



Via electronic submission
Karen.Lentz@icann.org

May 7, 2015

Ms. Karen Lentz
Director, Operations and Policy
ICANN
12025 E. Waterfront Dr., Suite 300
Los Angeles, CA 90094-2536

Dear Ms. Lentz:

We are pleased to submit the International Trademark Association's (INTA) response to ICANN's request for comments regarding the Draft Report of the Rights Protection Mechanisms review. We appreciate the courtesy of the extension and your consideration of the fact that the INTA Annual Meeting coincided with the due date.

We are also pleased that you, Margie Milam, Mary Wong and Owen Smigelski were able to attend the Annual Meeting in San Diego and speak with members of our Internet Committee as well as our staff.

INTA is proud to be an active participant in the multi-stakeholder process. We look forward to assisting ICANN in its ongoing efforts to evaluate and improve rights protection mechanisms in order to create a fair and competitive landscape within the domain name system. Thank you for your consideration of our comments and recommendations.

Sincerely,

A handwritten signature in black ink, appearing to read "Bruce MacPherson", is written in a cursive style.

Bruce MacPherson
Chief Policy Officer
BMacPherson@inta.org

**International Trademark Association Comment on the
New gTLD Program: Rights Protection Mechanisms Review Draft Report**

Due Date: May 1, 2015

I. INTRODUCTION

On February 2, 2015, ICANN published the “new gTLD program: Rights Protection Mechanisms Review Draft Report”¹ (Draft Report) for public comment.

INTA appreciates that ICANN is evaluating the effectiveness of the new Rights Protection Mechanisms (RPMs), which were an underpinning of community support for the new gTLD program. In order to prepare these comments, INTA's Internet Committee conducted an informal survey of its members (INTA respondents), gathering responses to applicable questions posed by ICANN in the Draft Report plus some additional questions INTA felt relevant. ICANN's Draft Report sets forth the hard figures concerning the (less than robust) use of RPMs and seeks qualitative data to go behind these numbers.

INTA asserts that based on the survey results cited above and the data from the Draft Report, it is clear that any review of the RPMs in the new gTLD program (at this stage) must be regarded as preliminary. With that said, INTA is pleased to see the discussion start as early as possible, since the aims behind the implementation of the RPMs was to mitigate potential risks and costs to rights holders that could arise in the expansion of the new gTLD namespace, and to help create efficiencies for registration service providers among gTLD launches². Early indications as to the effectiveness of the RPMs in meeting those aims are certainly not as positive as one might have hoped. This view is largely based on the seemingly little overall change in rates of infringement within the new gTLDs, which is troubling to INTA and its members given that support of the new gTLD program was largely grounded upon the purported effectiveness of these new RPMs.

In providing these comments, INTA hopes to assist ICANN in developing qualitative survey questions to gain understanding about the how and why behind the data it intends to collect. INTA applauds these efforts to improve RPMs in the new gTLDs and encourages ICANN to extend such improvements to legacy TLDs, where much of the problem persists.

The following sections address the new gTLD RPMs adopted by ICANN, as set forth in the Draft Report.

II. INTA PRELIMINARY COMMENTS ON ICANN NEW gTLD RPMs

A. Trademark Clearinghouse

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>.

² Draft Report at 4.

ICANN created the Trademark Clearinghouse (TMCH)³ as a new rights protection mechanism (RPM) to aid trademark owners. At the outset, we note that at best, the TMCH is nothing more than a watch service and records database designed to help trademark owners defensively register their brands in new gTLDs and to learn when third parties may be misappropriating their intellectual property rights, albeit in a streamlined manner.

1. Administration and Implementation

The figures in the Draft Report show that trademark owners have applied to register over thirty thousand trademarks with the TMCH.⁴ Our findings indicate that the primary purpose for applying is to qualify for Sunrise registration applications and the Trademark Claims services.⁵ INTA respondents have experienced a number of issues while trying to satisfy the requirements for trademark inclusion in the TMCH. While the TMCH website offers “Support” and “Frequently Asked Questions” pages covering various topics, including “API,” “Proof of Use,” “Mark Record Verification,” “Renewal,” etc., that does little to offset the awkwardness of the site when a trademark owner uses it to submit its trademark data for verification. There is no easy way to communicate in real time with the TMCH. Responses by email are slow and oftentimes questions asked are not fully answered, resulting in further unnecessary email correspondence between the trademark owner and Deloitte -- the TMCH verification services operator.

