
ICANN Transcription
Review of all Rights Protection Mechanisms (RPMs)
Wednesday, 14 August 2019 at 17:00 UTC

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TERRI AGNEW: Good morning, good afternoon, and [good evening. Welcome to the Review of all Rights] Protection Mechanisms (RPM) in all gTLD's [PDP Working Group taking place on the 14th] of August 2019.

[In the interest of time], there'll be no roll call as we have quite a few participants. Attendance will be taken by the Zoom room. If you're only on the audio bridge, could please identify yourselves now?

DAVID MCAULEY: Hi, it's David McAuley I'm on the audio bridge only today.

TERRI AGNEW: Thank you. David, are you ending in 624 by chance?

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DAVID MCAULEY: 8624, yes.

TERRI AGNEW: Okay, great.

DAVID MCAULEY: Yes, 624.

TERRI AGNEW: Wonderful. Thank you very much. Hearing no one further, I would like to remind all to please state your name before speaking for transcription purpose, and to please keep your phones and microphones on mute when not speaking to avoid any background noise. With this, I'll turn it back over to our co-Chair, Brian Beckham. Please begin.

BRIAN BECKHAM: Thank you, Terri. Welcome, everyone. So let me start by asking if there are any comments on the agenda which you should've received by e-mail earlier this week and/or any updates to Statements of Interest?

Okay, seeing none, what we proposed to do here this week was, if you remember, we still had a few outstanding questions regarding the Trademark Clearing House, and we thought it might be useful before we launch into that to try to see if we have any agreement on any of those – I think there were three outstanding questions – to just refresh

everyone's memory on the kind of chronology of how we got here and that included a list of source documents that there are a lot of links to if you want to do a deeper dive into those. And then of course there is the Special Trademark Issues Work Team Report which is situated in that chronology.

If I could just have the chronology up on the screen, I think we were going to through that first. I'm not going to propose to read through all of these because it includes a lot of Board and Council motions and things that I think are a little bit extraneous to our discussion today. The idea was really just to refresh our memory, not to go over in any level of detail the specific motions and that sort of thing. But of course, the text is there for everyone to read and is available for you to read outside of this call as well.

If it's okay with you, what I propose to do is to just sort of go over on a very high level this listing of source documents. I think that will take a little bit of time. But what we have going way back into 2007 – so we're over a decade ago – was the protecting rights of others working group which was a subgroup of the GNSO PDP on introduction of new gTLDs and they kind of gotten the ball rolling in terms of the RPM discussion by making a recommendation which found its way into the GNSO PDP final report which said in very broad terms that [inaudible] the rights and it didn't really provide much more detail beyond that. That was if you want to go back and look at history, that was down to the fact that there was a lack of agreement on the specifics.

That was later approved by the GNSO Council. The Board adopted those recommendations and then we came to the first version of the

Guidebook, also over 10 years ago. From then you had a Board resolution convening what they call the IRT, the Implementation Recommendation Team, and it was decided that trademark protection was I think what they called an overarching issue in terms of the new gTLD launch, and so the IRT team was formed. It published its final report in May of 2019. From there, following some community discussion, the Board requested that GNSO Council view on the IRT Report and the Guidebook version followed that. In effect, the Board said to the Council, “If you would like to come up with something better or different, please do so. Otherwise, the Board would take a vote on the Guidebook version that followed the IRT work.”

The Council took the Board up on that, it set up the Special Trademark Issues Review Team or the STI, and we’ll look a little bit more in detail at what that team recommended after we go through this chronology. Following that, the STI, together a final report which was voted on and approved by the Council. And you see there, the Council – I understand there was some kind of discussion around the specifics of the STI reporting so the Council approved the overall package of recommendations contained in the STI Report.

From there the Council and the Board, I think both requested public comments on the STI Report that was put out for public comment, the staff produced a report of those and we’re now up to February 2010. The Board asked the staff to look at the public comments on the STI Report, and that takes us to March of 2010 which is the fourth version of the Applicant Guidebook, which is the version prior combining the STI work and the public comments on the STI final report.

That takes us further to May of 2010 where we have the updated TMCH document published in the Guidebook version 4. From there there's a rapid succession of relevant entries here. We had updated TMCH document published in Guidebook version 5, version 6, have an explanatory memorandum in May 2011. We have the Board resolution launching the New gTLD Program. We have Guidebook version 8, guidebook version 9. Then in June 2012 we have the final TMCH framework published. That's followed by an explanatory memorandum on the "matching rule" and on the "proof of use."

Then we have a staff report on public comments received in reaction to those two memorandums. We have an ICANN report of the input received that takes us to, I think for relevance here, the final TMCH requirements that features an operation published in September of 2013.

I know that's a bit of whirlwind and I obviously didn't cover every last item and didn't read a specific text of the various motions, but we thought it may be useful just for working group members to recall some of the history, very detailed history, over the past 10 plus years that got us to where we are today. Are there any questions or comments or thoughts on the chronology? Martin, I see you have your hand up. Please.

MARTIN SILVA:

Hi, can you hear me?

BRIAN BECKHAM: Yes.

MARTIN SILVA: Oh, thank you very much. At least in my case, I've seen the STI before. It's not the first time that I read but in these last things that we've been discussing, some things came to my mind. Most of you know I'm a GNSO Councilor, so when I see stuff that came from the GNSO Council, for me it's both something to update on history and that somehow the Council should work and the legitimacy of this decision and everything.

