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ICANN MECHANISMS: EXTRA REMEDIES EVALUATION

Abstract: *At incorporation with World intellectual property organization, ICANN has created administrative mechanisms to solve contested domain names and other rights related to the use of trademarks in Cyberspace. In this context, this mechanism called UDRP was limited to general top-level domain names because at the early beginning of the world wide web, the conflicts were basically surrounded by domain names chains such as .com, .org, .net with high trade value. On top of that, and because the increasing demand in the domain names industry was huge, ICANN seeks to pump new domain names chains into the market to encounter such an increasing demand for domain names. Accordingly, this step has increased the conflict while the UDRP mechanism was limited to solving the conflicts over top-level domain names. In this connection, ACANN had to find another mechanism to solve other conflict-related with the new gTLD. This article tries to shed light on these remedies and their effectiveness in solving such conflicts.*

Keywords: *RPMs, gTLDs, UDRP, Domain names, Trademark.*

Abbreviations

gTLDs	<i>General top-level domain names</i>	TCS	<i>Trademark Claims Service”</i>
ICANN	<i>The Internet Corporation for Assigned Names and Numbers</i>	PICDRP	<i>Interest Commitments Dispute Resolution Procedure</i>
RPMs	<i>Rights Protection measures</i>	UDRP	<i>Uniform dispute resolution policy</i>
URS	<i>the Uniform Rapid Suspension System.”</i>	PDDRP	<i>Post-Delegation Dispute Resolution Procedure</i>
LRO	<i>The Legal Rights Objection</i>	TM-PDDRP	<i>Trademark Post-Delegation Dispute Resolution Procedure</i>
PDDRP	<i>The Trademark Post-Delegation Dispute Resolution Procedure</i>	RRDRP	<i>the Registration Restriction Dispute Resolution Procedure</i>

IGO *intergovernmental” institutions* **PICDRP** *public Interest Commitments
Dispute Resolution Procedure*

WIPO *World intellectual property
organization*

TCHM *Trademark Clearinghouse*

1. INTRODUCTION

Several disagreements over cybersquatting are resolved out of court because of the considerable judicial costs¹. The alternative UDRP POLICY became the favorite track to solve cases related to domain name disputes. In this context, to encounter the increasing demand for domain names, the colossal flourishing of the domain names industry has led ICANN to supply 400 New gTLDs. Such New gTLDs might be “unrestrictive or restrictive, or details attribute, for example, taking the brand, city, community, Culture, industry, or Language. With 200 more gTLDs delegated by January 2018. However, these New gTLDs cached around 22 million customers under second-level domain names² registrations³. In return, increasing the margin of gTLD domain names has, in turn, increased the conflicts over domain names.

Furthermore, as a result, and bearing in mind that UDRP was limited to specific genera of gTLD, ICANN’ had to solve this dilemma by finding a new mechanism to solve this increasing disputation⁴. Such theses new mechanisms or remedies emphasize the vital roles of ICANN as a real guardian of intellectual properties related to new gTLD⁵. The question arises hereafter new gTLDs are approved. What are the mechanisms of protection given to trademarks? Besides the “Uniform Domain Name Dispute Resolution Policy” (UDRP) that applies to all new gTLDs, ICANN has created Mechanisms based on a wild margin of “Rights Protection measures called (RPMs). This umbrella includes, among others, a” Uniform Rapid Suspension system” (URS) and a “Post-Delegation Dispute Resolution Procedure,” a “Trademark Clearinghouse” that use in connection with

¹ Roger Miller ,*Business Law Today, The Essentials: Text and Summarized Cases* Cengage Learning USA 2021, 163.

² Frederick Abbott, Thomas Cottier, Francis Gurry, *International Intellectual Property in an Integrated World Economy*, Wolters Kluwer, New York 2019, 550.

³ Ibid, 550.

⁴ ibid 550.

– World Intellectual Property Organization, *Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications*(thereafter SCLTID &GI) Thirty-Eighth Session Geneva, October 30 to November 2, 2017 Update On Trademark-Related Aspects of The Domain Name System WIPO, Geneva 2017, 3.

⁵ ibid 3.

Sunrise periods and “Trademark Claims services”⁶. These different remedies are presented in:

1. The Legal Rights Objection (LRO).
2. Clearinghouse.
3. The Uniform Rapid Suspension System (URS)
4. The Trademark Post-Delegation Dispute Resolution Procedure (“PDDRP”)

2. RPMS

Because UDRP policy is limited to gTLD, and based on the ICANN decision to facilitate dispute resolution, ICANN was forced to find additional alternative policies to fix increasing disputation over domain names resulting from colossal demand in this industry. Thus, different mechanisms are founded to deal with new domain names. In this connection, RPMs combine curative and precautionary procedures, including the top-level and second-level domain names, before any new gTLDs are handed over by ICANN, the particular registry operators. Hence, RPMs comprehensively influence the intellectual property implementation related to global society⁷. In this regard, The ICANN supervisors adopt all the applicable procedures and services related to its second-level domain name enrollment⁸. Although ICANN’s RPMs are a jumble of policies, they focus on the General core of preserving intellectual property rights, especially trademark rights⁹, including the rights of the domain name owner¹⁰.

