**General concerns**

**The Business Constituency holds a minority statement that the Trademark Clearinghouse as described below creates no significant new/additional benefits for Trademark Holders due to:**

**The scope of the match for sunrise and IP Claims being even more limited than those adopted by existing gTLD launches (footnote: eg. Dot Asia's Mark Plus words in the Nice Classification rule etc.)**

**And**

**The possibility to circumvent the whole Clearinghouse system due to its inapplicability to Post launch thereby allowing gaming and making it irrelevant in the first 30 seconds of lunch.**

In search of rights protection mechanisms with respect to the launch of new gTLDs we have seen an outcome of a partial solution to RPMs by the IRT (since the IRT itself stated that there were several other problems and solutions it did not have time to work on) which already were a tapestry of compromised solutions between the various interest groups and as such by no means necessarily represented adequate protection in themselves. In any case the BC endorsed the IRT Report’s outcome as a step in the right direction.

Subsequently, the compromised tapestry was unraveled in the form of watered down Staff proposals presented to ICANN community for comments. As such there seems to be have been a watering down of an already compromised solution. Now with the STI report there seems to have arisen a further compromise to a watered down version of an already compromised solution. As such we view the current outcomes as being below the bare minimum compromise of the IRT.

**Nonetheless, since ‘something is better than nothing’, the BC reluctantly joins the ranks of others in submitting these proposals to the Council for onward submission to the Board in the hope that in an effort to adequately address the issue of rights protection for new gTLDs these plus more appropriate and adequate rights protection mechanisms will be implemented before the launch of new gTLDs.**

**TM Clearinghouse (“Sunrise Database” or “SD”)**

*What this is not*

The BC does not view nor does the BC believe that the more appropriately termed Sunrise Database is anything more than simply that: a centralized Database for Sunrises. It is not a Rights Protection Mechanism.

It doesn’t address any of the pre-launch concerns of Trademark Mark Holders such as defensive registrations.

*What this can be*

It is at best a tool or functionality to supplement and enhance the efficiency of the already existing Sunrise process. Viewed only in this restricted role the SD has value and benefits both TM Holders and Registries to enable the former to submit ‘one window a one time’ verification of their Trade Marks and for the latter Registries to be able to outsource this function thereby benefiting from economies of scale without the requirement of incurring administrative and other costs in relation to Sunrise. As such this is not a Rights Protection Mechanism and especially not one that addresses the general or specific concerns/problems in relation to the new gTLDs

*Who pays:*

TM Holders have to PAY ANNULLAY to be in this Sunrise Clearinghouse. Although it may provide the singular benefit of single window and one time sunrise registration it also conversely also financially benefits Registries since it reduces their costs for administering Sunrises. Hence, the BC is of the view that the costs of the Sunrise Clearinghouse should be shared and not be borne by TM Holders alone

*Are the applications for the Sunrise Database sufficient/adequate and why?*

The Clearinghouse was a product of the GPML discussions. A tool to enable that proposed Rights Protection Mechanism. The IP Claims Notice and Sunrise were merely by-products. Now with simply the IP Claims and Sunrise applications the value has, albeit not completely, it has been substantially reduced.

***With what does a Brand Match (its even narrower than Dot Asia)?***

It would be reasonable that the match for Notices as well as Sunrise should be competitive with existing practices. However, he STI recommends match to be only EXACT and IDENTICAL to the Trade Mark. So variants and Mark plus significant words would not be matched for any application for which the Clearinghouse is used. This is less significant than the Watch Notices offered by existing providers. The definition of match is even narrower than those allowed by .TEL and .ASIA and as such do not represent best practice. The STI also excludes common law rights and protected names. This will impact the IP Claims Notice and Sunrise as elaborated below.

So, if the brand is “Yahoo”, the only time a match for the services mentioned below would be triggered is if someone tried to register the domain name “yahoo.TLD” – and that’s it.

However, “yahoos.TLD”, “yahoosearch.TLD” or “yahoosports.TLD” or “searchyahoo.TLD” etc. would NOT be matched.

*Suggestions for Improvements*

Allow inclusion of common law rights and protected names.

