



13 May 2011

The gTLD Applicant Guidebook – April 2011 Discussion Draft

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession of IP attorneys throughout the world, herewith comments on the April 2011 Discussion Draft of the New gTLD Applicant Guidebook.

FICPI is pleased to note that ICANN has made serious efforts to adopt measures aimed at avoiding the considerable number of trademark infringements that are anticipated with the expected new gTLDs, and therewith also have created a better and safer platform for industrial and other Internet users involved in future on-line business. Especially, we note that the latest version of the Guidebook has returned to some of the original IRT proposals, and in certain cases even proceeded to create a safer and more workable trademark protection mechanism.

Even if FICPI is in agreement with other organizations stating that the best and safest way to handle new gTLDs would be to implement fewer than planned, and release new gTLDs in smaller groups on a timely basis in order to get a more both legally and technically controlled introduction, we realize that this may no longer be a possible solution. It is of course essential to develop a technically, legally and economically safe way to handle new TLDs.

Clearinghouse

As previously stated, FICPI suggests adoption of the IRT recommendation with a change of the name from “Trademark clearinghouse” to “IP Clearinghouse”.

The purpose of the Clearinghouse should be to list a number of different “name” rights that, *depending on the jurisdiction*, could be used as a basis to create an obstacle to registration of a certain domain name.

A Complainant in a **.eu** domain name dispute case can rely on, inter alia, registered national and Community trademarks and, in as far as they are protected under national law in the Member-State where they are held: unregistered trademarks, trade names, business identifiers, company names, family names, and distinctive titles of protected literary and artistic works (Article 10(1) of the European Commission regulation 874/2004). The Clearinghouse should allow collection of such prior rights, whereas it will be up to each gTLD provider to regulate if only registered and common law trademark rights may be relied upon or whether other nationally protected name rights can form the basis of an objection as well.

In this respect, FICPI notes that 3.2.1 now has changed to cover “nationally or multi-nationally registered word marks from all jurisdictions”, which is an important step in the right direction. For example, now European Community trademarks are given the same status as U.S. trademark registrations.



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FICPI notes that in 6.1.5, the description of what is considered as an “Identical Match” has been briefly amended to an improved, or at least more understandable, version. However, as previously stated by FICPI, the Clearinghouse will still come up short as the trademark claims are only triggered by matches involving marks and names which are almost identical. Most cybersquatting cases are based not on identical marks and names but instead for example on “typosquatting” names or combinations of well known trademarks and a descriptive word such as “line”, “com” or “buy”.

FICPI strongly recommends ICANN to reconsider the Clearinghouse terms in order to apply the description of “match” to cover obvious, ongoing and common online trademark infringements.

Trademark Claims service / Sunrise registration

FICPI fully supports the Trademark Claim and Sunrise Registration services as requiring registries to provide notice to mark holders through the (IP) Clearinghouse mechanism.

URS

FICPI notes with pleasure and support that the proposed URS regulations have changed in several important respects, such as:

- 1.2.6.1 now accepting all officially registered trademarks
- 2.2 the “limited loser pays” model for the URS which FICPI strongly supports
- 7.2 accepting that “Examiners should have demonstrable relevant legal background, *such as in trademark law*, which in fact is a necessary legal background in order to be able to understand and consider the cases in legally clear and neutral way.

TRADEMARK POST-DELEGATION DISPUTE RESOLUTION PROCEDURE (TRADEMARK PDDRP)

Here, FICPI supports the proposed changes of 6.1(a) and 6.1(b), as well as 6.2(b)(ii) and (iii), deleting the words “unjustifiably” and “impermissible”, therewith creating a stronger trademark owners protection.

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.



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Regarding clause 9 “Threshold Review”, FICPI positively notes that all registered trademarks, independent of the national or regional registration system, are accepted, and can therefore accept the new regulation that the trademarks have to be in “current use”.

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