Proposed Updates to Existing Rights Protection Mechanisms Documentation: NCSG Comments

October 18th, 2023

About NCSG

NCSG represents the interests of non-commercial domain name registrants and end-users in the formulation of Domain Name System policy within the Generic Names Supporting Organisation (GNSO). We are proud to have individual and organizational members in over 160 countries, and as a network of academics, Internet end-users, and civil society actors, we represent a broad cross-section of the global Internet community. Since our predecessor's inception in 1999, we have facilitated global academic and civil society engagement in support of ICANN's mission, stimulating an informed citizenry and building their understanding of relevant DNS policy issues.

About this Public Comment Proceeding

https://www.icann.org/en/public-comment/proceeding/proposed-updates-to-existing-rights-protection-mechanisms-documentation-24-08-2023

Overall comment about the Public Comment proceeding and the work done by the Implementation Review Team (IRT)

The NCSG would like to thank the IRT for all the work this team has already done until now. Most of the changes to the documents are welcome and reflect a genuine attempt to seek a better level of balance in alternative dispute resolution systems that historically seem to be created, interpreted, or modified towards the interests of rightsholders. The search for balance and fairness, fundamental pillars not only of ICANN's policies but also of intellectual property, are not just a question of ethics or justice, but a way of guaranteeing the legitimacy of these systems.

For this reason, the NCSG urges the team to remain attentive to sensitive points of the debate around Rights Protection Mechanisms (RPMs) developed within ICANN, especially in the processes that have led to the present moment, which is the subject of this Public Comment. The language used is highly relevant, particularly in the field of intellectual property, and cannot be perceived as something secondary, which is why we recommend that all the points be reviewed in detail to reflect the aforementioned discussions.

We are particularly interested in knowing when the IRT will convene digital rights and law education groups to help clarify the Trademark Notice so it is understandable by those who are outside of ICANN, unfamiliar with ICANN, and unfamiliar with many of the issues they are facing in the Trademark Notice.

Commentary on the Proposed Changes being shared by the IRT to the rules to be provided via to the Documentation of the New Applicant Guidebook.

I. **Proposed Correction and Redline to the URS Rules**
Item 15, Determinations and Publication, p. 11-12,
https://community.icann.org/display/RPMIRT/Implementation+Documents?preview=/222269760/258769230/EXT_IRT.URS%20Rules_Public%20Comment.pdf:

The proposed IRT Text is inconsistent with the published and proposed Recommendation of the RPM PDP Working Group. The RPM WG intended and recommended that the decision whether or not to disclose redacted registrant data would remain in the hands of the Panelists.

RPM Working Group's **URS Final Recommendation #2**:

> ***"The Working Group recommends that URS Rule 15(a) be amended to clarify that, where a Complaint has been updated with registration data provided to the Complainant by the URS Provider, URS Panelists have the discretion to decide whether to publish or redact such data in the Determination. The Working Group further recommends that each URS party has the right to request that Panelists consider redacting registration data elements from publication as part of the Determination."***
> RPM WG Final Report ("RPM Final Report"), p. 10,
> https://gnso.icann.org/sites/default/files/file/field-file-attach/rpm-phase-1-proposed-24nov20-en.pdf

Further, the RPM WG provided Panelists with full discretion to publish or redact without leaning towards one decision or another:

> => ***"URS Panelists have the discretion to decide whether to publish or redact such data in the Determination."***

The reasons were stated by the RPM WG for leaving the decision to disclosure the redacted registrant data entirely in the hands of the Panelist(s), and the RPM Working Group created no default for that decision:

> *=> "The Working Group believed that either URS party should be able to raise the specific reason for the Panelists to consider and request publication or redaction of registration data,* ***but it is ultimately up to the Panelist to decide whether publication or redaction is appropriate.*** *The Working Group's recommended action is consistent with Purpose 6-PA5, which states that "any request to redact a party's name from a decision should normally be submitted for the panel's consideration". The Working Group's recommended action is also consistent with WIPO's practice for UDRP decisions, where in a number of UDRP cases,*

Respondents' names are redacted in the published Determinations at a Panelist's discretion." [Emphasis added, RPM WG Final Report, p. 11]

The RPM Final Report provided additional support from the WG for this policy decision to leave publication of the redacted/personal data decisions in the hands of the Panelist(s):

