

ASSOCIATION DES INDUSTRIES DE MARQUE
EUROPEAN BRANDS ASSOCIATION
EUROPÄISCHER MARKENVERBAND

AIM submission to ICANN public comments



ICANN NEW GTLD PROGRAM
DRAFT APPLICATION
GUIDEBOOK V4



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AIM submission to public comments on the ICANN draft application guidebook version 4 (DAG4)

Background

ICANN plans an unlimited expansion of new top-level domain names (TLDs) and developed a process to assess applications for new TLDs with tests for financial and technical robustness. Key overarching issues such as trademark protection were factored in late via a two stage process involving the 2009 Implementation Recommendations Team (IRT) and the Special Trademark Issues (STI) Review Team. Some of these recommendations have found their way in the version 4 of the draft application guidebook for new TLDs.

About AIM

AIM is the European Brands Association. It represents the branded goods industries in Europe on key issues which affect the ability of brand manufacturers to design, distribute and market their brands. AIM's membership groups 1800 companies of all sizes through corporate members and national associations in 22 countries. For more see footnote or www.aim.be

AIM's position on the anti-fraud and trade mark protection within DAG4

AIM has serious concerns that proposed protections remain weak and ineffective. Specific issues are listed below.

1. ICANN's role as a guardian of the public's trust

Cybersquatting, phishing and fraud have increased under ICANN's watch. The Internet is a potentially dangerous place to conduct business. ICANN's Board is obligated to ensure its actions do not cause further harm. But to date it is brand owners that have born the costs of preventing this harm by costly defensive registrations and UDRP actions. These are costs that are an externality to the business model of the registry but born by third parties. The IRT recommendations set out to mitigate this unfairness but sadly the outcome in DAG4 is weak. AIM is concerned that the ICANN Board is therefore not fulfilling its role as a guardian of the public's trust.

2. Trademark Clearinghouse – fails to solve the problem it was intended to address

DAG4 specification 7 page 56 and beyond

Brand owners are faced with a poor choice: spend money uselessly in more defensive registrations or suffer from the loss of consumer trust resulting from infringement of their brands. The past tells us that the existing rights protection mechanisms are insufficient. The future will only be worse unless action is taken.

The current proposal for a Trademark Clearinghouse is that it is not a rights protection mechanism but only a database. Without the link to the IRT proposal of the Globally Protected Marks List (GPML) it does not address the trade mark issues the Board intended to address.

Specific issues

2.1 Clarify terminology.

The terminology “substantive review “ or “substantive examination” is vague and ill defined with respect to what trade mark offices actually do. A better wording to capture the same intent with respect to generics is “[examination on absolute grounds.](#)”

2.2 Remove an arbitrary discrimination.

Nevertheless AIM opposes the fact DAG4 proposes a different standard for the claims service and sunrise. This difference is discriminatory and arbitrary. It assumes there are different qualities of trademark. There are not: trade mark offices adopt procedures that suit their country balancing cost, speed and contribution to innovation.

AIM proposes that the requirement for registries for claims and sunrise should be the same and as follows:

For Trademark Claims and Sunrise services - Registries must recognize all text marks that have been or are:

- (i) nationally or multi-nationally registered;
- (ii) court-validated; or
- (iii) protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.

2.3 A better definition of identical match to catch bad faith

Widen the definition of "identical match" to encompass "obvious misspellings" eg Google, Coka-Cola etc. This approach is current practice in some trade mark offices.

3. Uniform Rapid Suspension System (URS)

The UDRP was set up to resolve disputes between two parties acting in good faith (at least in part).

The URS proposal in DAG4 is a failure as it seeks to be too similar to the UDRP.

Instead the public interest will be better served if the URS is re-focused to fight crime. That is immediately take down a web site that is conducting crime. The expectation is that once a complaint is made there will NOT be any reaction from the criminal.

Required improvements

AIM proposes a simplified system targeted at the criminal based on the following presumptions:

- a) a Complainant acts in good faith
- b) a silent Registrant acts in bad faith
- c) a Registrant that reacts to a suspended web site is assumed to be in good faith.

3.1 A URS decision should be binding for life not a few months

The current URS remedy is to block a domain and later release it. This is absurd as it will perpetuate a cycle of cyber-squatting.

3.2 Reduced scope of the URS provider

The URS provider acts as a rapid check on the apparent bona fides of the Complainant and the conduit between the Complainant and the Registry.

3.3 Dramatically reduce the timelines

Complaint starts.

24 hours URS provider validates bona fides of the complaint and notifies the Registry.

24 hours The Registry notifies the Registrant that it will act to lock and then prevent resolution of the web site in 24 hours.

This will thus STOP the criminal act being conducted. This will cover probably 99% of URS cases.

In the unlikely case that the registrant reacts within the 24 hours the presumption of bad faith should be reversed and the web site should be immediately allowed to resolve again.

AIM proposes defining registrant reacts as:

- 1) confirmation of registrant data AND
- 2) a statement that the complaint is or is not valid.

3.4 Turn over any good faith dispute to a UDRP

If the registrant reacts (as defined above) the Registry notifies the URS provider who notifies the Complainant (within 24 hours) and the URS finishes. At that point the complainant should then be invited to instead launch a de novo UDRP.

AIM

AIM is the European Brands Association. It represents the branded goods industries in Europe on key issues which affect the ability of brand manufacturers to design, distribute and market their brands. AIM's membership groups 1800 companies of all sizes through corporate members and national associations in 22 countries. These companies are mostly active in every day consumer goods. They employ some two million workers and account for over 350 billion Euro in annual sales in Europe alone. AIM's mission is to create for brands an environment of fair and vigorous competition, fostering innovation and guaranteeing maximum value to consumers now and for generations to come.

Our corporate members include: Arla Foods ▼ Bacardi-Martini ▼ Barilla ▼ Beiersdorf ▼ Bongrain ▼ Cadbury ▼ Campbell Europe ▼ Coca-Cola ▼ Colgate-Palmolive ▼ Diageo ▼ Energizer ▼ Ferrero ▼ Freudenberg/Vileda ▼ Georgia Pacific ▼ GlaxoSmithKline ▼ Groupe Danone ▼ Heineken ▼ Heinz ▼ Henkel ▼ Johnson & Johnson ▼ Kraft Foods ▼ Kellogg ▼ Kimberly-Clark ▼ Leaf Holland B.V. ▼ LEGO ▼ Lindt & Sprüngli ▼ LVMH ▼ Mars ▼ McCain Foods ▼ McCormick ▼ Nestlé ▼ Oetker International ▼ L'Oréal ▼ Pepsi-Cola ▼ Pernod Ricard ▼ Philips Lighting ▼ Procter & Gamble ▼ Reckitt-Benckiser ▼ Royal FrieslandCampina ▼ Sara Lee / DE ▼ SCA Hygiene Products Holding ▼ SC Johnson ▼ Unilever

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