

**IN THE MATTER OF AN INDEPENDENT REVIEW PROCESS
BEFORE THE INTERNATIONAL CENTRE FOR DISPUTE RESOLUTION**

ICDR Case No. 01-18-0004-2702

AFILIAS DOMAINS NO. 3 LIMITED,
Claimant

v.

INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS,
Respondent

PROCEDURAL ORDER NO. 4

12 June 2020

Members of the IRP Panel

Catherine Kessedjian
Richard Chernick
Pierre Bienvenu Ad. E., Chair

Administrative Secretary to the IRP Panel

Virginie Blanchette-Séguin

Table of Contents

	Page
I. OVERVIEW.....	1
II. BACKGROUND.....	1
III. POSITIONS OF THE PARTIES AND RELIEF REQUESTED.....	3
A. Claimant	3
B. Respondent	6
IV. ANALYSIS.....	8
A. Applicable Law.....	8
B. Burden and Standard of Proof.....	9
C. PO 2	10
D. Alleged Inadequacy of the Respondent’s Privilege Log.....	14
E. Alleged Insufficiency of the Respondent’s Production.....	19
V. CONCLUSION	24

I. OVERVIEW

1. This Procedural Order No. 4 (**PO 4**) concerns an application by the Claimant seeking various forms of relief in relation to the Respondent's document production pursuant to the Panel's Procedural Order No. 2 (**PO 2**). For the reasons set out below, the Claimant's application is denied.

II. BACKGROUND

2. In PO 2, dated 27 March 2022, the Panel ruled on a number of outstanding objections to the Parties' respective requests to produce documents. In the case of the Claimant's requests that had been objected to by the Respondent, the Panel granted 12 of the Claimant's 14 outstanding requests.
3. The Panel also granted the Claimant's request that, to the extent ICANN were to take the position that any responsive documents are protected from disclosure by any asserted privilege or other source of protection, those documents should be listed in a privilege log describing, in regard to each document withheld, the type of document, its general subject matter, the date on which it was created, the author(s) of the document, all persons who were intended to be recipients of the document, and the legal privilege being claimed, referencing the law under which the privilege claimed is asserted.
4. On 17 April 2020, the Respondent produced to the Claimant its document production pursuant to PO 2. On 24 April 2020, the date fixed by PO 2, the Respondent transmitted to the Claimant a privilege log identifying documents that the Respondent had withheld from production based on the attorney-client privilege or the attorney work product doctrine under California or U.S. federal law.
5. On 29 April 2020, the Claimant filed the application that is the subject of the present order (**Application**), seeking assistance from the Panel regarding what the Claimant described as the Respondent's "grossly deficient document production and insufficiently detailed Privilege Log" (Application, p. 1).

6. As directed by the Panel, the Respondent responded to the Application by letter dated 6 May 2020 (**Response**), rejecting the Claimant's complaints and asserting that the Respondent had, in all respects, complied with PO 2.
7. On 11 May 2020, the Panel, as had been suggested by the Claimant, held a telephonic hearing in connection with the Application. On that occasion, both Parties had the opportunity to amplify their written submissions orally and to present arguments in reply. Consistent with the Panel's Decision on Phase I, the *Amici* were permitted to attend this procedural hearing as observers, which they did. A transcript of the hearing was prepared, reviewed by the Parties and made available to the Panel on 18 May 2020.
8. It bears noting that while the Claimant initially took the position that the timing of the Application necessarily put in jeopardy not only the agreed dates for the merits hearing but also the deadline for the filing of its Reply (see Application, p. 11), the Claimant subsequently deferred to the Panel's discretion in regard to the filing of its Reply (see Claimant's email dated 30 April 2020). In the event, the Panel directed the Claimant to file its Reply on 4 May 2020, in accordance with the procedural timetable (as slightly amended by agreement of the Parties), but to do so under a reservation of its right subsequently to apply to the Panel for leave to supplement or amend its Reply, or otherwise to file additional submissions, if additional documents were ordered to be produced by the Respondent as a result of the Application. The Claimant's Reply was duly filed on 4 May 2020.
9. On 10 June 2020, while the Application remained under advisement, the Claimant filed a supplemental submission in support of the Application (**Supplemental Submission**). In its Supplemental Submission, the Claimant argued that with the filing of the Respondent's Rejoinder Memorial on 1 June 2020, there is no longer any question that the Respondent has put certain documents for which it claims privilege "at issue" in this

arbitration, thereby waiving any potentially applicable privilege and requiring the Respondent to produce them to the Claimant.

10. By email date 11 June 2020 (corrected on 12 June 2020), the Panel established a briefing schedule in relation to the Supplemental Submission. As noted below, to the extent that the specific waiver argument set out in the Supplemental Submission already formed part of the Application, the Panel reserves this question for determination in a subsequent procedural order, to be issued once the Parties have filed their respective submissions in relation to the Supplemental Submission.

III. POSITIONS OF THE PARTIES AND RELIEF REQUESTED

11. The Parties' positions are set out, in the case of the Claimant, in the Application, as amplified in oral argument at the hearing and in Afiliias' PowerPoint presentation dated 11 May 2020; and, in the case of the Respondent, in the Response, as amplified in oral argument and in ICANN's PowerPoint presentation, also dated 11 May 2020.
12. These positions are briefly summarized below to provide context for the Panel's analysis. While the Panel refers in its analysis to those parts of the submissions and legal authorities of the Parties found by the Panel to be most pertinent to its analysis, in reaching its conclusions the Panel has considered all of the Parties' submissions and legal authorities.