Broaden match to include at least the protection offered by Dot Asia in sunrise[[1]](#footnote-1)

The BC has advocated throughout the process that a so-called “TM Claims” service should be mandatory throughout the life of new gTLD registries, unless there is strong reason for an exception granted by ICANN, and the scope of the matches triggering a notice to registrants should be broad. This would benefit everyone, and cause harm to nobody. It would be a much broader incentive for TM owners to participate in the Clearinghouse, and demonstrate a much broader commitment by ICANN and its contracting parties to prevent domain name disputes from occurring. It could be implemented easily enough -- if there was such a will, there would be a way.

As it is, the Clearinghouse affords TM owners the opportunity to pay to register one exact match of their textual trademarks, and have one chance to pay to register one identically corresponding domain name in each of hundreds and eventually thousands of new TLDs. The fee will have to be extremely minimal for TM owners, as that is the extent of the benefit. The whole point of this “overarching issue” was to lessen the need for defensive registrations and to deter cybersquatting. The Clearinghouse does little in either regard, because it will only be used for sunrise periods, and primarily to encourage defensive registrations, as registries and registrars tend to promote their sunrise periods broadly to the TM owner community. If it is also used for a TM notification system, it will be of much bigger benefit to everyone in the community, with no discernible downside. We are encouraged that such systems still could be built from the Clearinghouse and employed by willing registries or registrars, even if they will not be required of all new gTLD registrations.

***The IP Claims (its only Pre-Launch)***

This is merely a Pre-launch notice to an applicant (the TM Holder getting notice of the registration after launch).

However, this notice provision is restricted to Pre-launch and has not been extended to Post-Launch and has no relevance to registrations after launch.

Also, notice would only issue with respect to applications for registration of domain names which EXCATLY match the Trade Mark in the Clearinghouse. So “XYZ LLC” which is a technology company with a TM “XYZ LLC” would only match with the domain name “XYZ LLC” and not match with an application to register “XYZ LLC Technologies” or “XYZ LL”.

*Suggestions for Improvements*

Allow the service to be available Post-Launch.

As mentioned above, broaden the match.

***Sunrise (match is even narrower than Dot Asia)***

The narrow definition of match excludes the existing best practices and the possibility of such best practices from continuing. Dot Asia in its Sunrise allowed the registration of Trade Marks Plus significant words in the registrations Nice Classification of goods and services.

In Pre-launch, if someone tries to register ‘yahoo.TLD’, then they get a notice telling them that their application matches with a brand in the IP Clearinghouse. They are asked if they affirm that they will only use this for legitimate purposes (paraphrase) – they accept by clinking ‘affirm’ and they get the domain name. The TM holder only gets a notice that such a registration has been allowed once the new gTLD has launched to then decide whether to file a UDS, UDRP or Court case. No notices, however, in case someone tries to register “yahoosearch.TLD”.

*Suggestions for Improvements*

The BC would suggest that this is at the very least a best practice that could be adopted to improve the Sunrise Eligibility and Match requirements[[2]](#footnote-2). In addition the inclusion of common law marks and protected names would also improve its

*How can these Pre-Launch applications be gamed?*

As a bad actor one could wait and not register any domains which are EXACT matches in PRE-LAUNCH such as “yahoo.TLD” and wait for the first 30 seconds of the new gTLD being launched and then register to CIRCUMVENT the entire Clearinghouse mechanism for which a Brand holder being asked to PAY to keep it running.

But as a bad actor I can register “yahoos.TLD”, “yahoosearch.TLD” or “yahoosports.TLD” or “searchyahoo.TLD” etc. in PRE-LAUNCH and POST-LAUNCH and I won’t get a notice and the Brand holder won’t get a notice.

**The URS:**

The BC is in agreement with the proposal, except for the issue of transfer of domain names to successful complainants. We agree with Alan Greenberg’s statement on this, that it is mean-spirited to force successful URS complainants to file a UDRP in order to be assured the domain will not be maliciously re-used, and/or in order to use the domain itself. The whole point of the URS should be to provide a quicker and cheaper remedy than the UDRP, for the most egregious cases of cybersquatting. Not a different remedy, just a quicker and cheaper remedy. As it looks, the cost of preparing and filing a URS does not look to be dramatically cheaper or faster than filing a UDRP, as the evidentiary standard is even higher; and the time to resolution also does not appear to be dramatically different if the URS plays out its entire life… to the point where the complainant would have to file a UDRP or court action anyway, in order to control the domain name.

