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**VIA EMAIL**

Mr. Peter Dengate Thrush  
Chairman of the Board of Directors  
Dr. Paul Twomey  
President and CEO  
ICANN  
4676 Admiralty Way, Suite 330  
Marina del Ray, CA 90292

**April 10, 2009**

Dear Mr. Dengate Thrush, Dr. Twomey and the Board of ICANN:

MarkMonitor Inc. ("MarkMonitor") appreciates the opportunity to submit these detailed comments relating to the distinct modules of the Applicant Guidebook Version 2 ("DAG").

MarkMonitor is the world's largest corporate domain name registrar, providing services to over 50 Fortune 100 companies, as well as 5 of the top 10 most popular Internet sites in the world.

In December of 2008, MarkMonitor submitted comments on version 1 of the Applicant Guidebook. Although a number of our comments were addressed, our comments related to the protection of rights holders were not. We understand that the newly created Implementation Recommendation Team (IRT) will work to develop and propose solutions to the overarching issue of trademark protection in connection with the introduction of new gTLDs. We are hopeful that this team will identify policy, processes and requirements to improve trademark protection as related to the introduction of new gTLDs, including where such protection contributes to the safety and security of the Internet.

We also trust that the IRT will work diligently to identify and propose solutions to address trademark protection issues that are of low or no-cost to brand owners at both the top and second levels. However, trademark protection is only one of the four "overarching issues" which must be addressed. Thus, further substantive changes and enhancements to the gTLD program and DAG are also required.

Below are detailed comments to the DAG and the Base Agreement prepared by MarkMonitor:

**Comments on 'Module 1'**

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**Section 1.1 – Creation of a gTLD Reserved Name List**

An automatic "Reserve Name List" should be created for global brand owners. To be placed on this list, the global brand owner must have a trademark that is registered in multiple international jurisdictions. At least one of these jurisdictions must have a stringent examination review process for trademark registrations. Under this mechanism, registry applicants would be required to check the "Reserve List" as a resource before proposing a top level string, and names that

are exactly alike, or confusingly similar to a name on the Reserve Name List should be summarily rejected. The database of reserved names can be operated and/or maintained by a third-party, however, ICANN must retain ultimate responsibility and accountability for its provision and use. There must also be an appropriate challenge procedure for seeking the removal of a name from this Reserve Name List.

## **Section 1.2.2.1 - Allow a New Designation for Single-Purpose or Sponsored gTLDs**

There are numerous rights holders with potential gTLDs that share substantially the same or similar attributes of a community gTLD. These gTLDs do not share the attributes of an open gTLD given that they are not available for registration by any potential registrant. Examples would include service and broadband providers, industry-wide professional associations, and social networking sites. These rights owners should be recognized for the communities they represent, and as such should receive the protections of a sponsored application.

## **Comments on 'Module 2'**

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### **Section 2.1.2.2 - Ability to Provide Missing, Incomplete or Incorrect Application Information**

The application process entitles applicants to only one exchange of information if clarification is required. This is an extremely inflexible procedure given the level of commitment made by the applicant. ICANN should therefore allow for additional exchanges of information. In addition, although specified channels for receiving updates about applications have been identified as a requirement in version 2 of the Applicant Guidebook, this is not an appropriate mechanism for providing additional or clarifying application information. Given the high cost of the application fee, and the complexity of the process for most applicants, this provision should be amended to allow a more structured communication channel between applicants, evaluators and ICANN.

## **Comments on 'Attachment to Module 2'**

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### **New Potential Questions to be Added re: Moral and Legal Standing**

In addition to the requirement for proof that the applicant entity is 'legally established and in good standing,' it is essential that thorough investigative checks of applicants including board members, executives, funding sources, etc. be conducted in order to identify any involvement by those who seek to control a registry in criminal activities, or any wrongful activities associated with the domain name industry. To that end, examples of some questions that can be asked to elicit the above information are:

"Have you been convicted of a felony? If so, please explain.

"Have you or any company that you have been associated or affiliated with or been the subject of an action (court case or any dispute resolution proceeding) as a defendant in connection with any domain name related matter.

Applicants that have significant or repeated ties to illicit or wrongful activities should not be allowed to proceed through the process. Falsification of, providing misleading or omitting data should result in application disqualification, or, in the case of a delegated registry, it should be re-delegated when such is discovered.

## **Question 43 - Standardizing ‘Measures Against Abuse’**

Although the questionnaire does address ‘Measures Against Abuse,’ allowing registries to define their own policies for policing, managing and remediating is too vague. Measures to mitigate abuse should be mandated by ICANN so that they can be fully vetted and standardized. There appears to be industry support for a group similar to the IRT which would assist in establishing and developing draft proposals, including an effective mechanism for insertion in registry contracts to deal with malicious conduct as opposed to trademark protection mechanisms.

## **Question 45 - Requirement for a “Thick” Whois Model**

ICANN is considering assigning more points for registries that adopt a ‘Thick Whois’ model. ICANN should go further and require a ‘Thick Whois’ model for all registries so that access to full ownership records is ensured by ICANN. This will be especially important for addressing issues of consumer fraud enabled by domain name abuse. International right to privacy standards have long been cited as a barrier to availability of ‘Thick Whois’. While those rights are well understood and recognized, ‘thin’ registries do not afford proper safeguards to protect brand owner rights nor to support the needs of law enforcement dealing with abusive activities, given that control of the registrant’s data is largely held by the individual registrar.