Under the current system, in order to update an already validated mark, Deloitte must be contacted to perform a manual update to its database so that the new information can be submitted.

Recommendation 1: It would be helpful if a new interface/API command could be created that would automatically submit the changes to the TMCH where the changes could be reviewed and/or approved by Deloitte as part of its process without requiring an intervening manual step. INTA suggests that ICANN develop survey questions to investigate this issue further.

2. Proof of Use Requirements

³ The TMCH is a centralized database of verified trademark registrations that is connected to the launch of new gTLDs. Brand owners who validate their trademark data through the TMCH are given access to participate in the Sunrise Period of the new gTLDs, which gives priority in registration to trademarks. In addition, when someone wishes to register a domain name that matches a trademark record in the TMCH, the TMCH will alert this person of the brand owner’s rights and he or she will need to acknowledge the brand owner’s rights before completing registration. Should that registration be completed, the TMCH will also notify the brand owner of the domain that has been registered matching its trademark.

⁴ Draft Report at 13.

⁵ The Draft Report states only 92% of applicants opted to have their marks verified for proof of use and be able to take advantage of the Sunrise period. See Report at 24.

INTA respondents have noted proof of use concerns during the trademark data verification process. In some cases, the mark application was returned as incomplete because the proof of use was labeled insufficient even though the same proof of use was accepted by the U.S. Patent & Trademark Office (USPTO) in connection with the trademark registration application. Having to provide alternative or additional proof of use should not be necessary if a trademark owner is providing what is already on file with, and approved as proof of use by the USPTO. In the case of U.S. registered trademarks under Section 1(a) or Section 1(b) of the Lanham Act, another consideration would be to exempt TMCH's proof of use requirement entirely because U.S. trademark law mandates such proof of use prior to the registration of these marks. We note that in the Draft Report the United States is the jurisdiction with the most verified registered marks in the TMCH.⁶

Trademark owners from other jurisdictions where no proof of use requirement exists under the local law, for example the EU countries, are frustrated by ICANN's the proof of use requirement, however, considering this to be unsupported by law.

Recommendation 2: INTA supports the qualitative questions on proof of use set forth in the Draft Report. INTA further recommends that in order to make the trademark verification process more effective, the TMCH should consider synchronizing or cross referencing its review of submissions related to U.S. registered marks with the USPTO records database, and with other registries which similarly operate a proof of use system.

3. Inadequacy of Available Remedies

INTA respondents report that the inadequacy of the available remedies supported by the TMCH is a key factor in reducing its perceived effectiveness in meeting the aims of the RPMs. The simple watching and brief duration of the Trademark Claims service, (just 90 days) is viewed as minimizing the benefit to trademark owners. The limitation of the TMCH records to identical matches to the trade mark, both for the purposes of Sunrise registration and for the Trademark Claims service also reduces the perceived value to trademark owners. This fails to account for domain names that are confusingly similar or misspellings of recorded marks, which are routinely the target for cybersquatting. Moreover, cybersquatters have reported to trademark owners that they never received a warning notice or failed to read it at the time of registration.

The perceived inadequacy of available remedies also ties closely to the cost of those remedies. There is a fee for recordal in the TMCH, and subsequent fees to utilize the available remedies, i.e. Sunrise registrations and Trademark Claims. Many registries are

⁶ Report at 15.

continuing the well-established practice of offering Sunrise registrations at prices substantially higher than those at general availability, with those designated as “premium” being charged at an even higher price. In doing so, the perception of INTA respondents is that these registries are ignoring the cost savings proffered by the TMCH and its validation processes.

Recommendation 3: ICANN should investigate the unreasonably high prices being charged for Sunrise registrations.

