

Summary and Analysis of Comments for Revised Conflicts of Interest Policy

1 September 2009

ICANN staff prepared this summary and analysis of comments received on the WIPO proposal for Modification of the UDRP Rules. The comment period ran from 13 July 2009 to 12 August 2009. Excluding one comment that appeared to be spam, twenty comments were received, 2 from the same commenter, fourteen on behalf of an entity. The public comments on this forum are available at <http://forum.icann.org/lists/eudrp/>.

High Level Summary:

Many commenters, including two other UDRP providers, expressed support for WIPO's proposal. Many commenters noted the increased efficiency that could be achieved and that the move to an electronic system would return the UDRP to the streamlined process envisioned at its creation. It could also reduce costs, and commenters noted that they hoped those savings could be passed onto UDRP complainants. One UDRP provider submitted additional suggestions for proposed modifications to the rules to allow for eUDRP.

Other commenters noted that while they are in agreement with the principles behind the proposal and moving to a paperless system, emails are susceptible to being lost through spam filters or otherwise unnoticed, and so physical notice should be required to allow for actual notice, with some commenters stating that requirements for initial postal or fax notification needed to be strengthened. Other commenters noted that the WIPO proposal includes a requirement for physical notice to the respondent.

Multiple commenters noted that the modifications are appropriate only as modifications to the UDRP Rules, and should not be achieved through provider-initiated changes to Supplemental Rules. Commenters took different views on whether implementing modifications required the initiation of a GNSO Policy Development Process (PDP) or the formation of a separate committee. One commenter noted that no PDP was required because the rights of domain name registrants would not be substantively affected.

One commenter noted that eUDRP will be helpful in assisting trademark holders when ICANN launches the new gTLD program, given the anticipated increase in need for initiating administrative proceedings.

One commenter stated that all important documents should be required in hard copy, including the complaint and the decision.

One commenter recounted experiences in migrating to a paperless system for disputes in the ccTLD realm and offered some suggestions on the formation of user-friendly systems.

One comment expressed general support for the Revised COI, but raised questions regarding the application of the Duty to Disclose and Duty to Abstain as it relates to the ICANN CEO and those officers who report to the CEO, and also questions whether ICANN's Board Governance Committee will publish the identified interests.

Some commenters provided comments and suggestions outside of the scope of the items presented within the public comment period, such as: suggestions for expanding the time for response to UDRP complaints; requiring UDRP decisions to be presented in a uniform format, such as XML, for ease of searching and compilation of case information systems; allowing registrants to identify additional representatives or legal counsel to receive notice; the initiation of an expedited PDP to look at broader changes for the UDRP; and repeat complainants.

General Comments:

Kristine Dorrain, writing on behalf of the National Arbitration Forum (Forum), noted the Forum's support for WIPO's proposal and attached a 20 January 2009 letter from the Forum to ICANN General Counsel on the same topic. The Forum agrees with the reasoning and statistics set forth by WIPO in support of the proposal, and adds an additional reason for the adoption of an eUDRP process, the fact that the UDRP dispute resolution provider often winds up having to supplement the number of hard copies of complaints. This occurs: 1) when the complainant must modify their complaint to remedy deficiencies, and due to the 5-day submission window "it is frequently impossible for a Complainant to submit hard copies of the Amended Complaint as finally accepted. To that end the Forum currently takes on the role to print the needed copies of the Amended Complaint"; and 2) "the number of copies [of a complaint] provided by the Complainant is rarely sufficient to serve the Respondent [at every associated address]. . . . As a result, the Provider is frequently left making the necessary copies to achieve service." Ms. Dorrain states "It is the Forum's belief that this was not the intent of the UDRP. . . . However, the short timelines of the UDRP are NOT conducive to handling postal mail from around the world on such a short turnaround time and the practical effect has been to pass this burden on to Providers." Ms. Dorrain notes that the "Forum joins in WIPO's request for ICANN to consider a paperless UDRP process" and "offers its services to serve on a committee to analyze any proposed UDRP changes should ICANN wish to investigate this further." The Forum offers to head up the committee if beneficial. Finally, "[t]he Forum further notes WIPO's proposal to simply cause the same effect by amending its Supplemental Rules and has not yet determined if it intends to follow suit." See

<http://forum.icann.org/lists/eudrp/pdfpwKAOiftot.pdf> and
<http://forum.icann.org/lists/eudrp/msg00000.html>.

