

PARTRIDGE **IP** LAW

Mark V.B. Partridge
Direct: 312-634-9501
mark@partridgeiplaw.com

May 14, 2011

Mr. Peter Dengate Thrush
Chairman
ICANN
4676 Admiralty Way, Suite 330
Marina Del Ray, CA 90292

Mr. Rod Beckstrom
President and CEO
ICANN
4676 Admiralty Way, Suite 330
Marina Del Ray, CA 90292

Dear Chairman Thrush and President Beckstrom:

Partridge IP Law submits these comments to express our continued concerns with ICANN's intention to introduce new generic top level domains (gTLDs), in the manner provided in Version 5 of the Applicant Handbook, released April 15, 2011 (Handbook).

Partridge IP Law has experience representing domain name registries, registrars, registrants and brand owners in domain name disputes and intellectual property matters. We have previously commented on the new gTLD plans. Our founder, Mark Partridge, is also an active member of the IPC, served on the IRT and STI working groups, is a WIPO UDRP Panelist, and is a member of the ICANN Nominating Committee. We are, therefore, aware that ICANN has taken steps to study the concerns involving trademarks and domain names, and has consulted with the GAC regarding these issues. We appreciate those efforts.

Our first concern arises from the lack of demonstrated economic need for this expansion to offset the potential adverse impact of new gTLDs on intellectual property owners and users, that is, consumer and the general public. ICANN's own economic studies seem to indicate that there is no compelling economic need to introduce new gTLDs, and that the current gTLD structure adequately accommodates the current and forecasted needs of Internet users. The lack of economic need for new gTLDs, as indicated in ICANN's economic studies, demonstrates that there is adequate time to test new gTLDs through a pilot program, rather than a wide open launch of new gTLDs.

We recognize the modifications made to the Handbook relating to the Uniform Rapid Suspension System, the Trademark Clearinghouse and the Rights Protection Mechanisms in the new handbook. While the modifications demonstrate progress, there is still need for improvement, and need to test this system through a pilot program.

Uniform Rapid Suspension System

In the newest version of the URS, a registrant will have six months to appeal a judgment after a default. A shorter time period, such as sixty to ninety days would be more appropriate.

We also remain concerned that the only remedy available to a URS Complainant is a lock on the domain name. Greater consideration should be given to a Complainant's option to obtain the domain name after the appeal period has ended. This would avoid unnecessary time and expense to seek further relief in court or via the UDRP.

Trademark Clearinghouse

In the newest version of the Handbook any "marks which constitute intellectual property" can be included which broadens the scope of what will be included in the Trademark Clearinghouse. This is a positive change.

Rights Protection Mechanisms

The newest version of the Handbook requires all gTLD registries to implement both a Trademark Claims service and a Sunrise Process. In the previous Handbook, registries had the option of including either a Trademark Claims service or a Sunrise Process. Again, this is a positive change.

The major issue with the Trademark Claims service requirement is the short amount of time a registry has to maintain the service. According to section 6.1.1 of the Handbook, a registry must provide Trademark Claims services for at least the first sixty days that domain registration is open for general registration. Section 6.1.1 implies that the registry can cease offering Trademark Claims services after sixty days which, which should not be the case. Registries should be required to post Trademark Claims whenever a party attempts to register a domain which incorporates a mark on the Trademark Clearinghouse.

Despite these positive changes, the planned launch of new gTLDs continues to threaten brand owners with unwarranted expense due to legal costs and the costs of defensive registrations and IP claims. We urge ICANN to test these procedures through a pilot program.

Sincerely,

/s/Mark V.B. Partridge