/64066042/Deloitte%20Responses%20to%20Follow%20Up%20Questions.pdf?version=1&modificationDate=1493341766000&api=v2>

<sup>147</sup> Deloitte's response to Q7:

<https://community.icann.org/download/attachments/64066042/Deloitte%20Responses%20to%20Follow%20Up%20Questions.pdf?version=1&modificationDate=1493341766000&api=v2>

Question #	Final Agreed Charter Question	Proposed Answer
		recommends that the TM +50 should be retained as is.
<b>TMCH Question #10</b>	Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?	In the absence of wide support for a change to the status quo, the Working Group ultimately recommends that the current TMCH matching rules should be maintained, noting that members of the Working Group had diverging opinions on this matter.
<b>TMCH Question #11</b>	Should the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected.	The Working Group had diverging opinions on this matter and in the absence of wide support for a change to the status quo, the Working Group agreed that the scope of the RPMs associated with the TMCH should not be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected.
<b>Category 4: Costs &amp; Other Fundamental Features</b>		
<b>TMCH Question #12</b>	Are there concerns about operational considerations (such as cost, reliability, global reach, service diversity and consistency) due to the TMCH Database being provided by a single Provider? If so, how may they be addressed?	Some Working Group members had concerns about the operational considerations due to the TMCH Database being provided by a single provider (i.e, IBM). The Working Group agreed to include the TMCH Individual Proposal #6 in the Initial Report for public comment.
<b>TMCH Question #13</b>	Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the community and ICANN?	The Working Group considered this question but did not reach a conclusion.
<b>Category 5: Access &amp; Accessibility</b>		
<b>TMCH Question #14</b>	How accessible is the TMCH Database and RPM Rights Protection Actions and Defenses to individuals, organizations and rights-holders; as well as	The Working Group considered this question but did not reach a conclusion.

Question #	Final Agreed Charter Question	Proposed Answer
	trademark agents in developing countries?	
<b>TMCH Question #15</b>	What concerns are being raised about the TMCH Database being confidential, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain confidential or become open?	The Working Group had diverging opinions on whether the TMCH Database should remain confidential or become open. The Working Group agreed to include the TMCH Individual Proposal #7, which advocated for an open and searchable TMCH Database, in the Initial Report for public comment. The Working Group also agreed to include the opposing opinions on the proposal and the reasons for having/keeping the TMCH Database private.
<b>TMCH Question #16</b>	Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the rights of non-trademark registrants?	The Working Group ultimately concluded that the current balance between the rights of trademark holders and the rights of non-trademark registrants, as reflected in the scope of the TMCH and the protection mechanisms which flow from it, be maintained, noting that members of the Working Group had diverging opinions on this matter.

## 8.5 Sunrise Service Final Agreed Charter Questions & Proposed Answers

Question #	Final Agreed Charter Question	Proposed Answer
<b>Sunrise Preamble Question</b>	<b>Preamble Q(a):</b> Is the Sunrise Period serving its intended purpose?	The Working Group noted that the intended purpose for Sunrise service is as follows: Sunrise services allow trademark holders an advance opportunity to register domain names corresponding to their marks before names are generally available to the public. <sup>148</sup> The Working Group generally agreed that the Sunrise Period is serving its intended purpose as stated previously.

<sup>148</sup> See <https://newgtlds.icann.org/en/about/trademark-clearinghouse/faqs>

Question #	Final Agreed Charter Question	Proposed Answer
	<b>Preamble Q(b):</b> Is it having unintended effects?	The Working Group generally agreed that the Sunrise Period is having unintended effects. However, the Working Group was uncertain about the scope and extent of the unintended effects.
	<b>Preamble Q(c):</b> Is the TMCH Validation Provider requiring appropriate forms of “use” (if not, how can this be corrected)?	The Working Group generally agreed that the TMCH Validation Provider is requiring appropriate forms of proof of use, according to the enumerated rules (i.e., Section 2.2.3 of the TMCH guidelines). <sup>149</sup>
	<b>Preamble Q(d):</b> Have abuses of the Sunrise Period been documented by trademark owners?	The Working Group interpreted these questions as follows: “Have abuses of the Sunrise Period been documented?”
	<b>Preamble Q(e):</b> Have abuses of the Sunrise Period been documented by Registrants?	The Working Group generally agreed that the Sunrise Period is having unintended effects, but was uncertain about the extent and scope of abuses of the Sunrise Period.
	<b>Preamble Q(f):</b> Have abuses of the Sunrise Period been documented by Registries and Registrars?	
<b>Sunrise Question #1</b>	<b>Q1(a):</b> Should the availability of Sunrise registrations only for identical matches be reviewed?	The Working Group ultimately concluded that the availability of Sunrise registrations only for identical matches should be maintained, noting that members of the Working Group had diverging opinions on this matter.
	<b>Q1(b):</b> If the matching process is expanded, how can Registrant free expression and fair use rights be protected and balanced against trademark rights?	Since the Working Group ultimately concluded that the availability of Sunrise registrations only for identical matches should be maintained, the Working Group did not consider this question in detail.
<b>Sunrise Question #2</b>	<b>Q2 Threshold:</b> Is Registry pricing within the scope of the RPM Working Group or ICANN's review?	The Working Group had diverging opinions on whether registry pricing is within the scope of the RPM PDP Working Group. Some Working Group members pointed to the

<sup>149</sup> See Section 2.2.3 of the TMCH guidelines on pages 8-10 here: [https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.0%20\\_1.pdf](https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.0%20_1.pdf)

Question #	Final Agreed Charter Question	Proposed Answer
		Registry Agreements that state that registry pricing is not within the scope of the RPM Working Group due to the picket fence. <sup>150</sup> Specifically, Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement respectively specify that Consensus Policies shall not prescribe or limit the price of Registry Services and Registrar Services. <sup>151</sup> However, some Working Group members expressed concerns about the interplay of Registry pricing with RPMs obligations, which are discussed further in the proposed answer to Q2(a)-(b).
	<b>Q2(a):</b> Do Registry Sunrise or Premium Name pricing practices unfairly limit the ability of trademark owners to participate during Sunrise?	The Working Group generally agreed that some Registry Sunrise or Premium Name pricing practices have limited the ability of some trademark owners to participate during Sunrise. <sup>152</sup> The Working Group is aware of cases where the Registry Operator practices may have unfairly limited the ability of some trademark owners to participate during Sunrise, when pricing set for the trademark

<sup>150</sup> **Picket Fence:** In its original agreements with ICANN, registries and registrars agreed to comply with “consensus” policies adopted by ICANN provided (i) that such policies did not unreasonably restrain competition and (ii) that the policies related to: 1) issues for which uniform or coordinated resolution is reasonably necessary to facilitate interoperability, technical reliability and/or stable operation of the Internet or domain-name system; 2) registry policies reasonably necessary to implement Consensus Policies relating to registrars; and 3) resolution of disputes regarding the registration of domain names (as opposed to the use of such domain names), and do not unreasonably restrain competition. ICANN’s policy making mission, as described previously, creates a “picket fence” around ICANN’s authority -- ICANN can only mandate registry and registrar compliance with policies affecting issues inside the “picket fence”; ICANN could establish policy and/or best practices affecting issues outside the picket fence, but could not mandate registry and registrar compliance with such policies. Learn more:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/picket-fence-overview-23jan19-en.pdf>

<sup>151</sup> Section 1.4.1 of Specification 1 of the Registry Agreement and Section 1.4.1 of the Consensus Policies and Temporary Policies Specification of the Registrar Accreditation Agreement state the following: “In addition to the other limitations on Consensus Policies, they shall not prescribe or limit the price of Registrar Services”. See page 43 of the Base Registry Agreement (updated 31 July 2017):

<https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.pdf> and page 57 of the 2013 Registrar Accreditation Agreement: <https://www.icann.org/en/system/files/files/approved-with-specs-27jun13-en.pdf>

<sup>152</sup> **Premium Name:** second level domain names that are offered for registration that, in the determination of the registry, are more desirable for the purchaser. **Premium Pricing:** second level domain names that are offered for registration, that in the determination of the registry are more desirable for the purchaser and will command a price that is higher than a non-premium name.



Question #	Final Agreed Charter Question	Proposed Answer
		owners was significantly higher than other Sunrise pricing or General Availability pricing.
	<b>Q2(b):</b> If so, how extensive is this problem?	The Working Group noted that this problem seems sufficiently extensive that it may require a recommendation to address it. The Working Group also noted that pricing is outside the picket fence.
<b>Sunrise Question #3</b>	<b>Q3(a):</b> Should Registry Operators be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name?	The Working Group noted that every Q3 sub question covers both Premium Names and Reserved Names, which are very different. Premium Names are not clearly defined, as a Registry Operator can have multiple pricing tiers.  The Working Group had diverging opinions on whether Registry Operators should be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name.
	<b>Q3(b):</b> Additionally, should Registry Operators be required to create a release mechanism in the event that a Premium Name or Reserved Name is challenged successfully, so that the trademark owner can register that name during the Sunrise Period?	Since there was no wide support for a challenge mechanism within the Working Group, the Working Group did not consider this question.
	<b>Q3(c):</b> What concerns might be raised by either or both of these requirements?	Some Working Group members noted some possible concerns, but there was no wide support within the Working Group for those concerns. Hence the Working Group did not develop an answer to this question.
<b>Sunrise Question #4</b>	<b>Q4(a):</b> Are Registry Operator Reserved Names practices unfairly limiting participation in Sunrise by trademark owners?	Some Working Group members believe that certain Registry Operators' Reserved Names practices may be unfairly limiting participation in Sunrise by trademark owners.
	<b>Q4(b):</b> Should Section 1.3.3 of Specification 1 of the Registry	The Working Group did not agree that there are concerns that should be addressed with

