



Comments of **MARQUES, the European Association of Trade Mark Owners
on Implementing Rights Protection Mechanisms in the Name Collision Mitigation
Framework**

Introduction to **MARQUES**

MARQUES is the European association representing brand owners' interests. The **MARQUES** mission is to be the trusted voice for brand owners. **MARQUES** unites European and international brand owners across all product sectors to address issues associated with the use, protection and value of IP rights, as these are vital to innovation, growth and job creation, which ultimately enhance internal markets.

MARQUES membership crosses all industry lines and includes brand owners and trade mark professionals in more than 80 countries representing billions of dollars of trade annually. The trade mark owners and practitioners represented by **MARQUES**, together, own more than three million domain names and advise organisations of all sizes on rights protection in the domain name system. These domain names are relied upon by consumers across Europe as signposts of genuine goods and services.

More information about **MARQUES** and its initiatives is available at www.marques.org.

MARQUES' comments on Implementing Rights Protection Mechanisms (RPMs) in the Name Collision Mitigation Framework

MARQUES welcomes the opportunity to provide its comments on the implementation of RPMs in the Name Collision Mitigation Framework which was approved on 30 July 2014.

The second level domain (SLD) block lists (the Block Lists) which were created for individual registries as a temporary risk mitigation measure under the New gTLD Collision Occurrence Management Plan (the Collision Plan) include a substantial number of terms that correspond to trade marks registered in the Trademark Clearinghouse (TMCH). Consequently, the adequate implementation of RPMs in the Name Collision Mitigation Framework is a major concern from trade mark holders' perspective.

According to the Collision Plan, new gTLD registries that were eligible for the Alternate Path to Delegation (APD) were able to proceed to delegation by blocking names on the Block List for their TLD. The finalised Name Collision Mitigation Framework provides that TLDs that have been delegated prior to 18 August 2014 can now release their Block List names provided that they do not activate them until the required 90-day wildcard controlled interruption period has been completed. The fact that the Block Lists include thousands of terms which may correspond to trade marks raises the question of which RPMs these terms will be subject to once they are released for registration.

One of the options being proposed by ICANN in its paper " Implementing Rights Protection Mechanisms in the Name Collision Mitigation Framework" (the ICANN Paper) is that SLDs that have been blocked will be treated in the same manner as Reserved Names. This is

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characterised in the ICANN Paper as the “Status Quo”. Reserved names are names which have been withheld from registration by registry operators at their discretion under section 2.6 and Specification 5 of the Registry Agreement. If the registry operator chooses to release those names from reservation after the end of its Sunrise period the names will only be subject to the 90-day Trademark Claims period and not to a subsequent Sunrise Period. Under this proposal therefore Block List names from registries which have already gone into general availability would not be subject to a Sunrise when released, but only to the Trademark Claims procedure.

As such, the “Status Quo” option as identified in the ICANN Paper leads to inadequate implementation of RPMs and unfair treatment of holders of trade marks corresponding to terms in the Block Lists since it deprives them of the protections offered by the Sunrise Period. This causes harm to intellectual property interests, but also risks the deception of consumers and an undermining of consumer trust in the new gTLD program generally. Marques is therefore strongly opposed to the treatment of terms in the Block Lists as Reserved Names. Further, to use the term “Status Quo” is misleading. The obligation for registry operators to withhold the SLDs in the Block Lists was introduced into the process after the Registry Agreement and RPM Requirements were finalised and so was not taken into consideration when the current RPMs were designed. There is therefore no presumption that these names should be treated in the same way as Reserved Names.

As an alternative measure and in the limited and specific circumstances which arise in relation to the release of the Block List names, Marques fully supports the compromise approach proposed by the Business Constituency (BC), Intellectual Property Constituency (IPC) and the Registry Stakeholder Group (RySG) in their [joint letter](#) sent to the New gTLD Program Committee of the ICANN board (NGPC) on 17 July 2014 and the procedure for implementation suggested in their [public comment](#) submitted on 15 September 2014.

In order to ensure equal treatment of all trade mark holders and not to undermine the existing RPMs, terms in the Block Lists must be made available exclusively to SMD holders for at least 30 days prior to being made generally available for registration. In terms of procedural requirements such as duration, notice periods, reporting and dispute resolution processes the rules that apply to the Sunrise Period should also apply when the terms in the Block Lists are released. The release by registries in “two batched waves” as suggested by the BC, IPC and RySG as an additional mechanism in their [public comment](#) is also acceptable if it is seen as a practical solution for all parties. We note that under this proposal the suggestion is that advance notice could be limited to 10 days. Provided that there is sufficient advance notice of the dates for the batched waves, having only 10 days’ notice of the actual registries electing to go in each wave may be adequate. We would suggest that there should be at least 21 days’ notice of the dates for the batches to allow trademark owners to adequately prepare.

In conclusion, in terms of implementation of the RPMs in the Name Collision Framework, we oppose the “Status-Quo” which requires the terms in the Block Lists to go through only Trademark Claims once they are released. As an alternative we support the joint BC, IPC and RySG proposal for a “secondary Sunrise” mechanism.

We thank you for your kind consideration of the above comments.

Yours sincerely,

Submitted on behalf of **MARQUES**
Signed on behalf of Caroline Perriard,
Chair of **MARQUES** Cyberspace Team

MARQUES