A. *Claimant*

13. By way of background, the Claimant recalls, relying on early decisions of IRPs, that the Respondent has been vested by the Government of the United States with regulatory authority of vast dimension and global reach. The Claimant insists on the importance of ICANN's obligation of transparency in the conduct of the recently-strengthened Independent Review Process. In such context, the Claimant contends that "ICANN's invocation of privilege must be narrowly-construed and scrutinized to a high standard" (Application, p. 5).

14. The Claimant also asserts that the Respondent cannot hide its decision-making and conduct from the public by delegating all potentially contentious issues to its legal department for resolution, or by copying its in-house lawyers on all documents relevant to a dispute.
15. The Claimant also contends that ICANN must be deemed to have waived its right to invoke privilege insofar as staff communications, including those of ICANN's legal department, are concerned. This is so particularly where, as here, the IRP concerns the conduct of ICANN's legal staff and their involvement in ICANN's business decisions concerning .WEB.
16. In the course of its counsel's reply submissions at the hearing, the Claimant articulated a different waiver argument. According to the Claimant, by arguing that the Respondent's Board reasonably decided not to make any determination regarding NDC's conduct until after the conclusion of this IRP, as alleged in the Response, the Respondent has in effect affirmatively put the reasonableness and good faith of that Board's decision at issue in the case. According to the Claimant, the fact that the Board's decision was made on the advice of counsel does not allow the Respondent to shield the basis for, or any discussion of, that decision by claiming privilege over responsive documents that the Respondent has been ordered to produce.¹
17. The Claimant avers that the Respondent's production was "woefully deficient" and failed to comply with the *Interim Supplementary Procedures (Interim Procedures)*, the *IBA Rules on the Taking of Evidence in International Arbitration (2010) (IBA Rules)* and PO 2. As illustrated in an annotated version of its Redfern Schedule (Attachment A to the Application), the Claimant alleges that the Respondent:

¹ Transcript, pp. 47-48.

- (a) refused to produce any document in response to 7 of Afiliias' requests;²
- (b) produced in total a mere 37 unique (i.e., after discounting duplicates) documents;
- (c) refused to produce documents that are clearly responsive and not privileged, such as the "request for information" sought by Afiliias' request 2(b); and
- (d) failed to produce a single document that one would presume to be in the possession of the *Amici*. In this regard, the Claimant avers that it would be unfair for the Respondent to be allowed to select, in consultation with the *Amici*, the evidence on which it would be able to rely all the while denying the Claimant the opportunity to seek discovery of evidence in the *Amici*'s possession, custody or control, a state of affairs that the Claimant describes as "unilateral third party discovery" (Application, p. 3).

18. With respect to the Respondent's privilege log, the Claimant points out that this 58-page log lists nearly 400 documents withheld from production based on unsubstantiated and unparticularized assertions of attorney-client privilege and attorney work product under California and U.S. federal law. In such circumstances, the Claimant contends that the Respondent must either be deemed to have waived its right to invoke privilege or be ordered to provide an amended log that contains sufficient detail to allow the Panel and the Claimant to evaluate the validity of the invoked privilege.

19. By way of relief, the Claimant requested in the Application that the Panel order the Respondent to "(i) supplement and remedy its production by producing those documents that are subject to the Tribunal's production order or ICANN's production agreement; (ii) produce those documents listed on ICANN's Privilege Log that are not privileged; (iii) produce those documents that contain privileged and non-privileged information with appropriate redactions covering only the privileged information; and (iii) (*sic*) for the

² Application, p. 2. The Panel notes that on p. 3 of the Application, the Claimant lists 8 requests in response to which, it is alleged, not a single document was produced by the Respondent.

remaining documents, remedy its Privilege Log so that the Panel and Afiliias can properly assess the validity of the privilege that ICANN has invoked.” (Application, p. 11) In the Application, the Claimant also reserved “its right to request the Panel to conduct an *in camera* review of documents that ICANN has asserted are covered by privilege” (*Id.*, fn 29).

20. The Claimant was more specific in the articulation of its requests for relief at the hearing, and sought various other orders comprehensively set out in the PowerPoint presentation prepared to support its counsel’s argument, including that the Respondent produce all communications that are marked either as “Clearly Not Privileged” or “Unlikely Privileged” in Attachment C to the Application. The orders sought by the Claimant as articulated at the hearing did not include a request for an *in camera* review of documents.

B. Respondent

21. The Respondent submits that the Application is based on false factual assumptions and incorrect legal principles. The Respondent avers that it searched for and produced all non-privileged documents responsive to the Claimant’s requests to which the Respondent agreed or was directed by the Panel to respond; and that it properly withheld only those documents protected by the attorney-client privilege or work product doctrine. The Respondent contends that it served a privilege log providing, in respect of each withheld document, all of the information necessary to establish privilege.
22. As regards the Claimant’s complaints about the sufficiency of its production, the Respondent avers that it collected documents and data from all custodians identified in the Claimant’s Redfern schedule, and also independently added custodians likely to have responsive documents in their possession. The documents collected were reviewed and were either produced to the Claimant or were withheld from production based on privilege.

