



November 30, 2015

Internet Corporation for Assigned Names and Numbers
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RE: Preliminary Issue Report on a Policy Development Process to Review All Rights Protection Mechanisms in All Generic Top-Level Domains

It has been both a long and short almost five years since the call for UDRP reform and review, which ICANN wisely suspended until the new gTLD program was underway. In reviewing FORUM's 2011 comments, much has changed.¹ As a neutral provider, without ties to Intellectual Property, Registry, Registrar, governmental, or other interests, FORUM is uniquely positioned to observe the competing needs and wants of the varying constituencies. The Issue Report calls for a community discussion on how the Rights Protection Mechanisms are working, both separately and together. FORUM has two key responses. First, we agree completely with the assertions in WIPO's paper, submitted on 17 November 2015. We strongly recommend that any RPMs review not carry with it the implication that change is a necessary outcome. In fact, we strongly caution that any changes be taken with an abundance of caution so as not to neutralize the overwhelming success of the UDRP. Second, we strongly recommend that any review be undertaken as a whole. Any issues that exist with a particular RPM should be balanced in light of the other RPMs. Any identified gap in one could be fixed by a solution with another, and so on.

A review of RPMs does not imply change

A review of RPMs should not, have at its core, any assumption that things must change. A mindset that "of course" something is broken will never lead to an objective outcome. ICANN has led the community to come together in deciding to enact policies and procedures to protect intellectual property rights. These are: the Trademark Clearinghouse, and the dispute policies that attend that; the sunrise dispute policies and the Trademark Claims Service that all new gTLD registries are required to implement; the Uniform Rapid Suspension System and the Uniform Domain Name Dispute Resolution system; and the Post-Delegation Dispute Resolution Procedures.

It is critical to the community to verify that the protections imagined by the parties who agreed to them are working as intended. It is also important to make sure that a review is looking for

¹ For instance, the GNSO approved new domain name locking requirements to ease the burden on providers, which was one of FORUM's primary requests for any UDRP review. Additionally, FORUM has recently begun mirroring WIPO's interpretation of Rule 11 regarding translations, in order to provide a more unified process for users of both providers.

unintended consequences (negative or positive) caused by the RPMs themselves or the current processes of the new gTLD program. No process or policy or system is going to be perfect. A review will look critically at the data and determine if the processes are accomplishing the goals set out by the community. Some processes, like UDRP, have over a decade of solid data. Other processes, like URS or Trademark Claims, have a fraction of the data but many anecdotal experiences. The key to a review is not to propose changes to fix every little bump or inconsistency, but to identify global issues of concern that affect reasonably large populations of users.

It's also going to be critical for any RPM review team to define and quantify success. Is the Claims Service a success if there are no notices? A million notices? Are there fewer URS and UDRP cases compared to legacy TLDs because of greater awareness? Or are there fewer URS and UDRP cases compared to legacy TLDs because new gTLDs haven't yet taken off? Are more URS and UDRP cases a success, or are fewer? Or are UDRP cases a success only if more of a certain party type wins or if there is a certain percentage of reverse domain name hijacking findings or if a certain percentage are appealed to national courts or there are no or few appeals? We predict that each interest group or constituency will define success differently, so until metrics are created to define success, an RPM review will likely flounder and could become a shouting match for competing interests.

Any RPM review process should include all RPMs in their interlocking parts

A good RPM review will compare and contrast the solutions as a whole, focusing on critical inconsistencies to determine if the mechanism is causing problems or confusion. For instance, the Applicant Guidebook lists criteria that must part of a Sunrise dispute program (Section 6.2).² On its face, this seems like an excellent solution. However, the Trademark Clearinghouse is already validating most of these and the TMCH has its own dispute policy in the event a user is able to enter a trademark despite the validation. Furthermore, to our knowledge, article 6.2.4(iv) is no longer even valid as a requirement, yet the Applicant Guidebook requires that every Registry have a dispute policy that encompasses a failure to meet that requirement. This sort of critical inconsistency is the type of situation a review process should examine to determine if it is causing any problems or confusion. If the entire section is now handled by the TMCH, then the requirement to even have a Sunrise Dispute Policy may be moot. If an entire RPM is moot, that would be a good topic for an RPMs discussion. But this particular review can

² 6.2.4 The proposed SDRP must allow challenges based on at least the following four grounds: (i) at time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; (ii) the domain name is not identical to the mark on which the registrant based its Sunrise registration; (iii) the trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; or (iv) the trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received.

only be examined in combination with the TMCH process and dispute process, current SDRP practices among new TLDs, and possibly even looking at Claims or URS/UDRP data in relationship. Looking at simply “the SDRP” in a vacuum will not result in a holistic solution.

The URS and the UDRP should be examined together. They were designed to be complementary. But some constituencies are looking for the quality and detail of the UDRP to be handled using the automation and “quick look” review of the URS. A full-scale review of both policies together would allow the working group to compare and contrast where both policies have succeeded or failed. And looking at Claims data or TMCH filings might contribute to an understanding of why parties are choosing one over the other or choosing neither at all.

Conclusion

We conclude with a final word of caution from the neutral organization administering several of these processes: the UDRP has survived the test of time. There are few appeals. Most complaints are brought by legitimate complainants against cybersquatters. There are not so many “grey” area cases as to render the system broken. Features like (1) “loser pays” or (2) “penalties for reverse domain name hijacking” or (3) “laches” or (4) “codify a ‘free speech’ defense” seem to us to be red herrings. First, seventy percent of respondents don’t respond; they’re not likely to pay. Second, there are relatively few cases of RDNH given the high cost to bring a UDRP (and to those who have argued to reduce the fee, consider what sort of decision you’re likely to get from a competent attorney if you further reduce rates that haven’t gone up since 2009). Third, the majority of panelists will recognize a delay in bringing a UDRP dispute when the use of the domain name is not targeting the complainant’s brand. And fourth, the UDRP has a well-used paragraph 2(c)(iii) that is routinely used to justify true “free speech” uses.

From the perspective of an organization that can see the forest and the trees, we strongly urge the various constituencies to avoid using any RPM review process as a platform for focusing on potentially short-sighted solutions to singular problems that do not have a wide effect and benefit a few at the expense of the community.

Thank you for your consideration.

FORUM

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