



August 27, 2013

Via Electronic Mail to
comments-rpm-requirements-06aug13@icann.org

Re: Public Comment of Google Inc. on the Rights Protection Mechanisms

Google respectfully submits the following comments related to the recently published draft of the registry Rights Protection Mechanism (RPM) requirements. We offer these perspectives as a brand owner and global Internet company whose core business depends on a stable, secure, and interoperable Internet, and as an applicant¹ for new generic top-level domains (gTLDs) seeking to encourage greater choice and innovation on the web.

We are pleased that ICANN has provided for greater flexibility in the roll-out of the Trademark Claims Period and Sunrise Period, allowing our registries to adopt several voluntary measures for the protection of intellectual property rights, including a 60-day sunrise and a permanent claims service. The latter will incorporate the “enhanced” claims mechanism, permitting brand owners to monitor up to 50 previously abused trademark variants per Clearinghouse entry.

We are also encouraged that ICANN has been committed to maintaining an open dialogue with members of the various stakeholder groups and the community at large in order to explore further modifications to the RPM requirements. In the spirit of this open communication, we respectfully propose the following suggestions, which we believe will allow registries to better serve their registrants and communities without diminishing effective intellectual property protection.

Timing of Sunrise

Google supports the option of a 60-day sunrise period (as originally proposed by the BC/IPC in the “Strawman” discussions²) which does not distinguish between notice and sunrise periods; thus, registries would be permitted the flexibility of a 30-day notice period plus a 30-day sunrise, or a shorter notice period combined with a longer sunrise. Longer sunrise periods are beneficial to brand owners, as they provide increased time for

¹ Through our wholly-owned subsidiary, Charleston Road Registry Inc.

² See <http://blog.icann.org/2012/11/trademark-clearinghouse-update/>

planning, budgeting, and negotiation with the relevant gTLD registrar/registry prior to the delegation of domains to the general public. The post-RPM Requirements proposal, which in essence would punish registries who wish to offer longer sunrise periods by further delaying launch timing, would be contrary to these interests. In addition, because the proposed change does not allow registry operators to make allocation decisions for the first 30 days, no trademark holders are at any disadvantage relative to a 30-day notice period followed by a 30-day Sunrise.

In the same vein, Google supports the ability to run parallel sunrise periods, “landrush” and/or limited registration periods, so long as actual delegation and registration of domains remain subject to sunrise requirements. In other words, prospective landrush registrants would be permitted to request domain names immediately upon launch, but such requests would be subordinate to any competing sunrise claim by a Trademark Clearinghouse entry owner, and would not result in delegation until after all Sunrise registrations had been allocated. This type of arrangement would allow registries to exercise greater flexibility and innovation in the promotion of their top-level domains while still preserving established sunrise protections for brand owners.

Founders’ Program

One of the primary goals of the new gTLD program is to “foster diversity, encourage competition, and enhance the utility of the DNS.”³ Given that many new gTLD registries will be focused on specific industries, geographic locations, or demographics, we believe that Founders’ Programs that allow prominent figures in those respective markets to pre-register and promote domain names will help accomplish these goals and encourage greater adoption and innovation. Of course, any such Founders’ Program must be sensitive to intellectual property rights; accordingly, we envision fairly narrow exceptions for any pre-sunrise registration program. For instance, the total number of such registrations would be limited to the 100 reserved names as set forth in Spec. 5.3.2. Additionally, participants may be limited to securing only their brand or business name as well as key generic terms related to their field. Finally, any names allocated under a Founders’ Program would still be subject to the Trademark Claims service.

Exceptions to Sunrise Priority

Along with narrow exceptions to sunrise priority in the context of Founders’ Programs, we encourage ICANN to consider how other specific types of pre-registration processes may be beneficial to the public interest. As ICANN considers such a possible exception procedure, it should focus on two important factors: first, the goal should be to minimize any chance of consumer confusion, and second, the procedure should be predictable, consistent and efficient.

³ gTLD Applicant Guidebook, Version 2012-01-11, Preamble.

To the first point, ICANN should consider granting exceptions to trademark priority in situations where the exception will reduce the probability of consumer confusion, and should reject exceptions that are likely to increase it. To this end, it is entirely reasonable that ICANN may approve exceptions allowing for protection of the name of public agencies or services within geographic gTLDs (so that police.london is allocated to the Metropolitan Police rather than the band, or that subway.nyc is allocated to the New York City Transit Authority rather than to the sandwich store) or related to the purpose of a community (so that lions.rugby is allocated to the British and Irish side rather than to the international service organization) within community gTLDs. Exceptions should be narrowly tailored to avoid abuse, and should be subject to the registry operator's Sunrise Dispute Resolution Procedure. We believe that such exceptions are consistent with trademark law's primary purpose of preventing consumer confusion without damaging its parallel function of allowing brands to protect their reputation.

At the same time, any exception procedure must be implementable for ICANN and predictable for both applicants and the trademark community. ICANN should establish clear procedures with fixed time limits for evaluation, and should consider defining classes of exceptions that will be automatically approved as long as they do not raise the risk of consumer confusion. At a minimum, exceptions previously approved for similarly situated applicants should also be approved for subsequent registry operators (for example, if one geographic TLD is approved for a policy protecting public authority names, other geographic TLDs should have a straightforward mechanism of adopting an identical policy).

We respectfully believe that the foregoing proposals will strengthen the overall rights protection regime for rights holders, applicants, and registrants, while minimizing the risk of consumer confusion. Thank you for considering our feedback, and please do not hesitate to contact us if you have further questions about this submission.

Very truly yours,

A handwritten signature in black ink, appearing to read "Andrew Abrams". The signature is fluid and cursive, with the first name "Andrew" and last name "Abrams" clearly distinguishable.

Andrew Abrams
Trademark Counsel
Google Inc.