|  |  |  |  |  |  |  |  |  |  |
| --- | --- | --- | --- | --- | --- | --- | --- | --- | --- |
|  | Main Issues | NCSG | ALAC | Registry | Registrar | BC | IPC | ISPC | Out of the Box |
|  | **IP CLEARING HOUSE**  **(To be discussed in upcoming STI mtg)** |  |  |  |  |  |  |  |  |
|  | Separation into two parts: Review/Approval/Repository | Yes | Yes | Yes | Yes | Yes | Yes | No need |  |
|  | Centralised Database for maintaining the TMs and providing Sunrise and TM Claim services to the Registries; Change Name to “Trade Mark Database” | Yes | Yes | Yes | Yes | Yes | Yes | Yes |  |
|  | Regional Marks Validation Service Providers (VSP) | Yes | Yes | No objection | No objection | Yes | No objection |  |  |
|  | Validation vs. Database – Split Roles (above- as a first step) | Yes | Yes | Yes | Yes | Yes | Yes | No need |  |
|  | VSP to adhere to minimum Standards/requirements under contract with ICANN | Yes | Yes | Minimum Standards but not a Contract | Minimum Standards but not a Contract | Yes | Yes |  |  |
|  | Centralised Database to have contract with ICANN | Yes | Yes |  |  | Yes | Yes | ICANN should oversee and have complete responsibility for the clearinghouse. |  |
|  | Identical – Matches means:  ‘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 replaced by hyphens (and vice versa), (b) spaces, hyphens, punctuation or special characters contained within a trademark that are spelt out with appropriate words describing it (Including but not limited to ~ @ # ! § % ^ © and &.), (c) punctuation or special characters contained within a mark that are omitted or replaced by spaces or hyphens will be considered identical matches, and (d) also the singular and plural of the mark (and vice versa) | Under review | Yes | Yes | Yes | Yes  Should also include Typographical errors  And aural and meaning | Yes | No objection |  |
|  | Eligibility of Mark:   1. Nationally Registered Mark 2. Court Validated Mark (through final judgement) | Yes | Yes | Yes but not Court Judgement based Mark – basically do not complicate the process |  | Yes  VSP & Database should be able to validate and repose data with respect to other Rights if the Registry so chooses | Should also include possibility to repose other rights/data | No objection | can we speak about letting in addition to this the Registry also seeking other rights that can be reposited in the Database |
|  | Post Launch  IP Claims Service |  | Yes | No | No | Yes |  | The clearinghouse is an existing and proven model that preserves rights while expediting the registrants ability to register domains that do not infringe on the rights of others. It is a model that should extend to existing registries, but consideration should be given to the timing. | If IP Claims is only pre-launch a bad actor can game the solution by simply waiting until launch and then register.  The notice advantage in terms of a URS will not be available in such a case. If this is gamed en mass, it will practically make IP Claims redundant and ineffective |
|  | As clear information as possible on the IP Claims service so that the notice is a binding one | Yes  A set of minimum requirements for inclusion by Registries and Registrars in the TM Claims process  • Clear notice to the potential registrant of the description of goods or services being claimed by an existing TM owner (not just the international class, but the TM owner's own description). This is good for both TM owners (a mere International Class listing, to an ordinary registrant, would be unlikely to be considered fair notice as few would understand it);  • A link to the underlying TM registrations being referenced – a link into the specific listings of the TM Database. This will be particularly important, for commercial entities, especially in developing countries, seeking to name new services, new brands, and wanting to explore and understand what exists already – and where the room is for them.  • A solid notice of rights: that the rights being claimed above may or may not limit the ability of the registrant to register the domain name, particularly if the use is non-commercial, generic, highly descriptive, or in a completely non-infringing commercial manner; all reduce chilling effects. | Yes | Yes | Yes | Yes | Yes | No Objection |  |
|  | It should be clearly stated in mandate of the TM Database that simply inclusion of a reviewed mark into the Database is not proof of any right nor does it confer any legal rights on the Rights Owner | Yes | Yes | No objection | No objection No objection | Yes |  | No objection |  |
|  | **URS**  **(Updated per 11-5-09 STI discussion)** |  |  |  |  |  |  |  |  |
|  | Mandatory | No  (Recommend table issue until URS fleshed out) |  | Yes | Yes | Yes | Yes  A primary issue; “optional” will cause havoc/ expose Ry/Rr to liability. | URS must be mandatory. Staff’s belief that there is a strong incentive to do this anyway does not address the impact of a business model formed as a haven for bad actors. | Agreement to return to this issue. |
