

Proposed Example Principal Terms of Intellectual Property Agreements

This draft relates to a possible use of the IETF Trust as an independent entity to hold IANA-related IPR. ~~The IETF Trust is one of the discussed alternative holders of IPR.~~

~~This non-binding draft has been prepared in order to assist in discussion only. No offer to enter into a binding agreement is expressed or implied herein. The IETF Trust has provided this draft as a hopefully helpful initial contribution, but clearly discussion in the various communities and further work is needed. Comments are appreciated.~~

A. Background

The ICG proposal¹ indicates that the IANA trademark and iana.org domain should be transferred to an entity independent of the IANA Numbering Services Operator. ~~The CWG has also agreed² that the IANA trademarks and domains should be transferred to an entity independent of the IANA Functions Operator. The IANA trademarks and domains consist of three IANA trademarks registered with the US Patent & Trademark Office ("Internet Assigned Numbers Authority", "IANA" and the IANA logo) and three IANA-related domain names (iana.org, iana.net, and iana.com) (collectively, the "IANA IPR").~~

The IETF Trust (the "Trust") would be a potentially acceptable candidate for this role, ~~and the Trust has discussed the implications of assuming this responsibility.~~ The following is ~~some background of the Trust's position and~~ an overview of how the role and responsibilities could be fulfilled by the Trust.

~~While this fulfillment is a part of implementation rather than the ICG proposal, the IETF Trust wants to ensure progress on determining those implementation steps. The Trust is of course only one of the possible ways to satisfy the requirements from the ICG proposal. Nevertheless, the Trust wanted to start by suggesting an overall framework for one way of satisfying the requirements.~~

The IETF Trust is a Virginia USA private or "common-law" trust,³ the trustees of which are the members of the IETF Administrative Oversight Committee (IAOC), and the beneficiary of which is ~~the IETF community "the IETF as a whole."~~⁴ The purpose of the IETF Trust includes acquiring, holding, maintaining and licensing certain existing and future intellectual property and other property used in connection with the Internet standards process and its administration, for the advancement of the science and technology associated with the Internet and related technology.⁵

B. Framework

The Trust and the operational communities believe theres it would need to be enter into three different types of agreements to ~~effect the transfer of~~ the IANA IPR from ICANN to the Trust intellectual property

Comment [1]: Could we define "IANA IPR" earlier, perhaps even in the preamble, and then say "The CWG has agreed that the IANA IPR should be transferred ..."?

Comment [2]: Could we define "IANA IPR" earlier, perhaps even in the preamble, and then say "The CWG has agreed that the IANA IPR should be transferred ..."?

Comment [3]: Could we define "IANA IPR" earlier, perhaps even in the preamble, and then say "The CWG has agreed that the IANA IPR should be transferred ..."?

Comment [4]: Could we define "IANA IPR" earlier, perhaps even in the preamble, and then say "The CWG has agreed that the IANA IPR should be transferred ..."?

Comment [5]: Do we have a definition of "operational communities"?

¹ [IANA Stewardship Transition Coordination Group \(ICG\). Proposal to Transition the Stewardship of the Internet Assigned Numbers Authority \(IANA\) Functions from the U.S. Commerce Department's National Telecommunications and Information Administration \(NTIA\) to the Global Multistakeholder Community, October 2015. <http://www.ianacg.org/icg-files/documents/IANA-transition-proposal-v9.pdf>](http://www.ianacg.org/icg-files/documents/IANA-transition-proposal-v9.pdf)

² [<insert reference to CWG decision>](#)

³ [In a common-law trust, the trustees have legal ownership of the trust assets, but the beneficiary has beneficial ownership \(i.e., the beneficiary owns the benefits associated with the assets\).](#)

⁴ [If the IETF stops developing technical standards for the Internet, then the IETF's successor with respect to the development of technical standards for the Internet will become the beneficiary, if approved by the IESG or its successor. IETF Trust Agreement, Section IV http://trustee.ietf.org/trust-agreement-2014.html.](http://trustee.ietf.org/trust-agreement-2014.html)

⁵ <http://trustee.ietf.org/trust-agreement-2014.html> clause 2.1

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~~(IP), to hold the IANA IPR and to enter into a licensing arrangements with the IANA IPR to the IANA service provider(s), specifically-~~

