



Request for Proposal -  
Trademark Post Delegation Dispute  
Resolution Procedure

30 April 2013

## 1.0 Introduction

### 1.1 About this Document

By issuing this Request for Proposal (“RFP”), the Internet Corporation of Assigned Names and Numbers (“ICANN”) is requesting your best offer to provide a response to the requirements of a Trademark Post Delegation Dispute Resolution Procedure (TM PDDRP), which may be amended from time to time. (For posted version please see <http://newgtlds.icann.org/en/applicants/agb/pddrp-04jun12-en.pdf>). In seeking a comprehensive proposal for these services, ICANN is placing maximum emphasis on several key components of value including expertise with similar processes, demonstrated practices, value-added services, and the ability to work within the guidelines established in this RFP.

### 1.2 Overview of ICANN

The mission of ICANN, pursuant to its Bylaws, is to coordinate, at the overall level, the global Internet's systems of unique identifiers, and in particular to ensure the stable and secure operation of the Internet's unique identifier systems. In particular, ICANN:

1. Coordinates the allocation and assignment of the three sets of unique identifiers for the Internet, which are
  - a. Domain names (forming a system referred to as "DNS");
  - b. Internet protocol ("IP") addresses;
  - c. Autonomous system ("AS") numbers; and
  - d. Protocol port and parameter numbers.
2. Coordinates the operation and evolution of the DNS root name server system.
3. Coordinates policy development reasonably and appropriately related to these technical functions.

ICANN is dedicated to preserving the operational security and stability of the Internet; to promoting competition; to achieving broad representation of global Internet communities; and to developing policy appropriate to its mission through bottom-up, consensus-based processes.

ICANN does not set policy for the Internet. Rather, it manages the process to facilitate a multi-stakeholder collaborative policy building effort. Please go to [www.icann.org](http://www.icann.org) for more information on its processes and scope of activities.

### **1.3 Overview of the new gTLD Program and the TM PDDRP**

If you surf the Internet today, you will most likely access an Internet site from one of the 22 generic Top Level Domains (“gTLD”) on the Internet. Examples of gTLDs include .COM, .ORG, .NET, and .GOV (a complete listing of all gTLDs is available at <http://www.iana.org/gtld/gtld.htm>).

Since ICANN was founded fifteen years ago as a not-for-profit, multi-stakeholder organization dedicated to coordinating the Internet's addressing system, one of its foundational principles has been to promote competition in the domain name marketplace while ensuring Internet security and stability. Following these principles, a policy to introduce new gTLDs, to allow more innovation, choice and change to the Internet's addressing system was developed by ICANN's Generic Names Supporting Organization (GNSO) in 2007 and adopted by ICANN in June, 2008.

This decision was not made overnight. A detailed and lengthy consultation process with all constituencies of the global Internet community including representation by a wide variety of stakeholders – governments, individuals, civil society, business and intellectual property constituencies, and the technology community was followed. Contributing to this process were ICANN's Governmental Advisory Committee, At-Large Advisory Committee, Country Code Names Supporting Organization, and Security and Stability Advisory Committee.

Since the beginning of the idea to expand gTLDs, there have been a number of concerns from various constituencies of the global Internet community regarding the potential increase in risks that users, businesses, and other organizations face today as they use the Internet. Individuals, organizations, and brand owners are exposed to malicious behaviors such as spamming, phishing and/or infringing websites. For brand owners, there are often infringing websites that monetize off the value and goodwill of the brand and may distribute counterfeit goods, malware, malicious software or illegal content. The New gTLD Program has incorporated rights protections mechanisms to help mitigate concerns raised that brand owners might face increased exposure to improper conduct.

Specifically, ICANN's Board directed the intellectual property constituency to form an Implementation Recommendation Team (“IRT”), which was asked to identify and proposed solutions for the potential risks to brand owners. The IRT made several recommendations. One such recommendation was the implementation of a Trademark Post-Delegation Dispute Resolution Procedure as a supplement to other safeguards, both existing and foreseen.

As described in the IRT's report, the purpose of this procedure is to address situations where the Registry Operator's manner of operation or use of a TLD lead to or supported infringement of trademark rights either on the top-level or on the second level.

The TM PDDRP can only be used when a complainant has first approached the Registry Operator in good faith without achieving redress and a complaint will then only be accepted if it

passes a threshold review test. Once a TM PDDRP process has been completed with a finding in favor of the Complainant, the TM PDDRP Determination will include a suggested remedy, the implementation of which is left for ICANN's decision and enforcement.

## Section 2.0 Objectives and Requirements

### 2.1 Objectives

ICANN desires to engage one or more providers of TM PDDRP services to provide cost-effective and timely mechanisms for brand owners to protect trademarks. The process will focus strictly on cases in which there are allegations of Registry Operator complicity in trademark infringement on the first or second level in a new gTLD.

