

**News Corporation**  
**Comments on the Draft Applicant Guidebook, version 4**  
**on new gTLDs**

Submitted: July 21, 2010

News Corporation appreciates the opportunity to comment on the fourth version of ICANN's Draft Applicant Guidebook (DAGv4) for the launch of new generic top level domains (new gTLDs).

News Corporation is a global media company headquartered in the United States. Its wholly-owned subsidiaries include Twentieth Century Fox, HarperCollins, Dow Jones, Fox Cable Networks, News International, News Limited, and Sky Italia. News Corporation companies own and promote their offerings (e.g. films, audio/visual programming, books, newspapers, etc.) under numerous globally recognized and famous trademarks, such as Fox, 20<sup>th</sup> Century Fox, FX, Fox News, The Wall Street Journal, Barron's, HarperCollins, New York Post, The Times, The Sunday Times, The Sun, and News of the World. News Corporation companies actively engage in the advertising, marketing, promotion, distribution and/or sale of their respective offerings via the Internet and invest substantial human and financial resources in the development, protection, and enforcement of their respective brands and related offerings on a worldwide basis in an effort to defend and enhance their valuable intellectual property rights and protect consumers from confusion and fraud.

News Corporation has been closely following and working with ICANN during the development of the new gTLD program. While progress has been made, we remain deeply concerned that our input and the input of the greater intellectual property community regarding the protection of trademarks and consumers has not been clearly heard or adequately taken into account in DAGv4. (We refer to the concerns outlined in our submission dated December 15, 2008 following the release of DAGv1.) For the purposes of DAGv4, our comments will focus on trademark and consumer protections as addressing those concerns are our priority.

Trademark Protection

The DAGv4 fails to include the necessary mechanisms to protect intellectual property owners as proposed by the Implementation Recommendation Team (IRT). We support many of the recommendations previously made by the IRT to address the concerns of brand-owners. Three components to the IRT's "tapestry" recommendation are the Trademark Clearinghouse (TMC), the Uniform Rapid Suspension System (URS), and the Global Protected Marks List (GPML).

While the revised TMC in DAGv4 was expanded from its prior iteration, it still limits the intellectual property that may be registered in the database to text marks that are 1) nationally registered; 2) court-validated; or 3) protected by statute or treaty. Much greater clarification is required before the TMC can serve the objective for which it was intended by the IRT. In particular, there is no universally accepted definition of "text" marks. To be effective, this definition should include stylized text marks and text marks that incorporate a design. While it appears some progress has been made in framing the TMC, we believe that many critical, open issues remain.

Regarding the URS, again, we urge ICANN to adopt the IRT recommendation. The URS as currently constituted in DAGv4 is not an effective mechanism for trademark owners to challenge abusive domain name registrations. The URS was intended to be a "rapid" and "less expensive" remedy for clear cases of cyber-squatting. In DAGv4, the URS is neither. Instead, brand-owners are left with a higher burden of proof and a longer process (an appeal could take up to two years). The proposed remedy for a prevailing complainant is suspension, not transfer, of an abusive domain name registration. In effect, ICANN has created an overly burdensome procedure that no one will use. For

these reasons, the URS should be amended to follow the IRT recommendation; and even then, it should be in addition to (not instead of) the current Uniform Domain Name Dispute Resolution Policy (UDRP).

We are further concerned that the Globally Protected Marks List (GPML) has not been incorporated in DAGv4. It would be a straightforward way to protect trademarks, brand-owners, and consumers. Throughout the new gTLD launch process, as currently outlined, brand-owners are forced to incur costs to prevent the abuse of their brand. For example, if not part of the application process, these costs are incurred when a brand-owner objects to a new gTLD, validates and maintains a trademark in the TMC, or defensively registers names. The GPML has the potential to help off-set some of these costs by eliminating the need for defensive registrations. In turn, the decrease in malicious sites will also better protect consumers from fraud. ICANN repeatedly states their responsibility to the public interest. Consumer protection is a key factor in this equation, and the GPML would help serve this purpose.

### Economic Analysis

ICANN has conducted “An Economic Framework for the Analysis of the Expansion of Generic Top-Level Domain Names” (Economic Analysis), and has planned follow-up analyses.

We support the Economic Analysis’s suggestion of conducting case studies on past introductions of new gTLDs – ones that were meant to compete with .com, and ones that were created for specific or underserved communities. The results of these case studies should provide helpful guidance as to whether there is a need for new gTLDs. If so, these results will also provide insight on if a measured rollout is the best path forward as well as effective rules and mechanisms to protect intellectual property. If the case studies do not demonstrate a need for new gTLDs, then we would urge ICANN not to introduce new gTLDs.

If, however, the results of the case studies provide evidence that new gTLDs will increase competition and innovation in the domain name system (and subsequent recommendations to protect intellectual property are adequately incorporated in a new DAG), we would support the conclusions reached in the Economic Analysis. These conclusions advise ICANN to continue the “practice of introducing new gTLDs in discrete, limited rounds” and “adopt practices that will facilitate the assessment of the net benefits from the initial rollout of additional gTLDs.” Additionally, a phased rollout in discrete, limited rounds would afford ICANN the opportunity to develop and put into practice necessary compliance and enforcement resources to assure intellectual property owners and the public that the registrars will comply with their obligations.

We believe it would be irresponsible for ICANN to issue a final Applicant Guidebook before these case studies and economic analyses are complete and before the community has a chance to comment on their incorporation in another Draft Applicant Guidebook.

### Conclusion

As a global company, we wholly support competition and innovation, and think that ICANN’s mandate to encourage both on the Internet is laudable. We support the rollout of IDNs and ccTLDs, which is greatly expanding the Internet in a systematic and responsible manner. We appreciate the opportunity to comment on DAGv4, and ask that ICANN heeds the caution of not just us, but the intellectual property community and your own Economic Analysis, to continue to very carefully evaluate the need for and development of the process for the potential introduction of new gTLDs. Thank you.