You don't have to take a lot of time on me, but for me it would be very helpful to understand first of all, what was the background of the STI? What was the purpose and the composition of the STI?

And second of all, what happened afterwards? Because it seems like a very multistakeholder developed work on issues that we are literally debating right now and then sort of disappeared into new policy or new things. So what happened with the works of the STI?

BRIAN BECKHAM: Thank you, Martin. Again, I will certainly invite others on the call who have been involved in this work to assist with the attempted explanation here.

My recollection was you had me that the idea the program was going to be launched. You had some concerns raised from trademark owners. Primarily, I think it centered around scalability. So, in the past there were new gTLD rounds where there were a handful, half a dozen new gTLDs launched, and it was reasonably manageable for brand owners to

monitor Sunrises and potential infringements in those spaces. And the concern was that we were moving from a situation where you were going to have five or six new gTLDs launching at once to what ended up being over a thousand. So, the question was whether people could possibly manage to monitor new gTLD launches on such a scale.

I see Mary had her hand up. Mary, maybe I'll just quickly wrap up and then feel free to add.

So, the Board formed the IRT, the Implementation Recommendation Team, that was about 20 intellectual property experts. It was also included Mary who was a Non-Commercial I think Councilor at that time, Jeff Neuman who represented the Registrars, and Jon Nevett who represented the Registries. They came up with the package of recommendations that was put out for comment and the STI was formed basically, if you will, to kind of reshape along the community's preferences work of the IRT, and then this is where we went through the history just now.

After the STI, there were different calls for public comments and iterations of the Guidebook following this public comment. So it seems that the Guidebook iterations that we had following the STI work were tweaked, if you will, in response to public comments.

Mary, I think that's my best stab at answering Martin's question. Do you have something you could help out with maybe?

MARY WONG:

Hi, Brian. Hi, Martin. Hi, everyone. It's Mary from staff. So, Brian, I think you did a really nice job summarizing and encapsulating the history that brought us to where we are today in terms of reviewing the TMCH. The chronological timeline that you're seeing on the screen probably does speak for itself and, Brian, your explanations were exactly in line with that.

So, on the staff side – and I'd like to note that I'm speaking for the Staff Support Team. I'm not speaking in a capacity of someone who participated in early discussions, but the Staff Team did go back to look at the GNSO Council's deliberations that led to the creating of the STI through the work of the STI and to the GNSO Council's adoption of the overall package that the STI recommended. So, hopefully just these additional details can help flesh out the story a little bit.

The Board letter to the GNSO Council in, I believe, was October 2009, concerned the implementation of the GNSO's 2007 recommendation. That's stated in the Board's letter which also says that the Board request the GNSO's view on whether the then current AGB model were consistent with that recommendation. And as a result, the Board basically said, given that this original direction from the GNSO is very general, the Board wanted the Council to have the opportunity to offer more focused and timely input at this time which was late 2009.

So, like I said, the staff went through the GNSO Council's deliberations as to how to address this Board request in October 2009. The Council first formed a drafting team which eventually became the STI Review Team. And the STI Team did amazing amount of work in a short period of time, which then, as you noted, Brian, led to the over package that

they recommended being approved by the Council for forwarding to the Board and I believe it was December, so in a two months' span of time.

So, Martin, I hope that answers your question because I think Brian has already described that subsequent to the STI Report which the Board directed ICANN staff to then use to develop a further model, we had another few more years of work that brought us to the final features of the TMCH. So without repeating too much, I hope that was helpful. Thank you.

BRIAN BECKHAM:

Thanks, Mary. Next I have Susan in the queue.

SUSAN PAYNE:

Yeah, hi. And I just wanted to – my quick take on this [inaudible] work. To be fair, I wasn't really participating actively in ICANN at the time that this was all happening, although I did put in comments in my employer's capacity on the Applicant Guidebook. But I think if one is familiar with what PDP output looks like these days and how it's treated by the Council, then what was happening back in 2007 to 2009 or even beyond that period is perhaps a bit unfamiliar. And we've had these same conversations in the Subsequent Procedures Working Group where we've been looking at what the actual policy was and it's really high level. The 2007 policy is really – these really high level statements of intent and then all of the kind of real detail got worked out in these successive version of the AGB in a way that I think probably isn't how things would work now. And perhaps that's why it's sort of looking so unfamiliar to you and to most of us, frankly.

BRIAN BECKHAM: Thanks, Susan. Martin, is that a new hand I think?

MARTIN SILVA: Yes, new hand.

BRIAN BECKHAM: Please, go ahead.

MARTIN SILVA: Okay, thank you very much. Thank you all. I mean that has been amazing. As Susan said, this is definitely old ways of work and I mean tomorrow we're going to have new ones, and I'm pretty sure new people is going to ask him whether we did it now, so thank you all for taking the time.

The last question I think to fully address the impact of the STI is, was it policy? The policy was then absorbed by the Guidebook – because as a lawyer I tend to think, the wheel of the Council is replaced over time and the new wheel replaced the old one, so is that what happened here? The STI ruled out rules and policy and then was overwritten by the Guidebook, for instance?

BRIAN BECKHAM: Yeah, thanks, Martin. I can try to answer that but I'll also answer that by saying that this is a question we've been discussing amongst the co-Chairs and staff, and we don't have unanimity in an assessment of that.