2.1. Legal Right Objection Procedure

“The Legal Right Objection” (LRO) approach is a crucial safety measure instrument that empowers a trademark holder to challenge an appeal for a gTLD chain that can infringe the Trademark under normally approved and worldwide acknowledged concepts Of law¹¹. “Since it had started in 2008¹², ICANN gives “the Legal Rights Objections procedure” (LRO) to permit the complainers with

⁶ World intellectual property organization, *Frequently Asked Questions*, thereafter (FAQ), <https://www.wipo.int/amc/en/domains/lro/faq/#24a>, accessed 16 may 2021.

⁷ Tana Pistorius, *Intellectual Property Perspectives on the Regulation of New Technologies* Edward Elgar Publishing, 2018 36

⁸ Taubman, Antony, and Jayashree Watal. *Trade in Knowledge: Intellectual Property, Trade and Development in a Transformed Global Economy*. UK: Cambridge University Press 2022., 129.

⁹ i Tana Pistorius 37.

¹⁰ Taubman, Antony, and Jayashree Watal, 129.

¹¹ Justine Chew, *Update & Consultation on New gTLD Subsequent Procedures Consensus Building on Recommendations objections* 2020, 4.

¹² World Intellectual Property Organization, *Report of the Director General to the 2020 WIPO Assemblies: Retrospective 2008-2020*, WIPO Publisher, Swizerland 1050/ 2020, 42.

standing to process disputes versus the authorized defined new gTLD chains. In the relationship, as mentioned earlier, the priority will be in favor of the complainer by default. However, some exclusions would be considered, for instance, if the competitor fails to react to the Objection¹³. Each Objection gives rise to an arbitration process with the WIPO Arbitration and Mediation Centre dealing with legal rights objections¹⁴.

Therefore, in the instance of the domain name (.Lotto) chain lawsuit, the objector had failed to confirm the probability of material harm. Therefore, the claimant party prevailed. Moreover, for the opportunity to prove the material damage, the objector declared that while European lotteries stick to strict requirements of responsible gaming, through decreasing potential damage to the community and particularly vulnerable targeted parties, the general accessibility of the ".10tto" domain name might confer upon unlawful operators the benefit of connecting their website with lottery games authorized by the state would certainly damage the interests of unwary customers¹⁵.

The plaintiff might file a formal action to the Objection, subject to the dispute policy. To name a few, the objector with the standing might submit standard arguments in the areas of "community opposition principles, legal rights, public interest, or confusion"¹⁶. As for the(.INT) domain name and other stakeholders and individuals, the observer bodies and other functional agencies of the united nations are acknowledged as satisfying the requirements¹⁷. Besides that," inter-governmental" institutions (IGO) are also qualified to arrange a lawful rights argument if it matches the standards for enrollment (.INT) domain name¹⁸. In this regard, the global treaty within or amongst national governments needs to have recognized the organizations. Also, these recognized organizations must be extensively considered an independent global legitimate individuality and must be the topic of and controlled by international legislation¹⁹. In the same context, INGOs are given 90-days as service of claims notifications for every new gTLD²⁰.

Moreover, an effective argument will file against the correct application from being accepted or passed on by ICANN in this situation. For example, the new

¹³ T. Pistorius 37.

¹⁴ Murray, Andrew. *Information Technology Law: The Law and Society*. 4th ed. UK: Oxford University Press. 2019,300.

¹⁵ Burkhard Hess, Maria Bergström, Eva Storskrubb, *EU Civil Justice: Current Issues and Future Outlook* 2016, Hart publishing, UK-USA I71.

¹⁶ T. Pistorius, 37.

¹⁷ ICANN, *gTLD Applicant Guidebook* (v. 2012-06-04) Module 3, 2021. 4 June 2012,3-6 .

¹⁸ *ibid* 3-5.

¹⁹ ,*Ibid* 3-6 .

²⁰ Luc Seuffer, *The next round of gTLDs is around the corner*, August 9, 2019, <https://ebrand-services.com/the-next-round-of-gtlds-is-around-the-corner/>. Accessed 25 June.2021.

gTLD applicant might try to resolve with the objector or repeal the involved gTLD application. The question that can be left for discussion here is whether compulsory to file a response to a Legal Rights Objection? In this connection, the reactions need to be sent online to the WIPO Center, using the WIPO Center's official "LRO frame" Response to inform both ICANN and the objector. The reaction declaring cost should be listed when declaring the reaction. The International Center for Dispute Resolution manages strand confusion oppositions. The Expertise of the International Chamber of Commerce addresses each community and social challenge RElated to their interest²¹.

On top of that, a reaction has to include, at the very least, the applicant's names, complete call info, as well as the full points that were answered to the declarations made in the Objection²². From 2012 to 2013, the Center received 69 compliant LRO requests, of which panelists decided on WIPO's LRO²³. In this regard, ICANN must reduce the risk of inconsistent outcomes in the String Confusion Objection Process, Especially where the objector seeks to object to multiple applications for the same String²⁴. The question that arises here is What criteria will the panel use to determine the Legal Rights Objection outcome?

