

AGENDA - 30 SEPTEMBER 2016 SPECIAL BOARD Meeting - 60 minutes

Time, etc.	Agenda Item	Shepherd
Assembly, Roll Call & Consent Agenda Vote	1. Main Agenda	
Discussion & Decision	1.a. IANA Intellectual Property Agreements	
	1.b. AOB	

ICANN BOARD PAPER No. 2016.09.30.1a

TITLE: **IANA Intellectual Property Agreements**

PROPOSED ACTION: **For Board Consideration and Approval**

Updated with Revised Briefing Materials. See pg. 11-18.

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ICANN BOARD PAPER No. [To be assigned by the Secretary]

UPDATED as of 30 September 2016

TITLE: **IANA Intellectual Property Agreements**

PROPOSED ACTION: **For Decision**

EXECUTIVE SUMMARY:

Within the IANA Stewardship Coordination Group Proposal (ICG), the community included a requirement that the domain names that ICANN uses to perform the IANA functions and the IANA trademarks (the "IANA IPR") be transferred to an entity independent of the IANA Functions Operator, and held for the benefit of the entire community. The community identified the IETF Trust as that independent entity. The community then developed a group of agreements, including:

- IANA IPR Assignment Agreement
- IANA IPR License Agreement (model); and
- IANA IPR Community Agreement.

Through these agreements, ICANN will transfer the IANA IPR to the IETF Trust, and the IETF Trust will license back to ICANN the rights to use that IANA IPR in the performance of the IANA functions. There will be three IANA IPR License Agreements, so that there is one representing each portion of the IANA functions (naming, numbering and protocol parameters). The Community Agreement sets out how the naming, numbering and protocol parameters communities will work together with the IETF Trust. The ICANN Board is requested to approve ICANN entering into each of these Agreements.

STAFF RECOMMENDATION:

The Board is recommended to approve ICANN entering into the IANA IPR Assignment and License Agreements. The Board is also recommended to approve ICANN signing the Community Agreement at the request of and on behalf of the Names Community, based on the consents received from four of the five Chartering

Organizations of the CWG-Stewardship. Pending the final confirmation of consent from the Chartering Organizations, or identification that any changes may be needed to the instructions included within the Instruction Letter, the ICANN Board can accept this role with identification of some specific limitations that ICANN can follow as the signatory. These include:

- Accept the IANA Community Coordination Group representatives as identified by the Names Community, to the fullest extent of the law.
- Where the Community Agreement identifies that the CCG representatives are the entity to consult with the IETF Trust or other operating communities, ICANN can defer to the CCG representatives identified by the Names Community.
- ICANN is not agreeing in advance to take any action at the direction of the CCG representatives that would cause ICANN to breach the Community Agreement or License Agreements, or that would otherwise result in liability to ICANN.

The Board is also recommended to direct the Organization to reply to the CWG-Stewardship instruction letter laying out this conditional role.

BACKGROUND:

The ICG Proposal included a requirement that the three IANA trademarks (two word marks, for “IANA” and “Internet Assigned Numbers Authority”), and one logo be transferred to an independent entity, to hold for the benefit of the global Internet community. The ICG Proposal also included a requirement that the IANA-related domain name registrations be transferred to that same entity. On 15 August 2015, the ICANN Board issued a [statement](#) that it was supportive of this community proposal, so long as ICANN retained operational control of the iana.org domain so long as ICANN remains the IANA Functions Operator.

After community conversation, the community identified that IETF Trust would be

that independent entity, and developed a series of agreements to effectuate that transfer and use for the benefit of the community.