There's a view that the versions of the Guidebook control, if you will, and then the view that the STI principles would be our fallback point. And of course, the reason why this is a potentially relevant question is that we know that in the absence of policy recommendations from this working group then the status quo would prevail, so that raises the question of what is the status quo?

As co-Chairs, we were thinking because we have different views on this, it might be a question that we need to seek some guidance from the Council on. I think if I can be frank, that the Council is probably going to have some of the same questions we do and they will look at the same history.

And as Susan said, if you're looking back from the rearview mirror, a lot of the policy making has been done a bit on the fly it seems in hindsight. There were a lot of rapid fire versions of the Guidebook and public comments and a new version of the Guidebook and public comments and maybe it would be done differently today. I think one thing is relatively clear that the STI Report is not "policy" or consensus policy because it didn't go through a properly chartered policy development process. And of course, that's one of the questions for this working group which is – and the question is whether the RPMs that we're reviewing now should become consensus policy? So, as a practical example, that would raise the question of whether the URS, which is currently applicable by contract to new gTLD registries as part of the package of the Applicant Guidebook would become a consensus policy and therefore applicable to incumbent TLDs like .com. But that's a question before us. The kind of supposition from Council in asking us as a working group that question is that it's not a CP (consensus policy)

because it doesn't apply to all TLDs. So, they're asking us the question whether our policy recommendation is that it takes on that format.

I see as I was talking – Mary, is that a new hand? And then Phil and Martin, I don't know if that's a new or old hand.

MARY WONG: Brian, it's a new hand but I'll sit to Phil and then add maybe some staff feedback, if you can.

BRIAN BECKHAM: Phil, please.

PHILIP CORWIN: Thank you. Can you hear me okay?

BRIAN BECKHAM: Yes.

PHILIP CORWIN: Yeah. I just want to speak briefly to this point. I think the first thing that's incontrovertible is that the current RPMs are not consensus policy. They only apply to new gTLDs. They are not required as a legacy TLDs, and one of the questions in our Charter is whether any or all of them should become consensus policies. So, there's really like no dispute that they're not consensus policy.

Now, are they policy? I was very much involved with the STI and I was preparing the comments on various iterations of the Applicant Guidebook for clients, and my clear recollection that at that time, the word that was being used to describe both the STI and then the further subsequent development of the trademark protections in the Applicant Guidebook was that the implementation details of a general policy adopted by the Council in 2007 to protect trademarks and new TLDs. But in my view, the fact that the Council referenced the STI in 2009 didn't turn that into policy. It still wasn't the product of a PDP, and if that was a policy then we have 45 months of very detailed further refinement of that policy and the community comments on the Applicant Guidebook.

So, my final view on this – I think this would also be accepted broadly – is that whatever we recommend since we are a Council chartered PDP, that once we issue our report that the RPMs Post Council and Board Acceptance Program Report and whatever recommendations we make, then these things become policy. They're still not consensus policy. We have to recommend as one or more of these RPMs should become required of legacy TLDs, but they certainly would become policy by having gone through an entire PDP review.

So, those are my personal views. I'm not trying to oppose them. I think I'm on firm ground, but I'll stop there and defer to Mary and others to speak further. Thank you.

BRIAN BECKHAM:

Thank you, Phil. Martin, again.

MARTIN SILVA: Just to say thank you all. I know you all already saw this with your own eyes, and for me it's very, very interesting because, for instance, challenging the idea of what is or not consensus policy, for me it wasn't something that obvious. So, thank you, thank you. This is not in vain. Thank you very much.

BRIAN BECKHAM: Thank you, Martin. And just to double check, sorry, Mary and Phil, that those are old hands?

MARY WONG: Mine is in fact new, Brian.

BRIAN BECKHAM: Okay, go ahead.

MARY WONG: Thank you. Just to follow up on this discussion, staff would like to offer a couple of observations. One if from the ICANN Org perspective and I want to emphasize that this is not my view or the view of just myself, Julie and Ariel. It is the ICANN Org view that the STI recommendations are not policies that are binding on ICANN's contracted parties through a PDP.

Secondly, the procedures for initiating, approving and conducting a PDP existed in 2009, those were not the procedures that the GNSO Council

followed because the GNSO Council was acting a response to the Board's letter that requested feedback on the then current proposed implementation.

Thirdly, on the question of how policies, procedures, or etc., become binding on ICANN's contracted parties? There are two ways. One, if a consensus policy comes out of a PDP and is approved by the Board as such. Two, by agreement and insertion into the respective agreements. In this case, the Registry Agreement applicable to the New gTLD Program, and for the registrars, the 2013 Registrar Accreditation Agreement.

So, in terms of the STI recommendations, it is ICANN Org's view that the STI recommendations were not policies in the way that that word is understood in ICANN circles or the product of a PDP. It was binding in the sense that – and when I say "it" I mean the TMCH, Sunrise, Claims and the URS in their final forms were binding on ICANN's contracted parties because they were obliged through their contract with ICANN to specifically comply with each of these RPMs. So, I hope that's helpful and I hope that's a clear enough elucidation of ICANN Org's view. Thank you.

