

**Intellectual Property Constituency Comment on the**

**New gTLD Program: Rights Protection Mechanisms Review Draft Report**

May 1, 2015

# BACKGROUND

On February 2, 2015, ICANN published the “New gTLD Program: Rights Protection Mechanisms Review Draft Report”[[1]](#footnote-1) for public comment. The report states:

Publication of this draft for public comment is important to capturing the experience of users of the RPMs and to consideration of how they affect the variety of stakeholders in the context of the DNS. Feedback is especially important to ensure that all issues that need to be considered are identified, and to help determine those issues that have most impact, and accordingly, the areas where community resources will be best focused. To help execute an effective review process, ICANN encourages thoughtful input from a diverse set of stakeholders.[[2]](#footnote-2)

The Intellectual Property Constituency (IPC) offers the following comments to help guide the ICANN community to identify the most important issues to intellectual property owners with regard to the Rights Protection Mechanisms (RPMs) of the New gTLD Program. We hope that by identifying these issues, the community can prioritize them (among the issues identified by other key stakeholders in the RPMs) and focus time and energy on these issues in the impending Policy Development Process (PDP).

In order to prepare these comments, the IPC conducted an informal preliminary poll of its members’ opinions and experiences with the RPMs identified in the Draft Report, as well as some other RPMs that have been identified by the IPC as important for the ICANN community to examine. Most of our comments below are based on the results of this poll, responded to by a third of IPC members as well as by six trademark counsel who did not identify themselves as IPC members (the “IPC Respondents”). Although this poll was limited in both time and scope, and while we consider the views below to be preliminary, we hope the results are helpful to ICANN in identifying and clarifying important issues related to the RPMs.

# INTRODUCTION

Any review of the RPMs requires a perspective overview of the environment the new gTLD program creates for brand owners. At its core, the new framework of RPMs tacitly acknowledges that the existing tools for rights protection — whether or not sufficient for 22 gTLDs — would have been inadequate in a world with hundreds of new gTLDs. Brand owners could easily foresee that the expanded universe of gTLDs would increase the cost of brand protection and likely require that they change their protection strategies, so the RPMs were developed with the intention of minimizing costs and complexities and reducing trademark infringement in new gTLDs. Accordingly, the RPMs should not be evaluated as an end unto themselves, but rather for their contribution to those overarching goals.

A formal review can readily be divided into two categories: prevention and cure. Nowhere is the adage more apt that “an ounce of prevention is worth a pound of cure.” Given the exponential growth in new gTLDs, it is the IPC’s view that the initial goal of RPMs should be to prevent infringement by deterring potential infringers, and when that fails, to decrease the cost and complexity of curing the infringement.

To that end, a formal review must begin with a behavioral analysis to judge the success of the prevention framework as a whole. Once there is an understanding of the points of failure, surveys of both brand owners and registrants would be useful to understand the reasons for failure and the potential for remedy. That said, it is imperative to focus on the success of the framework overall and not its individual components, as the answers may lie outside of the existing framework of mechanisms.

Similarly, the new “cure” mechanisms must be evaluated by some objective measure of their cost and complexity. Examining the new RPM framework holistically requires a comparison of the cost and ease of “satisfactory resolution” of an infringement in the legacy gTLD environment to the same in the new gTLD environment. Once we understand the success of the overall RPM framework, we can begin to evaluate the new framework for strengths and weaknesses. For example, if there is no substantial decrease in cost to satisfactorily resolve infringement using a new mechanism (*e.g.*, URS), it could be that the cost of the new mechanism is too high or that it is too complex to use. Early indications are that both issues may be present, and that many may view the delivered remedies as unsatisfactory.

In sum, a successful review will take a step back from the particular mechanisms and ask larger questions about the success of the framework as a whole and only then delve into the particular shortcomings of individual mechanisms and the potential for improvement. The shortcomings may very well lie with the mechanisms themselves as much if not more than in the details of their implementation.