Question #	Final Agreed Charter Question	Proposed Answer
	Agreement be modified to address these concerns?	regard to Section 1.3.3 of Specification 1 of the Registry Agreement. <sup>153</sup>
	<b>Q4(c):</b> Should Registry Operators be required to publish their Reserved Names lists -- what Registry concerns would be raised by that publication, and what problem(s) would it solve?	<p>The Working Group had diverging opinions on whether Registry Operators should be required to publish their Reserved Names lists.</p> <p>Some Working Group members noted several possible registry concerns if Registry Operators were required to publish their Reserved Names lists.</p> <p>Other Working Group members discussed possible problems that the publication of the Reserved Names lists could solve.</p>
	<b>Q4(d):</b> Should Registry Operators be required to provide trademark owners in the TMCH notice, and the opportunity to register, the domain name should the Registry Operator release it – what Registry concerns would be raised by this requirement?	The Working Group had diverging opinions on this matter.
<b>Sunrise Question #5</b>	<b>Q5(a):</b> Does the current 30-day minimum for a Sunrise Period serve its intended purpose, particularly in view of the fact that many Registry Operators actually ran a 60-day Sunrise Period?	<p>The Working Group noted two types of Sunrise Periods:</p> <ol style="list-style-type: none"> <li>1) Start Date Sunrise: The Registry must give 30-day notice before commencing the Sunrise. Once the Sunrise starts, it must run for 30 days at a minimum.</li> <li>2) End Date Sunrise: The Registry can announce the Sunrise as late as the day the Sunrise starts but must run the Sunrise Period for 60 days at a minimum.</li> </ol>

<sup>153</sup> Section 1.3.3 of Specification 1 of the Registry Agreement states the following: “Such categories of issues referred to in Section 1.2 of this Specification shall include, without limitation, reservation of registered names in the TLD that may not be registered initially or that may not be renewed due to reasons reasonably related to (i) avoidance of confusion among or misleading of users, (ii) intellectual property, or (iii) the technical management of the DNS or the Internet (e.g., establishment of reservations of names from registration). See page 43 of the Base Registry Agreement (updated 31 July 2017) here: <https://newgtlds.icann.org/sites/default/files/agreements/agreement-approved-31jul17-en.pdf>

Question #	Final Agreed Charter Question	Proposed Answer
		<p>Both types of Sunrise Periods require a total of 60 days at a minimum.<sup>154</sup></p> <p>The Working Group generally agreed that the current 30-day minimum after a Start Date Sunrise Period starts appears to be serving its intended purpose.</p>
	<p><b>Q5(a)(i):</b> Are there any unintended results?</p>	<p>Some Working Group members believe that there are unintended results, such as complications when many TLDs are launched simultaneously for the Start Date Sunrise for 30 days. Other Working Group members believe that the 30-day advance notice before the launch of a Start Date Sunrise may help mitigate the administrative burdens on the trademark owners.</p>
	<p><b>Q5(a)(ii):</b> Does the ability of Registry Operators to expand their Sunrise Periods create uniformity concerns that should be addressed by this Working Group?</p>	<p>The Working Group generally agreed that the existing ability of Registry Operators to expand their Sunrise Periods does not create uniformity concerns that should be addressed by this Working Group.</p>
	<p><b>Q5(a)(iii):</b> Are there any benefits observed when the Sunrise Period is extended beyond 30 days?</p>	<p>The Working Group had diverging opinions on whether there are benefits observed when the Start Date Sunrise Period is extended beyond 30 days.</p>
	<p><b>Q5(a)(iv):</b> Are there any disadvantages?</p>	<p>Some Working Group members believe that there are disadvantages when the Sunrise Period is extended beyond 30 days, but the Working Group did not come to a conclusion on this point.</p>
	<p><b>Q5(b):</b> In light of evidence gathered above, should the Sunrise Period continue to be mandatory or become optional?</p>	<p>The Working Group had diverging opinions on whether the Sunrise Period should continue being mandatory or should become optional.</p>

<sup>154</sup> See the definitions of Start Date Sunrise and End Date Sunrise here: [https://icannwiki.org/Sunrise\\_Period](https://icannwiki.org/Sunrise_Period)

Question #	Final Agreed Charter Question	Proposed Answer
	<p><b>Q5(b)(i):</b> Should the Working Group consider returning to the original recommendation from the IRT and STI of Sunrise Period OR Trademark Claims in light of other concerns, including freedom of expression and fair use?</p>	<p>The Working Group considered this question but did not reach a conclusion.</p>
	<p><b>Q5(b)(ii):</b> In considering mandatory vs optional, should Registry Operators be allowed to choose between Sunrise and Claims (that is, make ONE mandatory)?</p>	<p>The Working Group considered this question but did not reach a conclusion.</p>
<p><b>Sunrise Question #6</b></p>	<p><b>Q6(a):</b> What are Sunrise Dispute Resolution Policies (SDRPs), and are any changes needed?</p>	<p>According to the Section 6.2.2 and 6.2.4 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB), SDRP is a mechanism that a Registry Operator must provide to resolve disputes regarding its registration of Sunrise Registrations.<sup>155</sup> It allows challenges to Sunrise Registrations related to Registry Operator’s allocation and registration policies on four non-exhaustive grounds, including on the grounds that the registered domain name does not identically match the Trademark Record on which the Sunrise-Eligible Rights Holder based its Sunrise Registration.</p> <p>In the time between when the AGB was written and the TMCH requirements were established, the TMCH dispute procedure</p>

<sup>155</sup> Section 6.2.2 of the Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook states the following: “Sunrise Registration Process. For a Sunrise service, sunrise eligibility requirements (SERs) will be met as a minimum requirement, verified by Clearinghouse data, and incorporate a Sunrise Dispute Resolution Policy (SDRP).” Section 6.2.4 states the following: “The proposed SDRP must allow challenges based on at least the following four grounds: (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; (ii) the domain name is not identical to the mark on which the registrant based its Sunrise registration; (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; or (iv) the trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received.” See pages 296-297 here: <https://newgtlds.icann.org/en/applicants/agb/guidebook-full-04jun12-en.pdf>

Question #	Final Agreed Charter Question	Proposed Answer
		<p>was created. This procedure allows for challenges to the recordal of marks in the TMCH that underlie Sunrise Registrations.</p> <p>As a result, two of AGB requirements for Registry Operator SDRPs are moot; and in any event the Registry Operator is not the best-placed party to adjudicate these challenges due to the fact that the Registry Operator is reliant on trademark eligibility information provided by the TMCH.</p> <p>Hence, the Working Group proposed a recommendation (see Sunrise Final Recommendation #8) that codifies the current practice.</p>
	<p><b>Q6(b):</b> Are SDRPs serving the purpose(s) for which they were created?</p>	<p>The Working Group had difficulty determining whether SDRPs are serving the purpose(s) for which they were created, as each TLD has its own SDRP and there is hardly any analysis of the SDRP decisions across all new gTLDs.</p> <p>The Working Group has proposed a recommendation in relation to Q6(a) that will eliminate the non-functional parts of the SDRP requirements and codify the current practice (see Sunrise Final Recommendation #8). Some Working Group members believe that the limited access to the TMCH and the lack of trademark information to identify whether a complaint is well-grounded makes it difficult to challenge a registration via the SDRP.</p>
	<p><b>Q6(c):</b> If not, should they be better publicized, better used or changed?</p>	<p>The Working Group attempted to address this question in its recommendation in relation to Q6(a) (see Sunrise Final Recommendation #8).</p> <p>One Working Group member commented that whether SDRPs should be better publicized is contingent on whether they are serving the purpose(s) for which they were</p>

Question #	Final Agreed Charter Question	Proposed Answer
		<p>created. However, it is not harmful for Registry Operators to periodically remind registrants of the existence of SDRPs. One Working Group member believes that it is not within the scope of the RPM PDP Working Group to recommend how SDRPs can be better used. It is up to the Registry Operators and challengers to decide.</p>
<b>Sunrise Question #7</b>	<b>Q7(a):</b> Can SMD files be used for Sunrise Period registrations after they have been canceled or revoked?	<p>The Working Group noted that after an SMD file or its underlying trademark record has been canceled or revoked, the SMD file cannot be used for Sunrise Period registrations. However, theoretically, an SMD file might still work for an asynchronous short period of time due to the registry process.</p>
	<b>Q7(b):</b> How prevalent is this as a problem?	<p>The Working Group generally agreed that the problem does not seem to be prevalent.</p>
<b>Sunrise Question #8</b>	<b>Q8(a):</b> Are Limited Registration Periods in need of review vis a vis the Sunrise Period? Approved Launch Programs? Qualified Launch Programs?	<p>The Working Group discussed this question but was unable to conclude whether the Limited Registration Periods or Qualified Launch Programs are in need of review.</p> <p>Nevertheless, the Working Group had further discussion about the ALP during its deliberation. The Approved Launch Program (ALP) was created as an additional voluntary program for Registry Operators in the implementation of the 2012 New gTLD round in the form of the Applicant Guidebook (AGB). A Registry Operator MAY, prior to the start date of its Sunrise Period, apply to ICANN for approval to conduct a registration program not otherwise permitted by these TMCH Requirements. Such a registration program application could, for example, provide for authorization to implement programs set forth in Registry Operator’s application for the TLD, which, if set forth in reasonable detail in the application for the TLD, will carry a presumption of being approved, unless ICANN reasonably determines that such requested registration program could contribute to consumer</p>