BRIAN BECKHAM:

Thank you, Mary. I don't see any other hands. I'm going to wait just a moment to see if anyone has any further reactions to this. I would note just from my own perspective, I don't want to speak for Phil or Kathy but I think for me, in preparation for this call I've gone through a lot of this history. I looked at the STI Report and I think it's absolutely useful

to inform our discussions and we can have an interesting debate about the STI versus the Guidebook. Maybe different people have different views on that, but I suggest that we have suite of RPMs that's been in operation for a couple of years now. We have some experiences based on registries and registrants and trademark owners and registrars implementing and using those RPMs, and while I think it's certainly useful to understand the history, I think maybe a more interesting approach would be to look at not only the history but the experience with the RPMs and look forward to see what have the experiences been in practice? Are there what people think to be deviations from whether it's the Guidebook or the STI report or whatever and take a view on how those work for us as a community, for individual stakeholders, stakeholder groups and make policy recommendations for the next round of new gTLDs. Because let's not forget that there is another group – Susan mentioned the Subsequent Procedures Working Group – that is from what I understand getting closer and closer to producing some recommendations. And so, we will have another round of new gTLDs and by some reports, there's expectations that there will be similar volumes. So I think there is certainly an expectation from Council and parts of the community that we would have some policy recommendations for them – for the launch of the next round of new gTLDs.

Phil, please.

PHILIP CORWIN:

Yes. I just wanted to add the observation that while it's very useful as we review all these RPMs, particularly the Trademark Clearing House, to

understand the history of the multiple processes that put it there, that in the end I don't think it's that important in that – I'm hearing some background noise. Please. And that we do know that, as Mary mentioned, the rules that the TLD operators are abiding by in regard to the RPMs are the rules in the Applicant Guidebook. That's what they're contractually bound to observe, so we certainly need to check the compliance there. And we have the ability as a working group to review each and every provision of every RPM and if we feel that it could be improved or is wrong in some ways, we can make any consensus recommendation we want to either – if we don't make a recommendation, it stays the way it is. If we want to make any recommendation that it would be slightly tweaked or revert to the STI version, or be some entirely new iteration, we have that in our power. So I think this is all interesting and useful for informing our discussion but this is a PDP chartered by Council. And as a result of our work, when our report is finally accepted hopefully by Council and the Board, whatever stays the same becomes a policy because we've signed off on it. Whatever we recommend for change by consensus will be changed and become policy. And if we want, we can recommend that one or more of the RPMs become consensus policy. So we've got the power to shape these going forward any way we want. Thank you.

BRIAN BECKHAM:

Thank you, Phil. I see Susan in the queue and I see Greg [needs a break].
Susan, please.

SUSAN PAYNE:

Thanks. I have a quick comment regarding what the SubPro is doing. Greg, could you mute your mic? Thanks. Sorry, I was just going to say one of the things we have been doing to go back to what is the policy, we've been looking in SubPro what the 2007 policy principles were and we've also been looking at the Applicant Guidebook and using geographic names as an example, not to suggest that we've reached the conclusion on that, which we certainly haven't. We're still working on it. But we definitely have been noting there were some policy recommendations, there were some policy in relation to geographic names that came out of the GNSO, and then what actually ends up in the Guidebook is not the same. And that is as a result of GAC advice, various public comment periods, and so on.

We are also within that working group taking the opportunity to do what Phil says which kind of formalize, so that if we're maintaining the status quo as expressed in the Applicant Guidebook but actually that's not what the policy says, then we're taking that opportunity to go, "Okay, the policy didn't quite say that but this is the policy now," or not to change it. You know, to change it if we think we need to change something.

I'm not sure if it matters so much in this case because if we go back to what the policy is, it's very, very high-level in relation to RPMs as in [you shan't] infringe the legal rights of others, and not much more detailed than that. But this is our opportunity to say now what the policy is rather than have this kind of continued uncertainty about, is the implementation is a policy, which was a whole working group by the way.

BRIAN BECKHAM:

Yeah, thank you, Susan. That's a good reminder of another working group on implementation.

Seeing no other questions, what I would propose to do is to move us over into the snapshot of the STI Report. And of course the idea here was whether one takes the view that this has one kind of status or another that it would be useful to know what one particular group thought in terms of the RPM specifically. For our purposes here, the Trademark Clearinghouse and if we have time, we can look a little bit at the URS, although I think having looked at that in preparation for today's call, that's going to be a little less relevant, if I might say, in terms of our plans to go over some of the individual proposals. Because if you remember, we actually did produce a couple of recommendations. I remember there was one regarding language and one regarding a provider notification by e-mail versus post. From my quick getting back up to speed on the STI Report, those would be the types of things that we've already covered in the individual proposals. Looking at the exact language of the STI Report I think is again an interesting background, but perhaps it's more squarely on our plate for the Trademark Clearinghouse.

So if I could just ask, Ariel or Julie, if they could help me pull up the STI Report. I am on page 8, it's Section 4. I'm going to – if it's okay with everyone – skip the preamble. I think we've discussed already the fact of the IRT and the Board asking the Council if they wanted to pull some recommendations together or the Board would vote on the IRT Report. I don't think we need to read that explanation in any great detail.

I think, frankly, the first Section 4.1 there is, of all the sections that I've read, I think most of them are a bit more on the background but this one is it's sort of squarely – the question that's in front of us in terms of the Guidebook versus the STI and the various, I think if I remember, there was something like nine iterations when we read over the chronology. So obviously, a lot of comments, a lot of iterations, but you see there that it says the recommendation – and I will note that there was a notation of rough consensus and a minority position – and so it says that the TC (Trademark Clearinghouse) database should be required to include nationally or multinationally registered “text mark” trademarks, from all jurisdictions, including countries where there is no substantive review.