2.1.1. the criteria used by the panel to determine the Legal Rights Objection

According to ICANN Applicant Guidebook section 3.5.2, the potential unjustifiably damages or taking the privilege of the distinct personality unjustly or enrolled or non-enrolled trademark reputation related to the objector, or else produces a possibility of confusion in linking the gTLD application to the objector trademark will be vital criteria to decide the result of "Legal Rights Objection"²⁵. For activation of the objection mechanism based upon trademark legal rights, the panel will consider the resulting nonexclusive circumstance: The objector's mark is exactly similar or identical. The penal will consider whether the objector's use of rights in the mark has been bonafide or not.²⁶ Also, the relevant part of the general domain name is associated with the mark of the appellant, objector, or other stakeholders. Moreover, The purpose was to request that gTLD by Applicant be highly considered. For instance, Suppose the contenders applied for or operated TLDs or registered them in bad faith. Alternatively, the domain name was identical or confusingly similar to the marks of others.

²¹ Murray,300.

²² World intellectual property organization, (FAQ)16 may 2021.

²³ World Intellectual Property Organization 2020, 42.

²⁴ J. Chew 2020, 10.

²⁵ World intellectual property orgaanization (FAQ), 16 may 2021.

²⁶ ibid

Moreover, it will be crucial that the applicant or the contender has any previous knowledge of the objector's mark at registration or operation²⁷. Regardless of to what degree the competitor has indeed utilized or has truly done provable work to make use of matching to the gTLD about a bona fide related to presenting of services or products info in a manner that does not conflict with the reasonable and legal performance by the objector of its mark rights²⁸. Besides that, the panel considers if the petitioner's behavior beyond using the gTLD would create a possibility of confusion against the mark of objector as to the source, sponsoring, association, or approval of the gTLD²⁹.

2.1.2. Dispute settled under the Legal Rights Objection

Based on the party's common desire to give a chance to solve their conflict using mediation, there is no legal obstacle, and just they are requested a 30-day suspension. In this regard, the role of the WIPO center is limited to assisting in achieving this wish without any extra fees or costs³⁰. In this connection, there is a requirement for there is demand considered consist of joining a "statute of limitations," consisting of an arbitration stage before settlement (as an example, to make sure that a subordinate infringing weblink might be eliminated without retrieving the domain itself), and also enabling longer due dates to react to cases of the violation³¹. The requestor Objection is restricted to 20 pages or 5,000 words, Whichever is less, except the other extra attachment. The objector or Claimant should likewise describe and submit any attached defending proof³².

2.1.3. LRO gives the remedies

As for the possible remedies the LRO can provide, the treatments are restricted to the gain or rejecting of the Objection. Furthermore, despite no financial damages, the dominating litigant is qualified to pay the panel partially³³ however, some reviewers call to apply the rule that forces the loser to pay"similar to the practice "in trademark opposition and cancellation proceedings in the EU³⁴."

²⁷ *ibid*

²⁸ *ibid*

²⁹ *ibid*

³⁰ World intellectual property organization (FAQ), 16 may 2021.

³¹ John McElwaine, Christopher Casavale, Nelson Mullins – "Tackling bad faith registration of domain names in a fast changing landscape", *WIPO Magazine*, 6/2019, 42.

³² World intellectual property organization, (FAQ), 16 may 2021.

³³ *Ibid*.

³⁴ J. McElwaine, C. Casavale, N. Mullins, 6/2019, 42.

2.1.4. *Retain the court options*

“The Legal Rights Objection” as an alternative policy to solve the conflicts between the main stakeholders does not prevent the parties from choosing to go to court as a possible further step to resolve the conflict that either defendant might have to send the case conflict to the court³⁵. Additionally, the present system demands such cases to be appealed before a tribunal of the competent jurisdiction, which costs substantial money, time, and effort³⁶.

2.2. Trademark Clearinghouse (TCHM).

The (TCHM) is an ICANNmandated central database of information on trademarks³⁷ to boost intellectual property defense in Cyberspace³⁸. In this respect, the data source of legitimate brands will absolutely shield these trademarks, particularly when the new TLDs are launched³⁹.

2.2.1. *Clearinghouse mechanism and functions*

(TMCH) has truly been developed to improve security and decrease the protection cost for trademark holders. On the other hand, the Trademark Clearinghouse will certainly approve and confirm legal rights info. It will unquestionably sustain trademark guarantee claims and sunrise service needed in all-new “top-level domain names” introduced in ICANN policy. It is anticipated to play a crucial function in the new TLD program’s launch and ensure that trademark legal rights can be smoothly protected⁴⁰. In this connection, “Trademark Clearinghouse” (TMCH) enables personal Trademark to do protective enrollment of new gTLDs related to these trademarks before opening the enrollment to the public⁴¹.” It functions by authenticating trademark information submitted by the right holders and providing the relevant information to the registry operators and registrars⁴².