~~These agreements include:~~

- ~~1. An Assignment Agreement between ICANN (as "Assignor") and the IETF Trust (as "Assignee") transferring the IANA IPR to the IETF Trust;~~
- ~~2. Community Assurance-An agreement or aAgreements between the IETF Trust and each of the names,⁶ numbers, and protocol communities (the IANA communities) regarding the relationship between the Trust and each community and the relationship among the communities, including the Trust's commitments, duties and obligations to each community; as further described below, and~~
- ~~3. A License Agreement(e) whereby the IETF Trust grants to ICANN with the right (as the post-transition IANA service provider) the right to use the IANA IPR provides for the use of the iana.org domain, or a subdomain, and licenses the use of the IANA trademarks to the IANA service provider(s) selected by the IANA communities. If, at some future time, one of the identifier communities should contract to another party ("IANA service provider") for administrative services for their respective IANA registries, it will be necessary for that a similar license agreement be entered whereby the IETF Trust to grants the right to use the IANA IPR to that IANA service provider.~~

~~The principal terms of each of these agreements are described below. The Trust understands that each community would need to follow its own internal processes before entering into any agreements, or selecting an IANA service provider. The same is true of the Trust itself.~~

~~The Ccommunity Assurance Agreement(s) with the IANA communities would establish and recognize the right of responsibilities for each operational community to identify (and enter into agreement with, if applicable) their selected IANA service provider, and the obligation offer the IETF Trust to provide, update, and revoke licenses as needed to support these selections.~~

~~In order to perform the tasks required of a trademark owner and to preserve the value and integrity of the IANA trademarks, the IETF Trust would maintain the trademark registrations, license the marks and monitor the quality of the services offered under the marks and the use of the trademarks. Trust actions would include enforcement against unauthorized users and engaging in monitoring the quality control of the services provided and uses by the licensed user(s). The community agreement(s) would also govern how the Trust and would work with the relevant IANA communities would work together to perform quality control and to address issues involving a licensee before taking action to resolve a quality issue or other breaches of the license agreement(s) maintain the quality of the trademarks. The community agreement(s) would also specify how and to what extent the communities control actions of the Trust, including how they each would hold the Trust accountable for its performance.~~

~~The Trust would also serve as the registrant for the IANA domain names. [INSERT BRIEF SUMMARY HERE; LONGER DESCRIPTION BELOW.]~~

⁶ ~~The names community will need to identify an appropriate legal entity to enter into this agreement on behalf of the names community.~~

Comment [6]: (text from John Curran)

Comment [7]: "operational communities" may be better than "identifier communities"

Comment [8]: (text from John Curran)

Comment [9]: "operational communities" may be better than "identifier communities"

C. Terms

The following ~~are key~~ ~~contains examples of the~~ principal terms that ~~will may need to~~ be included in ~~the~~ such agreements ~~outlined above should the community desire for the IETF Trust to take on the role of the Independent Entity. This non-binding draft has been prepared in order to assist in discussion only. No offer to enter into a binding agreement is expressed or implied herein.~~

1. IP ~~Assignment~~Transfer Agreement (between ICANN and IETF Trust)⁷

- a. ~~When requested by the IETF Trust, ICANN and the Trust will~~ enter into an Assignment Agreement, effective upon the IANA Transition, to transfer and assign all of its right, title and interests in and to the IANA IPR, including all goodwill appurtenant to the IANA trademarks therein, to the IETF Trust (the "Transfer"). The IETF Trust will not assume any obligations or liabilities of ICANN that arose prior to the effective date of the Transfer (the "Transfer Date").⁸
- b. ICANN will file all necessary assignment documentation with all local, national and regional offices in which the IANA IPR is registered including, without limitation, the U.S. Patent and Trademark Office and the registrar for the IANA domain names iana.org (GoDaddy), and will pay all fees associated with such filings. With respect to the IANA iana.org and any other domain names ~~within the IANA IP~~, the IETF Trust will be designated as the administrative contact with the registrar.
- c. ICANN will make customary representations and warranties to the IETF Trust regarding title to the IANA IPR, absence of actual or threatened litigation, the existence of any licenses or other encumbrances on the IANA IPR, and non-infringement of third party rights, all qualified by the knowledge of ICANN's in-house legal department.
- d. ICANN will indemnify the IETF Trust, PTI and any future licensee of the IANA IPR against any liability associated with use of the IANA IPR prior to the Transfer Date. The IETF Trust will indemnify ICANN and any prior licensee of the IANA IPR against any liability associated with use of the IANA IPR after the Transfer Date to the extent that IETF Trust receives a comparable indemnity from PTI or its successor entity.

Comment [10]: We should have a definition of "IANA Transition"

Comment [11]: Confirm whether this is correct.