And for those of you who aren't following at the time, there was a question – and I think part of the difficulty, frankly, that we're facing is that there's a lot of overlapping terminology and things are used in one sense to mean one thing and maybe different people interpret them differently, so where they talk about text mark and substantive review, of course, the term “text mark” does not seem to be defined in the STI Report and the issue of substantive review, there was a question about different examination practices in countries around the world. Most countries tend to take one approach, for example, they wouldn't require use prior to registration, whereas the USPTO and [full of] others do require that. So this is one of the reasons why in implementing the Guidebook ICANN required all trademark owners regardless of jurisdiction to submit proof of use to the Trademark Clearinghouse to be able to participate in Sunrises. So it goes on.

It says, “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.”

I want to make just two quick points here. I mentioned earlier that the term “text mark” didn’t seem to be defined and the term “design marks.” I’ve gone over some of our working groups e-mail discussions – this is taking us back I think two years now – but I found in a number of e-mails a number of different terms used for what seems to be kind of the same concept. So I found the word “stylized,” the word “non-standard,” the word “design,” the word “composite,” and the word “plus design,” and then of course “design marks.” Therein lies the rub, if you will. We have a reference to text marks, we have a reference to design marks, we have a half a dozen different iterations of this design mark terminology. Like I said earlier, I think the question before us is we have experience with RPMs in practice, how they worked, what are their concerns, what are the benefits, and what are our policy recommendations going forward?

Rebecca, please.

REBECCA TUSHNET:

I want to contest that characterization of the record that we have. We do. We have a lot of different words for things that aren’t text marks. We actually do have a pretty good word for things that are text marks which is text marks. So the fact there’s a lot of stuff and a lot of different subclasses of things that aren’t text marks is actually not very

relevant. I think the statement that you read is incredibly clear. The whole point of a non-text mark, even if it includes text, it is protected only as a whole, which is why it shouldn't be part of the TMCH because they're under a mandate not to expand trademark rights beyond what exist in the national law. International law, it protects something specifically. The domain name system, until it changes more substantially, you can't do that. Thank you.

BRIAN BECKHAM:

Thank you, Rebecca. I think you raised an interesting point, and of course there's in the USPTO, the standard character mark I think that's what we understand by a text mark here. You have design marks, as you said, we can't represent non-standard characters in the DNS. If I recall, I don't want to misattribute it, I think it was Greg Shatan's proposal, it was in terms of the design marks to say because, Rebecca, you made the point about the limitation of protection. It was that unless the text portions of the mark were required to be disclaimed as a whole then there seems to be a fair question about whether and to what extent that can or should be protected or allowed into the Trademark Clearinghouse for purposes of Sunrise.

I don't want to really get too much into the weeds on this today if that's okay with everyone because as I mentioned, this is part of a substance proposal and of course we'll have an opportunity to really discuss this in more detail. The idea here was really just to refresh people's memories on some of the legislative history, if you will, on this file.

Rebecca, is that new hand? Martin, please.

MARTIN SILVA:

Hi. Thank you. Yes. I'm not going to go into the weeds. It's just to say that I absolutely support Rebecca Tushnet's comments. It's insane that we give more rights than the national law gives. It doesn't make sense to have Deloitte or whoever is running the Trademark Clearinghouse creating new protections that go beyond the one that the right holder have. I think that the word "text" is definitely much more inclined to that way to say this is a text string. This is the concept of the word and so the word itself. That's why maybe when I read afterwards in the Guidebook, the word "word," a word mark, it's more vague. It could be interpreted as part of the design. I think it does matter. Go ahead.

BRIAN BECKHAM:

Thank you, Martin. I think there could be a reasonable question around whether in the absence of a disclaimer that we're in the territory of expanding trademark rights. But in any event, like I say, we'll have time to discuss that when we get to, as I remember, it was Greg's proposal or whoever it was that advocated us that proposal.

The next section was 4.2 on common law rights. The STI recommended that no common law right should be included in the TMCH except for court validated common law marks, provided that a new gTLD registries could ask TMCH to actually collect those if that particular registry wanted to do that and provided that it conformed with Recommendation 2.3.

I'll save you the trouble of looking that up. That relates to ancillary services. We started on Section 4. The first couple of sections really

relate to some of the contracting between ICANN and the Clearinghouse and separate functions. So, Recommendation 2.3 there is about ancillary services.

Then it said that Trademark Clearinghouse could charge higher fees to reflect the extra work that presumably they would have to do to collect common law marks if a particular registry wanted that for purposes of their Sunrise.

The next section was 4.3, conversion of marks into the Trademark Clearinghouse. I'm not going to read this if it's okay with everyone, but the text should be there on screen. The gist of this was that because there was the concept of an identical match, and of course you have some characters, you see there in the middle of the recommendation the @ and the & symbol, which if they were in a trademark then obviously there can't be at least as things stand today represented in the URL. So there was inability basically spell those out, if you will, and for example, if your mark had a hyphen, you could drop that. Or if your mark had a space, you could add a hyphen. This was a bit of a kind of technical application, if you will, of the fact that certain characters such as spaces the @ symbol couldn't be reflected in the Sunrise mechanisms.