23. The Respondent submits that it was under no duty to search documents in the possession, custody or control of the *Amici*, adding that the Panel has already denied the Claimant's requests to access documents in the possession of the *Amici*.
24. The Respondent responds to the Claimant's specific complaints, noting:
 - (a) that many of the documents the Claimant seeks do not exist; and
 - (b) that many of the documents the Claimant seeks were in fact produced.
25. Turning to the complaints leveled at its privilege log, the Respondent avers that its log contains all of the information ordered to be provided in PO 2, adding that the requirements of PO 2 reflect the legal requirements under California and U.S. federal law.
26. The Respondent observes that the number of privileged documents should come as no surprise given that litigation and other legal proceedings were ongoing or anticipated during almost the entire period at issue, which necessitated active involvement of the Respondent's in-house and outside counsel. The Respondent also notes that many of the Claimant's requests sought analyses that are inherently legal.
27. The Respondent asserts that the Application is predicated on incorrect legal positions, such that documents protected by attorney-client privilege or work product doctrine should be produced in redacted form to reveal the "unprivileged facts" that they may contain; or that work product protection is limited to documents that reveal legal strategy.
28. Finally, the Respondent submits that the Claimant's contention that the Respondent waived privilege either because its log is inadequate or by committing to be held publicly accountable for its staff's conduct through an IRP have no legal merit, whether it be under California, U.S. federal law, or under Rule 8 of the Interim Procedures. With respect to the contention put forward at the hearing that the Respondent waived privilege by affirmatively putting at issue the reasonableness of the Board's decision not

to make any determination regarding NDC's conduct until after the conclusion of this IRP, the Respondent objects to its late introduction and argues that it is, in any event, without merit since the Respondent has not argued that the Board's decision was valid because it was advised by counsel.

29. As regards the Claimant's reservation of its asserted right to request *in camera* review of documents that the Respondent has asserted are covered by privilege, the Respondent avers, first, that the Claimant by failing to request *in camera* review in the Application waived the issue, and second, that California law affirmatively prohibits *in camera* review of documents over which attorney-client privilege has been claimed.

IV. ANALYSIS

30. The Panel begins its analysis by determining the law applicable to the issues raised by the Application, and by recalling considerations relating to the burden and standard of proof in the context of claims of privilege. The Panel then turns to considering the grounds of the Application, addressing first the complaints directed at the Respondent's privilege log, and considering thereafter those directed at the sufficiency of its production.

A. *Applicable Law*

31. The Parties have relied in their submissions, for the most part, on authorities applying California law and US federal law, although the Claimant also made passing reference to English law, the law of the seat of these proceedings by agreement of the Parties.
32. At the hearing, counsel for the Claimant invited the Panel also to consider transnational law. However, no specifics were given as to the content of transnational law as it relates to the issues of attorney-client privilege or work product arising from the Application, nor as to whether or the extent to which, in relation to those issues, transnational law differs from California law or U.S. federal law.

33. The Respondent is an organization incorporated under the laws of California and the communications and documents at issue in the Application were created by or concern legal advice from California attorneys. In such circumstances, the Panel is of the opinion that the law of California, as supplemented by U.S. federal law, applies to the issues arising from the Application, and it is on the basis of that law that it has determined these issues. As explained in a leading treatise:

There is substantial support for the proposition that national rules of privilege governing the conduct of legal advisors (or other advisors) – rather than international standards – must be applied. That is because it is national law that provides the basis for privileged claims in the first instance (as discussed above, there being no international body or source of privileged rules). As a consequence, like other substantive rights in international arbitration (e.g., contract rights), the better view is that national law provides the appropriate source of law for privileges.

[...]

Where privileges for legal advice are concerned, applying the law of the place where the lawyer is qualified to practice or the client is based is generally the better choice-of-law solution, from the perspective of predictability and conforming to the parties' expectations.³

B. Burden and Standard of Proof

34. In the case of *Costco Wholesale Corp. v. Superior Court*, the Supreme Court of California said the following on the subject of burden of proof in relation to claims of privilege:

The party claiming the privilege has the burden of establishing the preliminary facts necessary to support its exercise, *i.e.*, a communication made in the course of an attorney-client relationship. [...] Once that party establishes facts necessary to support a *prima facie* claim of privilege, the communication is presumed to have been made in confidence and the opponent of the claim of privilege has the burden of proof to establish the communication was not confidential or that the privilege does not for other reasons apply.⁴

35. Applying this holding to the issues presently before the Panel, once the Respondent has alleged, by a sufficiently particularized entry in its privileged log, the facts necessary to support a claim of privilege, the burden then shifts to the Claimant to establish either that

³ Gary B. Born, *International Commercial Arbitration*, 2nd ed., Wolters Kluwer, 2014, pp. 2383-2385.

⁴ *Costco Wholesale Corp. v. Superior Court*, 47 Cal. 4th 725, p. *733 (2009) [**Costco**]. See also *Schaeffer v. Gregory Vill. Partners, L.P.*, 2015 WL 166860, p. *3 (N.D. Cal. Jan. 12, 2015) [**Schaeffer**], and Cal. Evid. Code, para. 917.

the communication was not confidential or that the privilege claimed does not for other reasons apply. Thus, and by way of example, it is the party who seeks to challenge a claim of attorney-client privilege who bears the burden to “make some showing” that the communication did not involve the giving of legal advice but related instead, *ex hypothesis*, to business matters or considerations.⁵

36. Because it impedes the full and free discovery of the truth, the attorney client privilege is strictly construed.⁶ Accordingly, the Panel accepts the Claimant’s above-cited contention that “ICANN’s invocation of privilege must be narrowly construed and scrutinized to a high standard”.
37. An essential element of the construct resulting from these principles and their application in practice are the ethical obligations of the attorneys involved in the process. Under Rule 3.4 of the California *Rules of Professional Conduct*, it is an ethical fault for an attorney to suppress evidence that the attorney’s client has a legal obligation to reveal or produce. Likewise, California lawyers are prohibited by the *Rules of Professional Conduct* from revealing privileged information without the client’s informed consent, except where disclosure is necessary to prevent a crime reasonably likely to result in death or substantial bodily harm (Rule 1.6).

c. PO 2

38. Some of the issues raised in the Application find their answer in PO 2. The Panel therefore recalls at the outset some of the provisions of that order.
39. As reflected in both Procedural Order No. 1 dated 5 March 2020 (**PO 1**)⁷ and PO 2,⁸ the Parties agreed during the case management conference of 4 March 2020 that

⁵ *Coleman v. Am. Broadcasting Companies, Inc.*, 106 F.R.D. 201, 206 (D.D.C. 1985) [**Coleman**].