## **Comments on ‘Base Agreement’**

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### **Section 2 – Adherence to Post-Delegation Dispute Resolution Procedures**

Given the significant potential for actual infringement post-delegation by registries, ICANN should adopt the post-delegation dispute resolution procedures proposed by WIPO. That report can be found at:

<http://www.wipo.int/export/sites/www/amc/en/docs/icann130309.pdf>.

Adherence to this policy should be mandated under the Registry Agreement.

### **Section 2.4 - Publication of Registration Data**

ICANN should require that all new gTLD registries provide ‘Thick Whois’ data. See above comments to Question 45.

The requirement to provide free zone file access for all gTLDs is noted as a positive inclusion.

## **Section 2.8 – Use of Registrars**

MarkMonitor fully supports non-discriminatory access for ICANN accredited registrars to offer unrestricted extensions. However, in cases of a TLD where the gTLD has a single purpose and use, and is limited to defined registrant communities, the registry should be allowed to designate a single registrar.

## **Article 4 – Term and Termination**

ICANN should add language that requires that all registry operators comply with the rights protection mechanisms contained in the Base Agreement. Any registry operator that fails to comply should be subject to termination of its accreditation with ICANN (so long as ICANN has provided the registry operator with written warnings and a reasonable time to cure).

## **Article 6 – Fees**

MarkMonitor endorses the comments of the NTIA with respect to the inclusion of price caps in the new gTLD registry agreements and adds the following: ICANN should require price caps in all new registry agreements in an effort to avoid the potential harm to consumers and brand owners that could result from discriminatory pricing. The risk is that registry operators and others may try to exploit the value created by brand owners. The value inherent in a name that contains a brand is not the name itself, but the value created by the brand owner. It is patently unfair for a registry operator to be allowed to profit from the efforts of the brand owner. More importantly, it is foreseeable that existing gTLD registry operators would also demand the removal of any price caps in their registry agreements by invoking the equal treatment clause in their registry agreements. Removing price caps in current registry agreements might allow current registry operators to unfairly charge brand owners different fee amounts depending on the "value" of the domain name, as subjectively determined by the registry operator.

## **Section 8.4 - Change of Control**

ICANN must reconsider its proposal not to require written approval in the event of a change of control of the Registry Operator. Registry applicants/awardees should be required to submit a request to transfer or sell its registry functions. Allowing a third party to take over control of the Registry Operator without undergoing proper due diligence, may raise potential concerns, including the ability to fully enforce the originally agreed upon conditions under which the registry was 'awarded'. A suggested change would be to require review and written approval in the event of a change. To the extent all conditions of operation as originally committed are verified, written approval should not be unreasonably withheld. If there is a modification in the terms and conditions, there will need to be an extensive review and pre-approval of a transfer agreement.

## **Comments on Specification 5: Reserved Names List at the Second Level**

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A Reserved Names List database similar to the Reserved Names List as set forth above for the gTLDs should be created at the second level. This Reserved Names List should be created based upon the submission of trademarks by corresponding rights owners. Only those rights, which have been granted by jurisdictions requiring trademark review and evaluation, would be eligible for inclusion in the Reserved Names List. In addition, only legitimate owners of names appearing in the Reserved Names List should be allowed to register these domains, and variations thereof. Again, a proper mechanism should be instituted to challenge and remove any name on the Reserved Names List.

## **Comments on Specification 7: Minimum Requirements for RPM**

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**In addition to RPM relevant issues mentioned elsewhere in the MarkMonitor comments in other sections of the guidebook, including, but not limited to, those referencing Whols, Reserve Lists, we propose the following RPM elements:**

### **Expedited Remediation Procedure**

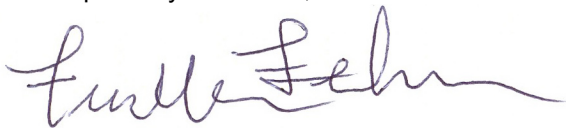
Upon formal and written notification to a registry of a domain that is infringing on intellectual property rights and used in bad faith, the registry should make every effort to remove the domain from the zone within a 4-hour timeframe on a temporary 'hold' basis. This procedure can be based in part on the notice and take down procedures set out in the DMCA. Registries should be required to make a determination as to the rightful ownership of the domain name based upon existing intellectual property rights. Nominet, the registry operator for .uk, currently employs a similar method for resolving conflicts. Registries should bear the cost burden to support this model, and should benefit from a 'safe harbor' from liability to the extent the registry complies with the provisions of this Expedited Remediation Procedure.

### **Registrant Notifications**

At the time of registration, registrants should be provided with a warning that, pursuant to the terms of the Registry Agreement, any domain names that infringe on any intellectual property rights and are being used in bad faith, will be confiscated without refund and returned to the legitimate rights owner and subject to the express remediation procedure.

MarkMonitor wishes to thank ICANN for their time and consideration of our comments. If you have any questions or wish to discuss any of points raised herein, please contact Frederick Felman ([ffelman@markmonitor.com](mailto:ffelman@markmonitor.com)).

Respectfully submitted,



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