*What this is not?*

This is not a Rapid systems for dispute resolution.

The IRT and Staff recommendation was for a Rapid system to be put into place. However The STI recommendation of increasing the time for filing of Answers from 14 to 20 days takes away the Rapidity of the System.

Time savings are not looking like they will be much in comparison to UDRP, particularly given the appeal mechanism. And again if transfer will not be available, then there really is no comparison to be made, since few will use the URS and risk having to file a UDRP or court action anyway.

The URS also does not allow an option of Transfer which would create certain problems during proceedings: e.g it would be possible for the Respondent to default in filing of an Answer. If the Complainant wanted a transfer they would have to expend further costs and initiate a UDRP. However, in such a UDRP, the Respondent (though at that time having no right to the suspended domain name) could file an Answer. This would allow the Respondent the possibility of taking back the domain name. In such a case, Complainants, even though desiring transfer, could from a strategic point of view not choose to initiate a UDRP. Thus, the supposed option being available to the Complainant to file a UDRP for transfer is illusory and needs to be addressed.

There is simply no reason not to allow a transfer after the process (including appeals) has run its course. Otherwise there is minimal if any value to the process, and tremendous resources will be wasted designing it and trying to implement it. Meanwhile many new TLDs will launch, and millions more cybersquatted domains may be registered in dozens or hundreds of those new TLDs

This is not really tuning out to be cost effective.

Cost is not looking much cheaper for URS, and if it doesn't result in transfer then will force a UDRP and/or court action anyway. I think it is laughable to assume a URS complaint can be resolved for a $300 filing fee.

It will be somewhere north of $500 at least, and that is some substantial savings on the UDRP filing fee ($1300 at NAF for one domain), but the costs of investigating the abuse and filing a complaint will be nearly identical.

Since any remedy other than transfer would likely require a UDRP next year anyway, why would anyone choose it? Thus, purported cost savings are a red herring, maybe an average of $5000 per case instead of $6000, or something of that 10-20% magnitude. Simply not worth all of the time expended by the IRT and this group thus far.

The appeal processes should be designed for those, and perhaps stronger penalties for abuse of the process. We have strong notification provisions and a very high burden of proof on complainants.

*What this is*

[some word of support for the URS……]

URS is no more immune to reverse hijacking than the UDRP, except by technical definition of hijacking. Elements of claim should be identical.

TM owners will still overreach, especially if cost is cheaper. We are building in procedural mechanisms on par with the UDRP, if not greater, to try to prevent this.

[4. I have thrice re-read the comments this morning from Jeff E., Wendy and Konstantinos. They make almost no sense in my world, where I have dealt with cybersquatters almost every business day for a decade. All those comments are focusing on fringe cases, a tiny percentage of the UDRP cases that have been filed. We need to devise a better process designed to address the huge percentage of UDRP cases (and far larger number of cases that could be filed under UDRP, but are not because of the expense), that are clearly unnecessary over the past decade, so that newTLDs don't suffer the same fate as .com in this regard. That is the overarching issue we are dealing with, not the fringe cases.

Other than these two issues, the BC is satisfied with the proposed resolutions of the STI team.]

**BC’s line item comments:**

For the reader’s ease of reference and clarity the BC has also developed line item comments:

