

Adobe Chat Session – 13 April 2010 Consultation  
PDDRP/Registry Agreement Amendment Processes

palage: Could Kurt get closer to the mic, Craig's voice was much clearer - or is it just my connection?

Caroline Greer: Same here

Jeff Eckhaus: it is an inch from his mouth

Konstantinos Komaitis: i have the same problem...

Michael Delaney: same problem here

Craig Schwartz 2: working on it...

palage: much better - thx

Konstantinos Komaitis: indeed

Craig Schwartz 2: ok...

Elaine Pruis: much better thanks

Craig Schwartz 2: Please continue to provide feedback on the sound quality. Thank you.

Craig Schwartz 2: Can you hear Kurt ok now?

Konstantinos Komaitis: not very well

Caroline Greer: yes

Craig Schwartz 2: You're in the queue Kathy K.

Kathy Kleiman: i dropped ... will be back asap

Craig Schwartz 2: ok

Kathy Kleiman: back on

Craig Schwartz 2: ok kk

Caroline Greer: who is this speaking?

Jon Nevett: who is speaking now?

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Jeff Neuman: Jon spencer - Verisign

Jon Nevett: Thanks Jeff

Elaine Pruis: is there a precedent for need for a PDDRP?

Jeff Neuman: Elaine - no

Elaine Pruis: thx

Craig Schwartz 2: Amy Stathos now...

Kathy Kleiman: staying out of it.

Kathy Kleiman: who is talking now?

Jeff Neuman: Jon Spencer again

Elaine Pruis: good point

Konstantinos Komaitis: exactly - from a legal point of view Jeff is spot on

Craig Schwartz: I see you Kristina.

Brian Beckham: As mentioned earlier, Erik Wilbers has joined me.

Craig Schwartz: Thank you Brian.

John Jeffrey: Mike, speak clearly and slowly.. hard to hear you in the room in MDR

Craig Schwartz: Tim, you're in the queue.

Elaine Pruis: agreed!

Elaine Pruis: how about a court of law decision that there has been extensive trademark violations as being the threshold? ruling instead of assertions?

Kathy Kleiman: that makes a lot of sense to me.

Craig Schwartz: Queue is growing and I see all your hands. We'll get to you.

kurt: "Jeff nods"\

Craig Schwartz: Dan Halloran talking...

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Kathy Kleiman: Elaine, you are putting forward a truly neutral party, and that makes perfect sense.

Jeff Neuman: Jon Spencer speaking

Kristina Rosette: @Elaine: Are you talking about a court decision in an action in which the registry is a party? Or, are you talking about actions against registrants?

Elaine Pruis: PDDRP has two parts...1. pattern of abuse by the registry operator in violating their agreement not to abuse a confusingly similar (to a trademark) string

Elaine Pruis: 2. pattern of abuse in allowing/promoting 2nd level abuse.

Elaine Pruis: so both.

Tim Ruiz: Must be more than allowing. Must be allowing AFTER being made aware of clear infringement and not taking any action.

Kristina Rosette: From my perspective, if a trademark owner has to get a court decision finding in an action against the registry that there is widespread infringement, why would the trademark owner file a PDDRP? I'd just go for a preliminary injunction against the registry. Once that's entered, it may as well be permanent. Seems like there's a real downside to requiring court decisions to satisfy trademark owner standing requirements.

Jeff Neuman: I would rather have you file for an injunction and have to post the bond :)

Jeff Neuman: I would MUCH rather have a court decide these issues

Kristina Rosette: My point is that if PDDRP standing requires court decisions, why bother?

Konstantinos Komaitis: who is talking now?

Jeff Neuman: Remember, registries have the protection of the safe harbors from the line of cases starting with Lockheed and the ACPA safe harbors

Jeff Neuman: (in the US)

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Elaine Pruis: @Kristina, agreed, current protection policies and registry agreement should cover these issues, PDDRP should be dismissed

Caroline Greer: That was Chuck Gomes Konstantinos

Kathy Kleiman: Agree with Chuck@

Kathy Kleiman: !

Kristina Rosette: That wasn't my point, Elaine. My point was that if you tie standing to court actions you could have some unintended consequences.