⁶ *Schaeffer, supra*, p. *3, quoting *United States v. Graf*, 610 F. 3d 11, 610 F. 3d 1148, 1156 9th Cir. 2010 [**Graf**].

⁷ PO 1, p. 2.

⁸ PO 2, para. 5.

document production in this IRP would be governed by Rule 8 of the Interim Procedures, to be applied by the Panel using as non-binding guidelines the IBA Rules.

40. Rule 8 allows IRP Panels to order a party to produce “documents [...] [that] are not subject to the attorney-client privilege, the work product doctrine or otherwise protected from disclosure by applicable law” [emphasis added].
41. Consistent with the provisions of Rule 8, and of Arts. 9.2(b) and 9.3(a) of the IBA Rules, in PO 2 the Panel recognized the right of each Party to assert privilege in respect of any document otherwise responsive to a request to produce from the other party:
 24. Any document otherwise responsive to a document production request that is protected by solicitor-client or legal advice privilege (or professional secrecy), by litigation or attorney work product privilege, or by settlement communications/discussions privilege may be withheld from production. Should a responsive document contain reference to a privileged communication, or to information in respect of which the producing party asserts a claim of confidentiality, the document should be appropriately redacted and produced. By parity of reasoning, the Panel directs that any privileged or confidential document that is inadvertently produced should, upon request, be immediately returned to the producing party.
 25. In principle, matters of confidentiality and/or privilege shall be dealt with on a document-by-document basis and, as already indicated, any document over which either Party asserts a claim of privilege or confidentiality shall be identified in a privilege log, as described above.
42. In the opinion of the Panel, the foregoing suffices to dispose of the Claimant’s contention that the Respondent’s accountability for its staff’s conduct and its commitment to transparency under its Bylaws somehow imply a waiver of its right to invoke privilege. Rule 8 of the Interim Procedures, which governs document production in IRPs, provides otherwise.
43. Moreover, by agreeing that document production would be governed by Rule 8 of the Interim Procedures, to be applied by the Panel using as non-binding guidelines the IBA Rules, the Parties acknowledged that the attorney-client privilege and the work product doctrine would be available to ICANN – as well as to Afilias – in *this* IRP.

44. Pending receipt of the Parties' full submissions in relation to the Claimant's Supplemental Submission, the Panel expressly reserves - and makes no finding in connection with - the Claimant's waiver argument based on the Respondent's reliance, in this IRP, on the Board's decision not to make any determination regarding NDC's conduct until after the conclusion of this IRP.
45. Second, any discussion of the adequacy of the Respondent's privilege log must likewise begin by considering the provisions of PO 2, paragraph 16 of which reads as follows:
16. As a privilege log may prove useful to the Parties and the Panel in addressing issues arising from refusals to produce justified on the basis of privilege, the Panel directs both Parties to prepare a privilege log in the present case. In light of the tight procedural timetable applicable to this case, the Panel directs that each Party shall have until 24 April 2020, that is, one week after the date set for the production, to provide the other Party with a privilege log. The privilege log shall list documents over which a privilege is asserted, and describe in regard to each document withheld, the type of document, the general subject matter thereof, the date on which it was created, the author(s) of the document, all persons who were intended to be recipients of the document, and the legal privilege being claimed, referencing the law under which the privilege claimed is asserted.[emphasis added]
46. The Panel examines below the Claimant's contention that the Respondent's assertions of privilege are "unsubstantiated and unparticularized" (Application, p. 4). However, subject to considering the adequacy, under the applicable law, of the Respondent's description of the claimed privilege, it is apparent that the privilege log prepared by the Respondent, at least *prima facie*, complies with the requirements of PO 2.
47. Third, the Claimant's complaint that "ICANN failed to produce a single responsive document that one would expect to be in the *Amici*'s possession, custody or control" (Application, p. 3), must be evaluated in the light of PO 2 and the Panel's prior pronouncements.
48. In its Decision on Phase I, the Panel wrote:
188. ICANN's counsel also suggested, at the hearing, that if the Applicant *Amici* were permitted the type of broad participation they are seeking, then it would be appropriate that both of them be subject to the provisions of the Interim Procedures relating to Exchange of Information.

This means that they would be subject to document requests, and that Afiliás would in turn be subject to document requests by both ICANN and the Applicant *Amici*.

189. The Panel is unable to reconcile the type of participation rights being sought by the Applicant *Amici* with the terms of the Interim Procedures.
(...)

(...)

195. The conclusions the Panel draws from its review of the provisions of Rule 7, read as a whole, are the following:

(...)

- The provisions of the Interim Procedures relating to Exchange of Information (Rule 8) apply to Parties, and the Panel can find no basis in Rules 7 or 8 for the submission that Afiliás may be subject to motions for exchange of documents by the Applicant *Amici*.

(...) [emphasis added]:

49. In PO 2, the Panel explained as follows its decision to order the production of responsive documents in the possession, custody or control of either Party:

10. The Respondent objects to the Claimant's definition of "ICANN", which is stated to include counsel and agents not employed by ICANN. The Claimant counters that both Article 3 of the IBA Rules and Rule 8 of the Interim Procedures require parties to search for documents that are in a party's possession, custody, or *control*.