4. Misuse of TMCH Data

In addition, trademark owners are concerned that some registries may be misusing the TMCH data. For instance one gTLD registry operator appears to be designating terms which are subject to inflated Sunrise Premium pricing based on existing TMCH registered trademarks in prior Sunrise periods. In this vein, the large numbers of Trademark Claims notices, as compared to the smaller number of actual domain registrations, could also indicate that some are using this process to identify which marks have been recorded in the TMCH.

Recommendation 4: INTA urges ICANN to thoroughly investigate misuse of TMCH data in order for registries to charge unreasonably high prices.

B. Sunrise Period

This RPM allows trademark owners an advance opportunity to register domain names corresponding to their marks before names are generally available to the public. Registration of domain names in a TLD during the Sunrise period is restricted to Sunrise-eligible rights holders, as demonstrated by a Signed Mark Data (SMD) file generated by the Trademark Clearinghouse. New gTLD operators were required to choose between running a Start-Date Sunrise period and an End-Date Sunrise period. New gTLD operators also had significant discretion to reserve from registration and over pricing of names throughout the Sunrise period.

1. Experience of the Sunrise process overall

Overall, Sunrise periods are utilized by a small but significant number of brand owners, many of whom deem Sunrise protection adequate. However, many INTA respondents cited challenges in utilizing some registry Sunrises, which rendered the Sunrise periods less effective. The main challenges identified included the following:

- Sunrise prices per domain frequently are significantly higher than the price during general availability. This perception is exacerbated by some registries designating

some terms, protected by trademark law, as being premium names, and thus subject to higher pricing than the standard Sunrise pricing. More than one respondent referred to the “exorbitant fees” that some registry operators charged during Sunrise as foreclosing participation by brand owners. In the words of one respondent: “they contravene the spirit of the RPMs, damage ICANN’s reputation, harm consumers in contravention of ICANN’s mandate to promote the public interest, and create disincentives for rights owners to take advantage of the Sunrise period.” Trademark owners see the need for some formalized method for capping pricing during Sunrise, and a dispute resolution procedure for challenging pricing, particularly the designation of premium names.

- Trademark owners are having great difficulty in tracking TLD launches and related information about Sunrise requirements. For these reasons, many INTA respondents thought that large teams and budgets were necessary to successfully utilize Sunrise periods.
- The lack of notice exacerbated the problem of tracking registry policies that were subject to change. While most respondents found having a minimum set of requirements helpful, many commented that these were frequently rendered less effective in practice.
- RPMs Requirements permit registries to reserve an unlimited number of names, permitting registries to withhold names from registration for the duration of the Sunrise. If released for registration after the Sunrise, the registry operator is not obliged to run an additional Sunrise, only to apply the Trademark Claims. Many INTA respondents were informed that their desired domain name, which was a match to a trade mark recorded in the TMCH, was reserved and unavailable for registration. As one INTA respondent said: “[S]unrise periods are not effective because they are being easily circumvented by registries through use of reserve lists.” Concerns were also expressed about the lack of transparency over reservation of names by registries and the difficulty in obtaining definite information as to the reason a name was unavailable.

Based on INTA's informal survey, the greatest challenges facing trademark owners during Sunrise phases, there were the recurring themes of high prices, imperfect information, high volume of TLDs being launched at the same time, and reservation of names. Other challenges include:

- Misleading pre-registration verification processes;
- Previous registrations for the same domain name by third parties;
- Inconsistent SMD acceptance policies by registrars/registries; and
- Insufficient registrars/difficulties identifying which registrars were participating in the Sunrise for a particular registry.

Recommendation 5: INTA supports the qualitative questions concerning the Sunrise process set forth in the Draft Report ensuring that ICANN examines the issues of Sunrise pricing, communication of Sunrise periods, and inconsistent operation of Sunrise and verification processes by registrars.

2. Use of SMD Files

Generally, INTA respondents were favorable to the use of SMD files, and few issues were identified. Most respondents believed the SMD files did help streamline the process, although some initial investment of time was required to learn how to use them and to educate colleagues internally.

