



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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30 November 2015

via email: comments-rpm-prelim-issue-09oct15@icann.org

RE \\
FICPI Comments to ICANN on the Preliminary Issue Report on a Policy
Development Process to Review All Rights Protection Mechanisms in All
General Top-Level Domains

Dear Sirs,

On behalf of the Bureau of FICPI, I submit the attached comments in response to the ***Preliminary Issue Report*** issued by ICANN, providing FICPI's input on the issue of launching a GNSO Policy Development Process to Review all Rights Protection Mechanisms in all gTLDs (including the UDRP).

FICPI respectfully requests the consideration of our attached comments with regard to finalising the Issue Report to be provided to the GNSO Council for consideration.

ICANN's kind consideration of our Federation's attached comments is respectfully requested.

Yours faithfully,

Roberto Pistolessi
Secretary General

Enc.



30 November 2015

FICPI Comments on the Preliminary Issue Report on a Policy Development Process to Review All Rights Protection Mechanisms in All General Top-Level Domains

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, is pleased to have an opportunity to provide its comments on the Preliminary Issue Report on a policy development process to review all rights protection mechanism in all generic top-level domains.

Founded over 100 years ago, **FICPI** represents IP attorneys in private practice internationally with almost 5,500 members in 81 countries and regions, including all major countries. **FICPI** has strong US and European memberships and has recent and growing sections in India and China. **FICPI** aims to enhance international cooperation amongst IP attorneys, study reforms and improvements to IP treaties and conventions with a view to facilitating the exercise by inventors of their rights, increasing their security and simplifying procedures and formalities, and promote the training and continuing education of its members and others interested in IP.

THE FORMAT OF THE UPCOMING REVIEW

The Preliminary Issue Report suggests three alternative formats for the Review, namely:

- 1) a combined, single-step review of all RPMs, including the UDRP,
- 2) alternative 1, but with an additional requirement that the assigned Working Group review its timeline and overall Work Plan when the output from the Competition, Consumer Trust and Consumer Choice (CCT) review becomes available, or
- 3) a two-step process for review that involves first analyzing the status and effectiveness of the new RPMs, followed by a second stage of review that focus on the UDRP.

Although URS and the Trademark Clearinghouse relates only to the new gTLD strings, whereas UDRP is used for all gTLDs as well as some ccTLDs, they are all systems created to ensure that trademark owners have available the tools necessary to stop infringements and misuse in the form of registered and used domain names. **FICPI** believes a combined, single-step review is therefore the best and most effective way to review and consider improvements generally in order to ensure the real world trade mark rights are protectable and enforceable when used on the Internet.

FICPI supports a combined, single-step review of all RPMs, including the UDRP.



UDRP

The current UDRP, adopted by ICANN on August 26, 1999, functions reasonably well in meeting the needs of domain name holders and trademark owners. It must be recognized that those two groups are not mutually exclusive but that trademark owners and domain name holders are very often one and the same. **FICPI** members are responsible for representation of both trade mark holders and domain name holders.

However, **FICPI** is of the view that cautious and minor changes that *do not* erode the fundamental premises upon which the UDRP was based should be considered. **FICPI** also advocates all means through which ccTLD dispute resolution mechanisms based on those same fundamentals are implemented, and compliance assured.

An example of one minor change that would bring better balance to the system, is the “bad faith” requirement. **FICPI** believes the UDRP process should be revised slightly so as to allow a challenger to succeed in instances wherein there has been either use *or* registration in bad faith. This would improve the fairness of the current requirement for use *and* registration in bad faith. Further means of enhancing fairness would be to ensure that protections for due process of law exist to a greater extent than is the case at the moment and also to ensure that evidentiary requirements are more explicit.

As to the specific questions referenced in the Preliminary Issue Report:

Q: Are the UDRP’s current appeal mechanisms sufficient?

FICPI is of the view that the current mechanisms are sufficient. Having in mind that the clear majority of the UDRP cases where a Panelist orders a transfer of the disputed domain name to the complainant trademark owner, are cases with obvious bad faith registration and use on the part of the domain name holder.

Q: Should there be a limit to the time period allowed (e.g. similar to a statute of limitation) for bringing UDRP complaints?

FICPI believes there is no need for a formal time limitation. The Panelists now make reasoned determinations of whether or not time periods are significant in each case reaching appropriate conclusions, based on the facts of the case.

Q: Are free speech and the rights of non-commercial registrants adequately protected in the existing policy?

FICPI believes that free speech and the rights of non-commercial registrants are adequately protected by the existing policy.



Q: Should there be a formal (mandatory) mechanism of early mediation?

While **FICPI** believes mediation can be an excellent way to quickly and inexpensively solve disputes especially between relatively equal commercial entities, **FICPI** sees no reason to incorporate mandatory mediation in the UDRP, as the dispute resolution policy is itself is a quick and cost-effective procedure.