=> "Some Working Group members also believed that leaving the decision to the Panelists would mitigate potential concerns regarding defaulting Respondents not providing Panelists with reasons for party name redaction.15 The Working Group's review of data from over 900 URS cases found that a majority of cases resulted in Default Determinations, meaning that no Response to a Complaint was filed by a Respondent. The Working Group recognized that there was a noticeable number of defaulting Respondents who prevailed in URS proceedings." [RPM WG Final Report, p. 11]

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Yet, the Published IRT Report leans towards, indeed mandates, a data publication decision that runs counter to the WG's recommendation:

URS Rules, IRT proposed edits, Section 15:

> Where a Complaint has been updated with Registration Data provided to the Complainant by the URS Provider, URS Panelists have the discretion to decide whether to publish or redact such data in the Determination. Each URS party has the right to request that Panelists consider redacting Registration Data elements from publication as part of the Determination. Absent a URS Panelist decision to the contrary, the Provider shall publish the party names in the Determination." [Color added]

The proposed new text in GREEN above clearly confirms the URS Final Recommendation #2. The proposed new text in RED is clearly inconsistent with the language, intent, and rationale of the RPM Recommendation, and must be corrected for two reasons:

a) to preserve the consistency and integrity of ICANN's Multistakeholder Model and its Policy Making Processes, which require that implementation by an IRT follow be consistent with the approved PDP Working Group's Recommendations)[1] and

b) to avoid physical exposure for Registrants and liability and legal exposure for Providers and Complainants pursuant to privacy and data protection laws.

[1] See ICANN Bylaws, Annex A, Section 10: "**based upon** the implementation recommendations identified in the Final Report"

This last argument is based on the understanding that the RPM Working Group gave the URS Panelists discretion for a reason. There are additional, independent, and legal reasons for Providers to protect redacted WHOIS/RDDS data.

Most General Data Protection legislation around the world, especially those based on the European GDPR, have as central principles concepts of "data minimization" (even if using other terms, such as necessity) when processing personal data. Controllers have to choose the option that is effective and achieves the desired goal while being as least intrusive as possible[2].

While sometimes publishing this personal data may be necessary, under the URS Panelists' discretion, setting this as a standard is not only ethically controversial, but also generates a risk for providers, who can, with a solid and clear legal basis in data protection legislation throughout the world, be sued by data subjects for the unnecessary publication of their information.

The text as it is currently written, after all, reverses the logic normally applied in most, if not all, general data protection legislation[3], making disclosure the default and the confidentiality of information something that needs to be motivated.

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Since no "default decision" was required or stipulated by the RPM WG Working Group, NCSG strongly recommends the following "fix" to the language proposed by the IRT to place the decision squarely in the active determination of the Panelist:

NCSG suggestion on how to fix the proposed language:

~~=> "Absent a URS Panelist decision to the contrary, the Provider shall publishthe party names in the Determination."~~ Should be corrected to: "*URS Panelists have the discretion to decide whether to publish or redact redacted Registrant data in the Determination and shall communicate their decision to the Provider."*

Such a correction will align the IRT with the WG recommendation.

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[2] See, f. ex., https://edps.europa.eu/data-protection/our-work/publications/factsheets/edps-quick-guide-necessity-and-proportionality_en

[3] See, f. ex., https://ico.org.uk/media/for-organisations/documents/2021/2619016/how-to-disclose-information-safely-20201224.pdf

II. Proposed Correction and Redline to the URS Rules,
Item 3, The Complaint, p. 4-6,
https://community.icann.org/display/RPMIRT/Implementation+Documents?preview=/222269760/258769230/EXT_IRT.URS%20Rules_Public%20Comment.pdf

At the top of Page 5, the IRT proposes to modify the Complainant to allow amendments far greater than those recommended by the RPM Working Group.

According to the RPM Final Reports and its Recommendations, **the purpose of this amended filing is to add redacted data about the Registrant to the Complaint.** *Unfortunately, the broad proposed change leaves room for adding any type of change or amendment to the Complaint - something barred by present URS rules, unchanged by the RPM WG, and not intended to be changed by this proposed IRT edit.*

Clearly, wide-ranging changes could introduce additional arguments potentially bringing confusion and delay to the URS proceeding. Yet, the IRT proposes an unlimited and unrestricted set of changes – adding anything in "amended complaint":

> => "Pursuant to URS Procedure Section 3.3, Complainant shall have the opportunity to file an amended complaint following disclosure of the relevant contact details of the Respondent."