**Trademark Clearinghouse - “Sunrise Clearinghouse”**

|  |  |  |  |
| --- | --- | --- | --- |
|  |  |  |  |
|  |  |  |  |
|  | **Feature** | **STI Principles** | **Level of Consensus** |
| **1** | **Name** |  |  |
| 1.1 | Trademark Clearinghouse | The name of the rights protection mechanism should be the “Trademark Clearinghouse” to signify that only trademarks are to be included in the database. | Rough Consensus  BC Minority position: View the outcome as more of a Free[[3]](#footnote-3) **Sunrise Database** for use by Registries to Launch and not a Trademark Clearinghouse since all Trademarks since other protected names are not included. This is not a Rights Protection Mechanism for New gTLDs |
| **2** | **Functionality of Trademark Clearinghouse** |  |  |
| 2.1 | Separation of Functions | The TC should be required to separate its two primary functions: (i) validation of the trademarks included in the TC, and (ii) serving as a database to provide information to the new gTLD registries. Staff should have the discretion to determine whether the same provider could serve both functions, or whether two providers would be more appropriate. | Rough Consensus  At-Large Minority Position  BC Minority position: The Separated function will unnecessarily increase costs. Seeking unified database and validation to reduce costs, bureaucracy and confusion |
| 2.2 | Use of Regional Expertise | The TC Service Provider(s) should utilize regional Marks Validation Service Providers (VSP) (whether directly or through sub-contractors) to take advantage of local experts who understand the nuances of the trademark rights in question. | Rough Consensus  BC Minority position: These would increase costs |
| 2.3 | Segregation of TC Database | The TC Service Provider should be required to maintain a separate TC database, and may notstore any data in the TC database related to its provision of ancillary services, if any. | Rough Consensus  BC Minority position: the current services are of little or no use for TM protection for new gTLDs and would not allow sustainability of the ‘Sunrise Database’ |
| 2.4 | Global Submission of Data into the TC | The TC should be able to accommodate submissions from all over the world. To accommodate this principle, the entry point for trademark holders to submit their data into the TC database could be regional entities or one entity (provided that can demonstrate it can accommodate language/currency/cultural issues globally). The system to be adopted by the TC Service Provider for submissions from trademark holders should allow for different/local languages, with the exact implementation details to be left to Staff. Multiple portals for entry of data to be submitted into the TC Database would be acceptable. | *Unanimous Consensus* |
| 2.5 | Trademark Holder Submission Through One Entry Point | The trademark holder would only be required to submit to one entry point if it has multiple registrations covering many regions. If multiple entities used, ICANN should host an information page describing how to locate regional submission points. | *Unanimous Consensus* |
| 2.6 | One Centralized Database for Registry Use | Registry should only need to connect with one centralized database to obtain the information it needs to conduct its sunrise processes or TM Claims Services (TM Claims), regardless of the details of the TC service provider and its contract(s) with ICANN. | *Unanimous Consensus* |
| **3** | **Relationship with ICANN** |  |  |
| 3.1 | ICANN Accreditation Agreement for Validation Services | The Service Provider(s) providing the validation of the trademarks submitted into the TC should adhere to rigorous standards and requirements that would be specified in an ICANN contractual agreement. The model to be suggested for this contractual relationship would be similar to the detailed registrar accreditation agreement, rather than the minimal accreditation practice adopted by ICANN for UDRP providers (e.g., WIPO, NAF, and others). | *Unanimous Consensus* |
| 3.2 | ICANN Agreement for Database Services | The TC Service Provider responsible for maintaining the centralized database should have formal, detailed contract with ICANN. The contract should include service level agreement metrics, customer service availability (seven days per week, 24 hours per day, 365 days per year), data escrow requirements, and equal access requirements for all persons and entities required to access the TC database. The Agreement should also include indemnification by Service Provider for errors such as false positives for participants, such as Registries, ICANN, Registrants, and Registrars. | *Unanimous Consensus* |
| **4** | **Marks Eligible for Inclusion in the TC** |  |  |
| 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). (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.) | Rough Consensus  BC Minority position: should include all registered marks and also include other legally protected names |
| 4.2 | Common Law Rights | No common law rights should be included in the TC Database, except for court validated common law marks; provided that a new gTLD Registry may elect to have the TC Service Provider collect and verify common law right provided that it conforms to Recommendation 2.3.   The TC Service Provider could charge higher fees to reflect the additional costs associated with verifying these common law rights. | Rough Consensus  At-Large Minority Position  BC minority position that TC should include:   1. additional common law rights, 2. marks/names that are protected by national law, also   combinations of registered marks plus additional words as allowed by Dot Asia[[4]](#footnote-4). |
| 4.3 | Conversion of Mark into TC Database | The TC Database should be structured to report to registries strings that are considered an “Identical Match” with the validated trademarks. “Identical Match' means that the domain name consists of the complete and identical textual elements of the Mark. In this regard: (a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted, (b) only certain special characters contained within a trademark are spelt out with appropriate words describing it ( @ and &.), (c) punctuation or special characters contained within a mark that are unable to be used in a second-level domain name may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches, and (d) no plural and no "marks contained" would qualify for inclusion. | Rough Consensus  BC Minority Position that the Database should be structured to at the very least allow existing best practice[[5]](#footnote-5) (and not existing least common denominator) by registry to provide coverage to include "marks contained" and at least Mark Plus significant word in Nice Classification[[6]](#footnote-6).. |