The next section was on the pre-launch RPMs, the Claims, and the Sunrise, Section 5.1. The recommendation was that all new gTLD registries should be required to use the Clearinghouse to support these RPMs – that's the Claims and the Sunrise – and provided that there'd be a Sunrise challenge grounds as specified in the IRT Report – there's a link there – except to the extent that the registry elected not to extend

Sunrise protection for certain types of marks described below in Section 5.2. This is about the substantive review. There was also a suggestion at the end there that registry operators wouldn't be required to operate both Claims and the Sunrise.

Just checking for hands. I don't see any.

Section 5.2 was for protection of all trademarks in the Trademark Clearinghouse. So the STI said that new gTLD registries should provide equal protection to all trademarks except as follows. Then it says that marks from countries where there was no substantive review could be excluded and there was – I will note – a rough consensus on this and IPC minority statement that this would potentially unfairly prejudice trademark owners in a lot of the countries in the world as I mentioned earlier. Outside of the U.S., a lot of European countries, for example, don't have the same examination standards as the USPTO, so there was concerns raised by the IPC that this could unfairly prejudice non-U.S. trademark owners. And of course, this was also subject of some attention by the GAC during the various Guidebook iterations.

The STI went on to say that registries shall have discretion to decide whether to grant protection to trademarks in the Trademark Clearinghouse. ICANN could allow specialized gTLDs to restrict eligibility for Sunrise registrations and they give the example of .shoe could restrict Sunrise registration to shoe-related trademarks. Of course, you will all recall that we discussed this concept at some length previously in our working group discussions.

The next section really I think brings us to the end. I'll just read the beginning of 6.1, which was that there'd be no bar on the Trademark Clearinghouse service provider providing ancillary services on a non-exclusive basis, and so I believe that Deloitte actually does offer – I'm not familiar with the details – but I believe they offer some sort of a watching service outside of the Sunrise and the Claims process. But maybe someone who's familiar with that in practice could explain if that's relevant.

I think the rest really, it's not particularly relevant. It goes on to in Section 8, for example, the Trademark Claims notice. We've discussed that previously. I think there was agreement in the working group that the current Trademark Claims notice which is an annex to this STI Report maybe could be brushed up a little bit and made a little bit more plain English so it's a little more understandable for potential registrants. There's some kind of concluding recommendations from the STI in Sections 9 and 10 about not creating legal rights and fees, but again, I don't think those are particularly germane to our discussions here.

I'm going to stop there just to see if there are any comments or questions on this quick recap of the background from the STI on some aspects of the Trademark Clearinghouse.

Okay. I'm not seeing any. Oh, I'm sorry. Mary Wong?

MARY WONG:

Hi, Brian. Just two things from the staff. One is I did respond in the chat to your comment about the ancillary services. There's two or three, I

believe, that have been approved by ICANN in accordance with the contract and as permitted by the AGB, and one of them is the ongoing watch service that you described. I think the newest one may be the TReX service that builds on that.

Second point is that in relation to the chat that has been going on and perhaps not necessarily germane to today's discussion, but as the working group goes on to deliberate on what ought to be the proper scope of the TMCH as policies emerging from this working group. One of the staff's suggestions is that perhaps instead of using specific or technical terms that perhaps are differently described in different jurisdictions that it might be easier to speak about word marks as in marks that consist entirely of text or letters or numerals, stylized text marks in that they're basically word marks but then in a stylized font, and word marks being those pure text marks but combined with a graphical or design element or other visual element. And maybe this last and third category that we will rely on the working group's expertise, because there is a lot of trademark expertise amongst this working group as regard disclaimers, as regard which parts of those composite marks are actually protected by applicable laws. Maybe in that way, we can arrive at an appropriate scope to be recommended out of this working group. Thank you.

BRIAN BECKHAM:

Thank you, Mary. Any other thoughts or comments? I think I see a comment from Cytia in the chat. I think this was one of the questions that would possibly help with the proposal if it was Greg's about non-standard character marks – the question of, what do we mean when

we're talking about text or word or standard character marks? That's something that I think we can possibly get into more when we get to that proposal. Personally, I think that the more we're on the same page in terms of what we're talking about then we'll all come out with better policy recommendations.

That was it for the Trademark Clearinghouse history from the STI Report. We have a good amount of time left. I think maybe we can move on to the URS, which is page 15 of the STI Report.

They start by saying that it should be required for all new gTLDs. There was consensus on this. They then moved on to say that the elements should be the same as the UDRP. And if you go to Annex 6, we don't need to do that now but that just takes the elements from the UDRP and captures those for us to see those are the three elements with the various defenses and that the URS should basically mirror those elements.

I will note that you see towards the bottom of that block there's the URS should include safe harbors to protect legitimate uses of domain names. Of course, the URS codifies some defenses that aren't codified as such in the UDRP there's a lot of cases that kind of cover the same defenses and that has been established over the years in cases but the language themselves doesn't appear in the UDRP. Again, those are described in Annex 6.