Konstantinos Komaitis: thanks caroline

Elaine Pruis: PDDRP as it is written now has many terrible unintended consequences

Kathy Kleiman: who is talking?

Kathy Kleiman: Jon Spencer?

Caroline Greer: Nevett

Kathy Kleiman: Tx Jon N. for the explanation.

Kathy Kleiman: But I don't agree...

Tim Ruiz: Shouldn't this process at least include the ability of the Registry to file an appeal through the Courts that at least temporarily stays the remedies?

Elaine Pruis: yes!

Konstantinos Komaitis: definitely...courts will have to be included

Kristine Dorrain: the UDRP currently includes that as an option and it seems to work well.

Jeff Neuman: But the Court needs to have jurisdiction so that is why Number 2 and 3 in the slide presentation as will be discussed.

Jeff Neuman: Kristine...not sure the court option for the registrant has worked well

Jeff Neuman: some courts have denied jurisdiction over appeals from a registrant that loses its name

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Konstantinos Komaitis: it will not work - for registrants this system will not work at all - period

Konstantinos Komaitis: mainly in the US - courts do not want to deal with these issues and send them to Virginia courts

Kristine Dorrain: I was referred to suits filed during the UDRP, not the ones to prevent transfer. If registrants file (declaratory judgment actions, for instance), panels frequently stay the UDRP cases until the resolution. That's what I meant by "works well." :)

Konstantinos Komaitis: what do we mean by 'clean'?

Jeff Neuman: rights, but courts sometimes refuse to take those cases

Tim Ruiz: Thx Jeff. But if the Registry Operator chooses to try to appeal in court I think the remedies should be delayed. Right now the process does not allow for that.

Kathy Kleiman: Trademark owners have been given huge new benefits in the new gTLD space - through URS and TM Clearinghouse

Jeff Neuman: tim - correct

Tim Ruiz: I know that some will be concerned with gaming, always file an appeal, but I don't see that as much of a concern in this situation.

Elaine Pruis: if I'm .nike and i want to take out .addidas all i need to do is file >50 complaints

Elaine Pruis: gaming opportunities are huge

Konstantinos Komaitis: @elaine: this is very correct and more than a possibility

Kristina Rosette: @elaine: any brand owner that uses the PDDRP solely for competitive purposes isn't getting very good legal advice.

Kathy Kleiman: This is a business to business dispute - rising to the level of international litigation or international arbitration for the vast majority of disagreements at this level.

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Kristina Rosette: what cases, Jeff? I'd be interested in reading those.

Kristine Dorrain: I agree.

Elaine Pruis: is it possible to see points 2 & 3 on the same screen please?

kurt: i don't think it is possible

Craig Schwartz: Sorry Elaine...not that I am aware of.

Elaine Pruis: ok thx

kurt: Craig - flip back to the previous slides for a couple minutes so people can take notes

kurt: excellent

Konstantinos Komaitis: but the PDDRP is NOT arbitration

steve metalitz: Is the "RySG redline" available somewhere?

Konstantinos Komaitis: the court is not obliged to follow the PDDRP (or the UDRP) decision

Craig Schwartz: The redline is in the public comment forum on the PDDRP...submitted by David Maher.

steve metalitz: Thanks Craig.

Tim Ruiz: Can we see item 3 again, please?

Konstantinos Komaitis: it can only be de novo

kurt: to Steve: <http://forum.icann.org/lists/ppdrp-15feb10/msg00011.html>

Kathy Kleiman: ... and a fair and neutral jurisdiction.

Kathy Kleiman: and a heavy sanction against Registrants - they may lose their online presense through no fault of their own. Is that in the public interest?

Kristina Rosette: @kathy: do you have a specific jurisdiction in mind (or not)?

Kathy Kleiman: That's a good question, Kristina.

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Kathy Kleiman: I have views but they are personal, not the views of the Registry Constituency

Konstantinos Komaitis: @jeff: that is correct - there is a case establishing that - Dan Parisi v Netlearning

Konstantinos Komaitis: the court can hear it on the basis of contractual compliance

Kathy Kleiman: Here, we already have ICANN pre-screening registrations so that no one either than .GOOGLE. There is no such pre-screening for 2nd level domain names. Here, I think a regular and traditional international arbitration process might be the right fit. Your thoughts?