# COMMENTS

## TRADEMARK CLEARINGHOUSE (TMCH)

### Recordation in the TMCH

As one would expect, knowledge and use of the TMCH amongst the members of the IPC is high. The overwhelming majority of IPC members who provided input have used the TMCH to record trademarks either for themselves or their clients.

The numbers of marks registered per brand owner (and its affiliates) range from as few as 2 to more than 100, with the average being in the region of 10-15 marks per brand owner.

For a substantial minority of IPC Respondents, the primary reason for recording their trademarks in the TMCH was to take part in one or more Registry Sunrise periods. For the majority, the Sunrise and Trademark Claims Notice (TM Claims) procedures were equally important reasons for registering, with some also taking into account the requirements as a dotBrand applicant for qualification for Specification 13, and the requirement to have a mark in the TMCH in order to utilize one or more of the Registry-specific RPMs, such as Donuts’ Domains Protected Marks List (DPML). In fact, a small minority of Respondents cited the DPML as being the primary driver for recording their marks in the TMCH. This demonstrates the need for the Review to take a holistic approach to the RPM ecosystem and shows that excluding Registry-specific RPMs from the Review would result in an inaccurate picture of the current RPM environment.

However, the use of the TMCH unquestionably fell below expectations. The IPC encourages ICANN to seek qualitative and quantitative information and data from brand owners to help determine why brand owners did not utilize the TMCH more, and to determine what improvements can be made to the TMCH and the RPMs to which it offers access. For instance, IPC Respondents identified a number of factors brand owners take into account when making decisions about whether to record in the TMCH and, if so, which of their trademarks to record. The two most relevant factors cited were the available remedies and the available budget.

Available remedies: the TMCH recordal itself offers no rights protection, merely the means to streamline access to and use of the other RPMs, i.e., the Sunrise and TM Claims notices (in addition to the DPML). IPC Respondents report that the appeal to brand owners of these ICANN-mandated RPMs is reduced by factors such as:

1. Their limitation to exact matches to the trade mark and the exclusion of “mark plus” both for Sunrise and for the TM Claims:
	1. In order to make the most of finite trademark registration budgets, it is fairly common practice that where a brand owner has a strong house brand that is used with a variety of added terms, they may seek to rely on trademark registrations of the house mark alone, because the additional terms add little to the strength of the trademark. Limiting RPMs to exact matches prevents the brand owner from registering its legitimate suite of brands during the Sunrise;
	2. Not coincidentally, it is a very common practice among cybersquatters to register a domain consisting of a brand together with additional descriptive or generic words.
	3. It is also a very common practice among cybersquatters to register a domain consisting of a misspelling of a brand (*i.e.*, “typosquatting”).

Limiting the TM Claims to exact matches significantly devalues this RPM for the brand owner.

1. The TM Claims service does not afford the brand owner prior notice of a registration, but only notification after the event, at which point the only remedy would be some form of enforcement action.
2. There is no ICANN-mandated block facility for brands across all registries, and only very few limited Registry-specific blocks.

Available budget: This is of course closely tied-in to the perceived value of the available remedies. In the words of one IPC Respondent:

“I registered several of our trademarks in the TMCH for a fee…. I paid higher registration fees during the Sunrise Period to obtain a [domain name] with our trademarks. I feel that trademark owners were penalized twice in protecting our own brand with this new gTLD program.”

However it is also relevant that when the RPM policy was being developed, ICANN’s expectation—and that of the community—was that there would only be approximately 500 new gTLDs. With the number of applications far exceeding this expectation (even when excluding the dotBrands), brand owner budgets for defensive registrations have been stretched to the limit, and given the costs involved, for many it simply has not been possible to register all of their brand names during the Trademark Sunrise Periods that have already occurred, not to mention the Trademark Sunrise Periods that have yet to commence.