George Kirikos commented that he is “generally in favour of the motivation behind the proposal. However, it might need to be tweaked a little, in order to improve safeguards for registrants as we move towards reducing paper.” Mr. Kirikos commended that his concern is that “registrants have ACTUAL notice of the complaint, and sufficient time to prepare a defence.” He notes that it is easy to miss an email. Mr. Kirikos offers a suggestion to assist in achieving actual notice: “to optionally permit registrants to store at their registrar . . . the name and contact information of their legal counsel, who would then also receive copies of the UDRP notice.” This would raise “the odds of actual notice.” Mr. Kirikos notes that this could be a way for organizations to “whitelist themselves, separating themselves from fly-by-night operations who would never list a legal counsel and who would typically never respond to a UDRP.” Mr. Kirikos also commented that the 20 day response time allowed under the UDRP should be extended for domain names that have been registered for longer periods of time, such as an extra 5 days for every year that a domain name has been registered. This would counter “the growing trend of frivolous UDRPs being filed in attempts to reverse hijack valuable domain names.” Mr. Kirikos also suggests that “thought should also be given to ensuring that submissions are in easy-to-use standardized formats, e.g. PDF (not MS Word)” and making UDRP decisions available in a similar format. This would allow academics, legal scholars and service providers with a standard format to simplify analysis, etc. Finally, Mr. Kirikos states that “UDRP providers should be required to publish notices of ALL complaints via standardized machine-readable formats . . . at the same time that the notice of the complain is sent to the respondent. . . . [T]his would permit 3rd parties to aggregate all complaint data as early as possible.” Mr. Kirikos suggests that this requirement would “allow for the development of a complaint-monitoring services . . . [that] would increase the likelihood of ACTUAL NOTICE for domain name registrant, reducing default cases” as well as other stated benefits. See <http://forum.icann.org/lists/eudrp/msg00001.html>.

Mr. Kirikos submitted a separate comment in response to Ms. Dorrain’s submission on behalf of the Forum. Mr. Kirikos commented on the “shocking statistic” that 90% of UDRP complainants have at least one deficiency with their complaint “given that complainants have unlimited time to prepare their complaints. This highlights the lack of fairness and lack of success in the short time period for domain name registrants to respond to UDRP complaints.” Mr. Kirikos also noted willingness to participate in UDRP reform, “but that process should be handled within the GNSO. We would oppose the Forum ‘heading up’ a committee” and states that “[a]ny GNSO workgroup should be chaired by a true neutral” and “suggest[s] that a neutral be chosen from the non-commercial constituency or from the ALAC” following proper GNSO procedures. See <http://forum.icann.org/lists/eudrp/msg00003.html>.

Marco Rinaudo, CEO of Internet.bs Corp, an ICANN Accredited Registrar, states his company “supports and congratulates WIPO for the excellent initiative that is fully in line with modern times.” See <http://forum.icann.org/lists/eudrp/msg00002.html>.

Vijaya Sree Nidadhavolu comments that the while the WIPO proposal can be appreciable, the threat of theft and falsification of Internet material despite best efforts to safe guard information leads to a suggestion “that it may be made mandatory that the Original Complaint, Original reply, the first hearing date of these complaints, all important Orders or decisions my be only by way of Hard Copy.” This will allow the Parties to be aware of the complaint, the reply, the initiation of a proceeding against them “[s]o that they can follow the dates and any Order or Decisions made in the proceedings. . . . [I]t will help the Parties to Act legally without much ambiguity.” See <http://forum.icann.org/lists/eudrp/msg00004.html>.