11. In the Panel's experience, international arbitral tribunals expect parties to produce documents requested or ordered to be produced even if they are in the possession of third parties – like subsidiaries, agents or advisors – who, because of a legal or relevant contractual relationship with a party, have in their possession documents which, effectively, are under the control of the party. The Panel therefore directs that both Parties should produce responsive documents in their "possession, custody, or control", even if documents a Party knows or reasonably should know are responsive are in the possession of external counsel or agents.

50. According to the foregoing pronouncements, the *Amici* are neither "parties" to this IRP nor "third parties – like subsidiaries, agents or advisors – who, because of a legal or relevant contractual relationship with a party, have in their possession documents which, effectively, are under the control of the party". It follows that the Respondent had no obligation under PO 2 or the Interim Procedures to ask the *Amici* to search for documents responsive to the Claimant's requests to produce. Consequently, the Claimant's claim that the Respondent should have produced responsive documents from

the *Amici* must be rejected. The difficulties associated with the participation of the *Amici* in this IRP -- with the status of *Amici Curiae*, as opposed to that of full parties or interveners -- have been the subject of ample submissions by the Parties and the *Amici* since the beginning of this IRP, and most recently gave rise to an application by the Claimant dated 10 June 2020, that is presently pending before the Panel. For present purposes, it suffices to observe that those difficulties are distinct from the issues of attorney client privilege and attorney work product that arise under the Application.

51. Having disposed of those issues that could be determined on the basis of the terms of PO 2 or of other prior pronouncements of the Panel, the Panel now turns to the remaining issues raised by the Application.

D. *Alleged Inadequacy of the Respondent's Privilege Log*

52. The Respondent has cited a number of cases identifying, under the applicable law, the items of information required to be disclosed in a privilege log.⁹ These broadly correspond to the items listed in paragraph 16 of PO 2.
53. The Respondent has also cited cases, mostly federal authorities, defining (or applying) the standard to determine the adequacy of a privilege log under the applicable law. In general, the standard is whether, as to each document, the log sets forth specific facts that, if credited, would suffice to establish each element of the privilege or protection from production that is being claimed. The focus is on the specific descriptive portion of the log, rather than on conclusory invocations of the privilege claimed.¹⁰
54. In its privilege log, the Respondent has listed, in addition to the other items of information required under PO 2, the "Privilege" claimed (e.g., "Attorney-Client", or

⁹ See, e.g., *Hernandez v. Sup. Ct.*, 112 Cal. App. 4th 285, 291 n.6 (2003); *Elat v. Ngoubene*, 2013 WL 4478190, *4 (D. Md. 2013); *Torres v. Kuzniasz*, 936 F. Supp. 1201, 1208 (D.N.J. 1996); *In re Grand Jury Investigation*, 974 F.2d 1068, 1071, 36 Fed. R. Evid. Serv. 860 (9th Cir. 1992).

¹⁰ See *SEC v. Beacon Hill Asset Mgmt., LLC*, 231 F.R.D. 134 (S.D.N.Y. 2004), pp. 144-145 [*SEC v. Beacon Hill*], citing *Golden Trade, S.r L. v. Lee Apparel, Co.*, 1992 WL 367070 at *5; accord *A.I.A. Holdings, S.A. v. Lehman Bros.*, 97 Civ. 4978(LMM)(HBP), 2002 WL 31385824 at *4 (S.D.N.Y. Oct. 21, 2002); *In re Copper Mkt. Antitrust Litig.*, 200 F.R.D. 213, 223 (S.D.N.Y.2001).

“Attorney-Client; Work Product”¹¹) separately from the “Privilege Description”. Typical of the latter are the following two entries: “Email seeking legal advice from J. Jeffries* regarding auction rules”; “Email from outside counsel* seeking advice in anticipation of litigation regarding .WEB contention set”. A third example of a Privilege Description said to be insufficiently particularized reads as follows: “Memorandum to ICANN counsel* prepared by outside counsel* providing legal advice in anticipation of litigation regarding .WEB contention set.” The asterisk, when used in the log, denotes that the person listed is among the Respondent’s internal or external counsel.

55. In the opinion of a majority of the Panel, the authorities made available to the Panel establish that, under the applicable law, descriptions such as those used by the Respondent to assert privilege are sufficient.¹² Indeed, privilege was found to have been validly asserted even where, unlike in the present case, the log did not identify the subject matter of the legal advice or litigation. Thus in *Mitre Sports Int’l Ltd. v. Home Box Office, Inc.*, the Court held:

A review of HBO’s log reveals that it provides sufficient information, i.e., document date, author, recipients, persons copied (if any), and a description of redacted information, to permit a judgment that the challenged documents are potentially protected from disclosure. See, e.g., *Allied Irish Banks*, 252 F.R.D. at 167.

In addition, and as Judge Pitman explained in *S.E.C. v. Beacon Hill Asset Management LLC*, identifying e-mails in a privilege log as ‘seeking, transmitting or reflecting legal advice’—which is how HBO describes many e-mails—provides a sufficient description to sustain an assertion of privilege. 231 F.R.D. 134, 144-45 (S.D.N.Y. 2004) (explaining that although the subject matter of the legal advice was not described, disclosure of additional information as to the subject matter ‘would come perilously close to requiring disclosure of the substance of the privileged communication’); see also *Carl Zeiss Vision Intern. GmbH v. Signet Armorlite Inc.*, 07-cv-0894-DMS (POR), 2009 WL 4642388, at * 4 (S.D. Cal. Dec. 1, 2009) (citing *Beacon Hill* and finding that although the log did not provide certain ‘particulars’ to identify the subject matter of the documents, a seeking ‘legal advice’ description was sufficient).¹³ [Emphasis added]

¹¹ There seems to be no instance where work product is invoked in the Respondent’s log as the sole ground for seeking immunity from production.