### Proof of Use

IPC Respondents did not identify the proof of use requirements as influencing their decision whether to use the TMCH; however this was identified as being a relatively time-consuming process. In the case of marks from Canada and the United States, where proof of use must (in most instances) be submitted to the trademark office to obtain a trademark registration, we question the necessity of being required to submit such evidence to the TMCH as well. It is worth noting the United States is the jurisdiction with the most verified registered marks in the TMCH Others, however, particularly from countries such as those of the EU where no proof of use is required for a mark to be validly-registered, consider the proof of use requirements to be unsupported by law. ICANN is encouraged to seek data surrounding the efficacy of this requirement in light of the costs associated with the verification process and lack of a proof of use requirement to obtain registration and enforceable rights in many jurisdictions.

### Implementation Issues

IPC Respondents highlighted various practical issues encountered in using the TMCH, which are largely matters of implementation and staff training. These include difficulties with:

1. Changes of address leading to false notices because the validation process did not look to the underlying records;
2. Recording assignments;
3. Validating Chinese and Russian script;
4. Trademarks registered under the Madrid Protocol, where there is no separate trademark registration certificate;
5. Proof of use being rejected for showing other words together with the trade mark, when this is how trademarks appear when they are put to genuine use;
6. Rejections as a result of non-substantive differences in the translations of goods/services;
7. Inadequate word limits for some data fields;
8. Usability of TMCH interface; ease of navigation;
9. Technical interruptions to the system causing data to be lost;
10. Poor customer service from staff, including rejection of marks without proper explanation, and responses from staff rarely being adequate to resolve the matter without further rounds of correspondence.

The IPC urges ICANN to develop quantitative and qualitative questions to examine these issues as a part of its review of RPMs.

## SUNRISE PERIOD

Trademark owners supported the establishment of required Sunrise Periods as part of the New gTLD Program as a means for ensuring protection of their valuable trademarks in new registries. However, the IPC’s initial feedback reveals that the Sunrise Period protection, while helpful, has created a new range of problems for trademark owners.

The participation of trademark owners in Sunrise Periods has been lower than expected. Our feedback makes clear that trademark owners have reduced their participation due to: 1) decreased focus on defensive registrations in the face of the high number of new registries; 2) increasingly selective registration in registries that relate to the trademark owners’ business; 3) the difficulties and costs of participation in the process; 4) the increasing use of premium registration fees; and 5) the decision to monitor through the TM Claims program and selectively enforce trademark rights. Factors cited by IPC Respondents in determining whether and in which registries to register during Sunrise Periods include: 1) the importance of particular trademarks to drive online sales and support product reputations; 2) the relative risk of cybersquatting in particular registries; 3) the relatedness of new gTLDs to companies’ goods and services; and 4) the availability of UDRP, URS, and other challenge mechanisms, balanced against the increasing cost of registration. In addition, many trademark owners have taken advantage of Registry-specific RPMs, such as Donuts’ DPML, to block registration of their trademarks without the burden of registration.

Although most of the IPC Respondents either participated in or assisted clients in participating in the TMCH, far fewer found the notification of Sunrise Periods sufficiently clear that they could effectively plan or help clients effectively plan registration in new gTLDs (36% agreed whereas 40% disagreed or strongly disagreed). Awareness of Sunrise dates and requirements was a significant problem. Similar to the feedback that the Draft Report references, the inference to be drawn from this is that information regarding the nature and requirements of participating in Sunrise periods was difficult to obtain or understand. The IPC encourages ICANN to investigate improvements to the Sunrise notification process for future rounds of new gTLDs.

In addition, determining the start dates of the 500 Sunrise Periods administered so far has been challenging because there was no regularity to the releases and clients often had to scramble or pay additional fees for services to advise them of the various deadlines. As part of the RPM review, the IPC strongly suggests that ICANN seek input on whether the commencement of Sunrise Periods could be more regular and scheduled, and how clearer advance notice of Sunrise Periods could be provided to trademark owners.

A majority of Respondents encountered issues with participating in the Sunrise Periods due to Name Collisions (73%), Premium Priced Name Programs (89%) and Registry Reserved Names (78%). Of these, Name Collisions were perhaps the least understood.

