

March 30, 2010

Internet Corporation for Assigned Names and Numbers
4676 Admiralty Way
Suite 330
Marina del Rey, CA 90292

RE: National Arbitration Forum comments on Trademark Post-Delegation Dispute Resolution Procedure

Dear Sir/Madam:

The National Arbitration Forum has reviewed the proposed Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP) and, as an accredited dispute resolution provider, the Forum offers some unique insights that few other commentators to these processes have. With over ten years of experience handling domain name disputes, the Forum is well-suited to offering some practical advice regarding the procedural implementation of new Policies.

First, and generally, the FORUM agrees that the Registry Restrictions Dispute Resolution Procedure (RRDRP) and the Trademark PDDRP could and should be combined. Second, some of the Forum's comments are questions to ICANN Staff. The Forum encourages ICANN staff to evaluate the questions as the answers will determine the direction this Procedure would go. The Forum encourages ICANN staff to consider the Forum's comment to the URS, as some of the problems inherent in the URS proposal carry through here. The Forum is available for consultation and comment on the likely effect of any proposed solutions.

	Trademark PDDRP	FORUM Comment
1.	Paragraphs/procedures are not enumerated	The Forum encourages ICANN to enumerate all procedures and sub-procedures/rules using standard outline format, in the final draft. This will make referring to specific provisions much simpler.
2.	Applicable Rules section, Bullet Point #2: In the Registry Agreement, the registry operator agrees to participate...	Is there no such thing as a default (page 6 seems to contemplate the possibility of default)? What if the Registry refuses to participate?

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3.	Language section, Bullet Point #2: “Subject to the authority of the panel to determine otherwise...”	The panel is not yet appointed when submissions are made. At what point does the Panel make a determination that submissions need not be translated? Does the case start over if someone doesn’t submit their documents with English translations and the panel thinks the translations were needed?
4.	Communication and Time Limits section, Bullet Point #5: “calendar days unless otherwise specified.”	Please let the parties and provider know if deadlines for parties or the provider will fall on a weekend, or if calendar days are merely used for counting purposes (but not deadlines).
5.	Standing Section, Bullet 2: Established institutions and individuals associated with defined communities are eligible to file a community objection.	If the Provider is doing a “quick look,” as to trademarks, we assume this means only registered marks are comprehended and that evidence of those registered marks are included in the submission of the complaint. Is this “quick look” done before, during, or after the formal compliance check noted on Page 5?
6.	Standards Section, Top Level (first) Bullet, last paragraph: “An example of infringement at the top-level is where a string is identical to a trademark and then, contrary to declared intentions not to infringe the rights of the mark holder, the registry operator holds itself out as the beneficiary of the mark.”	This portion seems like it is a straightforward compliance issue—a violation of the terms of the Registry Agreement. We question the need for an external provider to adjudicate this when it seems this type of dispute SHOULD go straight to ICANN (in contrast to the second level disputes where the Registry is merely contributing to infringement).
7.	Complaint Section, Content Subsection, Paragraph 1: The name and contact information...of Complainant...and, to the best of Complainant’s knowledge, the name and address of the current owner of the registration.	Because this procedure is a dispute resolution mechanism against a registry, it appears the word “registration” is an error. We believe the word is supposed to be “registry.”

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8.	Complaint Section, Content Subsection, First-Level Bullet # 4: A statement that the proceedings are not being brought for any improper purpose.	The Forum has found that the UDRP-provided language, which includes a statement of good faith, and an indemnification of the Provider and Panel (except in cases of deliberate wrongdoing) is very effective and leaves little to the complainant's imagination as to what a statement of good faith might entail. The Forum suggests that ICANN staff create the language for this statement.
9.	Administrative Review of the Complaint Section, Paragraph 2: If the provider finds that the Complaint does not comply with procedural rules, it will dismiss the complaint and close the proceedings.... Filing fees will not be refunded."	The Forum strongly suggests that there be a "deficiency period" as provided in the UDRP, during which a complainant can remedy the defects of its case. If a complainant unwittingly omits a procedural element, dismissal without a chance to cure appears to be quite harsh.
10.	Response to the Complaint Section, Paragraph 1: Service will be deemed effective, and the time will start to run, upon confirmation that the electronic complaint and the written notice was sent by the Provider to the last known address of the registry operator.	The Forum suggests that the RRDRP adopt this language rather than the current RRDRP language on this issue.

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11.	Default Section	<p>The Forum questions the need for this section. First, the “deeming” of a Complaint to be in default is merely procedural. It has no substantive effect (at least as the Procedure is currently written).</p> <p>The second paragraph point in this section talks about the setting aside of a “finding” of default, but as the Panel makes all Determinations, any Provider recommendations are purely anecdotal—there is no “finding” to set aside.</p> <p>The point that all cases proceed to a Determination on the merits negates any effect of a Provider finding of “default.” The presence of any discussion in this section implies that the status of “default” holds some significance.</p>
12.	Expert Panel section, Bullet #2: “...which shall consist of one Panel member unless all Parties agree to three Panelists...”	Why must the parties agree on three panelists? Why not allow the party opting for three panelists to pay for the increased panel size? If ICANN chooses to stay with a consensus for a three member panel, who pays for it?
13.	Discovery Section, Bullet #1: Whether and to what extent discovery is allowed is at the discretion of the Panel...upon request from the Parties.	What if one or more parties wish to conduct discovery prior to panel appointment? What if the complainant wants some discovery prior to submission of the complaint? The way this is worded does not really allow discovery to happen.
14.	Discover Section, Bullet #3: “...the Provider may appoint experts...”	Since the Panel has the sole discretion to authorize discovery, perhaps this should be worded to authorize the Provider to act on behalf of the panel.
15.	Remedies Section, Bullet # 2: The Panel can recommend a variety of graduated enforcement tools...including:...”	Where will the finite universe of options come from? Will the ultimate list be limited or open to the Panel’s imagination?

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16.	Remedies Section, Sub-bullets under Bullet # 2: “ Remedial measures...monetary sanctions...suspension... or, in extraordinary circumstances...termination...”	<p>Again, the Forum would like ICANN to provide the universal of remedial measures that may be taken by a panelist.</p> <p>To whom are monetary sanctions paid? What are the parameters?</p> <p>What are examples of extraordinary circumstances for which termination of a registry agreement is an appropriate response?</p>
17.	<p>The Panel Determination Section, Bullet # 3: The Determination will further include a recommendation...[and]when those remedies should take effect.</p> <p>Bullet # 4: ICANN will review, approve, and enforce the recommended remedies</p>	<p>Is there a time period within which ICANN must conduct its review? How will the Panel/Provider know an appropriate date for the remedies to take effect if it doesn't yet know if the Panel will endorse the remedy recommended? For instance, if the Panel says the remedy is to take effect 20 days from the Determination, what if ICANN doesn't review the Determination until 30 days after the Determination?</p>

The Forum thanks ICANN staff for the opportunity to comment on the Trademark PDDRP and believes that this process, as written, could be very effective. The Forum again offers its services to assist Staff in defining the procedural elements of this new Procedure.

Sincerely,

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