¹² *Carl Zeiss Vision Intern. GmbH v. Signet Armorlite Inc.*, 07-cv-0894-DMS (POR), 2009 WL 4642388 (S.D. Cal. Dec. 1, 2009); *Mitre Sports Int’l Ltd. v. Home Box Office, Inc.*, 2010 WL 11594991 (S.D.N.Y. Oct. 14, 2010) [*Mitre Sports*]; *SEC v. Beacon Hill*, *supra*.

¹³ *Mitre Sports*, *supra*, pp. 15-16. See also *Grand Canyon Trust v. U.S. Bureau of Reclamation*, 2010 WL 457397, at *2 (D. Ariz. Feb. 5, 2010) (“FWS has made a prima facie showing that the documents are privileged. It has submitted a privilege log identifying the attorney and client involved with each withheld

56. The authorities cited by the Claimant do not support its contention that the Respondent's privilege log is inadequate or that the information provided in the log is insufficient. In *Electronic Frontier Foundation v. Central Intelligence Agency*,¹⁴ the issue was whether the US federal government had sufficiently described documents over which it asserted privilege in a so-called *Vaughn* index issued in connection with its response to a request under the *Freedom of Information Act*. The impugned entries in the index were found to be general and not to provide enough information to demonstrate, on a document by document basis, that the information withheld fell within the scope of the privilege. These entries included: "[a] one-page internal write up from the FBI to the IOB Board regarding IOB Matter 2007-1471. This report concerns the FBI's over-collection of information due to the inputting of the incorrect termination date of surveillance"; "[a] three-page internal write up regarding IOB Matter 2006-307"; and "[a] four-page internal write up from the FBI to the IOB Board regarding IOB Matter 2008-1194. This report concerns a highly sensitive joint investigation of the FBI and U.S. Army". Unlike the entries just quoted, the document descriptions in the Respondent's log are, in the opinion of a majority of the Panel, sufficiently detailed for the Panel to ascertain that the documents listed *prima facie* fall within the scope of the privilege.
57. The other case relied upon by the Claimant, *Oracle Am., Inc. v. Google, Inc.*,¹⁵ concerned an allegedly privileged email disclosed inadvertently as part of a party's document production. The District Court's decision contains no discussion of the information required to be disclosed in a privilege log in order to validly assert attorney client privilege under California law.
58. It is asserted in the Application that *all* of the privilege descriptions contained in the Respondent's log are inadequate. Having reviewed the Respondent's privilege log in

document, the nature of each document, the date the document was generated, and information on the subject matter of each document.").

¹⁴ *Electronic Frontier Foundation v. Central Intelligence Agency*, No. C 09-3351 SBA, 2013 WL 5443048, p. *17 (N.D. Cal. Sept. 30, 2013).

¹⁵ *Oracle Am., Inc. v. Google, Inc.*, No. C-10-03561-WHA DMR, 2011 WL 3794892, p. *2 (N.D. Cal. Aug. 26, 2011).

light of the authorities just cited, a majority of the Panel cannot accept that contention. The majority is satisfied, and finds, that the Respondent's log complies with PO 2, and that it provides a description of the privilege or protection asserted that is sufficient for it to be validly claimed under the applicable law.

59. The Claimant also complained, in the Application, that the Respondent's privilege log failed to identify the position and affiliations at the time of the communication of the individuals involved in the various communications listed in the log (Application, p. 4). This information was provided with the Response, to which was attached an appendix containing a list of all individuals who appear on the Respondent's privilege log, along with their corresponding job titles.
60. Finally, the Claimant complained that the Respondent's log did not identify the specific request to which a document that is alleged to be privileged pertains. The Claimant did not cite any authority or principle in support of its request for the inclusion of that information in the Respondent's log, and the Respondent was not specifically required to provide it under the terms of PO 2. It is recalled that in PO 2 the Panel declined the Claimant's invitation to require the Parties to identify, as part of their production, the specific document request(s) to which each produced document was responsive. The Panel did not see much benefit to this information being generated in the present IRP, and found that it would be unduly burdensome for the Respondent to comply with this request in circumstances where many of the Claimant's requests overlapped in their scope (PO 2, paras. 17-18). While this decision was concerned with produced documents, not logged documents, the reasoning also applies to the Claimant's complaint directed at the omission of that item of information from the Respondent's log.
61. For all of these reasons, a majority of the Panel concludes that the Claimant has failed to justify its request that the Respondent be required to revise its privilege log. The request is therefore denied.