The IPC believes that ICANN should further review the provisions of the RPM Requirements as they relate to reserved names. The majority of Respondents experienced some issues during Sunrise with their trademark having been reserved and thus unavailable for registration. In some cases this may have been as a result of Name Collision, with some Registries failing to clearly identify this as the cause. In a number of cases, however, IPC Respondents encountered reservation of their trademarks apparently at the election of the Registry. Under the current RPM Requirements, registry operators may reserve an unlimited number of terms, including trademarks which are recorded in the TMCH, and release them to third parties after the Sunrise Period ends. This loophole therefore allows registry operators to circumvent the Sunrise, in whole or in part. Where names have been reserved and subsequently released, for whatever reason, it is unacceptable to trademark owners that they should not be afforded a priority opportunity to secure domain names matching the trademarks they have recorded in the TMCH for that very purpose. Very few Respondents have utilized the Sunrise Dispute Resolution Policy where a registration was blocked (only 4%).

Trademark owners and service providers were aware from pre-new gTLD Sunrise programs that they would pay some additional amount to participate in the early registration of their trademarks. This was understood to reflect additional costs of administering the programs. However, many registries in the new gTLDs are perceived to be taking advantage of trademark owners by charging them exorbitant Sunrise registration fees. The IPC Respondents reported that Sunrise Period registration costs were generally considered much higher than appropriate and not reflecting mere “cost recovery”, with 38% disagreeing or strongly disagreeing that they were appropriate and only 24% believing they were appropriate. Although trademark owners understand ICANN’s reticence to suggest fair prices, they are frustrated by the present system. The impact of these perceived unfair pricing schemes directed at brand owners is a topic that should be examined by ICANN.

In addition, 89% of Respondents noted that they had faced premium pricing schemes applied to their trademarks in certain registries, where their trademarked term was on offer at a significantly higher price than the standard Sunrise price. Frequently, it appears to be the very use of the term as a trademark in a field of activity rated to the TLD that caused the registry operator to label and subsequently price the term as “premium.” Although the .SUCKS registry pricing practices are particularly egregious in this regard, a number of other new registries have adopted premium pricing policies targeting brand owners as a way to generate substantial additional revenue. This is viewed by some as a predatory and unfair pricing practice, and one reason why more trademark owners do not participate in Sunrise registration. The IPC believes ICANN should consider the reasonableness of fees when reviewing the RPMs.

In sum, the IPC believes that the RPM review should focus on whether and how the Sunrise system would benefit from greater coordination, standards, broader public and business education, and notification and redress (for issues such as Name Collision and Premium Name Programs). Some key issues that should be addressed include: How ICANN and the TMCH can better communicate Sunrise dates and requirements to potential registrants? Is there a benefit to organizing Sunrise launches around a particular date? How can circumvention of RPMs and practices unfairly targeting trademark owners be stopped? And, is there a benefit to standardizing some Sunrise procedures? And if so, which ones?

## TRADEMARK CLAIMS SERVICE

According to the Draft Report, 25 million TM Claims notices have been issued to would-be registrants,[[3]](#footnote-3) while only 96,000 domain names have been registered after a TM Claims notice was issued. That said, the IPC has identified numerous instances where the TM Claims notice was ineffective at preventing infringing or otherwise abusive registrations.

With this in mind, the IPC believes that in its review, ICANN should investigate whether it may be useful to provide clearer notice to potential registrants of the consequences of registering an infringing domain name in the TM Claims notice, including the possibility of having the domain suspended through a URS, cancelled or transferred through a UDRP, or other potential civil or criminal legal penalties. It may also be more useful to send TM Claims notices translated into the six UN languages, as some brand owners and their counsel have witnessed that such notices are disregarded by registrants who could not understand them because they did not speak English. Making these changes may improve the effectiveness of the TM Claims service by dissuading unauthorized and non-defensible registrations.

With respect to the notices sent to brand owners in the event an exact match domain is ultimately registered (*i.e.*, the Notice of Registered Name), the notices effectively communicate registration. However, it would be more useful to include in the notice the registry-provided Whois information for the registrant and a hyperlink to the domain, which would save the brand owner some time and money in having to take these investigatory steps separately from reviewing the notice itself.