Question #	Final Agreed Charter Question	Proposed Answer
		<p>confusion or the infringement of intellectual property rights.<sup>156</sup></p> <p>The Working Group has received limited feedback that the rules for the AGB do not integrate smoothly with the concept of Sunrise implemented under the 2012 New gTLD Program.<sup>157</sup> For instance, some GEO TLDs struggled to ensure that words needed for operation of their TLD (i.e. required by the governments that approved them) were all able to be allocated or reserved for subsequent registration prior to Sunrise. These words may have been recorded in the TMCH but needed to be reserved to the governments (one example is “police” which is both a word for local law enforcement and a brand). As a result, many Registry Operators did not use the ALP option; Dot Madrid was the only approved ALP application.</p> <p>In order to better understand the effectiveness of the ALP, the Working Group sought input especially from Registry Operators during the public comment proceeding of its Phase 1 Initial Report.<sup>158</sup> Limited input was received from Registry Operators, specifically the CORE Association, Fundació .cat, and Afnic. They pointed to the difficulty for Registry Operators to obtain ICANN org’s approval for an ALP application in a timely manner.<sup>159</sup> The Working Group also noted that there was no guideline for the ALP process at the start of the 2012 New gTLD Program; the relevant documentation,</p>

<sup>156</sup> To learn more, see Section 4.5.2 of the Trademark Clearinghouse Rights Protection Mechanism Requirements:

<https://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

<sup>157</sup> See transcript of the RPM session during the ICANN69 Johannesburg meeting on 29 June 2017:

[https://schr.ws/hosted\\_files/icann59johannesburg2017/8a/transcript%20RPM%201%20%2029%20June%202017.pdf%20session%201.pdf](https://schr.ws/hosted_files/icann59johannesburg2017/8a/transcript%20RPM%201%20%2029%20June%202017.pdf%20session%201.pdf)

<sup>158</sup> See the full text of Sunrise Questions #3 and #4 on pp.45-48 of the RPM PDP Phase 1 Initial Report:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>159</sup> See the public comment received related to the ALP in the public comment review tool here:

<https://docs.google.com/spreadsheets/d/1xMehg9o44bdz85ry0LJvhzoOaKdmJ6SwirLneMx0lxc/edit#gid=990976007>

Question #	Final Agreed Charter Question	Proposed Answer
		<p>including the Approved Launch Program Process &amp; Form and the Application Review Guidelines, was developed during the implementation/AGB Phase and published toward the end of 2013.<sup>160</sup> The Working Group also learned that most ALP applications were rejected by ICANN org because they proposed skipping or changing the mandatory RPM requirements.</p> <p>Based on public comments received, the Working Group agrees that the ALP process should be predictable, timely, and as transparent as possible while respecting the need for confidentiality and flexibility for ICANN org and an ALP applicant to engage in constructive discussion. To this end, as implementation guidance to the IRT, the Working Group suggests that the IRT review the published process documentation and review guidelines with a view toward providing future ALP applicants with clear guidance as to expected timelines for decisions. In addition, the Working Group expects that, in order to fulfill the objectives of transparency and predictability, all applications received and their results should be published, appropriately redacted so as not to display personal data or business-confidential information requested by the applicant. The Working Group hopes that these suggestions will help enable the ALP to become an effective solution for GEO TLDs for the protection of interests of public authorities and local entities.</p>
	<p><b>Q8(b):</b> Are the ALP and QLP periods in need of review?</p>	<p>The Working Group discussed this question but was unable to conclude whether the ALP and QLP periods are in need of review.</p>

<sup>160</sup> **Approved Launch Program Process & Forms:** <https://newgtlds.icann.org/en/about/trademark-clearinghouse/launch-application-process-12nov13-en.pdf>

**Application Review Guidelines** (ICANN uses these guidelines to review RO applications for conducting an ALP): <https://newgtlds.icann.org/en/about/trademark-clearinghouse/launch-application-guidelines-19dec13-en.pdf>



Question #	Final Agreed Charter Question	Proposed Answer
	<b>Q8(c):</b> What aspects of the LRP are in need of review?	The Working Group discussed this question but was unable to conclude what aspects of the LRP are in need of review.
<b>Sunrise Question #9</b>	<b>Q9:</b> In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?	The Working Group had diverging opinions on this matter, and the Working Group did not come to a conclusion.
<b>Sunrise Question #10</b>	<b>Q10:</b> Explore use and the types of proof required by the TMCH when purchasing domains in the Sunrise Period.	While the Working Group recognized that this question has a genesis, the Working Group did not formulate a response due to disagreement on what the question is asking.
<b>Sunrise Question #11</b>	<b>Q11(a):</b> How effectively can trademark holders who use non-English scripts/languages able to participate in Sunrise (including IDN Sunrises)?	Some Working Group members believe that Trademark holders who use non-English scripts/languages generally cannot effectively participate in Sunrise.
	<b>Q11(b):</b> Should any of them be further “internationalized” (such as in terms of service providers, languages served)?	The Working Group did not address this question as the question was unclear.
<b>Sunrise Question #12</b>	<b>Q12(a):</b> Should Sunrise Registrations have priority over other registrations under specialized gTLDs?	The Working Group discussed this question but was unable to conclude whether Sunrise Registrations should have priority over other registrations under specialized gTLDs.
	<b>Q12(b):</b> Should there be a different rule for some registries, such as certain types of specialized gTLDs (e.g. community or geo TLDs), based on their published registration/eligibility policies? (Examples include POLICE.PARIS and POLICE.NYC for geo-TLDs , and WINDOWS.CONSTRUCTION for specialized gTLDs)	The Working Group discussed this question but was unable to conclude whether there should be a different rule for some registries, such as certain types of specialized gTLDs, based on their published registration/eligibility policies.

## 8.6 Trademark Claims Service Final Agreed Charter Questions & Proposed Answers

Question #	Final Agreed Charter Question	Proposed Answer
Trademark Claims Question #1	<b>Q1 Threshold:</b> Is the Trademark Claims service having its intended effect?	The Working Group did not come to an agreement as to whether the Trademark Claims service is “probably” or “likely” having its intended effect, although the Working Group could determine that the service is at least “possibly” having its intended effect.
	<b>Q1(a):</b> Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing Claims Notice to domain name applicants?	The Working Group did not come to an agreement as to whether the Trademark Claims service is “probably” or “likely” having its intended effect of deterring bad-faith registrations, although the Working Group could determine that the service is at least “possibly” having its intended effect. The Working Group could not determine the extent of deterrence that occurred, if any.
	<b>Q1(b):</b> Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications?	The Working Group generally agreed that the Trademark Claims service may possibly have unintended consequences, such as deterring good-faith domain name applications. The Working Group could not determine the extent of deterrence that occurred, if any.
Trademark Claims Question #2	<b>Q2(a):</b> Should the Claims period be extended - if so, for how long (up to permanently)?	The Working Group generally agreed that where there is a mandatory Claims period, it should not be extended. However, the Working Group generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.
	<b>Q2(b):</b> Should the Claims period be shortened?	The Working Group generally agreed that where there is a mandatory Claims Period, it should not be shortened.

Question #	Final Agreed Charter Question	Proposed Answer
	<b>Q2(c):</b> Should the Claims period be mandatory?	The Working Group generally agreed that where there is a Claims period, it should be mandatory. However, the Working Group generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.
	<b>Q2(d):</b> Should any TLDs be exempt from the Claims RPM and if so, which ones and why?	Some Working Group members believe that some future TLDs should be exempt from the Claims RPM. Some Working Group members suggested that public comment should be sought on whether there is a use case for exempting a TLD from the requirement of a mandatory Claims Period due to the particular nature of the TLD.
	<b>Q2(e):</b> Should the proof of use requirements for Sunrise be extended to include the issuance of TMCH notices?	The Working Group had diverging opinions on whether the proof of use requirements for Sunrise should be extended to include the issuance of TMCH notices.
<b>Trademark Claims Question #3</b>	<b>Q3(a):</b> Does the Trademark Claims Notice to domain name applicants meet its intended purpose?	The Working Group generally agreed that the Trademark Claims Notice generally meets its intended purpose of notifying prospective domain name registrants that the applied-for domain name matches at least one trademark in the Trademark Clearinghouse. However, the Working Group also recognized the inadequacies and shortcomings of the Trademark Claims Notice as set out in the proposed answers to Q3(a)(i)-(iii).
	<b>Q3(a)(i):</b> If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved?	The Working Group generally agreed that for some of the actual and potential registrant respondents, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. The Working Group made recommendations to improve the Claims Notice (see Trademark Claims Final Recommendation #6), and also sought

Question #	Final Agreed Charter Question	Proposed Answer
		community input to address its inadequacy. <sup>161</sup>
	<b>Q3(a)(ii):</b> Does it inform domain name applicants of the scope and limitations of trademark holders' rights? If not, how can it be improved?	Some Working Group members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks). The Working Group made recommendations to improve the Claims Notice (see Trademark Claims Final Recommendation #6), and also sought community input to address its inadequacy. <sup>162</sup>
	<b>Q3(a)(iii):</b> Are translations of the Trademark Claims Notice effective in informing domain name applicants of the scope and limitation of trademark holders' rights?	<p>The Working Group generally agreed that the current requirement on translations of the Trademark Claims Notice does not seem effective in informing domain name applicants of the scope and limitation of trademark holders' rights.</p> <p>The current requirement states: "The Claims Notice MUST be provided by the registrar to the potential domain name registrant in English and SHOULD be provided by the registrar to the potential domain name registrant in the language of the registration agreement".<sup>163</sup></p>
	<b>Q3(b):</b> Should Claims Notifications only be sent to registrants who complete domain name registrations, as opposed to those who are attempting to register domain names that are matches to entries in the TMCH?	The Working Group generally agreed that when there is a Claims Period and the issuance of a Claims Notice is required (see proposed answer to Trademark Claims Q2(d)), the Claims Notice should be sent to potential registrants, who are attempting to register domain names that are matches to

<sup>161</sup> See the full text of Trademark Claims Question #1 on pp.52-53 in the Phase 1 Initial Report here:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>162</sup> See the full text of Trademark Claims Question #1 on pp.52-53 in the Phase 1 Initial Report here:

<https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-initial-18mar20-en.pdf>

<sup>163</sup> See the requirements of the Trademark Claims service here: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>