Comment [12]: Not just the admin contact, right? It's the registrant, actually, that needs to change. I think in fact the admin and tech contacts could be ICANN, to satisfy Steve Crocker's worry about control transfer. We may also need to find a different registrar, since I don't believe GoDaddy allows the granular control that is necessary for operational stability Steve has worried about.

2. Community ~~Assurance~~ Agreement(s) (between IETF Trust, IETF, RIRs, and the names community)

- a. This Agreement will ensure that the IETF Trust holds and licenses the IANA IPR in a manner that is agreed with the IETF, RIRs and the names community.
- b. For purposes of this Agreement, the RIRs, the IETF and the names community will each select [five (5)] representatives (the "IANA IPR Reps") to serve on an IANA IPR Governance Council ("IIGC"). ~~One a single~~ Representative from each community will be designated to be a co-chair of the IIGC and the primary point of contact with the IETF Trust. The IIGC will provide advice and approvals to the Trust on matters pertaining to the IANA IPR, and the representatives of each community will provide advice and

Comment [13]: I can live with this, and I appreciate that for ICANN purposes 5 may be the right number. But a council of 15 is rather large, I'd say, and if we could whittle it down to something more manageable I think that'd be nice.

Comment [14]: I've bracketed this for discussion. I was actually thinking of the RIRs when I put in the number 5. I think 3 per community is probably more manageable.

Comment [15]: I prefer 3. I think that 5 is too many.

Comment [16]: I think 3x5 is too many. I'd prefer 3 or even smaller number -- the communities can still name their rep at the a manner of their choosing. FWIW, 3x2 would be 6 and a small enough team to have actual discussions.

⁷ ICANN legal will need to review and comment on this.

⁸ We should determine if there are any specific obligations or liabilities.

approvals to the Trust on matters pertaining uniquely to that community, collectively the "IANA IP Reps".

c. The IETF Trust will hold, maintain and renew the IANA IPR in accordance with good IPR management best practices and shall seek new territorial registrations of the trademarks and additional domain name registrations based on the IANA IPR as instructed by the IIGC/IANA IP Reps.

d. The IETF Trust will license the IANA IPR to PTI and any successor provider(s) of the IANA functions identified by the IANA IPR Reps for one or more communities. Such license shall include the provisions described in Part III below. The IETF Trust will terminate the license to PTI or any successor in whole, solely upon the instructions of the IIGC or in part, solely upon the instructions of the relevant IANA IPR Reps.

d.e. The community agreement(s) will also include an agreement whereby the Trust delegates some or all of its quality control duties to the communities in accordance with each community's practice and method of maintaining oversight and control over the quality of services provided to that community. Notwithstanding such delegation, the Trust will still have the ultimate responsibility for quality control.

3. IANA IPR License Agreement (between IETF Trust and PTI and/or future IANA service providers)

a. The IETF Trust will grant PTI an non-exclusive, worldwide, royalty-free license, without the right to sublicense, to use, display and reproduce the IANA marks in connection with its provision and marketing of the IANA functions. If PTI is replaced as a service provider by one or two communities while being retained by one or two communities, the license will be partially terminated and shall be converted to a non-exclusive license, provided that the Trust will not have the right to use, display or reproduce the IANA marks.

b. PTI will agree that all services offered under the IANA marks will be of a consistent quality at least equal to the quality of services offered by ICANN immediately prior to the transition. The trust will be responsible for monitoring and controlling the quality of PTI's goods and services, including approvals of any material changes to such services, but may delegate such responsibility to each community with regard to services offered to that community. However, the Trust will still be ultimately responsible for such quality control.

b.c. All use of the IANA marks shall be in accordance with mutually-agreed quality requirements, as well as size, color, placement and similar guidelines to be agreed.

d. The IETF Trust will authorize PTI to operate via the iana.org domain and any number of sub-domains. IETF Trust shall appoint PTI as the technical contact for the iana.org domain during the term of the agreement. PTI shall use iana.org and all associated subdomains exclusively for purposes related to offering the IANA functions.

d.e. All goodwill arising from use of the IANA IPR will inure to the benefit of the IETF Trust, and PTI will not register or reserve any mark that contains, is identical or

Comment [17]: "operational communities"?

Comment [18]: What if the Trust's duty for quality control detects a problem, but the IIGC or the relevant community IIGC people refuse to permit an action?

Comment [19]: There is an escalation procedure described at the end of the document.