Nick Wenban-Smith, Senior Legal Counsel for Nominet UK, submitted a comment recommending that the “UDRP convert to a paperless process.” Mr. Wenban-Smith detailed Nominet’s July 2008 migration of its dispute resolution service for names registered in the dot-UK registry (“DRS”) to a paperless process. “DRS complaints are now almost entirely submitted electronically using our online services. While we have the option to notify registrants whose domains are subject to a complaint using only electronic means, in practice we always notify the registrant by a recorded delivery letter, to ensure that we have made all reasonable efforts to notify them about the complaint. However, after that the entire DRS process is conducted entirely by electronic means.” Mr. Wenban-Smith commented on the benefits to Nominet and the parties on having the electronic DRS system, including reduction of paper, administrative overhead and response times. He noted that in the transition to the electronic system, Nominet received some hard copy filings that had to be resubmitted, but parties have become used to the paperless proceedings. “Market research conducted before and after the changes indicates a positive impact on the parties.” Mr. Wenban-Smith offered some practical notes, including automatic population of WHOIS details; ability to save complaints/responses to research proper submission requirements; make systems “accessible, intuitive and user-friendly”; and to involve panel decision-makers in testing of systems. See <http://forum.icann.org/lists/eudrp/msg00005.html>.

Alexandre Foucher cited an article that referenced the public comment session on this topic and requested additional information. See <http://forum.icann.org/lists/eudrp/msg00006.html>.

Steve Billion of ChamberSign France submitted a comment offering to provide expertise on electronic security and signature requirements to the project. See <http://forum.icann.org/lists/eudrp/msg00007.html>.

Michele Neylon of Blacknight Solutions expressed his support of the views put forward by George Kirikos. Mr. Neylon also noted that he is “very wary of making [the UDRP] completely paperless. While ‘paperless’ might be ideal from WIPO’s perspective, there is a very real risk that the registrant will not receive the notification if it is electronic only OR that they will not be aware of how important the notification is OR they will confuse it with Spam.” See <http://forum.icann.org/lists/eudrp/msg00008.html>.

Frank Michlick, on behalf of DomainCocoon Inc., wrote to express opposition to the proposed eUDRP modifications. Mr. Michlick, echoing Mr. Kirikos' statement, states "there need to be safeguards in place in order to protect registrants from default decisions based on non-response, since email may potentially be identified as spam/UCE and may never reach the recipient, thus preventing him from filing a response. If no response is received after notification via email, the registrant should be informed by other means, such as by fax or a letter. Considering the complainant is given as much time as they like to prepare their complaint, a response time of 20 days is inadequate." Mr. Michlick also cited additional areas that should be addressed: "the recent rise of 'reverse hijacking' cases and the lack of penalty for those entities that try to gain access to generic domain names by means of filing UDRPs. In addition, provisions should be added to prevent a complainant from repeatedly filing claims for the same domain name." Finally, Mr. Michlick noted his company's agreement with Mr. Kirikos on introducing a standardized format for electronic UDRP filings, "allowing the development of services for monitoring complaints." See <http://forum.icann.org/lists/eudrp/msg00009.html>.

Sandrine Gerber, on behalf of the Institut Federal de la Propriete Intellectuelle, writes that in general, "we are favourable to a facilitation of the proceeding and to the control of costs" and see no objection to the UDRP being conducted electronically. "[T]he rights of the parties, in particular their right to be heard, seem to be respected." Mme. Gerber notes "we welcome the continuation of the written notice to the holder of the domain name that a complaint was filed against him." See <http://forum.icann.org/lists/eudrp/msg00010.html>.

