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Submitted to: comments-irp-supp-procedures-28nov16@icann.org

January 27, 2017

Karen Mulberry
Director, Strategic Initiatives
ICANN
12025 Waterfront Drive, Suite 300
Los Angeles, CA 90094-2536

Re: Updated Supplementary Procedures (USP) for Independent Review Process (IRP)

Dear Ms. Mulberry:

The International Trademark Association (INTA) appreciates this opportunity to comment on the on the draft Independent Review Process (IRP) Updated Supplementary Procedures (USP) prepared by the IRP Implementation Oversight Team (IOT). INTA generally supports the changes that have been proposed in the USP. Nonetheless, we do have some concerns around four issues; the definition of standing, the time for filing a written statement, the scope and application of the USP to pending independent review proceedings (IRP), and the limitations on discovery. We are pleased to contribute our thoughts and recommendations below.

1. Standing to File an IRP Should Include Actual or Imminent Injury or Harm.

The Updated Supplemental Rules build the legal concept of standing into the definition of CLAIMANT. In particular, a CLAIMANT is defined as being limited to a party “materially affected by a Dispute” and to be “material affected” a claimant “must suffer an injury or harm that is directly and causally connected to the alleged violation.” This is a fairly restrictive view of standing because it fails to offer a remedy for imminent injury or harm. For instance, the United States, which has conservative standing requirements, allows for standing where a complainant can show “actual or imminent invasion of a legally protected interest.” *Lujan v. Defenders of Wildlife*, 504 U.S. 555, 112 S. Ct. 2130, 119 L. Ed. 2d (1992). This standard enables a CLAIMANT to avoid harm which may allow for a more just outcome rather than to wait until injury or harm is inflicted by an action or inaction. As such, INTA recommends that the definition of CLAIMANT is revised as follows:

A CLAIMANT is any legal or natural person, group, or entity including, but not limited to the Empowered Community, a Supporting Organization, or an Advisory Committee, that has been materially affected by a Dispute. To be materially affected by a Dispute, the Claimant must suffer an actual **or imminent** injury or harm that is directly and causally connected to the **conduct complained of**.

Please note that this same definition is repeated in the USP at Section 9 which allows for a summary dismissal for such lack of standing. INTA suggests that Section 9 be clarified as allowing summary dismissal based upon a lack of standing and that the revised definition, as proposed above, is implemented. The standard of actual or **imminent** injury or harm should also be inserted into the USP at Section 11.d. which governs the standard of review for claims that ICANN has not enforced its contractual rights with respect to the IANA Naming Function Contract.

2. The USP Should Be Applied Retroactively to All Pending IRPs

The USP provision regarding Scope (USP 2) states that the USP shall apply in all cases submitted to the ICDR after the date the USP goes into effect. We submit that the effective date of the USP should be October 1, 2016 which corresponds to the completion of the IANA Transition and the adoption of ICANN's new Bylaws. If the USP does not apply retroactively to the date the Bylaws took effect, there will be inconsistency between the Bylaws and the rules of procedure governing IRPs commenced prior to the USP effective date. Furthermore, to the extent that the USP may be said to represent ICANN's present policy regarding fairness and due process, this could undermine confidence in proceedings governed by the old procedural rules. INTA recommends that for any IRP commenced after the date the new bylaws became effective and before the date the USP becomes effective, there be a mechanism whereby one or more parties to the proceeding may ask for the USP to govern the proceeding, provided there is no material disadvantage to any party's substantive rights. The text of Rule 2 of the USP contains language that could be used to define the process and articulate the relevant tests.

3. Time for Filing a Written Statement is Inadequate

USP Rule 4 states that "a CLAIMANT shall file a written statement of a DISPUTE with the International Centre for Dispute Resolution (ICDR) no more than 45 days after a CLAIMANT becomes aware of the material effect of an action or inaction giving rise to the DISPUTE; provided, however, that a statement of a DISPUTE may not be filed more than twelve (12) months from the date of such action or inaction."