³⁵ World intellectual property organization, (FAQ), 16 may 2021.

³⁶ J. McElwaine, C. Casavale, N. Mullins 6/2019, 42.43.

³⁷ Murry,380.

³⁸ Barney Warf ,*The SAGE Encyclopedia of the Internet*, SAGE, U K – USA – India – Singapore 2018, 262.

– F. Abbott, T. Cottier, F. Gurry 551.

³⁹ Bobbi Sandberg, *Networking The Complete Reference*, New York 2015, 289.

⁴⁰ Jennifer Wolfe, Anne Chasser, *Domain Names Rewired: Strategies for Brand Protection in the Next Generation of the Internet*, USA 2013 ,68.

⁴¹ Shahrooz Pouryousef, Muhammad Daniyal Dar, Suleman Ahmad, Phillipa Gilll, and Rishab Nithyanand , *Extortion or Expansion? An Investigation into the Costs and Consequences of ICANN’s gTLD Experiments, Passive and Active Measurement: 21st International Conference, PAM 2020*, Eugene, Oregon, USA, March 30-31, 2020, Proceedingsswiszrland, 2020, 147.

⁴² J. Wolfe, A. Chasser 68.

The “Trademark Clearinghouse” will certainly not just allow trademark proprietors to declare the total of the trademarks they have openly in public; however, as soon as a trademark has timely been sent and also verified right into the main database, the trademark proprietor will surely be provided an advantage treatment in terms of enrolling pertinent domain names throughout sunrise durations⁴³. The Sunrise enrollment procedure gives concern and full accessibility to the trademark owner to register the domain name(s) similar to his Trademark⁴⁴. Moreover, “the Trademark Clearinghouse” will definitely not just be a resource of info that brand name proprietors can log into to see what has been trademarked. However, it will also alert trademark proprietors who have sent their trademark info to the database source⁴⁵. Furthermore, If a trademark holder wants to omit his mark from all new gTLDs frames, it would assuredly get involved in each new “Sunrise duration.”⁴⁶. In that situation, the trademark holders will obtain a direct alert via email or SMS from “the Trademark Clearinghouse” to inform them if somebody else attempts to enroll domain names with their name or Trademark under a new gTLD.

The Clearinghouse mission will certainly be based on two practical functions: 1. Authentication as well as recognition regarding the trademarks in the Clearinghouse. 2. Work as a data source to provide details to the brand-new gTLD registries to sustain pre-launch sunrise or trademark cases services⁴⁷.

2.2.2. *Clearinghouse importance*

There are three primary advantages of “the Trademark Clearinghouse”:

First: the Trademark Clearinghouse will completely not just allow trademark proprietors to state all of the trademarks they have openly. For example, Nike will most likely not use the sporting activity new gTLD to acquire the Nike domain name. Nevertheless, as soon as a brand has been sent and verified right into the main database, the trademark proprietor will be given advantage treatment against other stakeholders about enrolling appropriate domain names throughout “sunrise durations⁴⁸.”

Second: The Sunrise enrollment procedure offers top priority access to the trademark owner to register the domain names like the Trademark⁴⁹. “The trademark Claim services” send out alerts to the trademark owner when a domain name

⁴³ Ibid 68.

⁴⁴ T. Pistorius, 38.

⁴⁵ J. Wolfe, A. Chasser 68.

⁴⁶ T. Pistorius 38.

⁴⁷ J. Wolfe, A Chasser, P68.

⁴⁸ ibid 68.

⁴⁹ T. Pistorius, 38.

meets the Trademark enrolled by a person throughout the Claim duration of an offered new gTLD⁵⁰. In that instance, they will certainly get a notification email from the “Trademark Clearinghouse” to inform them if somebody else attempts to enroll domain names, including their name, under the new gTLD.

The third factor that is so vital is that the “Trademark Clearinghouse” for personal trademark proprietors permits to use “of the Uniform Rapid Suspension System” (URS). In this regard, the goal of the TMCH is to pave the way for both sunrise services and trademark claims services to take their position in terms of trademark protection⁵¹.

Among other organizations and institutions in Europe, ICANN has chosen Deloitte as the TMCH in Europe⁵². To this point, Deloitte (www.deloitte.com) is one of the world’s biggest publicized accounting firms as qualified solution systems, use ADR and (ICANN)⁵³. This choice indicated ICANN’s practical steps to give more momentum to the protection given to trademarks within new gTLD in Cyberspace. Moreover, The “Trademark Clearinghouse” double mission as a comprehensive database and alert will certainly provide security against trademark violations. Still, it will possibly not completely safeguard individuals enrolling domain names, including trademarked names⁵⁴. According to available reports, the TMCH had indeed, by February 2018, collected over 43,000 access⁵⁵.