Jeff Neuman: Thanks Konstantine!

Elaine Pruis: @kathy, prescreening for such names at second level should happen with trademark clearinghouse

Konstantinos Komaitis: it affects the whole registration culture

Konstantinos Komaitis: what is the fine line between the two?

Tim Ruiz: One way or another, there needs to be an appeal that stays application of the remedie until done.

Craig Schwartz: Tim - you're in the queue.

Konstantinos Komaitis: but judges and juries are authorised by law to make these determinations and enforce remedies....ICANN is not

steve metalitz: Why wouldn't the remedy be an arbitrable issue under the registry contract Article 5?

Kristina Rosette: I would think it would be, Steve.

Kathy Kleiman: very worried

Konstantinos Komaitis: @steve: can you please say what article 5 states?

steve metalitz: registry can take to arbitration any dispute under the contract

Kristina Rosette: @Jeff: Would de novo review apply to only certain remedies?

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Craig Schwartz: I see all the hands in the queue...getting there.

Kristina Rosette: Couldn't you split the de novo review? If it goes to the determination, the trademark owner is the proper party. If it goes to the remedy, ICANN is.

Tim Ruiz: Non-lawyer question: Does De Novo imply that any remedies being appealed are on hold until the review/appeal is complete?

Elaine Pruis: de novo=new

Tim Ruiz: @Elaine, right. But what about the remedies?

Kathy Kleiman: @Tim, yes, the remedies as well as the facts are under a full re-review

Tim Ruiz: @Kathy, thank you.

Kathy Kleiman: :-)

steve metalitz: I have to drop off here, thanks.

Kristina Rosette: to follow up on Steve's point, I just checked the IRT Final Report. It anticipated that the registry and ICANN would use the dispute resolution procedures in the contract.

Konstantinos Komaitis: only courts are able to award monetary damages because they have the appropriate tools for doing so

Kristina Rosette: But the process was put forth by the IRT In part to punish for past (as opposed to deter future). Not speaking to damages point, just responding to Jeff.

Kristine Dorrain: Is the slide show current? I thought we were on #5...

Craig Schwartz: We're back live..

Kristine Dorrain: thank you.

Craig Schwartz: How is the sound quality on the line?

Kathy Kleiman: Sound quality good, tx Craig!



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Craig Schwartz: Thank you.

Kathy Kleiman: Jeff's idea would serve as a reasonable deterrent to frivolous TM claims as well.

Kristina Rosette: well, you could say that it's analogous to the bond required for an injunction.

Michael Delaney: will the slides be made available with the recording?

Craig Schwartz: Yes

Michael Delaney: excellent. thank you

Jeff Neuman: A bond is only required AFTER a finding of a likelihood of success on the merits

Kathy Kleiman: Who was talking before Amy?

Craig Schwartz: Jon Spencer, VeriSign

Kathy Kleiman: tx!

Kathy Kleiman: Agreed, it is hard to draft Safe Harbors right now.

Craig Schwartz: If speakers are brief and to the point we'll move along more quickly. Thank you.

Tim Ruiz: Craig, you may have to pull out the egg timer ;)

Craig Schwartz 2: LOL

Kathy Kleiman: And adding to #7, only text marks, not design marks

Tim Ruiz: @Kathy, like ;-).org ?

Kristina Rosette: Is this going to preclude trademark owners from developing countries from using PDDRP? Many of those countries don't use substantive review.

Kathy Kleiman: :-), not seriously, it's something we added to TM Clearinghouse, and design marks extend to their logo, their colors, their lettering, and then their words or letters.

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Kathy Kleiman: "but seriously..."

Craig Schwartz 2: KR you're in the queue.

Kathy Kleiman: "MUSIC" is registered 7 times in the US, including for scientific and medical research.

Kathy Kleiman: But it's a great conversation, and Jeff N. is right.

Kathy Kleiman: What about small new gTLD registries around the world?

Craig Schwartz 2: Is there something you need Kristina?

Kathy Kleiman: Each side should select a panelist, and together choose the 3rd-traditional arbitration rules.