3. Sunrise Consistency and Duration

Registry operators that were required to run a Sunrise period had to choose between a Start-Date Sunrise period and an End-Date Sunrise period. In a Start-date Sunrise, the registry must give 30-days' notice before commencing the Sunrise. Once the Sunrise starts, it must run for 30 days or more. Claims by trademark owners are processed on a first-come-first-served basis, so there is no need for auctions. In an End-date Sunrise, the registry can announce the Sunrise as late as the day the Sunrise starts, but must run the Sunrise for 60 days or more. Trademark owners have the duration of the Sunrise period to submit a claim for a domain. At the end of the period, the registry registers all the claims that are unique and generally utilized auctions if there is more than one applicant for the same domain.

Regarding alternative types of Sunrise periods that might be useful, several observations were made:

- The alternative models made it harder to track and manage Sunrise periods because it was one more piece of registry-specific information to take into account at a time when potentially high volumes of TLDs were being launched.
- It may be more equitable to rights holders for all registries to implement a single uniform 60-day End-Date Sunrise system across all open new gTLDs so that trademark owners with similar names have an equal chance at protecting their trademarks.
- Whether a particular model was useful may depend on the trademark owner:
 - Start-date Sunrise periods may be more attractive for trademark owners that have the capacity to keep well-informed and do not want to compete in an auction with other companies who use the same trademark in another field. However, this model “also creates some uncertainty for trademark owners,

because they cannot guarantee they get a name they want no matter how much they are willing to pay for it.” Also, this model is perceived by INTA respondents to engender more risk of illegitimate registrants.

- End-date Sunrises may be more attractive for trademark owners that could “not get their orders in at the beginning due to struggles in managing the process” and wanted to “challenge potentially improper TMCH registrations for the same mark”. However, this model’s potential lack of notice and the use of auction resolution “hamper[ed] effective business planning”, particularly where registries were “not uniform” in their administration of competing-claim resolution.
- That having more advance information about the Sunrise periods would help trademark owners plan for one alternative or both.

4. Other Launch Procedures

Many INTA respondents commented on the use of Qualified Launch Programs (QLP) and whether these succeeded in maintaining safeguards against intellectual property infringement.

The QLP was intended to provide a means for Registries to register a limited number of names to third parties in order to promote their TLDs prior to the Sunrise Period, while maintaining safeguards against intellectual property infringement. If a domain name matches a label in the Trademark Clearinghouse (TMCH), the domain name may be registered to a Sunrise-Eligible rights holder. If a domain name is not an exact match, the domain is permitted to be registered in a QLP to *any* third party, up to a limited maximum number.

Concern was expressed about whether allowing registries to enter into private arrangements gives preference to business partners above Sunrise-eligible rights owners and risks circumventing the RPMs altogether. Early indications are that the balance set under the QLP is probably the right one by limiting pre-Sunrise registrations to Public Authorities, except where there is no matching TMCH recordation. However there appears to be relatively limited evidence about the impact of QLPs to date, and it would be beneficial to gather further evidence on this.

Experience with Limited Registration Periods (LRPs) among INTA respondents was low. Those who were aware cited the same challenges with costs and in keeping informed of timing and requirements.

Regarding other launch programs such as Approved Launch Programs (ALPs), respondents were concerned with the lack of transparency into ICANN’s treatment of ALP applications.

To date, only a few ALP applications have been published for public comment, without any transparency regarding final disposition. The Draft Report reveals, however, that 41 such applications have been submitted, but it's unclear how many have actually been approved.

Recommendation 6: INTA suggests that ICANN develops questions and data to examine how best to treat pre-Sunrise programs which are perceived by ICANN and the IP Community as having at their heart the protection of trademarks, for example grandfather programs.

5. Sunrise Dispute Resolution Procedure (SDRP)

INTA respondents had little experience with SDRP. Only one respondent had direct experience on an SDRP, and reported that it was straightforward. It is not possible to form any conclusions based on this limited experience, which likely derives from inadequate awareness and utilization of TMCH and Sunrise processes.

C. Trademark Claims Service

Most INTA respondents believe the claims notice has been moderately effective in reducing cybersquatting in new gTLDs. However, the data quoted in the Draft Report seems surprising and would clearly benefit from further investigation and clarification. The Draft Report refers to over 25 million claims notices issued since the inception of the new gTLD program, but that only 96,000 domain names have been registered following the issuance of a claims notice. This suggests a deterrence rate of over 99%. Some INTA respondents noted, however, that their experience was that claims notices had been ignored with the infringing domains proceeding to registration.