| **5** | **Mandatory Pre-Launch Use of the Trademark Clearinghouse** |  |  |
| 5.1 | TM Claims or Sunrise Use | All new gTLD registries should be required to use the TC to support its pre-launch rights protection mechanisms (RPMs) that should, at a minimum, consist of a TM Claims process or a sunrise process that meets the minimum standards and sunrise challenge grounds as specified in the IRT Report,[[7]](#footnote-7) except to the extent that a registry elects not to extend sunrise protection for certain trademarks as described in 5.2 below). There is no requirement that a registry adopt both of these RPMs. | Rough Consensus  BC Minority position: Due to the watered down nature of IP Claims, identical match and no Post Launch, these should not be referred to as Rights Protection Mechanisms. A true RPM would not exclude the latter and would attempt to address defensive registration. Remedies could include a true IP Clearinghouse in conjunction a GPML or a Victim’s List[[8]](#footnote-8) |
| 5.2 | Protection for all Trademarks in the TC | New gTLD registries should provide equal protection to all trademarks in the TC for their RPMs, except as follows:   1. Inclusion of a trademark in the Trademark Clearinghouse from a country where there is no substantive review does not necessarily mean that a new gTLD Registry must include those trademarks in a Sunrise or IP Claims Process; or 2. Registries shall have discretion to decide whether to grant protections to trademarks in the TC. ICANN could allow specialized gTLDs to restrict eligibility for sunrise registrations to fit the purpose of the registry as described in the charter (example, .shoe could restrict sunrise to only trademark registrations in shoe-related class of goods and services). | Rough Consensus  BC minority position: the exception does not provide adequate protection to TM holders as even such ‘purpose-driven’ gTLDs can be the subject of trademark abuse. |
| **6** | **Voluntary Use of the Trademark Clearinghouse** |  | . |
| 6.1 | Use of TC For Ancillary Services | There should be no bar on the TC Service Provider or other third party service providers providing ancillary services on a non-exclusive basis. Such services could include, without limitation, a “marks contained” service, or a TM watch service. In order not to have a competitive advantage over competitors, the TC database should be licensed to competitors interested in providing ancillary services on equal and non-discriminatory terms, and on commercially reasonable terms; provided that the TC Service Provider is not materially advantaged in the provision of such ancillary services by virtue of it being the TC Service Provider.  The specificimplementation details should be left to Staff to address possible monopoly and competition concerns, and all terms and conditions related to the provision of such services shall be included in the TC Service Provider’s agreement with ICANN and subject to ICANN review. As stated in 2.3, if the TC Service Provider provides such ancillary services, any information should be stored in a separate database. Access by the Registrant to verify and research TM Claims Notices shall not be considered an ancillary service, and shall be provided without cost to the Registrant. | Rough Consensus  BC Minority Position that the TC should support voluntary use by registries to protect additional common law rights, including "marks contained," Mark Plus significant word at the very least from Nice classification for pre-launch and post-launch protections.  (see note to 4.3) |
| 6.2 | Pre-Registration of URS | The TC could be used to enable URS Procedures by allowing trademark holders to preregister their trademark information to support a future URS action based on rights in jurisdictions where there is substantive review of trademark registrations. The TC shall provide confirmation of the TM, and its jurisdictions, to the URS Providers for a fee. | Broad Consensus  BC minority position: this should be mandatory |
| **7** | **Mandatory Post-Launch Use of the TC** |  |  |
| 7.1 | No Required Post-Launch TM Claims | Use of the TC Database to support post-launch TM Claims shall not be required. | Rough Consensus  At-Large Minority Position  BC minority position that ICANN should be mandatory for Registries to adopt at the least an IP Claims Service for use after the initial launch of the Registry to avoid circumvention and gaming of the Clearinghouse |
| **8** | **Required Elements of TM Claims Notice** |  |  |
| **8.1** | **TM Claims Notice to provide clarity to Registrant** | The TM Claims Notice should provide clear notice to the Registrant of the scope of the trademark holder’s rights, in order to minimize the chilling effect on registrants. A form TM Claims Notice that describes the required elements is attached as Annex 5. If feasible, the TM Claims Notice should provide links, or provide alternative methods of providing access, to the registrant for accessing the TC Database information referenced in the TM Claims Notice for a fuller understanding of the TM rights being claimed by the trademark owner. These links shall be provided in real time without cost to the Registrant. The implementation details should be left to ICANN Staff to determine how to easily provide access to registrants to this information. The TM Claims notice should be preferably be provided in the language used for the rest of the interaction with the registrar or registry, but at the very least in the most appropriate UN-sponsored language (as specified by the prospective registrant or registrar/registry). | *Broad Consensus*  BC minority position: doesn’t view IP Claims Notice Service as ‘anything resembling adequate protection for New gTLDs’ as presented here due to narrow match and no post launch applicability |
| **9** | **Effect of Filing with the TC** |  |  |
| **9.1** | **TC is a depository of information and does not create legal rights** | It should be clearly stated in mandate of the TC that inclusion of a TC validated mark into the Database is not proof of any right, nor does it confer any legal rights on the trademark holder. Also, failure to file should not be perceived to be lack of vigilance by Trademark holders. | *Unanimous Consensus* |
| **10** | **Costs of Operating the TC** |  |  |
| **10.1** | **Costs of Operating Clearinghouse** | Costs should be completely borne by the parties utilizing the services. ICANN should not be expected to fund the costs of the operating the TC. The TC should not be expected to fund ICANN from its fees. | *Rough Consensus*  *RySG Minority Position* |

