

News Corporation

Comments on the Applicant Guidebook for new gTLDs - April 2011 Discussion Draft
Submitted: May 13, 2011

Introduction

News Corporation appreciates the opportunity to further comment on the policy development process relating to 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, 20th Century Fox, FX, Fox News, The Wall Street Journal, Barron's, HarperCollins, New York Post, The Times, The Sunday Times, The Sun, and other brands. 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.

This draft of the applicant guidebook, formally referenced as the "Applicant Guidebook - April 2011 Discussion Draft" (AG), is again improved from the last draft; however, in our opinion, it still needs to provide stronger rights protection mechanisms (RPMs). We would like to recognize and thank the Government Advisory Committee (GAC) for working with stakeholders to raise outstanding concerns, like RPMs, directly with the ICANN Board.

Current status and concerns

In our prior filings, we expressed great concern regarding inadequate RPMs with regard to the new gTLD program. We continue to support the Implementation Recommendation Team's "tapestry" of recommendations in this area. We are pleased to see that in the current AG both sunrise and IP claims services are mandatory for registry operators, and are linked to the trademark clearinghouse. While an improvement, with a few modifications, these RPMs could be even more robust and effective. The trademark claims services should be ongoing (instead of limited to 60 days) in order to serve as a truly useful tool to trademark owners as well as a preventative measure against cyber-squatters and fraud. We recognize the need for exact match in sunrise services in order to ensure that the system affords appropriate trademark holders an opportunity to register their marks early. However, we would like to see the standard of "identical or confusingly similar" applied in the ongoing IP claims service.

Regarding "proof of use," we agree with the principle that one party should not arbitrarily be able to stop another party from using a mark. However, we think that in addition to dropping "proof of use" in trademark service claims, it should also be dropped for sunrise service, URS, and PDDRP. Requiring "proof of use" will make the RPM tapestry cumbersome and complicate the process. In effect, as currently outlined, ICANN will create separate criteria from established systems in sovereign countries. RPMs for new gTLDs were not meant to be a substantive review system. These RPMs are meant to protect brand owners, and ultimately consumers.

Regarding the URS, two of our concerns had been that it was not rapid or less expensive than the UDRP. We are pleased that ICANN has decided to reduce the time allotted for appeal from two years to six months, and to implement a partial loser pays component. Additionally, we support the GAC resolution that the URS apply to registrations that are identical or confusingly similar to protected marks as well as terms associated with goods and services. We would like to see ICANN explain in greater detail how the trademark clearinghouse and URS will be linked in order to save trademark owners costs, and ultimately protect end-users from fraud.

An additional mechanism that enhances protection from abuse and fraud online is the WHOIS database. Registrars have a contractual obligation to provide accurate WHOIS data. While we recognize that ICANN is working toward improving WHOIS, the system -particularly enforcement of the agreements- is not yet adequate in the current DNS. ICANN needs to clearly address how it plans to provide adequate compliance and enforcement as this obligation will be even more difficult to enforce with the introduction of new gTLDs.

Lastly, we support the logical decision of ICANN to collect data from each launch and review systems such as the URS after a year to improve policy and procedure, however, are perplexed by ICANN not following the advice of their own economic studies and the GAC to do a pilot program (a limited launch) of new gTLDs. A detailed explanation for this rationale would be appreciated.

Conclusion

ICANN must get the launch of new gTLDs right. The success of the multi-stakeholder model depends on it. In recent months, tremendous progress has been made on the AG. ICANN should approve an AG only when the community supports it. We remain willing and available to provide input. Thank you for this opportunity to comment on the latest iteration of the AG.