Furthermore steps, ICANN has incorporated two stipulations to aid trademark proprietors in shielding their brand names within the gTLD second-level domain name enrollment procedure: “the Trademark Claims Service” (TCS) and “the sunrise” stipulations. Following the Trademark Claims Service, a minimum of the initial 60 days after a “gTLD” release for a specified duration, the “Trademark Clearinghouse” will certainly alert registrants whose potential second-level domain name matches their mark in the Clearinghouse⁵⁶.

The Center has indeed commented that the TMCH needs to deal with stakeholders fairly and do not obstacle rights holders in dealing with trademark registrations acquired through evaluation and registration systems legally as used in numerous international jurisdictions. Apparently, practical steps might be taken to recognize any illegal invocation related to contested rights in particular contexts if and where pertinent⁵⁷.

⁵⁰ *ibid* p38.

⁵¹ L. Seufer , August 9, 2019.

⁵² J. Wolfe, A. Chasser, 68.

⁵³ Crain, Michael A., William S. Hopwood, Richard S. Gendler, George R. Young, and Carl Pacini. *Essentials of Forensic Accounting*. 2nd ed. John Wiley & Sons. 2019,169.

⁵⁴ J. Wolfe, A. Chasser, 68.

⁵⁵ F. Abbott, T. Cottier, F. Gurry 551.

⁵⁶ J. Wolfe, A. Chasser 69.

⁵⁷ F. Abbott, T. Cottier, F. Gurry 551.

Despite “the trademark claim service” is not the best system when combined with the obligatory sunrise arrangements, the possibility of extensive violation within registrations of second-level domains may be decreased. Under the sunrise arrangements, for a minimum of 30 days prior to the general public launch duration for a new general TLD, the Clearinghouse registered mark might prioritize the right holder to register the domain names that contain his mark⁵⁸.

2.3. Uniform Rapid Suspension System

Besides the “Uniform Domain Name Dispute Resolution Policy,” ICANN offers another mechanism to facilitate dispute resolution. “The Uniform Rapid Suspension System mechanism” (URS), a dispute resolution forum. In this context, even though most dispute cases are subject to be resolved through the UDRP, using the advantage given by common law trademark claims, besides having a very simple procedural frame, the “Uniform Rapid Suspension system” can be used only in narrow domains limited in registered trademark holders with very clear infringement claims⁵⁹. The URS is planned to offer an expedited treatment for dealing with clear violation cases versus trademarks. Alongside that, the URS is developed to provide a much faster and more economical tool to prevent the operation of website violence. At the same time, the UDRP is limited to transferring the objected domain name or canceling it⁶⁰.

2.3.1. the Uniform Rapid Suspension System mechanism

ICANN has designed a special tool to meet new challenges in the domain names industry and deal with specific second-level RPM cases⁶¹. However, in a URS case context, once it is shown that a domain was identical confusingly with an authorized mark currently under usage, the owner has no genuine right or legal interest regarding the objected domain name⁶². The domain name that was enrolled and utilized in bad faith will be stopped and suspended in the network resolution. Therefore, although developed as a fast-track modification of UDRP, URS’s effectiveness is yet to be seen⁶³. The Complainant reports their Objection through an allowed URS policy.

⁵⁸ J. Wolfe, A. Chasser 69.

⁵⁹ Frank Cross, Roger Miller, *The Legal Environment of Business: Text and Cases*, Cengage Learning, UK – USA 2021, 172.

⁶⁰ J. Wolfe, A. Chasser 68.

– T. Pistorius 38.

⁶¹ F. Abbott, T. Cottier, F. Gurry 551.

⁶² Mark Jeftovic, *Managing Mission – Critical Domains and DNS: Demystifying nameservers, DNS, and domain names*, Packt Publishing Ltd, UK 2018, 56.

⁶³ T. Pistorius 38.

Moreover, the Complainant should pay for fees within 24 hrs Of submitting or even it is immediately canceled. In this context, the Complainant has to submit particulars of the Objection as laid out in the URS proceeding. Along with the UDRP, three crucial elements need to be declared, and all have to exist⁶⁴. Despite some similarities with UDRP, the legal scholar *M. Jeftovic* indicated that there are huge distinctions when it comes to URS choice, which Makes it different from the UDRP, particularly the margin of decisions or choices given upon the legal holder's request. The Complainant can request not to transfer the contested domain name, and rather, it is suspended and out of order. Furthermore, the Complainant does have an extra choice to extend the registration duration of the suspended domain name at the market aria. Another vital difference that would make URS more practical and preferred is an appeal procedure that the UDRP policy still lacks, such as this further practical step⁶⁵.

The URS is expected to bring greater accountability of evidence for claimants. The URS likewise consists of various extra registrant defenses over an increased duration. The only solution a URS panel might give success⁶⁶ and URS provides efficient protection for trademark proprietors versus cybersquatting. The significant distinction between both methods is that the URS is quicker and more economical than the UDRP.

Moreover, they participate in the substantive requirements where the URS substantive criteria resemble the UDRP⁶⁷. Unlike the UDRP, which is widely used to top domain name conflict, the URS, as *Michael Scott* believes, is mainly used for the new gTLD domain names and is meant to suspend the targeted domain name temporarily⁶⁸. The debated domain name is comparable or identical to the trademark registration to particular requirements. Therefore, the defendant has no legitimate right to enroll and owns the disputed domain name. Accordingly, the disputed domain name is kept by the Domain Name registrant under arbitration⁶⁹.