Question #	Final Agreed Charter Question	Proposed Answer
		entries in the TMCH, at some point before the domain name registration is completed.
<b>Trademark Claims Question #4</b>	<b>Threshold Q4:</b> Is the exact match requirement for Trademark Claims serving the intended purposes of the Trademark Claims RPM? In conducting this analysis, recall that IDNs and Latin-based words with accents and umlauts are currently not serviced or recognized by many registries.	The Working Group had diverging opinions on whether the exact match requirement is serving the intended purposes of the Trademark Claims RPM.
	<b>Q4(a):</b> What is the evidence of harm under the existing system?	The Working Group had diverging opinions on whether there is evidence of harm under the existing system of exact match.
	<b>Q4(b):</b> Should the matching criteria for Notices be expanded?	The Working Group had diverging opinions on whether the matching criteria for the Claims Notice should be expanded.
	<b>Q4(b)(i):</b> Should the marks in the TMCH be the basis for an expansion of matches for the purpose of providing a broader range of claims notices?	<p>The Working Group generally agreed that if the matching criteria for the Claims Notice were to be expanded, the marks in the TMCH should be the basis for an expansion of matches for the purpose of providing a broader range of Claims Notice.</p> <p>While there was no agreement within the Working Group that the matching criteria should be expanded, most Working Group members generally assumed that the TMCH would be the likely implementation for any expansion because contracted parties are already integrated with, and querying, the TMCH for the Claims Notice today. Nevertheless, the Working Group did not know how the implementation would technically work.</p>
	<b>Q4(b)(ii):</b> What results (including unintended consequences) might each	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.

Question #	Final Agreed Charter Question	Proposed Answer
	suggested form of expansion of matching criteria have?	
	<b>Q4(b)(iii):</b> What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?	<p>The Working Group believes that the exact match criteria have already struck the current balance of deterring bad-faith registrations but not good-faith domain name applications.</p> <p>The Working Group believes that the current balance can be enhanced by a well-crafted Claims Notice that appropriately notifies prospective registrants about a potential problem with their chosen domain name, employs clear/concise/informative language, and avoids a potential overflow of false positives.</p>
	<b>Q4(b)(iv):</b> What is the resulting list of non-exact match criteria recommended by the Working Group, if any?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	<b>Q4(c):</b> What is the feasibility of implementation for each form of expanded matches?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	<b>Q4(d)(i):</b> If an expansion of matches solution were to be implemented, should the existing TM Claims Notice be amended? If so, how?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
	<b>Q4(d)(ii):</b> If an expansion of matches solution were to be implemented, should the Claim period differ for exact matches versus non-exact matches?	Since the Working Group did not agree on the expansion of matches, the Working Group did not consider this question in detail.
<b>Trademark Claims Question #5</b>	<b>Q5:</b> Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds?	The Working Group generally agreed that where the Registry Operator has not obtained an exception (see proposed answer to Trademark Claims Q2(d)), the Trademark Claims period, including for the minimum initial 90-day period when a TLD opens for

Question #	Final Agreed Charter Question	Proposed Answer
		general registration, should continue to be uniform for all types of gTLDs in subsequent rounds. In addition, the Working Group generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period.

## 8.7 TM-PDDRP Charter Question

The Working Group’s Charter contains one question about the TM-PDDRP: **“Is there a policy-based need to address the goal of the TM-PDDRP?”**

The Working Group agreed that its approach to review this RPM would be to first engage with the various dispute resolution providers. Accordingly, it developed a list of survey questions to frame its interaction with the providers.<sup>164</sup>

## 8.8 Additional Marketplace RPMs Questions

Since reviewing the additional marketplace RPMs is out of scope for this PDP, the Working Group’s Charter does not contain any specific questions pertaining to these additional RPMs.

Nevertheless, the Working Group discussed these additional mechanisms, as its Charter mandated that it consider the interplay between the mandatory RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency.

The Working Group’s discussions about the additional marketplace RPMs were based on a final set of six (6) questions from the Additional Marketplace RPMs Sub Team that was formed to refine the initial list of questions prepared by the Working Group Co-Chairs.<sup>165</sup> As mentioned in the “Additional Marketplace Rights Protection Mechanisms” section of this Final Report, a subsequent Sub Team (the RPM Data Sub Team) reviewed the Working Group’s discussions about the additional marketplace RPMs and used relevant information derived from them to formulate guidance for Analysis Group, who had been contracted to conduct the Sunrise and

<sup>164</sup> See the TM-PDDRP survey questions targeting the TM-PDDRP Providers here:

[https://www.google.com/url?q=https://community.icann.org/download/attachments/59644078/PDDRP%2520Questions%2520List.docx?version%3D1%26modificationDate%3D1465585803000%26api%3Dv2&sa=D&ust=1583518417453000&usg=AFQjCNE4kecyhiCaKHX5VAY\\_e9OSCo154A](https://www.google.com/url?q=https://community.icann.org/download/attachments/59644078/PDDRP%2520Questions%2520List.docx?version%3D1%26modificationDate%3D1465585803000%26api%3Dv2&sa=D&ust=1583518417453000&usg=AFQjCNE4kecyhiCaKHX5VAY_e9OSCo154A)

<sup>165</sup> See the final set of proposed questions for Additional Marketplace RPMs here:

<https://community.icann.org/download/attachments/69283988/CLEAN%20Draft%20Final%20Additional%20Marketplace%20RPM%20Questions%20-%2015%20September%202017.pdf?version=1&modificationDate=1505764402000&api=v>

Trademark Claims surveys. As such, the Working Group did not develop specific recommendations for this topic.

Based on the RPM Data Sub Team’s suggestion, the Working Group considered the following question related to the additional marketplace RPMs following its analysis of public comments received on its Initial Report: **“How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?”** This question is related to the General Overarching Charter Question #3 as described above. In reviewing the public comment, the Working Group agreed that it did not collect sufficient data to develop a meaningful answer to that question. While the Working Group noted that several commenters expressed the desire for the Globally Protected Mark List (GPML) as an additional measure, it agreed not to develop any recommendation with regard to additional mandatory RPMs equivalent to GPML.<sup>166</sup>

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<sup>166</sup> See Rows #31-32 related to the GPML comments in the public comment review tool here: <https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhvIOskAILVraWp-88mqzScCtj01fw/edit#gid=1227219396>



## 9 Annex C – Consensus Designations

Below is the Working Group Co-Chairs' designation as to the level of Consensus on each recommendation in the RPM PDP Phase 1 Final Report. These designations were made following the process as outlined in the message to the Working Group mailing list on 30 October 2020 and in accordance with Section 3.6 - Standard Methodology for Making Decisions of the GNSO Working Group Guidelines as well as the RPM PDP Working Group Charter.<sup>167</sup> By the deadline of 12 November 2020, no objection was received from Working Group members to the Co-Chairs' proposed Consensus Designations.

Recommendation #	Co-Chairs' Proposed Designation
URS Final Recommendation #1	Full Consensus
URS Final Recommendation #2	Full Consensus
URS Final Recommendation #3	Full Consensus
URS Final Recommendation #4	Full Consensus
URS Final Recommendation #5	Full Consensus
URS Final Recommendation #6	Full Consensus
URS Final Recommendation #7	Full Consensus
URS Final Recommendation #8	Full Consensus
URS Final Recommendation #9	Full Consensus
URS Final Recommendation #10	Full Consensus
URS Final Recommendation #11	Full Consensus
URS Final Recommendation #12	Full Consensus
URS Final Recommendation #13	Full Consensus
URS Final Recommendation #14	Full Consensus
URS Final Recommendation #15	Full Consensus

<sup>167</sup> See the message sent by Support Staff on behalf of the Working Group Co-Chairs here: <https://mm.icann.org/pipermail/gns0-rpm-wg/2020-October/004611.html>; see the GNSO Working Group Guidelines here: <https://gns0.icann.org/sites/default/files/file/field-file-attach/annex-1-gns0-wg-guidelines-24oct19-en.pdf>; see the Working Group Charter here: [https://gns0.icann.org/sites/default/files/filefield\\_48755/rpm-charter-15mar16-en.pdf](https://gns0.icann.org/sites/default/files/filefield_48755/rpm-charter-15mar16-en.pdf)

<b>Recommendation #</b>	<b>Co-Chairs' Proposed Designation</b>
TMCH Final Recommendation #1	Consensus <sup>168</sup>
TMCH Final Recommendation #2	Full Consensus
TMCH Final Recommendation #3	Full Consensus
TMCH Final Recommendation #4	Full Consensus
Sunrise Final Recommendation #1	Full Consensus
Sunrise Final Recommendation #2	Full Consensus
Sunrise Final Recommendation #3	Full Consensus
Sunrise Final Recommendation #4	Full Consensus
Sunrise Final Recommendation #5	Full Consensus
Sunrise Final Recommendation #6	Full Consensus
Sunrise Final Recommendation #7	Full Consensus
Sunrise Final Recommendation #8	Full Consensus
Trademark Claims Final Recommendation #1	Full Consensus
Trademark Claims Final Recommendation #2	Full Consensus
Trademark Claims Final Recommendation #3	Full Consensus
Trademark Claims Final Recommendation #4	Full Consensus
Trademark Claims Final Recommendation #5	Full Consensus
Trademark Claims Final Recommendation #6	Full Consensus
TM-PDDRP Final Recommendation	Full Consensus
Overarching Data Collection Final Recommendation	Full Consensus

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<sup>168</sup> Please see the "Annex D - Working Group Members' Minority Statement on TMCH Final Recommendation #1" section of this Final Report for additional details regarding members' different views on the TMCH Final Recommendation #1.