This type of limitless set of changes, amendments and additions is contrary to the current URS rules (no changes to a URS Complaint at all), and would introduce delay and confusion with changes to the complaint.

The "Fix" is simple:
⇒ "Pursuant to URS Procedure Section 3.3, Complainant shall have the opportunity to file an amended complaint limited to adding additional contact details about the Registrant following disclosure of the relevant contact details of the Respondent."

We ask the IRT to make this clarification and change, and our thanks.

III. Proposed Correction and Redline to the URS (Policy),
#3. Administration Review, URS-2 to URS-3,
https://community.icann.org/display/RPMIRT/Implementation+Documents?preview=/222269760/258769234/EXT_IRT.URS%20Procedure_Public%20Comment.pdf

As in Section II above, the **Administrative Review** proposes to make too broad a change to Section 3.3. In the current URS Rules, there is a ban on all changes to the filing:

> 3.3 Given the rapid nature of this Procedure, and the intended low level of required fees, there will be no opportunity to correct inadequacies in the filing requirements.

The proposed IRT Rule, while legitimately allowing edits to the redacted Registrant data, inadvertently allows entry of all manner of changes, amendments or even a complete refiling of the complaint:

> **IRT Proposed 3.3: The Complainant will have the opportunity to correct inadequacies within (3) calendar days after the URS Provider provides updated Registrant Data related to the dispute domain(s).**

As above this change is inconsistent with the recommendation and intent of the RPM WG and we strongly request it be narrowed to that approved by the RPM WG:

> **=> [NCSG Revision Consistent with the Original URS and Consistent with the RPM Recommendation and Intent]: The Complainant will have the opportunity, ~~correct inadequacies~~ within (3) calendar days after the URS Provider provides updated Registrant Data related to the dispute domain(s), to add that updated Registrant data to its Complaint.**

IV. Proposed Redline to the URS (Policy)

#5. The Response, URS-2 to URS-3,
#8, Examination Standards and Burden of Proof, URS-6 to URS-7,
https://community.icann.org/display/RPMIRT/Implementation+Documents?preview=/222269760/258769234/EXT_IRT.URS%20Procedure_Public%20Comment.pdf

Proposed revisions to the URS (Policy) combine and confuse two different policy issues: not changing Registrant data during a URS Proceeding and not changing website content. This comment addresses the latter issue.

The RPM WG recommended deleting the text "the Registrant will be prohibited from changing content… " for many reasons, including technical infeasibility.

Further, the RPM Working Group specifically found and recommended that the Examiners not be directed how they should construe or interpret any changes to the Registrant's website after the filing of a URS Complaint.

Yet the wording of two proposed IRT changes on this topic are, alas, not even-handed in their direction to the URS Examiner:

5.9.3 Changes to the content found on the website associated with a domain name does not in and of itself constitute bad faith under the URS. Such conduct, however, may be evidence of bad faith depending on the circumstances of the particular dispute.

6.2 In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. **During the Default period, the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use and will also be prohibited from changing the Whois information.**

We ask to the IRT to review the careful and balanced wording of the RPM WG Recommendations and discussion and incorporate it into revised language:

Furthermore, the Working Group agreed that a registrant's action of changing website content can be taken into consideration by the Examiner, as to whether it might be further evidence of bad faith. Some Working Group members noted there may be legitimate or legal reasons for the registrant to update the content of a website, and some websites embed dynamically generated ads and social media feeds. Therefore, the Working Group recommends moving the prohibition against changing website content for domain names subject to URS proceedings to the appropriate section(s) in the URS Procedure as behaviors to be considered by the Examiners, who should make all reasonable inferences when finding bad faith.

NCSG suggestion on how to "Fix" the proposed language:

=> 5.9.3 Changes to the content found on the website associated with a domain name does not in and of itself constitute good faith or bad faith under the URS. Such conduct, however, may be evidence of good faith or bad faith depending on the circumstances of the particular dispute.

and

=> 6.2 In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. **During the Default period, any changes to the website associated with the domain name will be closely examined by the Examine for any good faith or bad faith the changes might indicate. Further, the Registrant** will also be prohibited from changing the Whois**/RDS** information.