2.4. Post-Delegation Dispute Resolution Procedure (PDDRP).

The “Post-Delegation Dispute Resolution Procedure” (PDDRP) is essentially A preventive mechanism that enables enrolling marks preemptively by trademark holders whose Trademark is had recorded in the Clearinghouse. The (PDDRP) is fundamentally made to carry out as a higher-level executive device to ensure the

⁶⁴ M. Jeftovic 56.

⁶⁵ M. Jeftovic 56.

⁶⁶ Michael Scott, *Scott on Multimedia Law*, Wolters Kluwer Law & Business, the Netherlands 2021, 5-99.

⁶⁷ Ibid 5-99.

⁶⁸ B. Warf 263.

⁶⁹ Ibid 263.

registry operators' legal practice and ICANN⁷⁰. Diffintaly, in this regard, in his book **The Liability of Internet Intermediaries**, *Jaani Riordan* confirms that The function of the **PDDRP** mechanism has participated in constituting secondary administrative liability against infringement trademark by the registry operator⁷¹.

2.4.1. Post-Delegation Dispute mechanism

This tool can be considered a turning point in the ICANN relationship with the registries operator of domain names. This mechanism's importance is shrinking the registration operator's immunity against the other and making them responsible for their faults committed against others stakeholders and holding the liability of such behaviors. As mentioned before, the main reason that had ignited the conflict between trademark holders and domain name owners was the immunity that registries have against the other main stakeholders.

2.4.2. Post-Delegation Dispute Resolution Procedure genera

The experts nominated by the committee will definitely figure out whether the registry operator is negligent and suggest treatments. In line with this, there are three kinds of the "Post-Delegation Dispute Resolution Procedure." These kinds of PDDRPs, are specifically: the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP), the Registration Restriction Dispute Resolution Procedure (RRDRP), as well as public Interest Commitments Dispute Resolution Procedure (PICDRP)⁷².

2.4.2.1. Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)

The TM-PDDRP makes it possible for a brand holder to impose its claims wherever one or more of its brands have definitely been violated by the registry operator's way of operation or into the usage of the gTLD. Moreover, TM-PDDRP needs proof of the registry operator's particular bad faith behavior or intrigue in brand name violation (i.e., benefiting from motivating violation and the normal registration charge) within the second or first level of a new gTLD. A specialist panel figuring out a TM-PDDRP case might suggest ICANN a range of resolutions, consisting of cancellations or ending the registry contract⁷³.

In this regard, the registry operator is not responsible under the "TM-PD-DRP" for any domain name registration that: (i) is enrolled by an individual or

⁷⁰ T. Pistorius 38.

⁷¹ Jaani Riordan, *The Liability of Internet Intermediaries*, Oxford University Press, UK 2016, 214.

⁷² T. Pistorius, 39.

⁷³ Ibid 39.

body that is unaffiliated with the registry operator; (ii) is enrolled without the indirect or direct motivation, temptation, initiation, or instructions of any individual or entity related with the registry director; and (iii) grants no direct or indirect advantage to the registry. In that case, the plaintiff is needed to show, by persuading and clear proof, that within the registry operator is endorsing behavior: (a) there is a certain pattern or practice of particular bad faith purpose by the registry administrator to benefit from the trade of trademark infringing domain names; and (b) that the registry operator has a bad faith intent to benefit from the organized enrollment of the domain names related the gTLD that is similar to or comparable with the Claimant's mark, which takes unjust benefit of the distinct character or the trade reputation of the Claimant's mark; or hinders the distinct character or the reputation or credibility of the Claimant's mark, or create or increase a possibility of the amount of confusion with the Claimant's mark ⁷⁴.

In this regard, the moment the request is completely accepted, the operator might be obliged to keep an eye on enrollments certainly not connected to the questioned domain names within the PDDRP proceeding. Moreover, in uncommon conditions where the operator showed bad intent, the contract might be in jeopardy and end the registered agreement, aside from the unclear and extremely subjective standards for documented behavior. This procedure will charge a liability indirectly against the operator on the gTLD register to compel him to control the domain enrolled in their operating system. That will certainly not simply restrict the capability of new gTLD operators, and rather, it might increase a major responsibility considering the result to steer a register to monitor the information and track the sites for which the domain name is utilized and the chains of domain names itself for evidence of his good faith and honesty as well⁷⁵.

2.4.2.2. public Interest Commitments Dispute Resolution Procedure (PICDRP)

The "Public Interest Commitments Dispute Resolution Procedure" (PICDRP) enables the complaints against a registry operator that might oppose "the Public Interest Commitments (PICs)" made in the Stipulation of its registry arrangement. The PICS consists of ICANN's obligatory provisions and the registry operator's proposed dedications. On occasion, the operator does not dominate in the (PICDRP), including the conflict resolution policy might suggest a range of treatments, such as particular specific commitments (2i). After an initial evaluation, ICANN sends the (PIC) announcement to the operator for 30 days to provide an effort to solve the dispute. If the parties stop working to settle, ICANN will ask

⁷⁴ T. Pistorius 41.