## 10 Annex D – Working Group Members’ Minority Statement on TMCH Final Recommendation #1

### **Minority Statement Jointly Submitted by Jason Schaeffer, Jay Chapman, Michael Karanicolas, Mitch Stoltz, Nat Cohen, Rebecca Tushnet, and Zak Muscovitch**

TMCH Recommendation #1 fails to satisfactorily define “Word Marks,”<sup>169</sup> thereby enabling the continued misapprehension of the scope and applicability of the TMCH by the TMCH Validation Provider. The absence of a satisfactory definition of “Word Mark” will likely contribute to the continuation of the erroneous TMCH Validation Provider practices, which violate the fundamental promise that the TMCH would not expand rights but would rather only recognize existing rights. The problem is compounded by the unwarranted lack of transparency of the TMCH database.

#### I. Inclusion of Text-Plus Marks Unwarrantedly Expands Trademark Rights

Deloitte’s current practices for review and extraction of words from design marks conflict with the policies developed for the TMCH and their underlying rationales (which do not contemplate these judgment calls by the TMCH Validation Provider).

Around the world, trademark systems distinguish between word marks—marks that consist solely of text—and other marks, including pure design marks and design + text marks, albeit under varying names. A valid word mark is protected no matter what typeface or stylization it uses and regardless of whether there are accompanying logos or other matter. By contrast, when a mark is registered as a design + text or otherwise stylized mark, the registration covers the specific visual presentation of the mark. Sometimes registrants choose this option because the stylization adds distinctiveness to an otherwise generic or descriptive term, or to avoid conflict with another mark that uses similar text but in a different presentation.

A national registration, as usually required for entry into the TMCH, confers presumptive rights on that which is registered, not parts of that which is registered.<sup>170</sup> When a design + text mark is registered, it is *possible* that the claimant has trademark rights in the text alone, but determining that would require additional factfinding in each instance. What is clear from the registration of a mixed mark on its face is only that the claimant has been granted rights in the specific combination of elements registered. To put the text alone in the TMCH, then, expands the registered right beyond its boundaries.

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<sup>169</sup> The recommendation uses a circular definition, stating that “word marks” “includes service marks, collective marks, certification marks, and word marks protected by statute or treaty.” TMCH Recommendation #1.

<sup>170</sup> The lack of transparency in the database has made it difficult to evaluate the scope of the problem. It does not appear that marks recognized by court decision form any noticeable part of the current TMCH entrants, and we are not aware of any IGO names recognized by treaty or statute that are not word marks. For example, U.S. statutes specifically protect the Olympic and Red Cross word marks, and grant separate protection to related symbols. The TMCH Validation Provider has explained that it uses the same standard for all: can text be extracted from the full mark presented to it? If text can be extracted from the remainder of the mark, the text will be entered into the TMCH.

But that is exactly what the TMCH Validation Provider has done. It extracts any text strings from design marks, composite marks, figurative marks, stylized marks, mixed marks, and any similar combination of characters and design (collectively “design marks”). See Appendix (showing marks whose text the current provider, Deloitte, confirmed it would put into the TMCH based on the WG’s Follow Up Questions of 4 March 2017).

The standard for entry into the TMCH has always been articulated as requiring a registration or a court judgment identifying the claimed mark as protected. But that requires actual attention to what the registration or court judgment says is protected. The TMCH Validation Provider should not make extrapolations about what *might* be protected. By adopting a standard looking for whatever text can be extracted from a mark, Deloitte is not asking whether a registration for a word mark exists; it is wrongly asking whether text can be extracted from a registration that exists, without any confirmation that the claimant has any valid trademark rights in the extracted matter. Deloitte is, in essence, creating new rights out of whole cloth. (And, as the CARS and MUSIC examples in the Appendix show, see *infra* p.6, its practices require it to create those new rights by interpreting which parts of the mark it should extract, contrary to the policy of requiring a national registry or court to confirm the existence of a mark.)

The Working Group did not reach consensus on this issue, and its in action, and adoption of a specific definition of “word marks” in TMCH Recommendation #1, may be interpreted as embracing or endorsing current practice. We could not disagree more with this contradiction of fundamental trademark law principles and the adoption of TMCH Validation provider practices never created and approved.

Specifically and consistent with the original rules for the TMCH approved by the GNSO and Board:

The TMCH Validation Provider (currently Deloitte) should accept only text marks. To assist the TMCH Validation Provider, TMCH applicants should be required to show that their marks are text marks, either by reference to a national classification system or to other competent evidence (such as that their marks are registered in a font that is standard for the relevant registry).

## II. Transparency

Decisions by this working group not to pursue greater transparency in the TMCH make it impossible to determine the scale on which these and other practices are taking place. Some argue for the importance of protecting “commercial secrets” contained in the TMCH. This is despite the fact that trademarks are by definition public and, as demonstrated by working group members, a dedicated researcher with a few hours on their hands can already find comprehensive information for which marks any particular brand holder has chosen to register in the TMCH.

ICANN should provide for greater transparency in the TMCH, including but not limited to the ability for qualified parties to audit it for compliance.

## III. Additional Background Material on Text Marks

### A. ICANN Background

## **STI**

The GNSO Council & ICANN Board adopted rules (based on the STI Final Report and IRT Recommendations) that were very clear about the type of mark to be accepted by the Trademark Clearinghouse:

“4.1 National or Multinational Registered Marks The TC Database should be required to include nationally or multinationally registered “text mark” trademarks, from all jurisdictions, (including countries where there is no substantive review).”

<https://gns0.icann.org/en/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

Further, the adopted rules themselves are very clear about the harm of putting design marks into the TMCH Database: “[Also 4.1] (The trademarks to be included in the TC are text marks because “design marks” provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.)

## **Applicant Guide Book**

The Applicant Guide Book adopted the same requirements:

### **“3.2: Standards for inclusion in the Clearinghouse**

#### **3.2.1 Nationally or regionally registered word marks from all jurisdictions”**

##### **B. Trademark Law Background**

“Word mark” has a consistent meaning across trademark organizations around the world:

**INTA:** *Word Mark (“standard character” drawings)—All letters and words in the mark are depicted in Latin characters; all numbers in the mark are depicted in Roman or Arabic numerals. The mark includes only common punctuation or diacritical marks and does not include a design element. The letters and/or numbers are not stylized.*

[http://www.inta.org/Trademark\\_Basics/FactSheets/Pages/FilinginUSFactSheet.aspx](http://www.inta.org/Trademark_Basics/FactSheets/Pages/FilinginUSFactSheet.aspx)

**WIPO:** *A mark in standard characters is equivalent in some countries to what is known as a “word mark”, as opposed to a “figurative” mark.*

<https://www.wipo.int/export/sites/www/madrid/en/guide/pdf/partb2.pdf>

**CIPO:** *Word mark: A trademark consisting of words in standard character, without regard to colour or font type.* <https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00837.html#w>

**EUIPO:** *A word mark consists exclusively of words or letters, numerals, other standard typographic characters or a combination thereof that can be typed.*

<https://euipo.europa.eu/ohimportal/en/trade-mark-definition>

### C. Harm from the Current Practice

Deloitte, which has understandable financial incentives to accept everything it can into the TMCH, has instead implemented an anything-goes approach. This contravenes the purpose of the TMCH—which was never to expand trademark rights, only to recognize them—and allows more invalid claims to be made, disrupting the proper operation of Sunrise and the Notice period.

The key principle violated by Deloitte’s practice is that a graphical mark incorporating generic or descriptive terms does not afford protection over the constituent words themselves. This lack of rights in such descriptive or generic terms within a “design” or “composite” or “mixed mark” was illustrated in the following WIPO UDRP decision of a unanimous three-member panel concerned with an Argentinian registered trademark that comprised graphical elements and a generic term:

“Complainant has shown that it owns two trademark registrations in Argentina. The Panel notes that both registrations are for “mixed” marks, where each consists of a composition made of words and graphic elements, such as stylized fonts, a roof of a house, etc. See details of the registrations with drawings at section 4 above.

“As explained on the INPI website, “[m]ixed (marks) are those constituted by the combination of word elements and figurative elements together, or of word elements in stylized manner.” Accordingly, **the protection granted by the registration of a mixed mark is for the composition as a whole, and not for any of its constituting elements in particular.** Thus, Complainant is not correct when he asserts that it has trademark rights in the term “cabañas” (standing alone), based on these mixed trademark registrations.”

Marco Rafael Sanfilippo v. Estudio Indigo, WIPO Case No. D2012-1064, <https://www.wipo.int/amc/en/domains/search/text.jsp?case=D2012-1064>. As this example shows, registrations that include design elements often do so to add distinctiveness to otherwise descriptive or generic terms, such as cabañas (cabins).

This result was not unusual; it follows from basic principles of trademark registration. The presumption of validity provided by registration does not extend beyond that which is registered. See e.g., *Neopost Industrie B.V. v. PFE Intern., Inc.*, 403 F.Supp.2d 669 (N.D. Ill. 2005) (registration of stylized mark didn’t extend protection to nonstylized uses); *Kelly–Brown v. Winfrey*, 95 F.Supp.3d 350, (S.D.N.Y. 2015) (dealing with special form mark whose words were unprotectable absent stylization), *aff’d*, *Kelly–Brown v. Winfrey*, 659 Fed.Appx. 55 (2d. Cir. 2016).

Extracting a word or letters from a larger design gives too many rights to one trademark owner over others using the same words or letters. It provides an unfair advantage for a claimant over others using the same words or letters, and expands the rights conferred by the registration.

Applicants should be required to demonstrate that they possess rights in word marks, not word + other matter marks. The TMCH Validation Provider could develop lists of how various countries categorize mark types for automatic processing of most marks. Applicants could also submit evidence from a national registry about its classifications to show that they possessed rights in a word mark, or they

could offer a court decision confirming that their rights extend to the words claimed as such, not limited to words + other elements.

### Appendix:

These are several mark-plus registrations for which Deloitte was provided both the mark and the registration information, including the classifications of the marks. Deloitte confirmed that it would extract the text from each one and enter the text into the TMCH Database.