62. One member of the Panel would have required disclosure of more detailed information from the Respondent in order to support the latter's claims of privilege. In the view of that Panel member, the applicable standard set out in paragraph 36 of this order requires of the Respondent, for example, not simply to assert that a Memorandum was prepared by "ICANN counsel" (see, e.g. entry no. 90 in the log), but to name the attorney(s) who has(ve) actually authored the document in question. By way of further example, in order to validly assert privilege over a document described as follows: "Transcript of ICANN Board workshop attended by S. Crocker, M. King, C. Disspain, X. Calvez, K. Wu, A. Maemura, A. Grogan*, L. Van der Laan, M. Botterman, S. Eisner*, R. da Silva, T. Swinehart, J. Jeffrey*, G. Marby, C. Chalaby, W. Profit, L. Ibarra, R. Rahim, M. Kummer, S. Bennet, D. Conrad, A. Hemrajani, B. Tonkin, A. Atallah, J. Soininen, D. Burns, D. Olive, S. Costerton, A. Stathos*, and G. Sadowsky, reflecting legal advice provided by ICANN counsel* in anticipation of litigation regarding .WEB contention set" (log entry no. 254), the Respondent should, in the view of that Panel member, be required to be more explicit and to specify that anticipated litigation regarding the .WEB contention set was the only subject-matter of the workshop, as opposed to being one topic, among many others, that may have been discussed in the course of the workshop, in which case the transcript ought to be produced with redactions. In respect of any entry in the log where the Respondent failed to meet the applicable high standard set out in paragraph 36, as that Panel member interprets it, the Panel member would have ordered the Respondent to produce the corresponding document to the Claimant.
63. Beyond alleged defects in the form of the Respondent's privilege log, the Claimant expressed concern at the large number of documents listed in the log. This, to some extent, is a cause of the alleged paucity of the Respondent's production, the subject of the Claimant's second major compliant, to which the Panel now turns.

E. *Alleged Insufficiency of the Respondent's Production*

64. The Claimant argues that the contrast between the number of entries in the Respondent's privilege log and the number of documents actually produced by the Respondent "by itself" demonstrates that the Respondent has clearly not made a reasonable or good faith effort to comply with its production obligations.¹⁶
65. In regard to this first line of argument, the Panel finds that there is force to the Respondent's argument in response that the number of entries in its privilege log is a logical consequence of the nature of the requests propounded by the Claimant, many of which directly sought documents most likely to be privileged or otherwise protected,¹⁷ and the fact that throughout the period there was ongoing litigation with Ruby Glen as well as a civil investigation by the Department of Justice, both dealing with subject matters that are the same or closely related to the issues in dispute in this IRP and which required the involvement of the Respondent's in-house and external counsel.
66. Some of the other underlying concerns of the Application were addressed in the Respondent's Response or in oral argument. For example, the Claimant illustrated its concern with the Respondent's production by noting that the Respondent had failed to produce documents that are clearly responsive and yet are not privileged since they are not listed in the privilege log, citing the "request for information" targeted by Claimant's request 2(b). At the hearing, Respondent's counsel clarified that the request for information in question had been made orally, and that the document sought by the Claimant's document request 2 (b) therefore does not exist.
67. Likewise, the Claimant was concerned that the Respondent may have considered, in its document review, that the mere sending of a communication to or from an internal

¹⁶ Application, p. 2.

¹⁷ The Respondent points in this regard to requests no. 3, 4, 6, 9, 10, 11, 12 and 14.

ICANN attorney suffices to render that communication privileged.¹⁸ The Respondent stated clearly in oral argument that it does not take that position, nor did it adopt it when conducting its document review.¹⁹

68. The Claimant's contention that the Respondent ought to have produced privileged documents in a redacted form, so as to disclose non-protected facts or information, engages the very nature of the attorney client privilege under the applicable law and, therefore, requires careful consideration.
69. The attorney client privilege protects confidential communications between a lawyer and a client.²⁰ The inclusion of facts in a confidential communication does not affect the privileged nature of the communication.²¹ As the Respondent's Response correctly notes (at p. 11): "A fact does not become privileged by being communicated to an attorney, but neither does a privileged communication lose its protected status merely because it includes facts." The Supreme Court of California's decision in *Costco*, already cited, confirms that proposition: "[t]he attorney-client privilege attaches to a confidential communication irrespective of whether it includes unprivileged material."²²
70. The same goes for documents and tangible things created by an attorney or its representative that are protected by the work product doctrine: while the doctrine affords no protection to facts learned in anticipation of litigation, the work product does not lose its protection by virtue of it containing facts.
71. Some of the cases cited by the Claimant confirm that a party cannot be forced to produce a redacted version of privileged documents in order to reveal "unprivileged"

¹⁸ See Claimant's PowerPoint presentation, p. 14, citing an extract of a procedural order in the *Corn Lake* IRP. It is noted that unlike in the present case, in *Corn Lake* no order for the production of a privilege log had been made by the Panel.

¹⁹ See Transcript, p. 24

²⁰ See, generally, the eight-factor test developed by the Ninth Circuit in *Graf*, as cited in *Schaeffer*, *supra*, p. *3.

²¹ *Kintera, Inc. v. Convio, Inc.*, 219 F.D.R. 503, 509 (S.D. Cal. 2003).

²² *Costco*, *supra*, p. *734.

material. Thus, in *State Farm Fire & Casualty Co. v. Superior Court*,²³ the California Court of Appeal held that while a witness may be questioned regarding unprotected facts, the witness cannot be made to divulge communications of those facts to an attorney. Likewise, in *Upjohn Co. v. United States*,²⁴ the US Supreme Court explained:

[T]he protection of the privilege extends only to communications and not to facts. A fact is one thing and a communication concerning that fact is an entirely different thing. The client cannot be compelled to answer the question, 'What did you say or write to the attorney?' but may not refuse to disclose any relevant fact within his knowledge merely because he incorporated a statement of such fact into his communication to his attorney.²⁵

72. Consequently, in the opinion of the Panel, it would violate the attorney-client privilege and work product protection to call upon the Respondent, as requested by the Claimant, to redact privileged communications or work product so as to reveal facts or information contained in those protected documents. This request must therefore be denied.
73. Another substantive point of divergence raised by the Application concerns the possibility for privilege to attach to communications between non-lawyers. In the Application, the Claimant contended that the Respondent cannot withhold documents from production on the ground that they “seek” or “reflect” legal advice or were prepared for counsel (Application, p. 7). However, the California Court of Appeal has held that if legal advice is discussed or contained in a communication between corporate employees, the communication is presumptively privileged even if it took place between non-lawyers.²⁶
74. The Claimant submitted that the Respondent cannot assert work product protection or attorney client privilege over documents or communications “created in connection with the non-legal functions of ICANN and outside attorneys acting in a purely administrative

²³ *State Farm Fire & Casualty Co. v. Superior Court*, 62 Cal. Rptr. 2d 834, p. 844 (1997).