⁷⁵ Jan Rosén, *Individualism and Collectiveness in Intellectual Property Law*, Edward Elgar Publishing, UK 2012, 264.

the registry operator to describe how it complies with its PICS. Furthermore, suppose that the operator did not want to cooperate to fix or continue not committing to legal measures made by ICANN; in that case, ICANN will put Determination in force and take remedial procedures⁷⁶.

On top of that, anybody might submit a “Limited Public Interest Objection.” Due to the comprehensive position base; nevertheless, complainers undergo a quick look” procedure developed to determine and remove violent or foolish objections. An objection discovered to be clearly misguided or an offense of the right to dispute might be removed at any time⁷⁷, and such unfounded Objection will be considered clear objection right abuse⁷⁸.

The Objection might be formed to fall within the accepted classifications for “Limited Public Interest objections. However, other truths might reveal that the Objection might be illegal and submitted in bad faith. Numerous objections submitted by the associated or same parties against the applicant might make up for harassment of the Claimant instead of a genuine defense of legal standards acknowledged under basic concepts of general or international legislation. Furthermore, the Objection that assaults the applicant, instead of the applied-for String, might violate the right of the legal Objection⁷⁹.

2.4.2.3. the Registration Restriction Dispute Resolution Procedure (RRDRP)

The “Registration Restriction Dispute Resolution Procedure” is planned to deal with situations in which the registry operator of new gTLD related to community interests differs from the registration limitations detailed in its registry arrangement.⁸⁰ In this connection, the importance of the “RRDRP” function is to deal with complaints related to behaviors that caused harm to the society or other public characters or individuals due to the fact that a community-based limited gTLD registry operator did not satisfy its commitments to control and watch the registration and usage of domain names within the limitations specified related to the gTLD registry contract⁸¹. The requirement for such a treatment is based upon the concept that it would not be reasonable and fair to provide a choice in the new gTLD frame allotment procedure to a claimant based upon a dedication to limiting

⁷⁶ T. Pistorius, 40.

⁷⁷ ICANN, 3-6 .

⁷⁸ Ibid 3 -7.

⁷⁹ Ibid 3- 7.

⁸⁰ T. Pistorius, 40.

- L. Seuffer , August 9, 2019.

⁸¹ Joost Pauwelyn, Pierre Véron, Edouard Treppoz, Julie Bertholet, Pierre-Alain Killias, Torsten Bettinger, Bernard Hanotiau, Sarah Theurich, *La résolution des litiges de propriété intellectuelle / Resolution of Intellectual Property Disputes*, Publisher Université de Genève, Genève, 2010, 56.

using a (TLI) to specific communities, groups, or other stakeholders or organizations. The inappropriate deeds of the registry operator may trigger damage to the public society or its members of organizations and other associations⁸².

3. REMEDIES AND LIABILITY

One of the main prime factors deciding the effectiveness of ICANN policy, and particularly the extra remedies adopted by ICAAN, is the element of liability. One of the main questions left for discussion is if ICANN's extra remedies can apply the intermediary liability?

3.1. Intermediary liability

Under the TM-PDDRP, PICS, and the PICDRP, the RPMs force the New gTLD registry operators to implement IP RIGHTS into their registration policies and services(Xue, 2018). One might question whether a new type of intermediary accountability is produced in the DNS. The RPMs require new gTLD operators to take duty for the actions related to their domain name registrants. The Offered RPMs in ICANN's Systems are executed within the DNS frame. The future intermediary liability might affect the international community's benefits and intellectual property enforcement⁸³.

3.2. Remedies

According to the trademark post-delegation dispute resolution procedure related to remedies and liability offered by ICANN, and based on the fact that registrants are not an original party to subject to actions taken with the originals parties of the conflict, ICANN has declared that the operators generally cannot be subject to the form of "suspending, transferring deleting registrations, except to the extent registrants are directors, officers, employees, agents, or entities under common control with a registry operator."⁸⁴ ⁸⁵ Furthermore, According to suggested remedies, statutory procedures will not impose any financial sentences punished to any party except the fees and other costs granted based on the regulations⁸⁶.

⁸² *ibid* 56.

⁸³ T. Pistorius 41.

⁸⁴ Trademark post-delegation dispute resolution procedure regulation thereafter (REG-TMPDDRP), https://newgtlds.icann.org/en/applicants/agb/pddrp-04_jun12-en.pdf, 4 JUNE 2012., art 18, 18.1.

⁸⁵ *Ibid*, art. 18-18.1.

⁸⁶ *Ibid*, art. 18-18.1.