Q: Are the current time limits of the UDRP (for filing, response, determinations and appeals) adequate?

FICPI is of the view that the current time limits are adequate.

Q: Should there be rules for the appointment of UDRP panels, such as formalized rotations?

FICPI is of the view that the system as it exists works well and as such there is no strong rationale for change.

Q: Under what circumstances (if any) should/could UDRP proceedings be anonymized?

FICPI sees no reason to anonymize cases. When physical persons, as opposed to legal entities, are involved, their identity / anonymity is sufficiently protected.

Q: Should there be clearer policy guidance on a registrar's obligations if a case is stayed or suspended?

FICPI defers on this response in order to await further comments from the registrars. Through these comments we hope to learn whether there are any practical problems or questions to consider.

Q: Should the possibility of laches be recognized in UDRP proceedings; if so, how can this be expressly addressed?

FICPI does not believe there is a need for laches in the context of the UDRP proceedings.



URS

Q: Should the ability for defaulting respondents in URS cases to file a reply for an extended period (e.g. up to one year) after the default notice, or even after a default determination is issued (in which case the complaint could be reviewed anew) be changed?

Noting that the URS aims to provide a trademark holder with a *fast* and reasonably *inexpensive* way to obtain the suspension of a domain name that was registered and used in bad faith, when adding up all the days involved in the process as of today, **FICPI** takes the view that the URS has not succeeded in achieving "rapid" suspension.

FICPI is therefore of the view that the reply periods must be limited.

Q: Is the URS' 'clear and convincing' standard of proof appropriate?

Noting that the URS contemplates a very fast and clear procedure, **FICPI** takes the position that the "clear and convincing" standard of proof is appropriate.

Q: Is there a need to develop express provisions to deal with 'repeat offenders' as well as a definition of what qualifies as 'repeat offences'?

FICPI is of the view that there may be, at least, a need to define what qualifies as "repeat offences".

Q: Should the URS allow for additional remedies such as a perpetual block or other remedy, e.g. transfer or a "right of first refusal" to register the domain name in question? Is the current length of suspension (to the balance of the registration period) sufficient?

FICPI's position is that the suspension remedy is not sufficient, due to the fact that it is time limited and carries the risk that once the domain name is released, it will be registered again by an infringer, thereby forcing the trademark owner to restart the process for the same domain name. One possible solution could be to give the trademark owner a limited pre-registration period, prior to the expiration of the suspension period.



Q: Is the cost allocation model for the URS appropriate and justifiable? Should there be a loser pays model? If so, how can that be enforced if the respondent does not respond?

While **FICPI** supports in principal a loser pays model, the practical issues relating to enforcement need to be further discussed by the planned working group.

Q: Should the Response Fee applicable to complainants listing 15 or more disputed domain names by the same registrant be eliminated?

FICPI is strongly of the view that the fee should not be eliminated. This fee acts as a deterrent, limiting the number of infringers registering multiple cybersquatting domain names. If the fee is to be amended, **FICPI** recommends having the same fee, independent of the number of disputed domain names involved.

TRADEMARK CLAIMS

Q: Should the Trademark Claims period be extended beyond ninety (90) days?

FICPI supports an extension of the Trademark Claims period of up to 120 days.

Q: Should the Trademark Claims period continue to apply to all new gTLDs?

FICPI is of the view that this period should continue to apply to all new gTLDs.

Q: Should the Abused Domain Name Label service be continued?

FICPI believes the Abused Domain Name Label service should be continued.

Q: Does a Trademark Claims period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?

FICPI members have not reported any “chilling effect” on genuine registrations. Rather good faith users are generally well informed of the system and their rights.

TRADEMARK CLEARINGHOUSE (TMCH)

Q: Should there be an additional or a different recourse mechanism to challenge rejected trademarks?

In order to provide a useful answer this question, the current mechanism to challenge rejected trademarks should be made more explicit so that it may be better understood.



Q: Should further guidance on the clearinghouse verification guidelines for different categories of marks be considered?

FICPI believes there is indeed a need for more clear guidelines, as well as for free education and information regarding the system. In this regard **FICPI** notes that the users of the TMCH are trademark owners and trademark attorneys, while the staff involved with the TMCH tend to have technical expertise.

Q: Should the clearinghouse matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?

FICPI believes there is a need to expand the matching rules, especially as infringers often base their business model on the creation of common misspellings of well-known trademarks, as well as trademarks combined with the generic description of the goods.

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industria I (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Colombia, Czech Republic, Greece, Hungary, India, Ireland, Israel, Malaysia, Mexico, Netherlands, New Zealand, Peru, Russia, Singapore, South Korea, Spain and the United States of America, provisional national sections in Poland, Romania and Turkey, and individual members in a further 41 countries.

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