#### Example 1: Parents



This is a US registration, No. 2654160, of words “in stylized form.” As a court decision confirmed, this registration grants the registrant no right in the word “PARENTS” as such, only in the particular stylization thereof. *Gruner + Jahr USA Publishing v. Meredith Corp.*, 991 F.2d 1072, 1077 (2d Cir. 1993) (“[T]he trademark registration of the title PARENTS in its distinctive typeface did not confer an exclusive right to plaintiff on variations of the word ‘parent.’”). Nonetheless, Deloitte would put it in the TMCH and give the registrant preemptive rights in Sunrise and trigger Claims Notices on its behalf. (The secrecy of the database prevents us from knowing whether this particular stylized mark, or the others shown in the Appendix, have been entered into the TMCH.)

#### Example 2: Dealhunter



This is an EU trademark, filing number 011340593. Its type is “figurative.” The additional description of the mark is “Colour: White, grey and green.”

## Example 3: CARS



Reg. No. 3419857. This generic term is registered only in combination with the visual elements, classified by the US PTO as “Design Plus Words, Letters, And/Or Numbers.” As the registration explains, “The mark consists of the word ‘CARS’ in stylized lettering, surrounded by a dark oblong and superimposed over a stylized ‘V.’” [Deloitte did not specify whether it would put this into the TMCH Database as CARS or as CARSV.]

## Example 4: MUSIC



This US registration for music-related services, No. 5053417, is “Design Plus Words, Letters, And/Or Numbers,” and the registration explains that it “consists of the stylized wording ‘MUSIC’ and the design of two parallel lines. One parallel line is longer than the other, the lines slant to the right, and form the letter ‘P.’” [Deloitte did not specify whether it would enter this into the TMCH Database as PMUSIC or simply as MUSIC.]



## Example 5: A



This US registration, No. 5140785, is for “Words, Letters, And/Or Numbers In Stylized Form” The registration explains that “[t]he mark consists of a stylized letter ‘A’.”

## Example 6: Own Your Power



This US registration, No. 3434419, is for “Words, Letters, And/Or Numbers In Stylized Form.” The mark “consists of light blue scripted letters which create the words Own Your ‘Power.’” As subsequent litigation confirmed, the registration conferred no rights against other uses of “own your power” that did not copy the stylization. *Kelly-Brown v. Winfrey*, 95 F. Supp. 3d 350, 358 (S.D.N.Y. 2015) (“Plaintiffs registered a ‘special form’ mark consisting of ‘light blue scripted letters which create the words Own Your “Power”’ with the following disclaimer: ‘No claim is made to the exclusive right to use own your power apart from the mark as shown.’ Plaintiffs’ registration is, therefore, limited to its stylized ‘light blue scripted’ use of the phrase ‘Own Your Power’ and Plaintiffs have no claim over the phrase itself.”).

## Signed:

Jay Chapman, President,  
Digimedia.com Nat Cohen,  
President, Telepathy Inc.

Michael Karanicolas, Wikimedia Fellow, Information Society Project - Yale Law School

Zak Muscovitch, General Counsel, Internet Commerce Association

Jason Schaeffer, Counsel, Esqwire.com P.C.

Mitch Stoltz, Senior Staff Attorney, Electronic Frontier Foundation

Rebecca Tushnet, Professor, Harvard Law

## 11 Annex E – Working Group Documents

The Working Group prepared a number of documents to conduct the review of each Phase 1 RPM, analyze data and input from numerous sources, develop preliminary recommendations, evaluate proposals submitted by individual Working Group members, and review and analyze the public comments received to its Initial Report.

This Annex lists some of the documents that were used by the Working Group in the course of its deliberations, and is included in this Final Report to provide the community with a sense of the extent of the work involved, the tools/formats that were used, and the Working Group's deliberation processes.

Please note, however, that this list is not a comprehensive record of all of the documents that the Working Group used during its deliberations. To see the complete record of all the Working Group documents, including records of all Working Group and Sub Team meetings, please visit the Working Group's wiki workspace.<sup>171</sup>

### 11.1 URS Documents

- Individual Proposals for URS Policy Recommendations & Operational Fixes -- Initial Report Review (22 January 2020):  
[https://docs.google.com/document/d/110tgExAlgzrCbuiy0OiefXG2mKbo\\_SCLrU037zErN2k/edit?usp=sharing](https://docs.google.com/document/d/110tgExAlgzrCbuiy0OiefXG2mKbo_SCLrU037zErN2k/edit?usp=sharing)
- Sub Team Proposals for URS Policy Recommendations & Operational Fixes for Initial Report (12 December 2019):  
[https://docs.google.com/document/d/1jlsM6yl3A9ssPdHymjZwoSQXsncl8h\\_9oOE1vFYm9o/edit?usp=sharing](https://docs.google.com/document/d/1jlsM6yl3A9ssPdHymjZwoSQXsncl8h_9oOE1vFYm9o/edit?usp=sharing)
- Working Group Survey to Ascertain More Specific Support Levels for Inclusions of the Individual Members' Proposals in the Initial Report (3 November 2019):  
<https://community.icann.org/download/attachments/93126760/URS%20Individual%20Proposal%20Survey%20Result.pdf?version=1&modificationDate=1576086277000&api=v2>
- URS proposals submitted by individual Working Group members (September-October 2018):  
<https://community.icann.org/display/RARPMRIAGPWG/URS+Proposals#URSProposals--324377862>
- Super Consolidated URS Topics Table with Findings, Issues, Suggestions from All Three URS Sub Teams for Working Group Discussion (31 August 2018):  
<https://docs.google.com/document/d/1YR7f60lkbaTyWJLaWvMVultyvxyjlp2uDE27B-SN30/edit?usp=sharing>

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<sup>171</sup> See the Working Group's wiki workspace here: <https://community.icann.org/x/wCWAaw>

- Responses from URS Providers (ADNDRC, MFSD, FORUM) to Sub Team-Developed Survey (23 August 2018): [https://docs.google.com/spreadsheets/d/1l-ge\\_I4OkQT7IU\\_rjHMQVa9Ebj8Ik6vay1vr5Yt9Zlg/edit?usp=sharing](https://docs.google.com/spreadsheets/d/1l-ge_I4OkQT7IU_rjHMQVa9Ebj8Ik6vay1vr5Yt9Zlg/edit?usp=sharing)
- List of Topics for Review of the URS (31 July 2018): [https://community.icann.org/download/attachments/90769206/Consolidated URS Discussion Document - updated 31 July 2018v2.docx?version=1&modificationDate=1533145538000&api=v2](https://community.icann.org/download/attachments/90769206/Consolidated%20URS%20Discussion%20Document%20-%20updated%2031%20July%202018v2.docx?version=1&modificationDate=1533145538000&api=v2)
- Staff Report of URS Cases and Initial Metrics:
  - Compilation Report (31 July 2018): [https://community.icann.org/download/attachments/90769206/Staff%20compilation%20report%20-%20updated%20URS%20data v1.1%20-%2009%20July%202018.docx?version=2&modificationDate=1533053814000&api=v2](https://community.icann.org/download/attachments/90769206/Staff%20compilation%20report%20-%20updated%20URS%20data%20v1.1%20-%2009%20July%202018.docx?version=2&modificationDate=1533053814000&api=v2)
  - Claims Denied Cases (28 August 2018): [https://community.icann.org/download/attachments/90769206/claim\\_denied\\_analysis v0.3 - with UPDATED notes.docx?version=1&modificationDate=1535564718000&api=v2](https://community.icann.org/download/attachments/90769206/claim_denied_analysis_v0.3_-_with_UPDATED_notes.docx?version=1&modificationDate=1535564718000&api=v2)
  - De Novo Review Cases (23 July 2018): [https://community.icann.org/download/attachments/90769206/Summary Table - URS Final Determination Cases as of Dec 2017 - UPDATED 25 July 2018.docx?version=1&modificationDate=1533053859000&api=v2](https://community.icann.org/download/attachments/90769206/Summary%20Table%20-%20URS%20Final%20Determination%20Cases%20as%20of%20Dec%202017%20-%20UPDATED%2025%20July%202018.docx?version=1&modificationDate=1533053859000&api=v2)
  - Cases with Final Determination (23 July 2018): [https://community.icann.org/download/attachments/90769206/Summary Table - URS Final Determination Cases as of Dec 2017 - UPDATED 25 July 2018.docx?version=1&modificationDate=1533053859000&api=v2](https://community.icann.org/download/attachments/90769206/Summary%20Table%20-%20URS%20Final%20Determination%20Cases%20as%20of%20Dec%202017%20-%20UPDATED%2025%20July%202018.docx?version=1&modificationDate=1533053859000&api=v2)
- Responses from URS Practitioners to Sub Team-Developed Survey (12 June 2018): [https://community.icann.org/download/attachments/86606544/URS Practitioners Survey Summary Results 12 June 2018.pdf?version=1&modificationDate=1528859972000&api=v2](https://community.icann.org/download/attachments/86606544/URS%20Practitioners%20Survey%20Summary%20Results%2012%20June%202018.pdf?version=1&modificationDate=1528859972000&api=v2)
- Mapping of URS Rules, URS Procedure, and URS Providers' Supplemental Rules (14 May 2018): <https://docs.google.com/spreadsheets/d/1Ej4rcuW3qYnj-vuMNZ2jF6aY6eoQOg9nGjj8H5rztWY/edit?usp=sharing>
- Analysis of URS cases performed by Professor Rebecca Tushnet, a Working Group member (2 May 2018): <https://www.dropbox.com/s/1dodxsqkauqp1vr/URS%20Case%20Review%20-%20Final.xlsx?dl=0>

## 11.2 TMCH Documents

- Proposed Answers to TMCH Charter Questions & Proposals for Community Input Agreed by the Working Group (23 October 2019) <https://docs.google.com/document/d/1YkrdpK0-JiVqEiIXi-C4CpbBK6SzmNidbYZeXMFitiw/edit#>