4. EVALUATION AND CONCLUSION

The working group of ICANN has basically finished considerations of six major and overarching topics; moreover, it has developed following different work tracks to resolve some issues. To name a few: Subjects associated with the total procedure, assistance, and outreach, besides the Statutory and regulative subjects; and Matters connected to domain names String, objections, and conflicts; furthermore, the group work hardly on Internationalized Domain Names, functional and other technical issues; in addition, it tried to solve the dilemmas of the top-level domain that consist of Geographical names⁸⁷. Even though the ICANN group has revised all RPMs and other objection mechanisms mentioned above, they still need more revision. It would be more accurate if the ICANN group combined all these mechanisms within the UDR policy rather than designed them separately. In this connection, such separated frames could distract the spent time and efforts dedicated to finding a solid resolution mechanism and make the essence of this mechanism empty and meaningless. For instance, if the Complainant infringed trademarks by different domain strings, one under gTLD and the other under the second top-level domain name string. Then it supposes he would submit two different complaints within two different mechanisms to settle the cases related to his infringed trademark rights. Besides that, there will be two different panels, and these panels might take contractual decisions. Furthermore, the separated mechanism could have different regulations that might hinder flexibility, accuracy, and centralization of decisions resulting from different panels related to infringing trademark rights.

Moreover, these mechanisms were turning points for the registry operator, bearing in mind that the registry agencies have enjoyed immunity against other stakeholders at an early stage of Cyberspace emerging and early conflicts between trademarks holders and domain names owners. Furthermore, giving immunity to the registry operator was the main reason for igniting the conflict over domain names in the early stage of Cyberspace and other rights related to trademarks in Cyberspace. In this connection, PDDRP has put the registry operator under the responsibility frame and made him liable for his behavior toward other stakeholders. On top of that, and in terms of PDDRP, The Specialist committee might advise a range of vast enforcement tools if the registry provider was responsible under the Tm-PDDRP, including Preventive measures against further infringing registration in the future⁸⁸. Another suggested penalty is to freeze accepting new domain enrollments in the gTLD up unto such time as the offense(s) recognized in the Determination is (are) treated or a set amount of time to fix it⁸⁹.

⁸⁷ L. Seufer , August 9, 2019.

⁸⁸ REG-TMPDDRP, art., 18.3.1.

⁸⁹ *ibid* art., 18.3.1.

Moreover, in a very exceptional situation, the suggested remedy support termination of the Registry contract if he acted in bad faith⁹⁰.

One of the most paid attention updates over this mechanism, especially the Trademark PDDRP, is having the appeal stage. Though this step comes late, the author believes it gives conflicting parties more credibility, flexibility, and satisfaction. Another issue that deserves to be considered is that some of these mechanisms keep the hierarchy of the relationship between ICANN policies and the judicial system by prioritizing registration agreements to use ICANN policies to resolve the conflict before that person can approach a court. For instance, the main policy of ICANN related to the use of UDRP has declared that approaching UDRP to resolve the conflict is mandatory to validate domain name registration. In contrast, another mechanism has given up this hierarchy by approaching the court concurrently with the case being heard within Trademark PDDRP. as an example, in this connection, Article 22.2 declared that:” In those cases where a Party submits documented proof to the Provider that a Court action involving the same parties, facts, and circumstances as the Trademark PDDRP was instituted before the Complaint filing date in the Trademark PDDRP, the Provider shall suspend or terminate the Trademark PDDRP⁹¹.

Moreover, in some mechanisms, ICANN kept the door open before the possible compensation to any possible infringing triggered by any stakeholder, including the registry operator. For instance, at TM PDDRP, ICANN indicated there “Nothing prohibits ICANN from imposing remedies at any time and of any nature it is otherwise entitled to impose for a registry operator’s non-compliance with its Registry Agreement.”⁹². The author believes that if ICANN has embedded the monetary penalties and compensation within its mechanism, it will make it very independent, flexible meeting the requisites of the stakeholders in Cyberspace. Furthermore, it gives these mechanisms huge momenta and makes them more practical than the court approach.

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⁹⁰ *ibid* art., 18.3.1.

⁹¹ REG-TMPDDRP, Art. 22.2

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ICANN механизми: процена додатних правних средстава

Сажетак: Удруживањем са Свешком организацијом за интелектуалну својину, ICANN је креирала административне механизме за решавање спорних назива домена и других права у вези са коришћењем жигова у сајбер простору. У овом контексту, овај механизам под називом UDRP био је ограничен на одређене називе домена првог нивоа јер су на самом почетку свешке мреже сукоби у основи били окружени ланцима назива домена као што су .com, .org, .net са високом вредношћу. Поврх тога, пошто је распућа истражња у индустрији назива домена била огромна, ICANN настоји да туми нове ланце назива домена на истражње како би одговорила на тако распућу истражњу за називима домена. Сходно томе, овај корак је повећао сукоб, док је механизам UDRP био ограничен на решавање сукоба око назива домена првог нивоа. С тим у вези, ICANN је морао да пронађе други механизам за решавање других сукоба повезаних са новим gTLD. Овај чланак настоји да расветли ова права средства и њихову ефикасност у решавању таквих сукоба.

Кључне речи: RPMs, gTLDs, UDRP, Називи домена, Жиго.

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