Steve Metalitz submitted a comment on behalf of the Intellectual Property Consituency (IPC). The IPC supports WIPO's proposal and the "WIPO provisions draft amendment rules for eUDRP" submitted to ICANN on 30 December 2008. The IPC states that "the preferable route forward for paperless UDRPs is via a change in the UDRP Rules rather than having each provider amend it's Supplemental Rules" so that a consistent approach is adopted across providers. The IPC "agrees with WIPO that a paperless UDRP process is appropriate for all of the reasons set forth in the letter accompanying WIPO's proposal . . . and reflect current preferences of participants in UDRP proceedings. . . . [t]he requirement for a 'hard copy' filing of the Complaint and Response . . . is an unnecessary expense and burden on all participants in the UDRP." The IPC statement references the requirement that all domain name registrants maintain complete and current contact information, including an e-mail address, in their Registrar's database . . . [therefore] a paperless proceeding will not interfere with a Respondent's ability to receive a complaint." Further, as most Respondents already indicated a preference to receive documents electronically, the proposal is "consistent with current practices." Finally, the IPC cites the "record number of UDRP complaints . . . filed with WIPO in recent years, given the rise in cybersquatting. . . . Accordingly the financial burden incurred by Complainants and Providers has escalated, threatening to undermine the UDRP's design as 'a streamlined, inexpensive administrative dispute-resolution procedure."

The elimination of the hard-copy filing requirement “would help to ensure that the UDRP remains true to this design.” See <http://forum.icann.org/lists/eudrp/pdfKAGU4vi3C5.pdf>.

Sarah B. Deutsch, Vice President and associate General Counsel of Verizon Communications, Inc., on behalf of Verizon, submitted a comment in agreement with “the reasons set forth by WIPO and [the Forum] as to why ICANN should consider allowing a eUDRP. We believe that certain commentators may have misread WIPO’s proposal by raising concerns that a eUDRP may result in erroneous default judgments. In fact, as outlined in WIPO’s proposal, respondent will continue to receive written notice that a dispute has commenced.” Ms. Deutsch notes that Verizon has filed numerous complaints with both WIPO and the Forum, and has also filed paperless complaints with Nominet under the DRS system. “In light of ICANN’s firm commitment to implement its new gTLD program which will potentially introduce an unlimited number of gTLDs into the domain name system, without having finalized what rights protection mechanisms will be offered to trademark owners, we expect to file additional UDRP complaints to protect against domain name abuse. A eUDRP would expedite our handling of such domain name abuses.” Ms. Deutsch also expressed a hope that the resulting operational efficiencies and cost savings realized by UDRP providers as a result of implementation of the eUDRP be passed on to users. See <http://forum.icann.org/lists/eudrp/pdf4Ah5KdRmaR.pdf>.

Zbynek Loebel, on behalf of the Czech Arbitration Court (CAC) submitted a comment in support of the WIPO proposal. Mr. Loebel provided additional discussion on the proposed language of the modification of the UDRP rules, with a suggestion to “add language regarding authentication of the electronic Complaints and Responses. At the moment UDRP Rules required . . . that the hardcopy Complaint or Response is signed” as a means of authentication of the documents. Mr. Loebel notes that the “eUDRP should contain similar authentication requirements for electronic-only Complaints and Responses, fulfilling similar functions as handwritten signatures do in relation to hardcopy documents.” As authentication processes are constantly developing, each provider should be responsible for selecting the method it deems appropriate. Mr. Loebel included a specific proposal for language to address this Electronic Signature requirement, based upon EC Directives. See <http://forum.icann.org/lists/eudrp/msg00013.html>.

Jerome Rhein, on behalf of F. Hoffman-LaRoche AG, submits a comment to welcome and support WIPO’s proposal. Mr. Rhein identifies his company as “a regular and frequent user of the UDRP procedure as Complainant.” See <http://forum.icann.org/lists/eudrp/msg00014.html>.