In this multi-step process, ICANN is seeking expressions of interest from entities that can demonstrate that they meet the Required Experience and TM PDDRP Specific Requirements set forth below.

### 2.2 Required Experience

ICANN expects that respondents will, at a minimum, satisfy the following experience requirements:

1. Possess a thorough knowledge of the TM PDDRP, its purpose and intended function
2. Have a demonstrated ability to handle administrative proceedings in an expedited, global, online context in an orderly and fair manner.
3. Have a track record in competently handling clerical aspects of Alternative Dispute Resolution or Uniform Dispute Resolution proceedings.
4. Have a team of globally diverse and highly qualified neutrals, with experience handling UDRP complaints or trademark-related disputes, to serve as panelists.
5. Have the ability to scale to meet the demands of an unknown number of complaints while meeting the time requirements to resolve complaints.
6. Have a demonstrated understanding of the workings of policy and uniform rules.
7. Have a demonstrated understanding of global intellectual property rights on the Internet.

## 2.3 TM PDDRP Specific Requirements

As the TM PDDRP will be mandatory in all registry agreements for new gTLD registries, Respondents to this RFP must demonstrate how they will manage to the specific TM PDDRP requirements, which include, but are not limited to:

1. Establishing a burden of proof evaluation analysis for TM PDDRP consideration, such analysis should be by “clear and convincing evidence” for either the top-level or the second level registrations
2. Integration with a centralized database to ensure all TM PDDRP determinations are recorded and searchable
3. Creating a payment account system that allows complainants to fund TM PDDRP filing fees in multiple currencies
4. Timely notifying relevant parties of an initiated complaint
5. Establishing an initial examination process, including a “threshold” review, to validate complaints prior to proceeding to the merits of a dispute
6. Providing a mechanism allowing the Registry Operator to timely respond to a complaint
7. Coordinating, as needed, with qualified legal experts with experience in UDRP or trademark related judicial proceedings
8. Establishing a process for notifying ICANN of TM PDDRP determinations with recommended remedies
9. Establishing a process to monitor TM PDDRP abuse from brand owners and others
10. Establishing an Examination Appeals process
11. Establishing a process to determine if appeals have been filed in a court of competent jurisdiction
12. Operating the TM PDDRP on a cost efficient basis, and preferable on a cost-recovery basis
13. Evidence of Errors & Omissions Insurance in an amount of not less than \$1,000,000.

## Section 3.0 Required Response Items

### 3.1 Company Information and Background

- Respondents must provide the following information regarding the organization:
  - Name
  - Street Address
  - City, State & Zip
  - State/Country of Incorporation
  - Phone
  - Fax
  - Website
- Please indicate if the organization is a subsidiary of any other company?
  - If so, please indicate the parent company and how you are managed by the parent (actively or autonomously)
- List the responding organization's Directors, as well as Officers and their titles
- Please indicate if you are an affiliate of any ICANN accredited registrar, registry or other contracted party or have any ownership interest in any ICANN accredited registrar, registry or other contracted party with ICANN
- Please indicate if you provide any advisory or consulting services to proposed Applicants or back-end registry providers interested in applying for new gTLDs.

### 3.2 Proposal Summary

- What characteristics most distinguish your organization from your competitors?
- Summarize the key points of the proposal including the benefits to the internet community of engaging your organization

### 3.3 Qualifications & Approach

- Provide an overview of the global resources of your organization
- Provide examples of any relevant thought leadership, industry participation, and publications that highlight your experience
- Describe your organization's qualifications to deliver the required TM PDDRP services including addressing the experience requirements of panelists as specified in 2.2 and 2.3 above and in the TM PDDRP section 13.
- Identify the internal processes which keep your organization abreast of relevant industry issues/trends including any thoughts on keeping the public informed of new trends related to cybersquatting and intellectual property abuse over the Internet
- Describe the communication processes that will keep ICANN, the Complainant(s), the Registrants, Registry, and the public timely informed of complaints
- Describe the internal processes to be followed, including guiding principles, critical events, and quality control mechanisms.
- Describe the team that will manage and administer the TM PDDRP. Please include:
  - The organizational structure of the team
  - Roles and responsibilities for each key team member
  - The name and description of any organizations that will participate in the delivery of the services
  - The CVs of key team members in an Appendix

## Section 4.0 Instructions to Respondents

### 4.1 Definition of Respondent

“Respondent” means any person or firm receiving this RFP or submitting a proposal in response to this RFP.

### 4.2 Timeline

The following dates have been established as milestones for this RFP. ICANN reserves the right to modify or change this timeline in its absolute discretion.

This is a general timetable for the written proposal process, and possible oral presentations.

