

INTA Internet Committee

Comments on the .PARIS Application for an Approved Launch Program

The City of Paris has submitted an application for an Approved Launch Program (ALP) for the .PARIS top level domain. Pursuant to the Trademark Clearinghouse (TMCH) Rights Protection Mechanism requirements (RPM Requirements), ICANN is currently accepting public comments from the community on all aspects of the ALP, including how the proposed .PARIS ALP might affect the intellectual property rights of others. The .PARIS registry also seeks to take advantage of provisions in the Qualified Launch Program (“QLP”) Addendum, which allow for the registration of up to 100 domain names to third parties prior to the Sunrise Period for purposes of promoting the TLD.

For the reasons set out below, INTA believes that the proposed .PARIS ALP threatens to significantly undermine the carefully negotiated RPM Requirements poses the risk of infringement of intellectual property rights and attendant consumer confusion, and therefore should not be approved as currently proposed. Further, the .PARIS Launch Program has a number of breaches under the TMCH RPM Requirements with regard to non-TMCH trademarks which should be corrected. Finally, there are ambiguities with the Mandates Program which need to be clarified.

ALP

The proposed ALP departs from the RPM Requirements by giving priority to the Public Administrators Program over the trademark Sunrise Period.

Under the proposed ALP, Public Authorities will be able to register their names (including any clear variations and abbreviations), names of public services, geographical names for any subdivision of the greater area of Paris (e.g. departments, districts, neighborhoods, cantons, streets...), local landmarks, and other locally relevant and iconic names over which the Public Authorities are the relevant authority according to local law.

Public services are proposed to cover at least: (i) public order and public security; (ii) public affairs and institutional relations; (iii) public health; (iv) taxation, economic development and promotion; (v) public utilities; (vi) transportation; (vii) urban planning and environmental protection; (viii) culture and education; (ix) citizen participation; (x) tourism. This is an extremely wide definition of public services which is very likely to conflict with terms to which

strong trademark rights attach. Furthermore, the number of domains which are proposed to be allocated under this Public Administrators Program appears to be unlimited.

Giving first priority to public administrations in Paris over TMCH rights holders effectively expands the Public Authority exception well beyond the 100 pre-Sunrise domain names already being allocated under the QLP Addendum. As a result, the ALP would circumvent the Sunrise Period at the expense of TMCH rights holders in a manner that was previously proposed and rejected by ICANN.¹ New gTLDs are mandated to provide a Sunrise Period for TMCH rights holders to register domain names corresponding to their trademarks in advance of the general public. Allowing any registrations beyond those limited number allowed under the QLP Addendum would circumvent the advance registration Sunrise Period set aside for TMCH rights holders.

Given the wide definition of public services referred to above, there is a clear risk that this Public Administrators Program could contribute to infringement of intellectual property rights and/or consumer confusion and thus, in accordance with paragraph 4.5.2 of the TMCH RPM Requirements, the ALP should not be approved.

Non-TMCH Trademarks

In addition to the proposed ALP, we note that under the .PARIS Launch Program, non-TMCH-validated trademarks with effect in France and geographical indications recognized by international treaties, EU regulations or French legislation are proposed to be considered during the Sunrise Period at the same time as trademarks which are recorded in the TMCH. While the intentions behind this may be good, this circumvents the Sunrise Period at the expense of TMCH rights holders. The Sunrise Period is set aside for those trademark holders that have registered rights within the TMCH and submitted evidence that the marks are in use.

Qualification 7 of the Applicant Guidebook allows the registry operator to implement additional rights protection mechanisms, such as allowing French trademark owners priority over the general public. However, such rights protection mechanisms must also be compliant with, and subservient to, the TMCH. Paragraph 2.4.1 of the TMCH RPM Requirements makes it clear that a Registry Operator MUST NOT allocate or register domain names during or in connection with the Sunrise Period except to holders of a validated trademark recorded in the TMCH. The proposal to allocate and register domain names to local trademark holders who are not registered in the TMCH at the same time is a clear breach of this provision.

¹ <http://forum.icann.org/lists/comments-qlp-addendum-13feb14/msg00005.html> (proposing to expand the number of QLP domain names beyond 100); <https://www.icann.org/en/system/files/files/report-comments-qlp-addendum-09apr14-en.pdf> (rejecting the proposal and confirming ICANN's commitment to the priority of Sunrise for all but the limited exception of 100 names under Spec 5, Section 3.2 of the Registry Agreement).

More concerning still, it would appear from the “.PARIS Launch Policy” that where there are two applicants for the same domain name, it is intended that priority will be given to the owner of the mark with local effect “whether registered at the TMCH or not” over other TMCH registrations. This is again a breach of the registry operator’s obligation to honor marks which have been recorded and validated in the TMCH before allocating domains to the owners of non-TMCH marks.

Mandates Program Early Activation Segment

Finally, the Launch Program seeks to allow the activation of certain domain names prior to the Sunrise Period during the Mandates Program Early Activation Segment. It is unclear whether this period will allow for additional pre-Sunrise domain registrations included within, or in addition to, the 98 contemplated under the Pioneer Name program. To the extent that it limits all pre-Sunrise registrations to 100 and respects the TMCH and Public Authority exception, it would appear to be compliant with the QLP Addendum. If this is not the case and there is, in fact, no limit to pre-Sunrise registrations, the Mandates Program would also amount to a breach of the Registry Agreement and the Rights Protection mechanisms that explicitly limit to 100 the number of domain names that may be allocated before conclusion of the Sunrise Period. INTA requests that the City of Paris clarify this ambiguity to allow for a more accurate assessment.

Conclusion and Alternative Recommendation

In conclusion, the proposed ALP for the .PARIS top level domain, including the proposals which relate to priority registration of non-TMCH trademarks during the Sunrise Period, is not in full compliance with the TMCH process and thus poses the risk of infringement of intellectual property rights and attendant consumer confusion. Furthermore, there is a clear risk that by allocating unlimited numbers of domains prior to the trademark Sunrise, the ALP could contribute to infringement of intellectual property rights and/or consumer confusion, which would serve to reverse any such presumption of approval. Based upon these and the additional reasons mentioned above, the .PARIS ALP should be refused as currently proposed.

If a .PARIS launch program is allowed by ICANN that provides priority for certain .PARIS domain name registrants over holders of a validated trademark recorded in the TMCH, then those .PARIS domain name registrations must be subject to transparency and other requirements. First, such ALP early domain name registration cannot be hidden behind privacy registrations so that potentially aggrieved parties can determine whether the registrant met the .PARIS launch programs' priority registration parameters. Second, such domain names must be used by Public Authorities in connection with the public services that domain name represents. For example, POLICE.PARIS should be used by the City of Paris Police Department for public

safety purposes and not for a website promoting a rock band. Lastly, any domain name registered during the priority period by a Public Authority or other qualifying rights holder cannot be transferred to a third-party except (i) to another qualifying Public Authority or (ii) in the event of a sale of all or substantially all of the assets of the registrant.