

**The Uniform Rapid Suspension System (URS) and the Trademark Clearinghouse (TC) – Comments
submitted on behalf of the Non-Commercial Users Constituency (NCUC)**

We would like to thank ICANN for providing us with the opportunity to submit comments on the Uniform Rapid Suspension System (URS) and the Trademark Clearinghouse (TMC). We continue to support the introduction of the new gTLDs as we also support those recommendations that ICANN implemented and stayed true to the multi-stakeholder proposals created by the Special Trademark Issues Team (STI).

Please find below our detailed comments and suggested language.

A. The Uniform Rapid Suspension System (URS)

Overall, we would like to commend ICANN for producing a Uniform Rapid Suspension (URS) mechanism that includes the necessary and fundamental fair use provisions (section 5.8), provides the opportunity for an appeal (section 12), forbids transfer from its process and acknowledges the need for a review of the URS one year after its operation (section 14). At the same time, however, NCUC fears that there are certain provisions within the URS model that are either too wide and discretionary, lack clarification and can be detrimental for non-commercial interests.

NCUC is generally very concerned with the ‘loser pays’ model that ICANN is suggesting, even in its limited fashion. We believe that the ‘loser pays’ model will feed into the existing culture of trademark bullying and will be abused by trademark owners who will seek to intimidate legitimate registrants. Moreover, we believe that the language of the provision in the Applicant Guidebook is open to discretionary interpretation. According to the provision (2.2): “A limited “loser pays” model has been adopted for the URS. Complaints listing twenty-six (26) or more disputed domain names will be subject to a Response Fee which will be refundable to the prevailing party. Under no circumstance shall the Response Fee exceed the Fee charged to the Complainant”. Under this language, it is not clear whether the twenty-six domain names will have to be registered by one single registrant or the Complainant will have the ability to activate this provision if he manages to identify twenty-six domain names incorporating his trademark, which, nonetheless, are registered by a multitude of registrants. In general, the ‘loser pays’ model is a procedural device used within traditional means of adjudication, which, however, incorporate checks and balances, which the URS lacks. We believe that the loose language of this provision and the lack of checks and balances within the URS will provide room for gaming of a model that is only meant to be limited to very specific cases; its language, thus, needs to be clarified (and we suggest some additional language below).

NCUC is also very concerned with the very short deadlines afforded to the Respondent to respond to the Complaint – an issue that we believe feeds substantially to the increase of default cases. One of the main criticisms against the UDRP is the very short (and unreasonable) deadlines, imposed against the responding party. We understand the need for speed in the URS proceedings, but we believe that due process should not be sacrificed in the process. NCUC has strongly supported a model that recognizes the different Internet experience in different parts of the world and has often spoken about the need to respect as much as it is practically feasible the due process of both parties.

Suggested Language:

Please find below some suggested language:

2.2: “A limited “loser pays” model has been adopted for the URS. Complaints listing twenty-six (26) or more disputed domain names **against the same registrant** will be subject to a Response Fee which will be refundable to the prevailing party. Under no circumstances shall the Response Fee exceed the fee charged to the Complainant.”

4.2: “Within 24 hours after receiving the Notice of the Lock from the registry operator, the URS Provider shall notify the Registrant of the Complaint, sending a hard copy of the Notice of the Complaint to the addresses listed in the Whois contact information, and providing an electronic copy of the Complaint, advising of the locked status, as well as the **potential** effects if the registrant fails to respond and defend against the Complaint. [...]”.

5.8.1: “The domain name is generic or descriptive ~~and the Registrant is making fair use of it~~”. (This second part is not necessary – a domain name that is generic or descriptive cannot raise trademark claims whether the use of is fair or not).

5.9.1: “Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner **will must** review each case on its merits”.

7.2: “Examiners should have demonstrable relevant legal background **from both practice and academia**, such as in trademark law, **human rights law and competition law**, and shall be trained and certified in URS proceedings. [...]”.

7.3: “Examiners used by any given URS Provider shall be rotated to the extent feasible to avoid “forum or examiner shopping”. URS Providers ~~are strongly encouraged to~~ **must** work equally with all certified examiners, with reasonable expectations (such as language needs, non-performance, or malfeasance) to be determined on a case by case analysis”.

9.4: “~~Determinations resulting from URS proceedings will be published by the service provider specified by ICANN, in order to provide notice to the next potential Registrant that the domain name was subject of a URS proceeding~~”. – We recommend this section to be removed – it sounds as if ICANN with the assistance of the Providers will be blacklisting domain names that may in the future be registered for fair and legitimate purposes. Further and for reasons of transparency, Providers, just like in the UDRP, should publish their proceedings.

B. Trademark Clearinghouse

In general, we feel that the current version of the Trademark Clearinghouse reflects most of the comments submitted by the non-commercial users and we applaud ICANN for explicitly forbidding the Clearinghouse from creating or acknowledging any rights of legal effect. However, we would also like to suggest some language and ask ICANN to more specifically clarify some issues with the Clearinghouse.

As a general note, we strongly opposed the idea of the Clearinghouse to be used in the future as a database for other intellectual property rights than trademarks. Copyrights, patents, industrial designs and any other intellectual property rights fall outside the scope of ICANN and domain names. The Clearinghouse is a mechanism for trademarks and should remain as such. We also generally object the idea of Trademark Claim services to be extended 60 days after the initial launch. One would think that the trademark claim and sunrise period services both allow the trademark community to make legitimate claims before anyone else; we cannot understand the rationale of allowing a trademark claim service after initial launch and we believe it will be an administrative nightmare for Registries and an additional disadvantage to registrants.

Suggested Language and issues of clarification

3.2.4: “Other marks that constitute intellectual property **but certainly not copyrights, patents, designs or any other form of intellectual property**”. – In this context, we request ICANN to further clarify which ‘other marks’ it has in mind.

6.1.1: “New gTLD Registry Operators much provide Trademark Claims services during an initial launch period for marks in the Trademark Clearinghouse. ~~This launch period must occur for at least the first 60 days that registration is open for general registration~~”.

Respectfully Submitted

The Non-Commercial Users Constituency (NCUC)