²⁴ *Upjohn Co. v. United States*, 449 U.S. 383 (1981) [**Upjohn**].

²⁵ *Ibid*, pp. 395-396, quoting *Philadelphia v. Westinghouse Electric Corp.*, 205 F. Supp. 830, 831 (E.D. Pa. 1962).

²⁶ *Zurich American Ins. C. v. Super. Ct.*, 155 Cal. App. 4th 1485, 1502 (2007).

capacity” (Application, p. 6), citing US and English cases in support.²⁷ The Panel does not understand that proposition to be disputed as a matter of law. However, the Claimant has not alleged any facts, or adduced any evidence, that would support the claim that some of the documents over which the Respondent has claimed privilege may involve communications between lawyers, internal or external, performing non-legal functions or acting in a purely administrative capacity.

75. Consistent with the case law cited earlier in this order, once the Respondent has made a *prima facie* showing that communications relate to legal matters, such as by listing in its log an email by which the author is said to be seeking legal advice from a lawyer regarding ICANN’s auction rules, then the burden shifts onto the Claimant “to make some showing that the communications did not involve the giving of legal advice, but rather related to business matters and considerations.”²⁸ The Claimant did not seek to discharge that burden in the Application.
76. The Panel adopts the same reasoning and reaches the same conclusion in respect of the assertion, in the Application, that the Respondent may not “hide its decision making and conduct from the public by delegating all potentially contentious issues to its legal department for resolution or otherwise [copying] its in-house lawyers on all documents that are relevant to the dispute.”²⁹ The Claimant did not allege that this in fact occurs within ICANN, nor did it seek to show that this in fact happened in this case, or that it impacted the Respondent’s production.
77. In its Response, and again in oral argument, counsel described the process by which, in seeking to comply with PO 2, the Respondent identified custodians and datasets, collected responsive documents, and reviewed the documents so collected using a team of outside and in-house counsel, first for responsiveness and then for privilege.

²⁷ See cases cited in fn 12 of the Application, p. 7.

²⁸ *Coleman, supra*, p. 206.

²⁹ Application, pp. 5-6.

The lawyers involved in this process, it was represented, are all bound by the ethical obligations quoted earlier in these reasons. In the experience of the Panel, the process so described reflects best practices and, in the opinion of the Panel, it complied with PO 2.

78. The Respondent has asserted compliance with PO 2 and that its production was complete. The Respondent is reminded, as is the Claimant, that neither party will be allowed, later in these proceedings, to rely on newly discovered documents that were responsive to the other party's document requests and thus ought to have been produced as part of the party's initial production.
79. The Claimant has impressed upon the Panel that the IRP as an accountability mechanism is the exclusive means by which Afiliac, as an applicant for .WEB, can challenge the conduct of the Respondent's Board and staff. The Claimant has characterized as a cardinal principle the Respondent's obligation of transparency under its Bylaws and international law, and emphasized the impact of the Respondent's claims of privilege on the Claimant's ability to challenge the Respondent's decision making process concerning .WEB. While sensitive to these arguments, the Panel cannot accept, as urged by the Claimant, that they outweigh the interests served by the attorney-client privilege and the attorney work product under California and US federal law. In *Costco*, cited above, the Supreme Court of California, applying California law, observed:

The attorney-client privilege, set forth at Evidence Code section 954, confers a privilege on the client "to refuse to disclose, and to prevent another from disclosing, a confidential communication between client and lawyer..." The privilege "has been a hallmark of Anglo-American jurisprudence for almost 400 years." (*Mitchell v. Superior Court* (1984) 37 Cal.3d 591, 599, 208 Cal.Rptr. 886, 691 P.2d 642.) Its fundamental purpose "is to safeguard the confidential relationship between clients and their attorneys so as to promote full and open discussion of the facts and tactics surrounding individual legal matters. [Citation.] ... ¶ Although exercise of the privilege may occasionally result in the suppression of relevant evidence, the Legislature of this state has determined that these concerns are outweighed by the importance of preserving confidentiality in the attorney-client relationship. As this court has stated: 'The privilege is given on grounds of public policy in the belief that the benefits derived therefrom justify the risk that unjust decisions may sometimes result from the suppression of relevant evidence.' [Citations.]" (*Id.* at pp. 599-600, 208 Cal.Rptr. 886, 691 P.2d 642.) "[T]he privilege is absolute and disclosure may not be

ordered, without regard to relevance, necessity or any particular circumstances peculiar to the case.” (*Gordon v. Superior Court* (1997) 55 Cal.App.4th 1546, 1557, 65 Cal.Rptr.2d 53.)

80. The relief requested in the Application, were it to be granted, would deprive the Respondent of the protection afforded under the attorney-client privilege and the work product doctrine under the applicable law, and it would undermine their rationale and underlying purpose.

V. CONCLUSION

81. For all of these reasons, the relief sought in the Claimant’s Application is denied in its entirety.
82. The Panel has unanimously agreed the terms of this Procedural Order No. 4, which is signed by the Chair on behalf of the Panel at the request of his co-panelists.

Place of the IRP: London, England

Dated: 12 June 2020



Pierre Bienvenu, Ad. E.
Chair
On behalf of the Panel