They then tell us that the form of the complaint should be as simple and formulaic as possible. I think there were something like a 300 or 500-word limit for a URS pleading. So I think that criteria was met. The

examination of the case should be done by examiners who have been provided with some sort of instruction on the elements in safe harbors and then of course, again in Annex 6, they sort of walked you through how they see some of those operating in practice including looking at the burden of proof or as they say that the standard of review. So unlike the UDRP, the URS burden is by clear and convincing evidence so that there would be no genuine issue of material fact. And of course, the history on that was that the URS because it was quicker and cheaper and had a different remedy than it would happen on a much more streamline basis than the UDRP, but basically if there was any open question then it would be more appropriate for UDRP or a court to look at the URS was meant for very obvious cases. Then Annex 7 walks you through how that could be applied in practice.

The next section talks about notice and that it effectively mirrors the notice requirements of the UDRP, and as I mentioned earlier, there was already a recommendation from our earlier work and agreed recommendation that those requirements should be met and there was an identified instance of one provider not meeting those criteria. That was a recommendation to make sure that those were followed in practice.

There was the next Section 3.2, again on the concept of notice to registrants. This effectively goes to – I mentioned earlier there was a recommendation as well from our working group that the language should be understood by the registrants so that goes to the translation of the notice to the language, I believe it was the predominant language of the registrant’s jurisdiction. But again, we have made a recommendation in our earlier discussions on this.

The next section is on the effect of filing the complaint. We'll probably be – no real surprise – once the complaint passed the initial examination, that's presumably by a provider to make sure that it requires the required elements without looking at the merits of the case was that the domain name would be locked from transfer so that the case could run its course, but of course that the name should still resolve pending the outcome of the dispute. They then recommend that after a decision, if it were to go in favor of the complainant, then the domain would be placed on hold and the content would no longer resolve but it would point to a placeholder page put up by one of the URS providers that basically informed people who would land on that page that it had been taken down following a URS complaint.

They then walk us through the effect of filing an answer after default and there they say if there's an answer after default – so this is F if a registrant doesn't reply in first instance but then they come back and say they have an interest in replying then the nameservers should be returned to their initial state so that if there were some content on the page, it would resolve while the dispute was running its course.

The next section was about the time to answer. That was 20 days, provided that the decision itself was rendered on an expedited basis.

The next section was on the answer fee and there wouldn't be one if the answer was filed within 30 days of a decision, and if it was after that then there would be some sort of a fee to reopen the case file, if you will.

The next section, the effect of filing an answer after default. I'm going to read because I'm a little fuzzy on how the URS works in practice. I remember there were different types of appeals options, if you will. They say if the registrant fails to file an answer within 20 days and the examiner rules in favor of the complainant, the registrant shall have the right to seek de novo review by filing an answer at any time during the life of the registration. And then they say of course, if that happens then the nameservers should resolve back to their original state. The filing of the answer after default is not an appeal because there's a different appeal layer for the URS.

They then walk us through what should happen once – sorry, this is about the timing to render decision and they say after the time to submit an answer expires then the decision should be rendered within three days. Just a little bit of time pressure on the examiners but don't forget that these were supposed to be slam dunk cases and they're limited to a couple of hundred words so that should be a manageable timeline in practice. They tell us that examination should be by one examiner just for reference in the UDRP, the normal case is by one examiner but the parties have the option to elect for three, so they're making a distinction there between the URS and UDRP, the one examiner presumably for efficiency because the URS was supposed to be a quicker alternative to the UDRP.

They tell us that examiner should have legal background and should be trained and certified and, if I remember, that was one of our agreed recommendations from our earlier work that I don't recall the exact details but I seem to recall some sort of a recommendation that there should be some sort of a training of URS examiners going forward.

Assignment of examiners. ICANN should discourage forum shopping among URS service providers through its URS implementation and contracts. Examiners within a service provider shall be rotated to avoid forum shopping. I'm guessing that means that they're just put on a list and the next person numerically on the list gets the case. Obviously, that needs to account for things like languages and a number of other factors. Then URS service provider should accept all credentialed and properly trained URS examiners.

Providing fair examiners. The URS service providers shall avoid "cherry picking" of examiners that are likely to rule in a certain way. Service providers should be required to work with all certified examiners, with reasonable exceptions – again, reminding that the URS providers should be encouraged to accept all properly trained URS examiners.

Evaluation of the merits. The STI told us that unless withdrawn by the complainant, the examiner should evaluate the claim on the merit regardless of whether the registrant defaults or answers. So that means that even if there's no response then the examiner would look at it.

In terms of the URS remedies, they tell us that it would be if the complainant prevails, that the domain name resolution would be suspended for the balance of the registration period. And I believe in practice, there's an option to extend that for one year and that there should be a placeholder page by the URS service provider but that it shouldn't be advertising their services just to say that it's a suspended domain name and that the WHOIS should reflect that the domain name would not be able to be transferred, deleted, or modified.

So there, as I mentioned just a moment ago, in terms of additional remedy, if they tell us that the suspension can be extended for a year after the suspension of the initial registration period, they then discuss the appeal. So they say that the party who's lost the URS case could seek a de novo appeal for reasonable cost to cover the appeal. The fee should be borne by the appellant. A limited right to introduce new evidence. And that the panel could request, in its discretion, further statements if it needed those.

Filing of an appeal should not change the domain name's resolution. Again, if it's suspended or not, it should stay that way during the pendency of the appeal.