ICANN should also further explore the previously abused label service, which to date has been under-utilized by brand owners (according to the Draft Report only 324 strings have been added to the Trademark Clearinghouse through the previously abused labels service). Thus, early fears within some segments of the community that this service could lead to unlimited inclusion of names in the Clearinghouse and abuse by brand owners have proven groundless. The cost of the service ($200 to validate a string based on a court decision and $75 to validate a string based on a UDRP decision, plus costs in gathering necessary supporting materials like the original complaints) may be the driving factor behind this lack of use to date. ICANN should continue to monitor the use and impact of the previously abused label add-on service, and work with the Clearinghouse to refine the validation process and reduce cost.

Some IPC Respondents felt that the availability of this additional protection for terms previously subject to cybersquatting was not well understood, and most felt that it was of limited usefulness, for the following reasons:

1. While the “mark plus 50” option did offer a means of registering “marks plus” in the TMCH, it applied only to TM Claims: the brand owner could not secure these names during Sunrise;
2. The likelihood of identical terms being registered again was, in many cases, considered to be low, and did not justify the additional work and cost involved in recording these terms in the TMCH;
3. Garnering the necessary evidence was difficult. In particular, the requirement for recordal that the string should have been subject to a successful UDRP or court action ruled out any strings where the dispute had been resolved without formal proceedings. Since these would often be the clearest cases involving strings with a high relevance to the brand and its field of activity, these would also be the strings most at risk of repeat registrations in other gTLDs, and thus also the ones of most relevance for protection in new gTLDs by the brand owner. However, the recovery of these domains without formal proceedings has the ironic result of excluding these terms from protection.

Apart from these issues, brand owners and their counsel reported to the IPC that the Trademark Claims services were useful, and often served as a key part of brand enforcement strategy with respect to the new gTLD program. On the whole, brand owners reviewed notices of registered names they received, and often took some kind of action in response – generally including some basic further investigation of the domain name and the registrant. Thus, the Trademark Claims services appear to be useful to brand owners, although several improvements should be considered to increase the effectiveness of the services for the benefit of both brand owners and the consuming public.

## UNIFORM RAPID SUSPENSION SYSTEM (URS)

As the IRT noted in 2009, an RPM can only be considered effective if it provides “clear benefits to trademark owners and new gTLD registries, such that as many as possible will be incentivized to use” it.[[4]](#footnote-4) Although rights holders had high hopes for the URS, the rate of adoption of this tool by rights holders has been low. Since the beginning of 2014, over 320 new gTLD registrations have been the subject of UDRP actions at WIPO alone. But only approximately 200 URS complaints total have been filed to date.[[5]](#footnote-5)

The IPC’s poll asked members several questions to better understand the views of the rights holders regarding the URS, its usability and effectiveness, and the reasons they choose to use (or not use) the URS. The findings illuminate the main reasons this RPM underperforms: inadequate remedy and high burden of proof. We address each of these topics below in an effort to help guide ICANN in its study of this RPM.

### Inadequate Remedy

As the Report recognizes, the main limitation of the URS is that its remedy is limited to suspension of the domain name for the remainder of the registration period, which could be a matter of mere months or weeks.[[6]](#footnote-6) By and large, the URS is likely not viewed as an attractive option by rights holders because the cost does not justify the remedy: merely suspending the domain name for a relatively short period is not sufficiently valuable in the eyes of most brand owners. If the domain name is important enough to the rights holder to engage in a legal proceeding, then a temporary suspension of that domain name is insufficient to prevent its further misuse. Suspension also carries the risk that once the domain name is released, it will be registered again by another (or even the same) infringer, forcing the rights holder to restart the process for the same domain name. Thus, any efforts to improve the utility of the URS for rights holders must start with the remedies available.

