The devil is in the detail

The ICANN RPM review working group, which was officially chartered in March 2016, is carefully assessing domain rights protection mechanisms. INTA internet committee chair John McElwaine provides an update on its progress.

How is first phase of the RPM review going? Is it dealing with broad concepts, or getting down to the details?

The first phase of the Trademark Clearinghouse (TMCH) analysis is focusing on how this rights protection mechanism (RPM) works in practice. Issues, such as sunrise and the trademark claims notice services, are being put to a later stage.

Right now, there are discussions in the RPM review working group on whether certain types of design or figurative marks should be included in the TMCH, or whether it should be limited to word marks. That’s the level of detail that the review is going into.

During the first phase, the RPM review working group is also examined the Post-Delegation Dispute Resolution Proceedre. As it has never been used before, there were discussions regarding whether it’s broken, and whether it is a solution to a problem that doesn’t exist. Theoretically, it allows brand owners to pursue a complaint against a TLD registry that is engaging in trademark infringement at the top level or contributing to infringement at the second level, but since it’s never been used, a lot of discussion has focused on figuring out why.

Are brands happy with the way trademark claims and sunrise have worked since the introduction of new gTLDs?

I think that International Trademark Association (INTA) members are generally happy with the trademark claims service. Brands that want to use that as a protection service are happy with those capabilities, and the expansion of the service to exact matches plus 50 variations was a welcome addition when it was negotiated and implemented.

On the other hand, sunrise registrations, I’d argue, have not been utilised heavily in new gTLDs. I don’t think that is an indictment of the sunrise programme, but rather the muted popularity of the new gTLDs. It’s even possible that some of the blocking mechanisms may be more popular than the sunrise process. But, that is something that we want to explore at the RPM review working group, specifically whether there should there be expanded blocking mechanisms coming out this review of the TMCH and the sunrise process.

How has the UDRP developed throughout your career? Have there been any significant failures that INTA believes need to be looked at during the second phase of the RPM review?

We would hope that the Uniform Domain Name Dispute Resolution Policy (UDRP) would fall under the rule of “If it ain’t broke, don’t fix it”. However, the UDRP is unlikely to escape attack during the second phase from those who believe it to be overly weighted towards trademark owners.

Improvements that we would like to see would include addressing the UDRP’s requirement of showing bad faith registration and use of the domain name. Most other domain dispute resolutions process allow a claim for registration or use, rather than both actions being required.

We’d also like to see a user pays system, as well as, developing creative solutions to address repeat offenders of cybersquatting, such as a reverse WhoIs system that reveals the identities of the owners of linked domain names.

What is the message that you want attendees of the INTA Annual Meeting to take away as far as this review is concerned?

For the internet committee, the annual meeting in Barcelona is going to be a working meeting. The internet committee has 11 sub-committees and so, rather than have all of those meeting in different corners of the conference, we are put them under three tracks to align interests and open them up to everyone in the internet committee. Those tracks are: advocacy and communications, which will focus on communicating with our membership, Internet Corporation for Assigned Names and Numbers (ICANN) constituencies, and governments; ICANN policy, which cover ongoing policy processes, such as the RPM review working group, the Internet Assigned Numbers Authority transition, and the subsequent procedures working group; and trademarks and the internet, which is going cover the intersection of trademarks, and online platforms, such as social media, as well as discuss the future of intellectual property on the internet. We’re inviting committee members to attend at least one of those tracks and all of them if they desire.

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