The effect of decision in appeal or UDRP. So they tell us here that the STI recommendation was that URS decision should not preclude any other remedies available to the appellant such as UDRP if appellant is the complainant. I seem to recall there was some discussion around the fact that because the UDRP takes a little longer than the URS but it has a different remedy if there were a particular time pressure on a brand owner, they could file a URS, and then if they wanted to put the name into their defensive or positive portfolio, they could then file UDRP case after the URS case or a court case of course to resolve that beyond the suspension remedy in the URS, and they finally say that they shouldn't prejudice the party in the UDRP.

More Section 8.4. The appeals – they say that the URS should not use an Ombudsman for appeals but they should be conducted by a three-person panel. So either a three-person panel from a preselected pool or a three-panelist with one selected by each party and one by the service

provider and, in the interest of time and efficiency, both options should be available.

In terms of abuse of process – and I think this is reflected in the URS itself I think. Frankly, I'm not recalling any of these that aren't reflected in the URS. So unlike the Trademark Clearinghouse where there was some confusion around some terminology, off the top of my head, I seem to think that most of these or all of these were actually carried over to the URS that's in operation today.

So they say that the URS should incorporate penalties for abuse in the event of two abusive complaints or one finding of "deliberate material falsehood," the party should be barred for one year from the URS, and that two findings of "deliberate material falsehood" should permanently bar the party. Multiple complaints must be against the same entity and should not include affiliates, and that staff should implement guidelines for what constitutes abuse consistent with previous cases under presumably the UDRP of reverse domain name hijacking, trademark abuse and general principles of fairness, and that in the URS decisions themselves, the examiner should opine on whether one of these types of abuse is occurring in the particular case and that service provider should report those to ICANN if they're occurring.

Abuse by examiners. The STI Report tells us that the URS should incorporate penalties for abuse of the process by examiners. Three or more findings of abuse of process or discretion against an examiner shall cause the examiner to lose its certification to serve as a panelist, and that staff should institute guidelines for this purpose and that they should collect data also for this purpose. Then they conclude by saying

that ICANN would conduct a review of the URS one year after the first date of operation.

We're doing that now. Obviously, we're a little off time but we're conducting the review. That's why we're all here every Wednesday.

So, that takes us through the STI Report on the URS. Again, this was because we had discussed on a previous working group call the idea of going back to the – I think there were 36 individual proposals. You may recall that we sort of ran out of steam in Barcelona I think it was to go through those, and so we said, "Well, let's just put everything in," and then maybe people have had second thoughts about that approach and think a bit more streamlining in terms of the initial report and seeing if we can't actually agree on some of those to produce recommendations may be useful.

You may recall that the last call where Phil Corwin was chairing, we asked if people wouldn't put views on that on the list. I think there seemed to be general agreement with a few caveats or questions on the last call on this approach, but there seemed to be general agreement on the approach of going through the individual recommendations to see on the one hand if we can't agree on recommendations, and if not, then those wouldn't necessarily form part of the recommendations, but of course they will be somehow be reflected in the initial report, perhaps in an annex. And don't forget that certainly both people who have proposed these individual recommendations and other stakeholders are free to comment during the first round of public comments on individual proposals that wouldn't have met the required level to be considered a recommendation.

So I would then encourage people to, if they have views on that, to put those on the list either to support going through that URS process or not. Again, there seem to be pretty broad agreement as I say with some caveats. I can't remember – Zak Muscovitch raised one intervention I think suggesting that it seemed like a worthwhile effort but it was going to take a little bit of time and did we really want to do that. So we need some guidance from you all on whether there's agreement to do that approach for the URS.

As I mentioned earlier, and as you all saw today, there's a little bit of an open question or maybe I should say people have some different views in the absence of recommendations, us going back to the status quo and what that means, whether that refers to the Applicant Guidebook or the STI Report that we've just gone through. In either event, we all agree that looking at the STI Report would be useful to inform our discussions. Staff reminded us the fact that the versions in the Guidebook are in the Registry Agreement and so there's some contractual impact there. Susan Payne reminds us that in terms of the SubPro, there was a working assumption that the Guidebook versions controlled, and of course this is a topic that we intend to seek the views of the Council on this to see if they can't help us pin this down a little bit more firmly.

I've said a lot today. I think we've had a little bit of a discussion around some of the issues that we need some clarity on. We've gone through a really rapid refresher on some of the history, both in terms of chronology and a little bit of substance along the way. I'm not seeing any hands. I haven't really been able to follow the chat too much as I've been reading, so maybe I can ask here if there are any questions or

concerns that have been raised in the chat or if there are any concluding comments that anyone would like to make before we possibly call it a day here.

I don't recall, Julie, Ariel, if there was any AOB on the agenda. I don't seem to recall any.

JULIE HEDLUND: Hi, Brian. No, there was no AOB.

BRIAN BECKHAM: Good. Okay, well, in the absence of comments or questions or concerns, we of course have the mailing lists. As I mentioned, we'll do our best to get back to you if we have any guidance from the Council on this question, and of course we could use some guidance from you all on the question of revisiting the URS proposals.

Okay. Thank you, everyone, for joining. Thanks for the discussion. We will be in touch with the agenda for next week and see you all there.

DAVID MCAULEY: Thanks very much.

JULIE HEDLUND: Thanks, everyone. Thanks for joining. Have a great morning, afternoon, or evening.

TERRI AGNEW: Thank you, everyone. Once again, the meeting has been adjourned. Please remember to disconnect all remaining lines and have a wonderful rest of your day.

[END OF TRANSCRIPTION]