Claudio DiGangi, on behalf of the International Trademark Association (INTA) Internet Committee (the “Committee”), submitted a comment in support of the WIPO proposal, as the “Committee believes the proposed amendments will produce a more effective, fair and streamlined UDRP process that will better protect the

interests and rights of all parties involved in the proceedings.” The Committee notes that the proposed amendments will not alter the obligation to provide written notice of the dispute to the Respondent, or the obligation to provide other electronic copies as currently specified in the UDRP. “The Committee believes the eUDRP process will better serve the interests of the public, including those trademark owners and consumers who are targeted and harmed from abusive gTLD domain name registrations, and domain name registrants who register domains for legitimate purposes.” See <http://forum.icann.org/lists/eudrp/msg00015.html>.

Douglas Isenberg writes in support of WIPO’s proposal for all of the reasons stated by WIPO, as well as those stated within Mr. Metalitz’s comment on behalf of the IPC and Mr. DiGangi’s comments on behalf of the INTA Internet Committee. Mr. Isenberg notes that he is a WIPO panelist and an attorney representing clients in UDRP proceedings. He states “[A] paperless system is entirely appropriate and consistent not only with today’s technology but also with one of the UDRP’s benefits, namely, that it provide a low-cost means of resolving domain name disputes.” Mr. Isenberg states that all parties will benefit, as he has seen proceedings with hundreds of pages transmitted in hardcopy to panelists and parties, an avoidable expense. Electronic submission would also reduce transmission time and increase the benefits of the UDRP. Mr. Isenberg notes that the WIPO proposal “would require service providers to continue providing written notice of complaints to respondents via postal mail and facsimile. . . . This requirement should alleviate any concerns that may exist about the adequacy of electronic communications, as the Provider’s responsibility to employ reasonably available means calculated to achieve actual notice would be maintained.” See <http://forum.icann.org/lists/eudrp/msg00016.html>.

Yvette Wojciechowski submitted a comment on behalf of FairWinds Partners, LLC, in support of WIPO’s proposal. “FairWinds agrees with WIPO that going paperless will make the UDRP process more effective, efficient, forward-looking, modern, expedited and greener.” FairWinds notes that “a paperless eUDRP will be much more streamlined and practical than the current process.” FairWinds noted WIPO’s statement that email notification is successful in 96% of cases, and that for those cases where email notification is not acceptable, “the safety mechanism WIP has proposed – requiring Complainants to provide a written notice to inform the Respondent of the complaint along with detailed contact information – is a sufficient measure to ensure that the Respondent has adequate opportunity to participate in the proceedings, and to prevent default decisions based on non-response.” FairWinds states that making the process electronic may lower the costs and make the UDRP more accessible for brand owners. FairWinds concludes its comments by stating “The amendments proposed by WIPO take advantage of technology’s ability to expedite procedures, reflect current attitudes toward environmental conservation and will ultimately make the whole UDRP process much more efficient and easier for all parties.” See <http://forum.icann.org/lists/eudrp/pdfVa04b33lqb.pdf>.