Comment [20]: (text from John Curran)

Comment [21]: We need to discuss the implications of exclusive versus non-exclusive, and especially the text later in this paragraph "provided that the Trust will not have the right to use, display or reproduce the IANA marks"

Comment [22]: Given this restriction, why not make the license non-exclusive with this restriction in the first place, but with only one license holder to start with? In that case, no termination is needed during a new IFO set-up, which makes future action less work.

Comment [23]: A non-exclusive license is not the right "flavor" of license now or in the foreseeable future. It would also not be the right flavor if ICANN is replaced in its entirety by a new IANA Functions Operator. The only time it might be appropriate is if the functions are ...

Comment [24]: How does this interact with the issue that the IETF's agreement is with ICANN, not PTI? Don't we need two licenses ...

Comment [25]: Good question. I would say that ICANN itself does not need to use the IPR and therefore it does not need a license to th ...

Comment [26]: PTI doesn't yet exist, so we may need to deal with that.

Comment [27]: (This comment is from Jari Arkko, but I have no access right yet with jari.arkko@gmail.com...) I do not understand ...

Comment [28]: Could we give an objective measure? Or at least explain which "transition" we are talking about, so that readers many ...

Comment [29]: What about the other IANA domains? iana.com and iana.net

Comment [30]: I think in here is also where we want the assurance that the Trust can't change the delegation data without ICANN's ...

Comment [31]: Thanks -- anything you can insert to flesh out the domain name related terms would be helpful. I think you had an ...

Comment [32]: I expect ICANN to require operational control, at least for as long as ICANN/PTI is the only IANA operator. I am r ...

Comment [33]: We need to address future transitions to other IANA operators

confusingly similar to any IANA mark in any jurisdiction, whether as a trademark, service mark, trade name or domain name.

- e-f. ~~The IETF Trust will be responsible for enforcing have the sole right to enforce~~ the IANA marks against infringers, at its expense. ~~All decisions regarding enforcement shall be approved by the IIGC or by the relevant IANA IPR Reps. Each party~~ PTI will use reasonable efforts to notify ~~the other party and the IIGC~~ IETF Trust of any such infringement that comes to its attention. IETF Trust will be entitled to retain all damages received as a result of its enforcement of the IANA marks, ~~after the expense of PTI, IIGC, the operational communities and the Trust are reimbursed on a pro rata basis.~~
- f-g. ~~If the IETF Trust believes that PTI has materially breached the agreement, the Trust will confer with the IIGC regarding a course of action. If agreed with the IIGC, the Trust will provide notice of the breach to PTI along with a reasonable opportunity to cure the breach, for a period of no less than 60 days. If the breach is also a breach of an agreement between an operational community and ICANN or PTI or a failure under relevant operational guidelines, the Trust and the relevant IANA IPR Reps will coordinate handling of the breach. If PTI can't cure the breach within this period, PTI, the Trust and the IIGC (or the relevant IANA IPR Reps) will enter into an escalation procedure, beginning with executive consultation followed by mediation. If the breach is still not cured by PTI, the Trust may request that the relevant operational community or communities begin the process to engage a new IANA service provider. The community or communities will start the procedure (but if they disagree with the Trust, they will confer to reach a mutually acceptable resolution. When the relevant community selects a new IANA service provider, this agreement will be terminated with regard to the relevant services simultaneously with the execution of a license to the replacement service provider. The Trust is not be entitled to terminate the agreement in the event of a, without penalty, following a material breach by PTI which is not cured within 30 days following notice thereof, an insolvency or bankruptcy event by PTI, or the involvement of PTI or any of its officers or directors in any criminal, civil or regulatory proceeding or investigation that is likely, in IETF Trust's opinion, to tarnish the IANA marks or the reputation of IETF, the termination, expiration or non-renewal of the PTI Service Agreement(s), or upon the express instruction of the IANA IP Reps.~~
- g-h. ~~Upon termination of~~ If the agreement ~~is terminated in its entirety,~~ PTI will immediately cease all use of the IANA IPR ~~and shall transfer technical control of the iana.org domain to its successor or successors~~ the IETF Trust, ~~subject to any transition period agreed between the community or communities and PTI. If the agreement is partially terminated, PTI will immediately cease all use of the IANA IPR related to the terminated services and will transfer technical control of the relevant subdomain(s) to the successor licensee.~~

Comment [34]: I am uncomfortable with language here. The Trust's role should be to inform the communities that there's an issue with IPR usage, and to move licenses as needed. However, the decision that a new operator is needed needs to be from the communities -- perhaps inspired by information from the Trust, but still.