



Domain Name Registrar

**May 13, 2011**

Internet Corporation for Assigned Names and Numbers (ICANN)  
4676 Admiralty Way, Suite 330  
Marina del Rey, CA 90292-6601

**RE: Comments on Applicant Guidebook Released April 15, 2011**

EnCirca appreciates the opportunity to provide comments on the most recent version of the Applicant Guidebook (AG). We have previously submitted comments for previous versions of the Applicant Guidebook as well as the Special Trademarks Issues Report.

The AG has shown noticeable improvement with each version. ICANN staff is to be commended for assimilating the often conflicting suggestions and feedback into a coherent and well-organized document.

We have focused our comments on the Trademark Clearinghouse; since this is an area we have a particular expertise. EnCirca has assisted trademark owners in virtually every new gTLD launch in the last ten years. Prior to founding EnCirca in 2001, Tom Barrett assisted Neustar in launching the IP Claims service for .BIZ and earlier was responsible for leading the effort for the development of a trademark database platform for Thomson Reuters' Thomson & Thomson business unit.

The trademark claims process is the most complicated function the CH needs to perform. As such, the implementation of trademark claims will likely have a significant impact on the overall architecture of the CH. There has been only one gTLD that has utilized the claims-type Rights Protection Mechanism (RPM), the .BIZ gTLD back in 2001.

In order to better understand how the trademark claims RPM might be implemented, EnCirca participated in a small ad-hoc working group organized by Neustar over the past few weeks to brainstorm on how the Trademark Claims process could work for new gTLD's. The resulting high-level process flow will be submitted under separate cover by Neustar and includes EnCirca's endorsement as the recommended implementation for the Trademark Claims RPM.

**General Comments:**

1. The Trademark Clearinghouse (CH), and Trademark Claims in particular, should be designed in a way to minimal operational dependencies on the Registries and Registrars
2. There are still many in the trademark industry continuing to ask for more expansive RPM's to prevent cybersquatting, including expanding notices beyond just identical matches and extending the trademark claims period longer than 60 days after general availability. There are additional costs involved with both of these. We suggest that there might be a compromise where the CH could accomplish these goals outside of the envisioned trademark claims process, and thereby

avoid incurring extra costs on registrars and registries and mitigating chilling effects on registrants.

3. ICANN should contract with a single entity for the CH functions, covering the validator and administrator roles. This places accountability with a single body and enables the CH to evolve its business processes over time without concern or conflicts with organizational boundaries between the administrator and validator roles. Contracting with two service providers introduces a new level of technical complexity that could result in delays in the implementation of the CH and possibly delay the introduction of new gTLDs.

4. The process to find a service provider for the CH must commence without delay. In addition, EnCirca recommends that ICANN coordinate a working group to engage interested members of the ICANN community to share ideas and brainstorm on the design of the Trademark Clearinghouse

### **Specific comments for Module 5: Trademark Clearinghouse:**

#### **Section 1.2**

While it may be appropriate for there to be two (or more) service providers for the CH, ICANN should contract with only the selected CH Administrator. This single administrator would then have the responsibility for contracting with and managing independent trademark experts for the authentication and validation processes. Such an approach would allow for the optimal architecture and integrated process flow for the CH functions. Separate contracted parties could lead to inefficient “silos” that would be resistant to continuous process improvements.

#### **Section 2.2**

Refers to the two functions performed by the Clearinghouse (CH). But the sub-bullets assume each function will be performed by different entities. Section 2.2 is about “functions” not “entities”. Section 2.3 already addresses the possibility of one or two entities. Section 2.2 should stay focused on “functions.”

- Suggested change: Section 2.2.1. Change “one entity” to “The Clearinghouse”.
- Suggested change: Section 2.2.2. Change “The second entity” to “The Clearinghouse”.

#### **Section 2.5**

This section highlights a potential problem area if the two functions are split with two service providers. Different service levels should not exist between the two service providers, as this will result in organizational “silos”, each optimized locally but inefficient for the overall CH, as opposed to integrated workflow that can be holistically improved and reengineered, as needed. If there are two service providers, the identical service levels should apply equally to both.

For example, if there are two service providers: both should have data escrow requirements; provide 24 hour accessibility; and have systems that are technically reliable and secure.

#### **Section 3.2.5**

For clarity, add “expired” as one of the status types not eligible for the Clearinghouse. Expired and cancelled are each valid statuses.

### **Section 3.3**

The data supporting a registered word mark should be a single registration number from a single jurisdiction. The text here implies that a trademark owner could submit multiple registrations numbers from multiple jurisdictions to support a single registered word mark. Validation of an application to the CH should be for a single jurisdiction. The CH should not be required to validate multiple jurisdictions for a single application to the Clearinghouse.

### **Section 3.7**

Double-negative: “neither will not be” should be “neither will be”

### **Section 3.8**

For clarity, include “expires”, as in “registration expires, gets cancelled...” Expired and cancelled are each valid statuses.