V, Proposed Redline to the RPM Requirements

Exhibit A, the Trademark Notice, p. 15-21.

- We ask the IRT to convene the experts that the Working Group said would and could provide the needed explanation and balance to the Trademark Notice to make it understandable and not "chilling" to potential domain name registrants.
- Adding the need for examples (or having a hyperlink to a page providing these examples) on what usually would constitute a permitted use

Here we are a bit dismayed. First, we must admit that, despite liking the original drafters, the RPM PDP WG did not like the Trademark Notice.

> "The Working Group generally agreed that for some actual and potential registrants, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. Some Working Group members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks)." RPM PDP Phase 1 Final Report, p. 55.

To that end, the RPM WG wrote one of its longest recommendations, spending extensive time on the implementation guidance which it wrote with great clarity:

> **Trademark Claims Final Recommendation #6**
> The Working Group recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined below. This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing the risk of unintended effects or consequences of deterring good-faith domain name applications.
> The Working Group agrees that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal consequences or describing what actions potential registrants may be able to take, following receipt of a notice).
> **Implementation Guidance:**
> To assist the IRT that will be formed to implement recommendations adopted by the Board
> from this PDP in redrafting the Claims Notice, the Working Group has developed the following Implementation Guidance:

• The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law;
• The current version of the Claims Notice should be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications;
• The Working Group advises that the IRT use appropriate flexibility and consider whether it believes it will be helpful to solicit input from resources internal and/or external to the ICANN community as the IRT deems necessary and appropriate. Suggested external resources could include academic and industry sources such as the American University Intellectual Property Clinic, INTA Internet Committee, the Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN. The IRT may also, in its discretion, consider input from communications experts, who can help review the Claims Notice for readability purposes and ensure it is understandable to the general public.

Unfortunately, the revised Trademark Notice remains hard to understand and difficult to read. In fact, some of the revisions make it even more difficult to understand. For example, what is the Trademark Clearinghouse, who runs, where can the Registrant find more information about it? (With the note that there are many repositories that could be understood to be "trademark clearinghouses" to those unfamiliar with ICANN.)

Further, how is an individual without legal background to understand the new wording of "You may or may be entitled to register" or "Your rights to register this domain name may or may not be protected…" This is confusing language.

Additionally:

- the added new length will drive readers away;
- the lack of headings makes the longer language more difficult to read for those without legal backgrounds,
- the bold language of paragraph starting four (starting "You may") is likely to be viewed as threatening and intimidating, in a manner likely to greatly increase, not decrease, the Registrant's misunderstanding of the Notice and its unintended chilling effect,
- The "Trademark Notice" should provide the most common examples that appear in different legislations (personal names, previous trademark rights, descriptive/generic signs, *etc*) or hyperlinks to better inform good-faith and legitimate registrants.

Happily, we know that prioritization of those with special needs for explanation and

services from ICANN has become a priority. In the area of Applicant Support, for example, ICANN has engaged in extensive outreach and research to learn how non-profit groups around the world are supported with explanations, education and funding. We can and do the same with this recommendation, and NCSG calls on the IRT to reach out to the larger Community, as those studying Applicant Support have recently done.

Specifically, we call on the IRT, generous in its granting of additional time for all to submit these comments, to activate the small but expert network of "external resources" laid out in the Implementation Guidance in clear detail. One such ICANN expert is ICANN Community leader Professor Humberto Carrasco of the Ciencias Jurídicas de la Universidad Católica del Norte in Chile. He teaches law and runs a legal clinic with law students who represent smaller registrants who find themselves caught up in domain name disputes. He is an expert at explaining domain name issues to ordinary people: individuals, entrepreneurs and small businesses, and small noncommercial organizations.

Like Professor Carrasco, American University's Intellectual Property Clinic (affiliated with the Program on Information Justice and Intellectual Property), INTA Internet Committee and the Electronic Frontier Foundation are experts in domain name issues and understanding/explaining legal and technical notices from the perspectives of registrants, and users, from the background of those who are not familiar with the detailed laws and do not follow the day-to-day work of the field's legal and policy development.

These groups will help us - ensure that we are- clear in the Trademark Notice without being intimidating and informative without being overwhelming. That's why the RPM Working Group recommended them to you. Further, each of these groups was contacted in the writing of the RPM Implementation Guidance and each generously agreed to work with this IRT, and collectively, to share their guidance and insight.

