



October 6, 2014

Via Electronic Mail
comments-name-collision-rpm-25aug14@icann.org

Re: Public Comment on Implementing Rights Protection Mechanisms in the Name Collision Mitigation Framework

Google appreciates the opportunity to comment on the issue of how ICANN can best implement the Rights Protection Mechanisms (“RPMs”) in the Name Collision Mitigation Framework. Above all, we would like to express our strong support for the approach proposed by Business Constituency (BC), the Registry Stakeholder Group (RySG), and the Intellectual Property Constituency (IPC) in their joint comment submitted on September 16, 2014 (the “Joint Comment”), as well as in their earlier joint letter to ICANN dated July 17, 2014. As expressed in those two documents, we urge the Board to require that all trademarked names which registry operators are forced to block under their alternative path to delegation plans be available for allocation during the original Sunrise period or be subject, upon release, to a period of exclusive registration limited to trademark holders.

Issues with ICANN’s Status Quo Treatment of Blocked Trademarked Names

The release of blocked names without an exclusive registration period will cause significant harm to brand owners, who are often finding their exact trademarks on the blocked list. This includes famous and distinct trademarks such as GOOGLE, which have not been permitted to be registered during the initial Sunrise period for many registries due to name collision restrictions. While reactive mechanisms such as the UDRP and URS may resolve certain abuses, they often involve substantial costs and resources, and are most effective when combined with priority opportunities for domain registration. Priority domain registration during Sunrise is also the only fail-safe method of truly preventing phishing or various other scams which involve mass email communications from a <google.TLD> or other exact-match <brand.TLD> domain.

The existing ICANN position is also problematic because it encourages inconsistent responses from registry operators to the alternate path to delegation. Registry operators have interpreted the ambiguous language in the alternative path, outlined in the New gTLD Collision Occurrence Management Plan, as permitting them to allocate blocked names

pending a resolution on name collision, but not requiring them to do so. As a result, some registry operators have made blocked names available for registration during Sunrise and others have not, leading to further confusion and mistrust of the new gTLD program among Internet users.

While we were initially disappointed that ICANN's original name collision framework did not directly address the foregoing RPM issues, we have been extremely encouraged by the recent discussion and consideration by the ICANN community, including collaborative efforts by the BC, RySG and the IPC. We believe it is significant that these three very diverse stakeholder groups have coalesced around a consensus viewpoint that there should be a requirement of a secondary Sunrise period for trademark names released from name collision block lists, and we urge ICANN to accord this community-based proposal the weight that it deserves.

Proposed Solution

In order to address the foregoing issues, Google requests that ICANN require that SLDs on name collision block lists be subject to at least a 30-day period during which they are made exclusively available to trademark owners prior to being made generally available.¹ Registries that made names on block lists available during their initial Sunrise period have already satisfied this requirement. With regard to specific implementation details, we are in full agreement with all of the Joint Comment's responses to the questions raised by the ICANN Staff Paper.

Namely, we support the Joint Comment's proposal that registry operators should choose one of two paths for announcing and conducting their exclusive registration periods. In the first path, registry operators could elect to either provide a minimum of 30 days of notice followed by at least 30 days of exclusive registration or, alternatively, provide a 60-day exclusive registration period (provided that first-come-first-served is not used as the allocation mechanism in the case of competing eligible SLD applications).

In the second path, registry operators could join one of two batched waves of start dates for exclusive registration periods. All registries opting into one of the two waves would operate 30-day exclusive registration periods beginning on the specific date selected for that wave. Registries opting for this path would provide 10 days' advance notice of their intent to join a wave.

¹ An exception would be for .Brand registries qualifying for Spec 13, which are not obliged to run a Sunrise period unless they later decide to open the registry to third-party registrations. In addition, we wish to clarify that our proposal relates solely to domains affected by the name collision block list. As such, it is intended to simply serve as a necessary extension of the name collision framework dictating how names may be released for registration and not to otherwise amend or alter Specification 5 of the Registry Agreement or the understood approach to RPMs.

Regardless of the path that individual registries select, SLDs released from the name collision blacklist would not be treated as reserved names and would not be subject to the requirement of an additional 90-day Claims period. However, the TMCH should provide notice to affected trademark holders that their marks will be included in specific upcoming exclusive registration periods. The TMCH notification service should also notify trademark holders of matching SLD registrations in the new TLDs on an ongoing basis, which should obviate the need for the 90-day period. (We also note that the Google Registry intends to voluntarily extend its Claims notification service for trademark holders indefinitely.)

Conclusion

We sincerely believe that the community's proposed approach, as set forth in the Joint Comment, provides the best model for implementing RPMs in the Name Collision Mitigation Framework. This proposal and the collaborative efforts involved in its drafting represent the best of ICANN's multi-stakeholder model -- forging common ground and developing consensus-driven solutions among disparate groups and interests. The end result provides the necessary trademark protections for rights holders while reducing operational burdens on registry operators. We accordingly ask that ICANN incorporate the Joint Comment proposal into the finalized name collision framework.

Sincerely,

A handwritten signature in black ink, appearing to read 'AA', with a stylized, cursive flourish extending to the right.

Andy Abrams
Senior Trademark Counsel
Google Inc.