- Status of Working Group Discussions on Agreed TMCH Charter Questions (17 October 2019):  
<https://drive.google.com/a/icann.org/file/d/1XVBTQEKU2zTCnaXAMIPGiUnFedKp8SZI/viw?usp=sharing>
- TMCH proposals submitted by individual Working Group members (April-May 2017 & September - October 2019): <https://community.icann.org/x/HJOGBg>
- Chronological Listing of Source Documents for the Trademark Clearing House (TMCH) (9 August 2019):  
[https://docs.google.com/document/d/17wmc\\_hmA25KXOL7W43A4vKyAeQnrxiUrU3ewCa8VYoA/edit?usp=sharing](https://docs.google.com/document/d/17wmc_hmA25KXOL7W43A4vKyAeQnrxiUrU3ewCa8VYoA/edit?usp=sharing)
- Tabular summaries of categorized, final TMCH Charter Questions, data reports and related discussions (February - March 2017): <https://community.icann.org/x/pHRAw>

### 11.3 Sunrise & Trademark Claims Services Documents

- Sunrise Sub Team Recommendations Endorsed by RPM PDP Working Group (24 July 2019):  
[https://drive.google.com/open?id=1WRKL\\_3JfzWtRIBmutxthyaEtO6yjr9XtgImWaB0eZk](https://drive.google.com/open?id=1WRKL_3JfzWtRIBmutxthyaEtO6yjr9XtgImWaB0eZk)
- Trademark Claims Sub Team Recommendations Endorsed by RPM PDP Working Group (17 July 2019):  
[https://drive.google.com/open?id=1jlu8SSGBh297PFAHPy\\_F59iqO7RD4c2MCNWG5ZDLwR\\_s](https://drive.google.com/open?id=1jlu8SSGBh297PFAHPy_F59iqO7RD4c2MCNWG5ZDLwR_s)
- Summary Table of Final Agreed Sunrise Questions, Data & Discussions (30 May 2019):  
[https://drive.google.com/open?id=1WmHmHz\\_fO6nrzkyXkgQ7uVoLEksyqQ1Kl6dENJf9yal](https://drive.google.com/open?id=1WmHmHz_fO6nrzkyXkgQ7uVoLEksyqQ1Kl6dENJf9yal)
- Summary Table of Final Agreed Trademark Claims Questions, Data & Discussions (20 May 2019):  
<https://drive.google.com/open?id=1sHelCAyd5ptxRynuG4LWQAR8q3fZfj3nffw1SqsUtXo>
- Sunrise and Trademark Claims proposals submitted by individual Working Group members:  
<https://community.icann.org/pages/viewpage.action?pageId=102146375#SunriseClaims--324377862> (27 March 2019)
- Analysis Tool for Previously Collected Data Related to Sunrise & Trademark Claims (27 February 2019):  
[https://docs.google.com/spreadsheets/d/1SzvdmVhY8dZ4l\\_ZGVoN5IOSueHNzbm1jQErssAJI8QQ/edit?usp=sharing](https://docs.google.com/spreadsheets/d/1SzvdmVhY8dZ4l_ZGVoN5IOSueHNzbm1jQErssAJI8QQ/edit?usp=sharing)
- Additional Data related to Sunrise & Trademark Claims (20 February 2019):  
[https://docs.google.com/spreadsheets/d/13cFaDug4DKMyajz\\_t1hunV6U4MSiyFFWbWBNGD4ppN0/edit?usp=sharing](https://docs.google.com/spreadsheets/d/13cFaDug4DKMyajz_t1hunV6U4MSiyFFWbWBNGD4ppN0/edit?usp=sharing)
- Analysis Tool for Sunrise & Trademark Claims Survey Results (12 December 2018):  
<https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWIPZt0yyNF-Vs1qmUuljg/edit?usp=sharing>

## 11.4 TM-PDDRP Documents

- Analysis of ICANN community responses to TM-PDDRP survey (18 October 2016): <https://community.icann.org/download/attachments/61606586/Consolidated%20GNSO%20RPM%20WG%20Survey%20with%20graphs.docx?version=1&modificationDate=1476828167000&api=v2>
- Collated information from Working Group members concerning perceived abuse by new GTLD Registry Operators relating intellectual property rights (17 October 2016): <https://community.icann.org/download/attachments/61606586/Collated%20Examples%20Of%20Perceived%20Registry%20Conduct%20within%20TM-PDDRP%20scope%20-%2017%20Oct%202016.pdf?version=1&modificationDate=1476830337000&api=v2>
- Compilation of survey questions and responses from TM-PDDRP Providers (June/September 2016): <https://community.icann.org/x/ugqsAw>

## 11.5 Additional Marketplace RPMs Documents

- Categorization of Additional Marketplace RPM Questions by Target Stakeholder/Respondent (10 March 2018 & 4 October 2017): <https://static.ptbl.co/static/attachments/169149/1520706764.pdf?1520706764> and <https://static.ptbl.co/static/attachments/169133/1520694505.pdf?1520694505>
- Summary Compilation of Information on Additional Marketplace RPMs (Protected Marks List Services) (21 September 2017): <https://static.ptbl.co/static/attachments/169136/1520695803.pdf?1520695803>
- Final set of proposed questions related to the additional marketplace RPMs that was considered by the Working Group (15 September 2017): <https://community.icann.org/download/attachments/69283988/CLEAN%20Draft%20Final%20Additional%20Marketplace%20RPM%20Questions%20-%2015%20September%202017.pdf?version=1&modificationDate=1505764402000&api=v2>
- Initial list of questions proposed by the Working Group Co-Chairs (28 May 2017): <https://community.icann.org/download/attachments/66080081/Questions%20for%20Private%20Protections%20Sub%20Team%20-%20For%20WG%20Discussion%20-%2028%20May%202017.docx?version=1&modificationDate=1497552761000&api=v2>

## 11.6 Public Comment Review and Analysis Documents

- Public Comment Analysis document that summarizes Sub Group A's and Working Group's deliberation on public comments for preliminary recommendations and questions related to the TMCH, Sunrise, Trademark Claims, and TM-PDDRP (27 August 2020): [https://docs.google.com/document/d/10mftuhNy7YMgtClu2ZRwsCleDgbP8AAAFz\\_jMHBF\\_L70/edit?usp=sharing](https://docs.google.com/document/d/10mftuhNy7YMgtClu2ZRwsCleDgbP8AAAFz_jMHBF_L70/edit?usp=sharing)

- Public Comment Analysis document that summarizes Sub Group B's and Working Group's deliberation on public comments for preliminary recommendations and questions related to the URS (8 September 2020):  
[https://docs.google.com/document/d/110lt4ZZMV6V4XY77J6DUq-H\\_ZGtdPNV8qCB\\_5Ukd29E/edit?usp=sharing](https://docs.google.com/document/d/110lt4ZZMV6V4XY77J6DUq-H_ZGtdPNV8qCB_5Ukd29E/edit?usp=sharing)
- Public Comment Analysis document that summarizes Working Group's deliberation on public comments for overarching charter questions and general input (25 August 2020):  
[https://docs.google.com/document/d/1B7f4i96jwZ\\_MmAV2GuMhkr6VJLPCT55aNH9\\_xqeeX3E/edit?usp=sharing](https://docs.google.com/document/d/1B7f4i96jwZ_MmAV2GuMhkr6VJLPCT55aNH9_xqeeX3E/edit?usp=sharing)
- Public Comment Analysis document that summarizes Working Group's deliberation on public comments for individual proposals that did not rise to the level of becoming preliminary recommendations (6 August 2020):  
<https://docs.google.com/document/d/1Pnqor6rHjvowH66GPQG9XI23n8H2mgkbf39-jA4KlFc/edit?usp=sharing>
- Public Comment Review Tool that facilitates review of public comments for preliminary recommendations and questions related to the TMCH, Sunrise, Trademark Claims, and TM-PDDRP (19 May 2020):  
<https://docs.google.com/spreadsheets/d/1xMehg9o44bdz85ry0LJvhzoOaKdmJ6SwlrLneMx0lxc/edit?usp=sharing>
- Public Comment Review Tool that facilitates review of public comments for preliminary recommendations and questions related to the URS (19 May 2020):  
[https://docs.google.com/spreadsheets/d/16p196gjSt1CCXnowlWeXl\\_BcaggiXpoxiRSKFv1Mg18/edit?usp=sharing](https://docs.google.com/spreadsheets/d/16p196gjSt1CCXnowlWeXl_BcaggiXpoxiRSKFv1Mg18/edit?usp=sharing)
- Public Comment Review Tool that facilitates review of public comments for individual proposals that did not rise to the level of becoming preliminary recommendations (19 May 2020): [https://docs.google.com/spreadsheets/d/1QTt\\_m5qdzoalRDclUED01ur-yJgODCex8bj\\_-aKO7fl/edit?usp=sharing](https://docs.google.com/spreadsheets/d/1QTt_m5qdzoalRDclUED01ur-yJgODCex8bj_-aKO7fl/edit?usp=sharing)
- Public Comment Review Tool that facilitates review of public comments for overarching charter questions and general input (19 May 2020):  
<https://docs.google.com/spreadsheets/d/1wke2krmhV2tNPNhviOskAILVraWp-88mqzScCtj01fw/edit?usp=sharing>

## 12 Annex F – Working Group Membership and Attendance

### 12.1 Working Group Membership and Attendance

The members of the full Working Group are listed below. Note that this list was accurate as of the publication of this report. Some members joined the Working Group only after it began meeting but left during its deliberation.

