

Martin Müller

From: Jonas Koelle/EMD/Merck
To: Contact Information Redacted
Cc: Martin Andre/EMD/Merck
Date: 06.12.2013 13:43
Subject: ICANN's position on WIPO determinations WIPO-LRO2013-0009, WIPO-LRO2013-0010, and WIPO-LRO2013-0011

Dear Amy, dear Allen,

I wish to thank you for your time in Buenos Aires and the fruitful discussions we had about the ICANN policies and procedures and its interpretation through the various providers and panellists dealing with our applications for new gTLDs.

In the meantime there had been further progress at the ICC as they have reviewed the MSD community objections against our two gTLD applications and on December 3, 2013 reconfirmed its original refusal to accept MSD's objection. Referring to the message received from Allen we now would expect further progress for our application .EMERCK and we are looking forward to receiving the ICANN contract.

I further wish to refer to our discussion about the lack of fundamental principles of law in context of the WIPO decisions in our objection cases WIPO-LRO2013-0009, WIPO-LRO2013-0010, and WIPO-LRO2013-0011.

You mentioned that it might be possible to file a Request for Reconsideration process in this context. The underlying recommendations were issued by a WIPO panelist in the context of the LRO dispute procedure, and contain serious errors of fact and law amounting to a violation of fundamental due process.

The WIPO Panel has incorrectly assessed the cases on the basis of the Uniform Domain Name Dispute Resolution Policy (UDRP) jurisprudence and thus only assessed whether the potential use of the applied-for gTLD by the Applicant MSD would take unfair advantage of the distinctive character or the reputation our registered or unregistered trademarks by using of the gTLD in "bad faith". However, the LRO regulations specifically require the arbitration panel to affirmatively assess whether the expected use of a gTLD according to the gTLD application made at ICANN is likely to infringe on third party's intellectual property rights. This WIPO has not done in our case, although it has in the *Del Monte* case. In other words, WIPO has abdicated the responsibility conferred on it by ICANN to rule on the substance of our objections.

Moreover, WIPO has based its expert determination on the expectation that Applicant MSD undertook to take all necessary measures, including geo-targeting to avoid infringement of our rights and internet users' confusion where we have exclusive rights to the trademark Merck. But in fact, only we have committed to this course in our application, whereas in its application MSD has made absolutely no provision for geo-targeting but rather made clear it will not take such steps should the contested TLDs be delegated to its control.

We contacted WIPO shortly after the issuance of the instant recommendations, in order to address our concerns, which WIPO communicated to the appointed expert. However, in his answer the panelist again refused to apply the LRO standards and failed to reconsider the case on the basis of the correct facts.

The Reconsideration Request, which is codified in the ICANN Bylaws, specifically states that the procedure may be used to challenge the "actions or inactions" of ICANN staff or of the ICANN Board. We discussed the difference between ICANN board and staff actions as referred to in the ICANN Bylaws and actions of the ADR providers during our meeting in Buenos Aires.

As noted, under the ICANN Bylaws, it is clearly stated that staff and ICANN Board actions are subject to review under the procedure. There is however nothing in the Applicant Guidebook indicating whether third-party "vendors," such as the various ADR providers, fall into the category of "staff" or "ICANN Board." Moreover the website of ICANN contains a section for the ICANN staff not mentioning any of the third-party vendors in this context.

Under ICANN's Applicant Guidebook, the expert determinations of ADRs are only recommendations to the attention of ICANN, so that they should logically always be formally endorsed by ICANN to be in full force and effect. We have however not yet received any confirmation from ICANN that it formally approved or endorsed the above mentioned WIPO recommendations.

You mentioned and we have now noticed that the expert determinations have been published on the ICANN website. However, there is no indication whether this is done following a formal endorsement of such determinations by ICANN, which obviously leaves uncertainty as to the legal validity of such determination under ICANN's Bylaws.

In any case, even if such a public communication was to be considered as some sort of official endorsement of the WIPO recommendations on behalf of ICANN, such endorsement had not been communicated to us as the affected party. Such communication in form of mere publication would fail to comply with commonly accepted fundamental procedural rights, which comprise the obligation to be individually notified of a decision affecting oneself and the obligation to indicate the available recourses, such as ICANN's Reconsideration request process.

In case ICANN has decided that it would appear appropriate that a Request for Consideration be available following a ADR expert determination, such determination being considered as decisions of the "staff" or Board of ICANN, such decision must be communicated by ICANN as otherwise, applicants could easily be deprived from their right to file a Request for Reconsideration against, which would be particularly chocking in cases like ours, where the decision of an ADR provider contains serious errors of law and facts.

Accordingly, I am contacting you to ask whether ICANN has to your knowledge formally adopted the determinations of the WIPO expert in the above mentioned WIPO recommendations and if not, what would be your advice for us to ensure that such WIPO determinations become indeed endorsed decisions of ICANN, so that we can file a Request for Reconsideration to address the aforesaid factual and legal errors contained in such determinations.

I will await your guidance in this matter, and will remain available should you require any additional information.

Thanking you in advance for your support!

With best regards,

Jonas Kölle
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Director | Head of LE-TB
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