



The Institute of Trade Mark Attorneys (ITMA) Comments on the ICANN Rights Protection Mechanisms (RPMs) Review Draft Report

ITMA is the professional body responsible for representing the interests of the UK trade mark attorney profession nationally and internationally. ITMA has around 1600 members (fluctuating slightly according to numbers of new and expiring memberships) consisting of a core membership of fully qualified Trade Mark Attorneys, and those training to be Trade Mark Attorneys, foreign Trade Mark Attorneys and other professionals in related areas of the law.

The responsibilities of ITMA include advising and consulting with legislative and other official bodies (in the UK and overseas) in order that the trade mark protection systems work for the benefit of trade mark owners and consumers. ITMA maintains strong relationships with the UK Government and international organisations, such as the European Community Trade Mark Office (OHIM) and the World Intellectual Property Office (WIPO).

ITMA welcomes this opportunity to comment on the RPMs Review Draft Report which has been produced as an initial assessment of the effectiveness of the rights protection safeguards adopted in ICANN's New gTLD Program. ITMA supports strong intellectual property protection in the new gTLDs and appreciates that the comments received during this public comment period will be incorporated into the Draft Report which will then serve as input to the RPMs Review, independent review of Trademark Clearinghouse (TMCH) and the Competition, Consumer Trust, and Consumer Choice Review.

ITMA recognises that while the new gTLDs that have launched to date are still in their early stages of operation, it is crucial for ICANN to identify now the fundamental issues that have had an impact on the effectiveness of the RPMs and work towards their resolution. To this end, ITMA's comments here seek to communicate to ICANN some of the key shortcomings of the RPMs.

The RPMs implemented during the initial launch of the new gTLDs, namely the Sunrise Period and Trademark Claims service (as well as the registry-specific RPMs, such as Domains Protected Marks Lists (DPMLs)) were operated through the TMCH. In this respect, the success of the RPMs are closely connected with the effectiveness of the TMCH. The feedback from brand owners, which is underlined by the relatively low number of trade marks recorded in the TMCH, is that the TMCH has not fulfilled its intended purpose of decreasing the administrative and financial burden on trade mark holders. On the contrary, the consensus view of brand owners is that having to go through the TMCH verification process, pay the high TMCH fees as well as the individual registry fees for Sunrise registrations, consider and in many cases sign up to private DPML blocks vastly increased the paperwork and cost of trade mark protection. In addition, the inadequacy of the protection offered by the TMCH, such as limitation of the TMCH protection to terms that were considered an "identical match" to a registered trade mark (rather than identifying the distinctive element of the trade

mark), and the limitation of the duration of mandatory Trademark Claims period to just 90 days, diluted the effectiveness of the TMCH.

It is a similar story with the Uniform Rapid Suspension (URS). The URS also failed to operate as a cost-effective brand protection mechanism for trade mark holders. We believe that there is a number of different way in which the URS could be developed, improved and simplified. However, if the URS is intended to provide a rapid relief in clear cut cases, then at the very least trade mark owners should be able to call for a transfer of the domain name (either in addition to, or in place, of the current remedy of suspension). We would also suggest that successful trade mark owners should not have to bear the cost of the URS process and that at least their URS fees should be repaid. There should be further consideration of how that repayment would be funded but there are a number of possibilities here ranging from the adoption of a “loser pays” regime in all cases or cross subsidies from those who have benefited from the introduction of the new gTLDs..

In conclusion, it is widely held by ITMA’s members and we believe trade mark owners generally that under the current framework the RPMs have not been satisfactory as cost-effective trade mark protection mechanisms. In the advent of the introduction of many more of new gTLDs, ITMA urges ICANN to resolve the issues identified above as a priority.

Thank you for your consideration of the above comments.

Best regards

**The Domain Name Working Group
part of the ITMA Law & Practice Committee**