### **Section 4.3**

Not sure why the last sentence is part of this bullet. “Misuse of the data...” Perhaps it is more appropriately belongs in 4.1?

### **Section 5.1.4**

The authentication process for applications to the Clearinghouse is for a single registration number from a single jurisdiction, not multiple “registration numbers and countries...for that registration number” as is implied here.

### **Section 5.2**

For clarity, define the time frame for “current use”. Does this mean: on the exact day of the application, or any day within the previous xx months?

### **Section 6.1**

For clarity, this should state that trademark claimants are automatically included in every new gTLD launch. In other words, they do not need to “opt-in” for each gTLD.

Also, if a new gTLD imposes geographic, industry or other restrictions for its registrants (sunrise, or general availability), none of these restrictions should apply to the trademark claims applicable for the gTLD.

### **Section 6.1.3**

The Clearinghouse shall provide the trademark claims notice in the UN-Sponsored languages. Practically, the trademark owner is the only qualified party capable of translating information such as goods and services. Thus, the translation into UN-Sponsored languages of specific trademark data, such as owner info, and goods/services description should be the sole responsibility, and at the discretion, of the trademark owner.

### **Section 6.1.4**

Domain names are not registered in the CH. Modify the phrase: “If the domain name is registered in the Clearinghouse, to “If a domain name is registered that matches a trademark claim in the Clearinghouse”

The “Registrar” should not be responsible for notifying the mark holder(s) of the registrations. This function is better handled by the Clearinghouse or Registry. Simply remove reference to which party does the notification. We suggest that you strike the phrase “the registrar (again

through an interface with the Clearinghouse) will notify” and instead say “The mark holder(s) will be notified of the registration.”

### **Section 6.1.5**

“The Trademark Clearinghouse Database will be structured to report to registries when registrants are attempting to register a domain name that is considered an “Identical Match” with the mark in the Clearinghouse.”

This first sentence refers to a possible design and implementation rather than a function. We suggest you revise first sentence to be: “Trademark Claims will be triggered when Registrants complete the registration of a domain name that is considered an “Identical Match” with one or trademarks in the Clearinghouse.

### **Section 6.2.1**

This section appears to be a special type of RPM for the sunrise process and should be identified as such. The Claimant(s) are notified if a domain name is registered during sunrise that matches a trademark in the Clearinghouse. However, the sunrise applicant is not displayed a notice of any Claims. We assume the omission of a registrant notice is based on the reasoning that: 1: Most of the time, the applicant will be the only trademark claimant and 2: they already have trademark rights to the string and do not need to be informed if others also have rights to the same string.

Many sunrise processes are batch oriented. The procedure should also specify when the trademark claimant needs to be notified of the sunrise registration.

### **Section 6.2.4**

Refers to “national” effect but not “multi-national” effect. In item (i) and (iii) add “or multi-national effect”

The last sentence is not clear: “...and was not applied for on or before ICANN announced the applications received. “. What applications is this referring to? Is this one of the criteria for the authentication process referred to in section 5.1? If so, then it should be added to 5.1. If it is not, why would it be part of the dispute process here?

### **Section 7.1**

Clarify that Registries must accept all trademark claims even if they have SER or general availability restrictions for registrants.

### **Section 7.2**

This should mention that Registries may have sunrise restrictions based on geographic, industry, etc. as referred to in the SER in 6.2.3. i.e. “optional registry elected requirements re: international class of goods or services covered by registration;”

### **Section 8**

Should also mention that CH renewal fees are required for trademark owners. “Trademark owners will pay to register and renew...”

## Section Appendix

How about drafting the proposed text to the trademark claimant(s) following a domain name registration?

Dear trademark claimant,

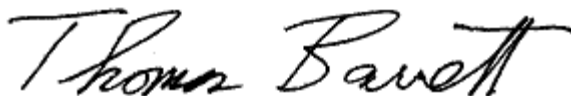
The following domain name registration has occurred for “domainstring.gTld that matches your trademark: “trademark”

The Registrant warrants that: (i) they have received notification that the mark(s) is included in the Clearinghouse; (ii) the Registrant has received and understood the notice; and (iii) to the best of the Registrant’s knowledge, the registration and use of the requested domain name will not infringe on the rights that are the subject of the notice.

Contact details for the Registrant can be accessed via the online Whois database for the “gTLD” Registry.

## End of Comments

Respectfully Submitted,



Thomas Barrett  
EnCirca - President  
400 W. Cummings Park, Suite 1725  
Woburn, MA 01801 USA  
+1.781.942.9975 ext: 11  
+1.781.823.8911 (fax)  
+1.781.492.1315 (cell)  
My LinkedIn Profile: <http://www.linkedin.com/in/thomasbarrett>  
My Boston Marathon Donation Page: <http://www.firstgiving.com/thomasbarrett>