The remedy was the factor that most determined IPC Respondents’ decisions not to use the URS to address infringing domain names. Many indicated that if they were to use the URS, they would try to acquire the domain name after it reentered the general pool of domain names. But the risk of the domain name being acquired by another third party was sufficient to dissuade most brand owners from investing the resources into a URS.

Neither its speed nor its low cost compensated for the limited nature of the remedy. In fact, the remedy entirely undermined the URS’ other intended benefits: many members ranked the URS as too expensive, too time consuming and too complicated for what it provided. With the extremely high burden of proof, the cost of involving an attorney -- whether inside counsel or outside counsel -- was viewed as too great to justify allocating such resources to obtain the mere remedy of a temporary suspension. In fact, even though most IPC Respondents viewed cost and speed as the downsides of the UDRP, they still chose to file UDRP over URS actions in order to obtain transfers of the infringing domain names--even where case complexity or the high evidentiary standard of the URS were not problematic.

### High Standard of Proof

The high standard of proof is another reported factor that discourages rights holders from using the URS. The "clear and convincing" standard of the URS is viewed as problematic for some trademark owners because the scope and reach of their trademark rights cannot be easily proven in the space allowed, and most cases of infringement require more legal analysis than is possible to present in a URS action. In other words, rightly or wrongly, a higher standard of proof is believed to add to the amount of evidence and detail needed to be successful.

In sum, the IPC believes that the study will show that the limited remedy available in the URS is not considered a worthwhile investment of time and money by many brand owners. The high burden of proof makes it appropriate for only a limited number of cases and increases the complexity and evidence needed to succeed. The IPC believes that a review of only quantitative data relating to the URS would provide an incomplete picture and supports the qualitative questions set forth in Section 6 of the Draft Report. The IPC offers the following as additional topics that ICANN should explore relating to the URS:

1. **Should there be a transfer remedy?** Given that the losing party loses the domain name either way, there is no reason such a remedy would unfairly prejudice the losing party. Moreover, instituting a transfer remedy would not disrupt the speed or cost-efficiency of the URS, because its adoption would not necessitate modification of other URS requirements, such as the word and time constraints.
2. **Should there be an extended suspension?** Another possible alternative would be to extend the length of the suspension. This option would be further enhanced if losing respondents were also allowed to transfer the domain(s) at issue to the prevailing complainant voluntarily during that extended suspension.
3. **Should there be a right of first refusal?** Yet another option would be to give the winning complainant the right of first refusal when, at the end of the suspension period, the domain name is eligible for re-registration.
4. **Should the standard of proof be modified?** Changing the standard from “clear and convincing” to the more common “preponderance of the evidence” would make the URS more cost-effective.
5. **Should the URS cover domain names that were either registered OR used in bad faith?** Broadening the URS to cover cases in which domain names are clearly being used in bad faith, but where proof of registration in bad faith is less compelling, would make the URS more effective.
6. **Should there be a financial penalty to the losing registrant?:** The infringing party loses nothing but the registration, and even has the ability to pick it back up on the drop. The ICANN community should explore options such as loser-pays, response fees, etc. to disincentivize infringing registrations.

## POST-DELEGATION DISPUTE RESOLUTION PROCEDURES (PDDRP)

As noted in the Draft Report, the PDDRP is an RPM designed to hold a registry operator accountable for bad acts. The Draft Report also includes the Registration Restriction Dispute Resolution Procedure (RRDRP) and the Public Interest Commitments Dispute Resolution Procedures (PICDRP) as additional quasi-RPMs. As further noted, to date, there have been no complaint filings under these procedures.

The IPC would point out that the fact that these post delegation procedures have not been used does not mean that they should not be reviewed. The IPC asserts that, similar to the URS, there may be fundamental problems in the burden of proof, cost of these proceedings, and the remedies afforded. ICANN would be well-served to review input from potentially affected parties which may tease out improvements to these RPMs.

The RPM review should also address registry Public Interest Commitments (PICs) themselves, some of which are specifically directed toward dealing with infringement-related abuses in the new gTLDs, and which ICANN has repeatedly stated it will enforce as a matter of contract compliance. In other words, the PICs themselves, and not just the PICDRP, are rights protection mechanisms which should be encompassed in the review.