**Uniform Rapid Suspension Procedure**

|  |  |  |  |
| --- | --- | --- | --- |
|  | **Feature** | **Principle** | **Level of Consensus** |
| **1** | **Mandatory RPM** |  |  |
| 1.1 | Mandatory Use | Use of the URS should be a required RPM for all New gTLDs | *Unanimous Consensus* |
| **2** | **Pleadings and Evaluation Standards** |  |  |
| 2.1 | Elements of the Complaint and Safe Harbors for the Registrant | The elements to be alleged in the complaint should be the same as the UDRP (as described in **Annex 6**), to take advantage of the body of precedent available. The URS Complaint should require the trademark holder to satisfy the same elements as the UDRP. The URS should include safe harbors to protect legitimate uses of domain names. The URS shall include language that explains safe harbors available to registrants. Such safe harbors have been successfully used in similar processes in other jurisdictions. These requirements are described in **Annex 6.** | *Unanimous Consensus* |
| 2.2 | Format of Complaint and Answer | The form of the complaint should be simple and as formulaic as possible. There should be reasonable limits on the length of complaint and answer. The complaint should allow space for some explanation, and should not be solely a check box. | *Unanimous Consensus* |
| 2.3 | Examination of the Case | ICANN should provide the examiners with instructions on the URS Elements and Safe Harbors, and how to conduct the examination of a URS case. These instructions are described in **Annex 6.** | *Unanimous Consensus* |
| 2.4 | Standard of Review | A URS Complaint needs to establish by clear and convincing evidence that there is no genuine issue of material fact requiring further consideration. **Annex 7** provides an explanation of how this standard should be applied to URS cases. | *Unanimous Consensus* |
| **3** | **Notice to Registrant** |  |  |
| 3.1 | Mode of Notice | Notices should be sent through all the following available modes to increase the likelihood that the registrant will receive actual notice of the Complaint: E-mail, fax, certified copy via postal mail. | *Unanimous Consensus* |
| 3.2 | Notice Contents | Notices should be clear to the registrant, and understandable to registrants located globally. ICANN Staff should have the discretion to evaluate options to implement this requirement, including language issues, in an efficient and effective manner; specifically, the notice should be in the language used by the registrant during the registration process. | *Unanimous Consensus* |
| **4** | **Effect on Domain Name** |  |  |
| **4.1** | **Effect of Filing Complaint** | Upon passing initial examination of the Complaint, an “Initial Freeze” status is applied to the domain name, meaning that the domain name cannot be transferred, the WHOIS record cannot change, but the domain name still resolves to the original IP address and all features would function (e.g. web, e-mail). | Unanimous Consensus |
| **4.2** | **Effect of Decision in favor of Complainant** | Promptly after receipt of a Default decision in favor of Complainant, the domain name shall be placed on hold, and the domain name shall no longer resolve to the name servers in effect prior to the decision. | Unanimous Consensus |
| **4.3** | **Effect of Filing a Answer after Default** | Promptly after filing an answer after a Default decision in favor of the Complainant, the name servers shall be returned to the state in which it existed immediately prior to the domain name being placed on hold. | Unanimous Consensus |
| **5** | **Answer** |  |  |
| **5.1** | **Time to Answer** | The Registrant shall have twenty (20) days to file its answer prior to being declared in default, provided that a d**ecision is rendered on an expedited basis (within 3 - 5 days).** | Unanimous Consensus |
| **5.2** | **Answer Fee** | No answer fee will be charged if the Registrant files its answer prior to being declared in default, or not more than thirty (30) days following a decision. For answers filed more than thirty (30) days after a decision, the Registrant should pay a reasonable fee prior to re-examination. | Unanimous Consensus |
| **5.3** | **Effect of Filing a Answer after Default** | If Registrant fails to file an answer within twenty (20) days and the examiner rules in favor of Complainant, Registrant shall have the right to seek de novo review by filing an answer at any time during the life of the registration. Upon such an answer being received, the Domain Name shall resolve to the original IP address as soon as practical. The filing of an answer after Default is not an appeal. | Unanimous Consensus |
| **6** | **Evaluation of URS Cases** |  |  |
| **6.1** | **Commencement of Evaluation** | Evaluation of a URS case should be conducted on an expedited basis. Evaluation should begin immediately upon the earlier of the expiration of a twenty (20) day answer period, or upon the submission of answer. A decision should be rendered on an expedited basis, with the stated goal that a decision should be rendered within three (3) business days. Staff should have the discretion to develop the implementation details in this regard, in order to accommodate the needs of the service providers. | Unanimous Consensus |
| **6.2** | **Number of Examiners** | Examination of URS Cases should be conducted by one Examiner. | Unanimous Consensus |
| **6.3** | **Training of Examiners** | Examiners should have legal background and should be trained and certified in URS proceedings. | Unanimous Consensus |