Kristina Rosette: @Kathy: Let's not forget that the type of conduct this mechanism is intended to address is willful and intentional. If a small new gTLD registry faces a PDDRP, it is because of its own action and its size shouldn't matter.

palage: JJ - but there is no page limit in the IRP

Konstantinos Komaitis: @jeff: a mediation mechanisms will be very useful

Kathy Kleiman: A PDDRP upfront, can't possibly indicate bad faith ipso facto. Small gTLDs serving underserved communities are entitled to protection too, right (as small trademark owners are?) They have already jumped huge ICANN application hoops to serve their communities.

Konstantinos Komaitis: @kathy: that is a very good point and something that we need to bear in mind

Kristina Rosette: That doesn't give them a free pass to engage in the type of conduct that the PDDRP is intended to cover.

Konstantinos Komaitis: @kirstina: yes but at the same time we should not automatically think that this is bad faith.

Kathy Kleiman: What we are talking about, by way of example, is an African cultural good and a US trademark on the same word (an issue an African ICANN

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participant keeps discussing). Assuming both parties hold their ground, why should the new gTLD registry be presumed wrong? It can't be.

Kristina Rosette: If we're talking specifics, I hope you'll understand that I can't comment. I have no idea if any of the specific parties are clients of the firm (or adverse) and I'm not comfortable responding.

Konstantinos Komaitis: i have to drop out of this call unfortunately. thank you very much for the discussion

Craig Schwartz 2: Sound check please, thank you.

Kristine Dorrain: the current speaker is a little tinny and distant, but understandable from my connection

Craig Schwartz 2: thank you.

Tim Ruiz: Same here.

Kristina Rosette: Have to jump. Very helpful conversation on PDDRP

Craig Schwartz 2: Thanks Kristina.

Elaine Pruis: 10% might be disadvantaged...

palage: Calm down Chuck - most emotion I have ever seen from you

Elaine Pruis: 10% might be brands

Jon Nevelt: Dan: you need to carve out picket fence issues from a new amendment process

Jon Nevelt: you still could have voluntary adoption without a pdp

Craig Schwartz 2: Jon...see your hand in the queue.

palage: In the PDDRP ICANN says it lacks the contractual right to interject itself into those matters, but in the examples provided by Dan there are a whole range of issues/subject matter which ICANN believes it has a unilateral right to amend a contract. Please help me reconcile this.

Kristine Dorrain: I have to run, thanks everyone!

Elaine Pruis: can barely make out what he is saying

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Elaine Pruis: sound please

Craig Schwartz 2: JJ is sitting at the mic?

Tim Ruiz: Jon, I'd be concerned about voluntary adoption of picket fence issues. They are in the fence because they're deemed to be bottom-up consensus issues.

Tim Ruiz: Cutting the community out of those would not sit well.

Elaine Pruis: have to drop off now, thanks for the consultation.

Kathy Kleiman: is anyone back yet?

Keith Drazek 2: just getting ready to begin

Tim Ruiz: Remote participation request: Portable Avatars, so we can go on break with you.

palage: +1

Craig Schwartz: Sure thing!

palage: can barely hear

palage: can he speak up and get closer to mic

palage: please

palage: thx Craig

Craig Schwartz: Sound ok?

Craig Schwartz: Can folks on the phone hear ok?

Tim Ruiz: Why, are you back from break now?

Craig Schwartz: yes...have been?

Tim Ruiz: Just kidding, sound is fine for me.

Craig Schwartz: Not funny Tim!

Craig Schwartz: Thank you.

Jeff Neuman: I thought that was funny

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Tim Ruiz: Though not noted in the slides, some aspect of public posting for community review/comment is assumed, correct?

Daniel Halloran: Tim: Yes

Jon Nevett: I agree with John J -- RAA process is very difficult

Tim Ruiz: Yes it is. I don't think it works well for us and won't work well for registries.

Tim Ruiz: us = registrars.

Jon Nevett: scope of what is eligible for hybrid proposal

Jon Nevett: there were 6 public comments on this issue -- don't think that we would be overloaded with volunteers

Jeff Neuman: We shall see....