## REGISTRY BLOCKS

IPC members have identified blocking mechanisms implemented across TLDs operated by a single entity as an additional Rights Protection Mechanism that ICANN should examine during the RPM review. While not administered by ICANN, blocking mechanisms such as Donuts’ DPML[[7]](#footnote-7) were utilized by IPC members and were considered helpful to manage the vast number of new gTLDs that were launched, necessitating defensive registration. Especially helpful were those blocking mechanisms that restricted registration of TMCH-eligible terms in a large number of new gTLDs.

The feasibility and success of these blocking mechanisms indicates to many in the IPC that ICANN was perhaps mistaken in its conclusion that a Globally Protected Marks List was not achievable or practical. Therefore the IPC asks ICANN, within the context of this review, to further explore the possibility of a Globally Protected Marks List. It would be useful in determining whether there is truly a barrier to implementing a new gTLD-wide blocking mechanism and, to that end, the IPC recommends a full examination into the context in which blocks were most useful, the benefits to brand owners who purchased these blocks, and the challenges that both brand owners and Registries experienced with blocking.

## DEFENSIVE REGISTRATIONS

As anticipated, most registrations by brand owners were defensive in nature. While there is some motivation to affirmatively use registrations that correspond to certain industry verticals or geographic TLDs associated with the brand in question (.bank, .london, etc.), most IPC Respondents believe that the new gTLD program significantly disadvantaged their ability to protect and monitor their brand, with no concrete advantage as a trade-off.

In the context of this review, as well as the Affirmation of Commitments review that will look at how the new gTLD program served the goals of increasing consumer choice, trust and competition in the domain name market, it is important for the ICANN community to take a close look at how brand owners were affected, and to balance that conclusion with the benefits of the new gTLD program.

## APPLICATION TO LEGACY gTLDs

Finally, IPC believes that it should be a priority for ICANN to consider how those RPMs which have been determined to be reasonably successful can be effectively applied to the legacy gTLDs. These registries are, and for the foreseeable future will remain, the locus of the vast majority of the abuses which the new gTLD rights protection mechanisms were intended to address. To the extent that the new gTLD program has succeeded in developing reasonably effective RPMs, determining how to port them to the legacy gTLD environment should be a high priority for ICANN. From the IPC’s perspective, this prospect provides one of the greatest potential benefits of the new gTLD program—one which ICANN will be in a position to accelerate as part of this RPM review.

# CONCLUSION

The IPC applauds ICANN for a thorough analysis of RPMs within the new gTLDs up to this point, and the identification of topics and questions for evaluations. As with many complex systems, the IPC urges ICANN to look not only at the hard facts and numbers (quantitative data) collected to date but to conduct meaningful interviews and surveys to obtain qualitative data. Many of the questions set forth in the Draft Report seek such qualitative data. However, IPC hopes that its informal poll and the assertions in this comment will help ICANN craft additional qualitative questions and, to that end, the IPC is willing to assist ICANN in this critically important task.

Respectfully Submitted,

Intellectual Property Constituency

1. New gTLD Program: Rights Protection Mechanisms Review Draft Report, February 2, 2015 at https://www.icann.org/public-comments/rpm-review-2015-02-02-en. [↑](#footnote-ref-1)
2. Report at p. 7. [↑](#footnote-ref-2)
3. The IPC believes that this data is either incorrect or that ICANN needs to explain its methodology or terminology. The Trademark-Clearinghouse's most recent update indicates that approximately 250,000 TM Claims have been issued to date. See http://www.trademark-clearinghouse.com/content/tmch-stats-april-21st-2015. [↑](#footnote-ref-3)
4. Report at 8. [↑](#footnote-ref-4)
5. Id. at 55. [↑](#footnote-ref-5)
6. Id. at 59. [↑](#footnote-ref-6)
7. <http://www.donuts.domains/services/dpml/dpml-faqs> [↑](#footnote-ref-7)