Name	Affiliation
Alyne De Andrade De Oliveira Bezerra	At-Large
Mona Al Achkar	At-Large
Plamena Petrova Popova	At-Large
Sean Martin McDonald	At-Large
Vinzenz Heussler	At-Large
Alison Simpson	BC
Beth Allegretti	BC
Gabriela Szlak	BC
Jay Chapman	BC
Margie Milam	BC
Marie Pattullo	BC
Nat Cohen	BC
Susan Kawaguchi	BC
Zak Muscovitch	BC
Mathieu Weill	ccNSO
Heather Costelloe	CSG
<b>Brian Beckham - Co-Chair</b>	GAC
Jaifa Mezher Arango	GAC
Alexandra Perry	Individual
Alonso Mayordomo Castilla	Individual
Arthur Fouré	Individual

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<b>Name</b>	<b>Affiliation</b>
Ben Menor Jr.	Individual
Brian Hayes	Individual
Charles Oluoch Oloo	Individual
Christine Farley	Individual
Christopher M. Thomas	Individual
Cindy Spencer	Individual
Colin O'Brien	Individual
Cyntia King	Individual
Dale Nelson	Individual
Daniel Loka	Individual
Danny Glix	Individual
Dan Weinstein	Individual
Dominic DeLuca	Individual
Elisa Cooper	Individual
Elizabeth Orembo	Individual
Elliot Silver	Individual
Flip Petillion	Individual
Gary Saposnik	Individual
Georges Nahitchevansky	Individual
Gerald M. Levine	Individual
Hasanuzzaman Lasker	Individual
Ines Hfaiedh	Individual
Ivett Paulovics	Individual
Jan Janssen	Individual
Jeff Lloyd	Individual
Joe Styler	Individual
Josh A. Partington	Individual
Julien Chaisse	Individual
Justin Bukspan	Individual



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<b>Name</b>	<b>Affiliation</b>
Justine Chew	Individual
Kamila Sekiewicz	Individual
Khaled Koubaa	Individual
Kostantinos Oikonomoy	Individual
Kurt Pritz	Individual
Liz Orembo	Individual
Louise Marie Hurel	Individual
Mariia Parubets	Individual
Mark Massey	Individual
Mary Forbes	Individual
Massimo Vittori	Individual
Michael De Wit	Individual
Mike Russell	Individual
Mitch Stoltz	Individual
Monica Mitchell	Individual
Paul Raynor Keating	Individual
Paul Tattersfield	Individual
Peter Muller	Individual
Rebecca Tushnet	Individual
Renee Fossen	Individual
Renee Reuter	Individual
Robin Cali	Individual
Roger Oteng Baah	Individual
Ryan Pearce	Individual
Salvador Camacho Hernandez	Individual
Shiva Kanwar	Individual
Steven M. Levy	Individual
Sue Williams	Individual
Takashi Nagazaki	Individual

Name	Affiliation
Thomas Brackey	Individual
Toni Ojala	Individual
Vaibhav Aggarwal	Individual
Voica Emil Catalin	Individual
Yogesh Malik	Individual
Zhou Heng	Individual
Alistair Payne	IPC
Ankur Raheja	IPC
Brian J. King	IPC
Brian Scarpelli	IPC
Brian Winterfeldt	IPC
Caroline Chicoine	IPC
Claudio DiGangi	IPC
David Einhorn	IPC
David Taylor	IPC
Diana Arredondo	IPC
Doug Isenberg	IPC
Emily Weaver	IPC
Greg Shatan	IPC
Griffin Barnett	IPC
Heather Forrest	IPC
Hector Ariel Manoff	IPC
Jim Bikoff	IPC
Jonathan Agmon	IPC
<b>John McElwaine - GNSO Council Liaison</b>	IPC
Kiran Malancharuvil	IPC
Liz Williams	IPC
Lori Schulman	IPC
Marc Trachtenberg	IPC

Name	Affiliation
Michael Flemming	IPC
Michael R Graham	IPC
Michael Peroff	IPC
Mike Rodenbaugh	IPC
Nick Wood	IPC
Pascal Boehner	IPC
Petter Rindforth	IPC
Phillip Marano	IPC
Sarah Deutsch	IPC
Scott R. Austin	IPC
Susan Payne	IPC
Zaki Ahmed Siddiqui	IPC
Paul McGrady	IPC
Amr Elsadr	NCSG
June Tessy	NCSG
<b>Kathy Kleiman - Co-Chair</b>	NCSG
Monika Zalnieriute	NCSG
Wisdom Donkor	NCSG
Benjamin Akinmoyeje	NCUC
Dina Solveig	NCUC
Farzaneh Badii	NCUC
Huthaifa Mohammad Albustanji	NCUC
Michael Karanicolas	NCUC
Padmini Baruah	NCUC
Renata Aquino Ribeiro	NCUC
Roxanne John	NCUC
Sarah Clayton	NCUC
Sonigitu Asibong Ekpe	NCUC
Taiwo Peter Akinremi	NCUC

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Name	Affiliation
Yuri Chumak	NCUC
Martin Silva Valent	NPOC
Poncelet Ileleji	NPOC
Rudi Vansnick	NPOC
Jeff Neuman	RrSG
Laurie Anderson	RrSG
Reg Levy	RrSG
Roger Carney	RrSG
Theo Geurts	RrSG
Volker Greimann	RrSG
Alan Woods	RySG
Elizabeth (Beth) Bacon	RySG
David Maher	RySG
David McAuley	RySG
Hector Gonzalez	RySG
Jason Schaeffer	RySG
Jonathan Frost	RySG
Jon Nevett	RySG
Lillian Fosteris	RySG
Maxim Alzoba	RySG
<b>Philip S. Corwin - Co-Chair</b>	RySG
Scott Harlan	RySG

**Additional information**

- Statement of Interest of Working Group members: <https://community.icann.org/x/3iWAAw>
- Detailed attendance records: <https://community.icann.org/x/7EqAAw>
- Email archives of the full Working Group: <http://mm.icann.org/pipermail/gnso-rpm-wg/>

## 12.2 Sub Team Membership

Membership was also tracked for all of the Sub Teams as well, which can be found on the Sub Team wiki workspaces below:

- TMCH Charter Questions: <https://community.icann.org/x/siK4Aw>
- TMCH Data Gathering: <https://community.icann.org/x/UwSbAw>
- RPM Data: <https://community.icann.org/x/fY1EB>
- Sunrise Charter Questions: <https://community.icann.org/x/nMrRAw>
- Sunrise Data Review: [https://community.icann.org/x/3wT\\_BQ](https://community.icann.org/x/3wT_BQ)
- Trademark Claims Charter Questions: <https://community.icann.org/x/qMrRAw>
- Trademark Claims Data Review: [https://community.icann.org/x/6QT\\_BQ](https://community.icann.org/x/6QT_BQ)
- URS Documents: <https://community.icann.org/x/1BW8B>
- URS Practitioners: <https://community.icann.org/x/yhW8B>
- URS Providers: <https://community.icann.org/x/3BW8B>
- Additional Marketplace RPMs: <https://community.icann.org/x/tcrRAw>
- Sub Group A: <https://community.icann.org/x/WwldC>
- Sub Group B: <https://community.icann.org/x/ZwldC>

## 12.3 Observers

There were close to 100 observers to the full Working Group. Observers were allowed to receive messages from the Working Group, but were not able to post to the mailing list nor attend the Working Group meetings. As Observers, they were not required to submit Statements of Interest. A list of the Observers can be found at: <https://community.icann.org/x/3iWAAw>

## 13 Annex G – Community Input

### 13.1 Request for Input

According to the GNSO’s PDP Manual, a PDP Working Group should formally solicit statements from each GNSO Stakeholder Group and Constituency at an early stage of its deliberations. A PDP Working Group is also encouraged to seek the opinion of other ICANN Supporting Organizations and Advisory Committees who may have expertise, experience or an interest in the issue.

At the start of its deliberation on Phase 1, the Working Group reached out to all ICANN Supporting Organizations (SOs) and Advisory Committees (ACs) except for the Country Code Names Supporting Organization (ccNSO), as well as all GNSO Stakeholder Groups and Constituencies with requests for input.

The Working Group sought input on the following three questions:

1. What are your general views, concerns, and questions on the RPMs listed in Phase 1?
2. What issues concerning the Phase 1 RPMs are most relevant to your work and what do you feel is essential that our Working Group be aware of or focus on as it proceeds in its tasks?
3. What questions and specific data points would you advise the Working Group to pursue in this data gathering effort?

In response, statements were received from the:

- Registries Stakeholder Group (RySG)
- Root Server System Advisory Committee (RSSAC)
- Security and Stability Advisory Committee (SSAC)

Their full statements can be found here: <https://community.icann.org/x/zheOAw>

All of the statements received were reviewed by the Working Group as part of its deliberations on relevant topics.

### 13.2 Public Comment Forum on the Initial Report

On 18 March 2020, the Working Group published its [Phase 1 Initial Report for public comment](#). The Initial Report covered the RPMs applicable to gTLDs launched under the 2012 New gTLD Program. The primary objective of the Initial Report was to solicit input/feedback on the PDP Working Group’s: (i) twenty-six (26) preliminary recommendations; (ii) seventeen (17) specific questions for community input; and (iii) twenty-four (24) proposals submitted by individual Working Group members that did not rise to the level of becoming preliminary

recommendations. In addition, the Working Group invited input on its six (6) overarching Charter questions.

The Working Group used a Google Form to collect public comments. Fifty-five (55) contributions were received (38 from organizations, five from ICANN community groups, and 12 from individuals). The public comments submitted can be found at:

[https://docs.google.com/spreadsheets/d/1VX5swylTsUMDOZu5t\\_a2bhohiqUDnLQg7Yqf1CtvSYM/edit?usp=sharing](https://docs.google.com/spreadsheets/d/1VX5swylTsUMDOZu5t_a2bhohiqUDnLQg7Yqf1CtvSYM/edit?usp=sharing)

To facilitate its review and analysis of the public comments received, the Working Group used a set of public comment review tools (PCRTs) and analysis summary documents (see <https://community.icann.org/x/HzSJBw>). Through online review, sub group processes, and plenary sessions, the PDP Working Group completed its review and assessment of the public comments received and agreed on changes to be made to its final recommendations and Final Report.