Philip Corwin submitted a comment on behalf of the Internet Commerce Association (ICA), noting a “general[] endorse[ment of] the proposal so long as it includes a strengthened requirement or fax and postal notice to alert registrants of the complainant’s filing.” ICA notes “we are in agreement that an eUDRP would have environmental, efficiency, and timeliness benefits, and given that the majority of UDRP complainants and respondents already utilize electronic means for the entirety of their procedural filings, we have no objection to ICANN’s amendment of the UDRP rules to facilitate or require that all materials related to a UDRP - other than an initial notice to a registrant that a complaint has been brought against a particular domain name - be transmitted in electronic form. “ ICA notes that if ICANN does not authorize a move to eUDRP, the ICA would object to unilateral action by the providers to amend supplemental rules, as “the prime benefit of having a UDRP is uniformity, and that uniformity should apply to both its substantive and procedural components.” Unilateral, non-uniform change could also encourage complainant “forum shopping.” Allowing such unilateral action to occur would nullify the provision of the UDRP rules, which state that ICANN must approve changes to the rules. The ICA then expressed its support of the IPC’s statement, that this change must be achieved through an amendment of the UDRP rules, and not through amendments to providers’ supplemental rules. ICA urges ICANN to communicate to Providers that unilateral action “could result in a loss of accreditation. Turning to the proposed rules, the ICA notes that the changes are “truly procedural in nature and do not have an impact on the substantive rights of registrants that would constitute a new policy. Therefore, we do not believe that the contemplated changes require the initiation of a Policy Development Process – unlike [proposals arising out of the new gTLD process].” The ICA “generally endorses” the proposed Rule changes, but notes that they would be mandatory as drafted, which the ICANN announcement did not state; the ICA endorsement is “contingent upon retention of the requirement . . . that registrants receive notice of the complaint to all postal and fax addresses showing the WHOIS database” as well as other identified address. The ICA recommends that the Rules be amended “to require that the fax notice be accompanied by confirmation of transmission and that the postal notice to the registrant’s primary physical address have a return receipt requested.” Finally, the ICA objects to any inclusion of the words “to the extent permitted by the provider” and all new proposed references to “the Provider’s Supplemental Rules” “as these would sanction the adoption of unilateral rules changes by different UDRP providers.” The ICA notes that notwithstanding the position presented “we continue to believe that . . . ICANN should undertake an expedited PDP on EDRP reform to address abuses committee by both complainants and registrants in a balanced mater.” ICA also urges the PDP process to consider ICANN entering into formal contracts with UDRP Providers. This work should be done through the GNSO, and not by a “global committee” as suggested by the Forum. See <http://forum.icann.org/lists/eudrp/msg00018.html>.

Tim Ruiz submitted a comment on behalf of GoDaddy.com, Inc., noting the support for the modifications proposed by WIPO. “The current UDRP system, both in process and in practice, often results in multiple wasteful exchanges of hard copy

filings. Our internal UDRP handling procedures are fully capable of transitioning to a paperless model, and we commend WIPO for introducing this proposal to the community.” GoDaddy “encourage[s] ICANN to carefully consider the impact of this modification on registrant notification. Email notification is not uniformly reliable, and can be impeded by mis-configured spam filters and malfunctioning or outdated email accounts. . . . [W]e urge ICANN to require written notification to the registrant, via postal mail or facsimile, for all UDRP filings. Subsequent documentation can then transition to a paperless format.” See <http://forum.icann.org/lists/eudrp/pdfRs89eGylCX.pdf>.

Next Steps:

ICANN expects to receive a modified proposal from WIPO, drafted after the conclusion of the public comment period. After review, the modified proposal is likely to be submitted to the ICANN Board for decision and action, assuming that that the modifications are acceptable and incorporate necessary responses to the issues raised in the public comment session.

Contributors:

Kristine Dorrain on behalf the National Arbitration Forum
George Kirikos
Marco Rinaudo, CEO of Internet.bs Corp
Vijaya Sree Nidadhavolu
Nick Wenban-Smith, Senior Legal Counsel for Nominet UK
Alexandre Foucher
Steve Billion of ChamberSign France
Michele Neylon of Blacknight Solutions
Frank Michlick, on behalf of DomainCocoon Inc.
Sandrine Gerber, on behalf of the Institut Federal de la Propriete Intellectuelle
Steven J. Metalitz on behalf of the Intellectual Property Constituency (IPC)
Sarah B. Deutsch, Vice President and associate General Counsel of Verizon Communications, Inc.
Zbynek Loebel, on behalf of the Czech Arbitration Court
Jerome Rhein, on behalf of F. Hoffman-LaRoche AG
Claudio DiGangi on behalf of the Intellectual Trademark Association (INTA) Internet Committee
Douglas Isenberg
Yvette Wojciechowski, on behalf of FairWinds Partners, LLC
Philip Corwin, on behalf of the Internet Commerce Association (ICA)
Tim Ruiz on behalf of GoDaddy

Tim Cole
Chief Registrar Liaison

ICANN
4676 Admiralty Way, Suite 330
Marina del Rey, CA 90292
tim.cole@icann.org
+1-310-823-9358