7 October 2014

Comments on Implementing Rights Protection Mechanisms in the Name Collision Mitigation Framework

We welcome the opportunity to comment on the appropriate process for applying Rights Protection Mechanisms (RPMs) to the names which are released from registries' second level domain (SLD) name collision block lists (the Block Lists).

As we stated in our letter to Cyrus Namazi of 28 June 2014, we were very concerned to be told at the London ICANN 50 meeting that ICANN proposed to treat names released from Block Lists as if they were registry reserved names. We are therefore pleased to see that, as a result of the objections to this proposal received from the Community, ICANN has decided to consult on how best to treat such released Block List names.

For completeness we reiterate that the Block List names are not names which were voluntarily reserved by the registries, they are names which were ICANN-mandated, and thus they are not reserved names within the meaning of the RPM Requirements. Contrary to the claims made in the comments by Ari Registry Services[1], this is not something which was contemplated or discussed when the RPM Requirements were developed. The requirement that registry operators must block the SLDs on the Block Lists was introduced only after the RPM Requirements were finalised. There is therefore no presumption that these names should be treated as reserved names, this is not an attempt to "re-open old issues" as Ari Registry suggests, and it is entirely proper that there should be consideration now as to the appropriate application of RPMs to these names.

Furthermore, the manner in which those Block Lists were generated, based on the "Day in the Life" datasets, inevitably resulted in the Block Lists including numerous names which are trade-marked terms. If the relevant registries did not previously make those names available for allocation during their sunrise, then trade mark owners with marks in the Trademark Clearinghouse (TMCH) must be given the opportunity to secure them on their release. The Trademark Claims process is not an adequate alternative. A sunrise grants the trade mark owner a priority opportunity to register a SLD matching their trade mark. The Trademark Claims provides no such opportunity, only notification after the event that a registration has been made, with the only redress then being to expend time and money in recovery proceedings. Treating the names in the Block Lists as reserved names is therefore a grave concern for trade mark owners, both due to the risk that it poses to their intellectual property rights and the risk of deception to the public should there be improper registration and use of these names.

[1] http://forum.icann.org/lists/comments-name-collision-rpm-25aug14/msg00004.html

We have reviewed the joint proposal put forward on 17 July 2014 by the Business Constituency (BC), Intellectual Property Constituency (IPC) and Registry Stakeholder Group (RySG) and the joint public comment dealing with implementation matters submitted by the same parties on 16 September 2014 (together the Joint Proposal). We would like to express our support for the Joint Proposal and the collaborative approach of the BC, IPC and RySG in seeking to find a solution which addresses both the desire of brand owners with marks in the TMCH to be given a priority opportunity to register those terms as SLDs, and the concerns of Registries at having to run a potentially extensive and unanticipated Trademark Claims. The RPMs are a suite of protections designed to work together and one is not a replacement for another. Nevertheless in the very specific, limited circumstances arising as a result of the release of Block List names, the Joint Proposal offers a reasonable compromise and is a preferable option to the so called "Status Quo" of treating the names as if they are reserved names.

On the questions asked by ICANN Staff as to implementation, as stated above, we support the Joint Proposal recommendations. With regard to the specific suggestion that registry operators may be able to elect to join one of two "batched waves" and that, if so, registries need only give 10 days' advance notice of joining a wave, we do have some concerns as to whether this is sufficient notice for trade mark owners and their registrars. However, provided that the actual dates of the two waves are announced with sufficient advance notice to allow for planning, and given the suggestion that relevant trade mark owners could be given proactive notifications , then having only 10 days' notice of which registries intend to release their Block List names within a particular wave may be adequate.

Thank you for considering these points.

Yours sincerely,

/s/

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