Request for proposals issued	30 April 2013
Respondents' Q&A – Teleconference	21 May 2013
Written proposals (Expressions of Interest) due	31 May 2013
Oral presentations to Selection Committee	mid-June 2013
Selection/appointment of one or more TM PDDRP Providers	25 June 2013
Public announcement of selection	30 June 2013

### 4.3 Pre-Proposal Question and Answer Session

A pre-proposal meeting/conference call (Respondents' Q&A – Teleconference) will be held for all prospective respondents on 21 May 2013. Please confirm your attendance by emailing [TMPDDRP-EOI@icann.org](mailto:TMPDDRP-EOI@icann.org).

### 4.4 Submission of Initial Expressions of Interest

Expressions of Interest shall be prepared and submitted as requested by this RFP. Your written submission should include explanations of how you will meet the Experience Requirements contained in 2.2 above and how you will satisfy the TM PDDRP Specific Requirements contained in 2.3 above. For ease of evaluation, please limit your response to no more than 15 pages, plus necessary appendices, including team resumes. Please arrange to have an electronic copy delivered to [TMPDDRP-EOI@icann.org](mailto:TMPDDRP-EOI@icann.org) by 23.59 UTC on 31 May 2013.



#### **4.5 Discrepancies, Omissions and Additional Information**

Respondent is responsible for examining this RFP and all addenda. Failure to do so will be at the sole risk of Respondent. Should Respondent find discrepancies, omissions, unclear or ambiguous intent or meaning, or should any question arise concerning this RFP, Respondent must notify ICANN of such findings immediately in writing via email no later than three (3) days prior to the deadline for bid submissions to [TMPDDRP-EOI@icann.org](mailto:TMPDDRP-EOI@icann.org).

Should such matters remain unresolved by ICANN, in writing, prior to Respondent's preparation of its submission, such matters must be addressed in Respondent's Expression of Interest.

ICANN is not responsible for oral statements made by its employees, agents, or representatives concerning this RFP. If Respondent requires additional information, Respondent must request that the issuer of this RFP furnish such information in writing.

A Respondent's submission is presumed to represent its best efforts to respond to the RFP. Any significant inconsistency, if unexplained, raises a fundamental issue of the Respondent's understanding of the nature and scope of the work required and of its ability to perform the contract as proposed and may be cause for rejection of the proposal. The burden of proof as to cost credibility rests with the Respondent.

#### **4.6 Receipt and Opening of the Proposal.**

Proposals will be received by ICANN at the address shown above until the date and time shown herein. Proposals will be opened only in the presence of ICANN personnel and consultants as required for proposal evaluation.

#### **4.7 Proposal Evaluation and Selection of Providers**

ICANN will evaluate Respondent's proposal and other pertinent information to arrive at a provisional award decision. Respondent's entire proposal will be reviewed for responsiveness to the RFP and for clarity and conciseness of the information presented. ICANN will review the information presented to determine which proposals best meet the TM PDDRP criteria. Respondents may be asked to submit updates to their original proposals. The proposals will then be evaluated by a Selection Committee, using a comprehensive set of criteria. Each proposal will be evaluated on the basis of its technical, management and cost merits after a review of all aspects of each category in relationship to the requirements of this RFP. The ultimate basis for selection will be in the absolute discretion of ICANN.

A partial list of the evaluation criteria follows:

- Is the Respondent's proposed solution capable of meeting the objectives and requirements set forth in this RFP?
- Are the Respondent's experience and capabilities clearly stated in the proposal?

- Does the Respondent have the experience to run such a program?
- Is the approach clear and does it meet the TM PDDRP requirements?
- Has the Respondent demonstrated an ability to scale as necessary?
- Is the requested proposal complete and in the format requested?

Proposals are required to be valid for a minimum of one hundred twenty (120) days following the deadline for submission of the proposal. A proposal may not be modified, withdrawn or canceled by the Respondent for a 120-day period following the deadline for submission of the proposal. The Respondent so agrees to this condition by submission of the proposal.

#### **4.8 Ownership of Documents**

All supporting documentation submitted by the Respondent with a proposal shall become the property of ICANN unless the Respondent specifically requests **in writing** that the documentation be returned.

#### **4.9 Disclaimer**

This RFP shall not be construed in any manner to create an obligation on the part of ICANN to enter into any contract, or to serve as a basis for any claim whatsoever for reimbursement of costs for efforts expended. The scope of this RFP may be revised at the sole option of ICANN at any time. ICANN shall not be obligated by any proposals or by any statements or representations, whether oral or written, that may be made by ICANN. ICANN shall be held free from any liability resulting from the use or implied use of the information submitted in any proposal. Submission of a proposal shall constitute Respondent's acknowledgment and acceptance of all the specifications and requirements in this RFP.