|  | Purpose: Garden variety Cyber squatting with no genuine contestable issue, clear and convincing (clear-cut) cases of infringement | Serious concerns and reservations  (If fair notice is fair and at least 20 days, process and appeals provided, and forum shopping eliminated) | Yes | Yes | Yes | Yes | Yes |  | (Details below largely not discussed on 11-5)  Domain Lock on Complaint passing Initial Examination  Notice period 14 or 20 days *(14 days if restoration to be made available – 20 days if restoration not to be made available)*  basis of claim to be Garden variety Cyber squatting  Standard of proof to be prima facie case having no genuine contestable issue, clear and convincing (clear-cut) case  Emails on the domain still function  Even after default the Respondent can come back and restore the process to the Answer stage – site should go back up.  *(this would only be available if the notice period is 14 days)*  In case of Answer matter goes to substantive review  Complainant and Respondent to have right of de novo Appeal  *(this right would also be available in case of default if notice period to be 14 days and no restoration available* |
|  | De novo Appeal  &  Sanctions | Yes  Critical element for NCSG –appeals of these rapid URS decisions on their merits and on abuse of process w/ real sanctions.  URS appeals allowed for:  (a) review on the merits,  (b) questioning the impartiality or abuse of discretion of the Examiner,  (c ) abusive Claim by the Claimant, or  (d) Perjury by the Claimant (lying about facts; lying about TM rights).  Panel should be a 3-Judge Panel comprised of a rounded group of experts: a Fair Use Attorney; an Academic in this Field; and a TM Attorney  Sanctions:  Sanctions by Appeals Panel:  • One finding of perjury (lying to the tribunal) and the Claimant, and its related entities, are barred from the URS process.  • Two findings of abusive Claims and the Claimant is barred from the URS process for a period of multiple years.  • Three findings of abuse of discretion (or perhaps merely 3 reversals) and the Examiner is removed. | Yes | Yes | Yes | Yes | Yes  Ombudsman for abuse of discretion review;  Court appeal for those courts which allow. |  | Agreement on need for Appeal.  No Agreement yet on scope and details. |
|  | Notice to Respondent should be clear | Yes | Yes | Yes | Yes | Yes | Yes | Yes | AGREEMENT! |
|  | Panellists / dispute resolution providers – randomised and no choice of which to be available to Complainant to avoid overzealous TM holder gaming. | Yes  Randomize Forums (Providers) to prevent forum- shopping.  In case Panellists examination are being overturned then the Panellist loses Accreditation to be a URS Panellist | Yes  No gaming of the system. | Yes | Yes  Avoiding foam shopping is a goal. | Yes (acceptable in exchange for Post Launch IP Claims & Domain Transfer) | Yes  Randomize Panellists across Providers |  | AGREEMENT ON GOAL OF AVOIDING FORUM SHOPPING  KKleiman and MPartridge agree to take details offline. |
|  | Notice time to be increased from 14 to 20 days | Yes  20 days + Rapid Review still results in Rapid Takedown from TM Owner point of view.  Critical issue for NCSG as short notice time reduces opportunity for Registrants to a) learn about the Complaint, and b) find counsel/help to respond well.  Gaming by TM owners in timing of filing.  Fairness of notice/response to the Registrant, and a Rapid Review and (upon successful decision) rapid end to the resolution of the domain name for the TM owner. By UDRP standards, a very rapid response. | Yes |  | Original IRT proposal timelines | Yes (acceptable in exchange for Post Launch IP Claims & Domain Name Transfer)  Either an extension in time from 14 to 20 days  Or  Right of Registrant to come back to restore the process to pre-default (website /domain goes back up)  But not both | 14 days  with IRT recommendation of de novo appeal in case of default and answer by Registrant. |  | Garden variety Cyber squatting to get 14 days with possibility of 7 day extension. Note the time taken to issue a decision by the Examiner will also add to the time available in addition to the 14 days, but review time is expected to be far less than UDRP Panel (URS= “Rapid Review”) |
|  | Modes of Notice through email, fax, hardcopy | Yes | Yes | Yes | Yes | Prefer email & fax | Yes |  | Violent Agreement! |
|  | Upon a Successful Decision by a Complaint, option to transfer Domain Name for a fee | No |  | No | No | Yes | Yes |  | Extensive discussion and no resolution. |
|  | Complaint and Answer should be limited and as formulaic as possible:  Limited Complaint with website attachment; Limited Response with website attachment.  IRT forms of Complaint and Answer to provide some guidance. | Yes  Consider fair for both Complaint and Answer to be limited and of equal length, e.g., one page each with one or a few attachments of website or other use/abuse exhibits. Forms may be helpful here; but not to replace textual comments completely. | Yes  Although absolute balance not necessary (adequate space to respond) | Yes | Yes | Yes | Yes |  | Agreement on limiting Complaint and Answer.  Details not determined. |
|  | Successful Complainant can obtain transfer of domain for a fee after 90 days if no appeal, UDRP or court action is filed |  |  |  |  |  |  |  | Duplicate item; see #19 above. |
|  | Reviews of the URS at regular intervals | Yes  Sunset is critical to provide assurance of review of URS by GNSO and timely initiation of a PDP to review URS and UDRP.  Review at 6 months, 12 months, 18 months. | Yes  In favour of regular review of URS; uncertain about Sunset. | Yes | Yes  “Hopefully no one is against the regular review of the URS… at predetermined regular intervals. | Can consider | No objection |  | AGREEMENT THAT REGULAR REVIEW OF THE URS IS NECESSARY.  Support of ICANN Staff finding that URS is an “interim implementation solution” subject to later review and policy development. |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |
|  |  |  |  |  |  |  |  |  |  |