Representatives from the names community (including external counsel to the CWG-Stewardship), the numbers community, the protocol parameters community, the IETF Trust, and ICANN have drafted a set of agreements to effectuate the transfer of the IANA IPR from ICANN to the IETF Trust and to govern the relationships amongst the parties with respect to the IPR after the transfer. These agreements are:

1. **IANA IPR Assignment Agreement.** This agreement transfers the IPR from ICANN to the IETF Trust.
2. **IANA IPR License Agreement.** This agreement allows for the IANA functions operator to use the IPR. The document available for public comment is a basic form that will be used to generate three license agreements, one each for the names, numbers, and protocol parameters IANA services. Items highlighted in yellow will vary by agreement and will be completed once the License Agreement is split into three. In each case the licensee is ICANN, with the ability established for ICANN to sublicense to PTI.
3. **IANA IPR Community Agreement.** This agreement explains the rights and obligations of the IETF Trust and each operational community in regards to the IPR.

ICANN is a party to the Assignment Agreement and the License Agreements. The License Agreements specify ICANN's operational control of the IANA.org site while ICANN is performing any part of the IANA Functions. The License Agreements are tied to each community's ability to terminate their relationship with ICANN for the performance of the IANA functions, so the IPR is inherently linked to the term for which ICANN performs each function.

Other key terms include ICANN's ability to maintain enforcement actions to protect the marks, as well as indemnification for claims. ICANN is currently in the process of informal enforcement actions against two entities for the use of the IANA

trademarks. ICANN has agreed to continue those enforcement actions at its own cost. ICANN has also agreed to indemnify the IETF Trust for infringement actions based upon usage identical to how ICANN uses the marks today. Finally, ICANN agrees that it has the opportunity to initiate new enforcement actions, in coordination with the IETF Trust, for enforcement actions that the Trust is willing to have ICANN control.

On 23 September 2016, the CWG-Stewardship transmitted to ICANN an instruction letter through which it requested ICANN to serve as the Names Community Signatory to the Community Agreement, and set out a series of expectations for how ICANN would perform in its role as a signatory. The specific directions that ICANN is requested to take on in relation to one part of the community has not been the subject of broader community consultation. In particular, the instruction letter leaves open the level of consent from the CWG-Stewardship Chartering Organizations for this arrangement. ICANN organization representatives are already trying to assess the consent levels. With that confirmed, ICANN should be able to serve as the signatory to the Community Agreement on behalf of the Names Community.

With confirmation of SO/AC consent, ICANN should be able to accept the IANA Community Coordination Group representatives as identified by the Names Community, to the fullest extent of the law. Where the Community Agreement identifies that the CCG representatives are the entity to consult with the IETF Trust or other operating communities, ICANN can defer to the CCG representatives identified by the Names Community. As anticipated under the letter, ICANN is not agreeing in advance to take any action at the direction of the CCG representatives that would cause ICANN to breach the Community Agreement or License Agreements, or that would otherwise result in liability to ICANN. Each of these limitations seems in line with the spirit of the CWG-Stewardship instruction letter. The ICANN organization understands that ICANN is requested to serve in this role as there is no other agreed upon entity in existence capable of signing the Community

Agreement for the Names Community.

PROPOSED RESOLUTIONS:

Resolution Text Superseded. See <https://www.icann.org/resources/board-material/resolutions-2016-09-30-en#1.a>

Resolution Text Superseded. See <https://www.icann.org/resources/board-material/resolutions-2016-09-30-en#1.a>

Rationale for Resolutions

Rationale Text Superseded. See <https://www.icann.org/resources/board-material/resolutions-2016-09-30-en#1.a.rationale>

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Directors and Liaisons,

Attached below please find Notice of date and time for a Regular Meeting of the ICANN Board.

30 September 2016 – Special Meeting of the ICANN Board of Directors - at 23:00 UTC (1900 Washington, 1600 Los Angeles, 0700 31 September/ Taipei). This Board meeting is estimated to last approximately 15 minutes.

SPECIAL MEETING OF THE ICANN BOARD

Main Agenda

- IANA Intellectual Property Agreements
- AOB

MATERIALS – You can access the Board Meeting materials in Google Drive; the link will be provided. If you have trouble with access, please let us know and we will work with you to assure that you get access to the documents.

If call information is required, it will be distributed separately.

If you have any questions, or we can be of assistance to you, please let us know.

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