INTA believes that the 45 day period for filing a written statement with the ICDR is insufficient for a claimant to adequately analyze and develop a bona fide claim and prepare a written submission. Given the likely complexity of any such claim and issues such as geographic distance among relevant parties, INTA is concerned that 45 days will almost never be an adequate amount of time for gathering, collating and analyzing all the necessary information for mounting an IRP. The result is likely to be a chilling effect on claims of this sort because the costs and benefits of filing a written statement will be outweighed by the low likelihood of success due to the lack of sufficient time to obtain and organize the relevant facts, consider the issues and prepare appropriate submissions. INTA recommends adopting a 90 day deadline.

In addition, INTA has concerns that the ultimate deadline for commencing an IRP, namely 12 months from the date of the action or inaction giving rise to the claim, is also insufficient. INTA suggests that the IOT consider increasing this time period from 12 to 24 months, as it is plausible that the effect of an ICANN Board or ICANN staff action or inaction may not be known to a party within 12 months of the action or inaction.

4. Certain Discovery Methods Should be Allowed based on a Good Faith Need for Information

USP Rule 8 provides that “depositions, interrogatories, and requests for admission will not be permitted.” INTA is concerned that a blanket prohibition on depositions, interrogatories and requests for admission will prevent a claimant from discovering facts that are necessary to its case. INTA believes that witness testimony and interrogatories are important methods of discovery that should not be peremptorily ruled out. Claimants preparing claims of this nature are unlikely to have all the necessary facts in their possession, and in some cases the facts will be difficult to acquire through the documentary discovery outlined in USP Rule 8. To ensure fairness and allow for adequate discovery, INTA recommends that a claimant be given an opportunity to demonstrate a good faith need for either a deposition or interrogatories based on the standard used to determine whether a witness is necessary at the hearing, namely, that the deposition or interrogatory requests (1) are necessary for a fair resolution of the claim; (2) are necessary to further the purposes of the IRP; and (3) considerations of fairness and furtherance of the purposes of the IRP outweigh the time and financial expense of the deposition and/or interrogatory requests. INTA would support that a limited number of requests for admissions be allowed. Moreover, the Updated Supplemental Rules permit relevant and material documents to be withheld on the nebulous grounds that the documents are “otherwise protected from disclosure by applicable law.”

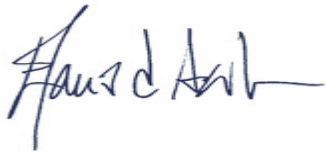
INTA believes that the reference to other “applicable law” is too vague and could encompass, for instance documents that are subject to a confidentiality agreement. In addition, this standard allows parties to forum shop and re-locate documents to jurisdictions that have laws protecting disclosure of documents outside of international legal norms. INTA recommends that, to the extent documents are subject to confidentiality restrictions, that the parties should be able to produce documents subject to a protective order. Moreover, INTA suggest striking “otherwise protected from disclosure by applicable law” and replacing it with “otherwise protected from disclosure by a valid order of a court with competent jurisdiction.”

5. About INTA

INTA is a 137 year-old global not for profit association with more than 6,400 member organizations from over 190 countries. One of INTA’s goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. INTA has also been the leading voice of trademark owners within the Internet Community, serving as a founding member of the Intellectual Property Constituency of ICANN. INTA’s Internet Committee is a group of over 200 trademark owners and professionals from around the world charged with evaluating treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet, whose mission is to advance the balanced protection of trademarks on the Internet.

Should you have any questions about our comments, I invite you to contact Lori Schulman, INTA's Senior Director of Internet Policy at 202-261-6588 or at lschulman@inta.org.

Sincerely,

A handwritten signature in blue ink, appearing to read "Etienne Sanz de Acedo". The signature is fluid and cursive, with a long horizontal stroke at the end.

Etienne Sanz de Acedo
Chief Executive Officer