Overall, our collective goal of a clear, informative, non-chilling Trademark Notice is clear so that potential registrants understand their rights and their responsibilities. With great respect for the drafters of the original Trademark Notice, and this new version, neither Trademark Notice achieves this goal.

Thus, we call on the IRT to take this important next step - and engage with the Implementation Guidance of Trademark Claims Recommendation #6 above.

Proposed Redline to the URS High Level Technical Requirements for Registries and Registrars

In #2, Registry Operator Requirements, under the first bullet point, Registry Requirement 1,

should be changed to provide notice of URS Requests to *both the Registry and the BERO, if a BERO is appointed.*

As pointed out in the same paragraph, "the appointment of a BERO shall not relieve Registry Operator of its obligations under the Agreed Obligations and Registry Operator shall remain liable to perform the Agreed Obligations," so the Registry Operator should have direct notice from the URS Provider's notification in addition to those sent to its BERO, should it have one.

Overarching Comments

To avoid confusion and add consistency, NCSG recommends labeling the "URS" policy document as "URS Policy," https://community.icann.org/display/RPMIRT/Implementation+Documents?preview=/22226976O/258769234/EXT_IRT.URS%20Procedure_Public%20Comment.pdf. This small title change will then create a parallel set of titles:

- *URS Policy and URS Rules with*
- *UDRP Policy and UDRP Rules,* and
- eliminate the current ambiguity of whether the title of "URS" refers to a document, a rule, a policy, or a system.

Summary and Conclusions

In conclusion, we thank the IRT for its current work, but note that there is more to do. Implementation must not go beyond the limits set by the Working Group, much less innovate in relation to what was previously decided, and Implementation Guidance, when provided with great care and detail, should be followed. To these ends, NCSG recommends that:

- In the document "Proposed Redline to the URS Rules", the text:
    - "Pursuant to URS Procedure Section 3.3, Complainant shall have the opportunity to file an amended complaint following disclosure of the relevant contact details of the Respondent" (p. 5) **should be changed to "Pursuant to URS Procedure Section 3.3, Complainant shall have the opportunity to file an amended complaint with and limited to additional information about the Registrant following disclosure of the relevant contact details of the Respondent."**
    - Absent a URS Panelist decision to the contrary, the Provider shall publish the party names in the Determination "(p. 12) **should be changed to "URS Panelists have the discretion to decide whether to publish or redact redacted Registrant data in the Determination and shall communicate their decision to the Provider."**
- In the document "Proposed Redline to the URS Procedures" (with a suggestion to change this name to "URS Policy"), the text:
    - "The Complainant will have the opportunity to correct inadequacies within (3) calendar days after the URS Provider provides updated Registrant Data

related to the dispute domain(s)" (URS-3) **should be changed to "The Complainant will have the opportunity, within (3) calendar days after the URS Provider provides updated Registrant Data related to the dispute domain(s), to add that updated Registrant data to its Complaint."**

- "5.9.3 Changes to the content found on the website associated with a domain name does not in and of itself constitute bad faith under the URS. Such conduct, however, may be evidence of bad faith depending on the circumstances of the particular dispute" (URS-5) **should be changed to "5.9.3 Changes to the content found on the website associated with a domain name does not in and of itself constitute good faith or bad faith under the URS. Such conduct, however, may be evidence of good faith or bad faith depending on the circumstances of the particular dispute."**
- "6.2 In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. During the Default period, the Registrant will be prohibited from changing content found on the site to argue that it is now a legitimate use and will also be prohibited from changing the Whois information" (URS-5) **should be changed to "6.2 In either case, the Provider shall provide Notice of Default via email to the Complainant and Registrant, and via mail and fax to Registrant. During the Default period, any changes to the website associated with the domain name will be closely examined by the Examine for any good faith or bad faith the changes might indicate. Further, the Registrant will also be prohibited from changing the Whois/RDS information."**

- In the document "Proposed Redline to the RPM Requirements":
  - The "Trademark Notice" should follow the RPM WG orientations more closely, being especially careful to gather the group of experts who specialize in making documents and notices comprehensible to laypeople and to establish a non-threatening tone. In order to achieve this goal, we call on the IRT to assemble the specialized entities set out in the Recommendation and its Implementation Guidance, look for examples that may facilitate understanding, and create an approachable Trademark Notice.