| **6.4** | **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. It is strongly encouraged that the URS service provider accept all credentialed and properly trained URS examiners. | Unanimous Consensus |
| **6.5** | **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 (such as language needs, non-performance, or malfeasance) - with such reasonable exceptions to be determined by ICANN Staff as an implementation detail. ICANN Staff will strongly urge URS Providers to accept all properly- trained URS Examiners. | Unanimous Consensus |
| **6.6** | **Evaluation on the Merits** | Unless withdrawn by complainant, the examiner should evaluate the claim on the merits in every case -- regardless if the registrant defaults or answers. | Unanimous Consensus |
| **7** | **URS Remedies** |  |  |
| **7.1** | **Remedy if Successful on the Merits** | If the complainant prevails, the domain name should be suspended for the balance of the registration period and would not resolve to the original website. Instead, the STI recommends that the nameservers are redirected to an informational web page provided by the URS service provider about the URS process. The URS service 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 WHOIS shall reflect that the domain name will not be able to be transferred, deleted or modified. | Rough Consensus  BC minority position: Remedies should include an option to transfer, subject to reasonable safeguards |
| **7.2** | **Additional Remedies** | Option for successful Complainant to pay to extend the registration period for one additional year for at commercial rates. No other remedies should be available in the event of a decision in favor of the complainant. | Rough Consensus  At-Large Minority Position  BC Minority Position |
| **8** | **Appeal** |  |  |
| **8.1** | **Appeal of Decision** | After a decision in any case (default or contested), either party should have a right to seek a de novo appeal based **on the existing record** within the URS process for a reasonable fee to cover the costs of the appeal.  The fees for an appeal should be borne by the appellant.  **A limited right to introduce new admissible evidence that is material to the decision will be allowed upon payment of an additional fee, provided the evidence clearly pre-dates the filing of the complaint.  The Appeal Panel may request, in its sole discretion, further statements or documents from either of the Parties.** | Unanimous Consent |
| **8.2** | **Effect of Appeal on the Domain Name** | Filing of an appeal should not change the domain name' s resolution. For example, if the domain name no longer resolves to the original nameservers because of a decision in favor of the complainant, it continues to point the informational page provided by the URS service provider. If the domain name resolves to the original nameservers because of a decision in favor of the Registrant, it continues to resolve during the appeal process. | Unanimous Consensus |
| **8.3** | **Effect of Decision in appeal or UDRP** | A URS decision should not preclude any other remedies available to the appellant, such as UDRP (if appellant is the complainant), or other remedies as may be available in a court of competent jurisdiction. A finding in URS for or against a party should not prejudice the party in UDRP. | Unanimous Consensus |
| **8.4** | **Evaluation of Appeal** | The URS should not use an ombudsman for appeals of URS decisions. URS appeals shall be conducted by either: (i) a three (3) person panel selected from a preselected pool of panelists, or (ii) three (3) panelists, with one appointed by each of the parties and third panellist selected by the other two panellists or by the service provider. In the interest of time and efficiency, both options shall be provided to the Appellant by the URS Service Providers. | Unanimous Consensus |
| **9** | **Abuse of Process** |  |  |
| **9.1** | **Abuse by trademark holders** | The URS shall incorporate penalties for abuse of the process by trademark holders. In the event of two (2) abusive complaints, or one (1) finding of a "deliberate material falsehood," the party should be barred for one (1) year from URS. Two (2) findings of “deliberate material falsehood” should permanently bar the party from the URS. Multiple complaints must be against the same entity and should not include affiliates. Staff shall implement guidelines for what constitutes abuse, consistent with previous cases of reverse domain name hijacking, TM abuse and general principles of fairness. The examiner of the URS case should indicate in the decision whether an abusive complaint or a deliberate material falsehood has occurred, and the Service Providers should report any of such findings to ICANN. | Unanimous Consensus |
| **9.2** | **Abuse by Examiners** | The URS shall incorporate penalties for abuse of the process by examiners. Three (3) 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. Staff to implement guidelines for what constitutes abuse and who makes the decision. ICANN to collect data related to such findings of abuse by examiners. | Unanimous Consensus |
| **10** | **Review of URS** |  |  |
| **10.1** | **Mandatory Review of URS** | ICANN will conduct a review of the URS one year after the first date of operation. There is no requirement that the URS should automatically expire or terminate after any set period of time. ICANN will publish examination statistics for use in the review of the URS. | Unanimous Consensus |

1. Dot Asia Sunrise: “Domain Name Applied For may be constituted with Mark plus significant words from the class description in the Nice Classification system ( http://www.wipo.int/classifications/nivilo/nice/) E.g. Mark for “XYZ” in Nice Class 1: “Chemicals” may apply for “XYZChemicals.Asia”.

   BC proposes a carve out to avoid any possible Chilling Effect:

   “ …additions of letters or words would not include letters or words that, prima facie, when read in conjunction with the trade name:

   1. imply a free speech use

   2. completely change the meaning of the name to another well recognized and understood name/dictionary word

   (a non-exclusive/non-exhaustive list of examples may be found at appendix “X” for the purpose of illustration)”

   Such an Appendix can include a list of examples for both exceptions. [↑](#footnote-ref-1)
2. [↑](#footnote-ref-2)
3. Since it has been suggested that the Database should be made available to new Registries at no costs [↑](#footnote-ref-3)
4. See Mark plus significant words from the class description in the Nice Classification system allowed by Dot Asia in Sunrise (see footnote 5) [↑](#footnote-ref-4)
5. Dot Asia Sunrise: “Domain Name Applied For may be constituted with Mark plus significant words from the class description in the Nice Classification system ( http://www.wipo.int/classifications/nivilo/nice/) E.g. Mark for “XYZ” in Nice Class 1: “Chemicals” may apply for “XYZChemicals.Asia”.

   BC proposes carve out to avoid any possible Chilling Effect:

   “ additions of letters or words would not include letters or words that, prima facie, when read in conjunction with the trade name:

   1. imply a free speech use

   2. completely change the meaning of the name to another well recognized and understood name/dictionary word

   (a non-exclusive/non-exhaustive list of examples may be found at appendix “X” for the purpose of illustration)”

   Such an Appendix can include a list of examples for both exceptions. [↑](#footnote-ref-5)
6. Ibid. [↑](#footnote-ref-6)
7. Please refer to the IRT Report posted at <http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf> [↑](#footnote-ref-7)
8. A List of names maintained on the basis of evidence of habitual abuse (this would also have a consumer protection use). [↑](#footnote-ref-8)