Some respondents expressed concern that claims notices are limited to an exact match of a mark registered in the TMCH, which reduces the value of a claims notice for trademark owners since cybersquatters choose to register slight variants rather than exact matches.

Most respondents are of the opinion that claims notices should be provided for the duration of the TMCH and not for only 90 days. Members generally advised that extended claims services were useful, with some stating that such services should be automatically provided instead of requiring an opt-in. Other than occasional challenges with managing the volume of notices received, members generally did not cite challenges with the extended claims services.

INTA respondents also provided content and process suggestions for improving the claims notices received by trademark owners. Suggested improvements included:

- Providing Whois information on a claims notice. During the look-up, much of the Whois information is either faulty or subject to privacy and proxy services, thus

increasing the difficulty of addressing infringing domains that have proceeded to registration despite receipt of a claims notice.

- Indicating whether the domain resolved an active website at the time the notice was issued and whether registrants had registered multiple domains.
- Having a tool to track the claims notices sent for any given record.
- Where there are multiple TMCH entries for one string, it would be helpful for the notices to be consolidated and not reiterated with only the mark information differing.

Previously abused labels were considered less effective in preventing trademark abuse and infringement by the INTA respondents. While members generally agreed that, conceptually, the idea of including previously abused labels in the TMCH was useful, members cited the cost of validation and a generally burdensome process as obstacles to using this aspect of the claims service. Of particular concern was that, even after going through the cumbersome verification process, previously abused labels were still only eligible for the claims service and not for Sunrise services. Members recommend exploring ways to streamline the previously abused labels process to make it easier for more TMCH registrants to access.

In summary, INTA members find the Trademark Claims service and notices provide a valuable and useful tool to combat trademark and domain name infringement in new gTLDs. In part, this is supported by data that appears to indicate that claims notices deter cybersquatters.

Recommendation 7: ICANN should investigate improving the Trademark Claims with its extension to “marks plus”, the inclusion of Whois information on notices, better tracking tools, indefinite extension of the claims notice period, and a less cumbersome process for including previously abused labels.

D. Uniform Rapid Suspension

INTA appreciates the URS as a quick, inexpensive alternative to the Uniform Domain Name Dispute Resolution Policy (UDRP). However INTA does not agree with the conclusion of the Draft Report that the URS “works fairly well in terms of what it is designed to accomplish.”⁷ Even the Draft Report concedes that “some rights holders have not opted to use this service”⁸

To illustrate, the Draft Report notes that approximately 200 URS complaints have been filed to date.⁹ But in that same timeframe (since the beginning of 2014), over 320 new

⁷ Report at 59.

⁸ *Id.*

⁹ *Id.* at 55.

gTLDs have been the subject of UDRP complaints filed at WIPO alone (not counting other UDRP providers such as NAF, which, according to its searchable case database, has handled 65 UDRP complaints involving new gTLDs).¹⁰ This comparison is not quite apples-to-apples: as the Draft Report notes, a URS or UDRP may involve more than one domain name. But the point still holds: the initial returns have been meager, to the point that some commenters have openly wondered whether trademark owners have “given up” on the URS in favor of the UDRP.¹¹ While the reality may not be so dire, the sentiment is still relevant to ICANN’s assessment of the effectiveness of the URS. A tool is only effective if it is actually used. Because the statistics demonstrate that the URS has only been used sparingly, INTA submits that the answer to the first question posed by the Draft Report is that the URS has not been effective – at least not yet. In response to the final question posed by the Draft Report – what would make the URS more effective – INTA offers two recommendations:

1. Improve the URS remedy.

As the Draft Report notes, 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.¹² By its nature, this is not a long-term solution; rather, it is at best a temporary fix that carries with it the risk that the domain name will simply be registered again by another infringer once it is released. Any steps to improve the utility of the URS must begin there. Most preferable would be a mandatory transfer remedy akin to that offered under the UDRP. Given that the URS is designed to address only clear-cut cases of infringement, we see no due process concerns that would make such a remedy inequitable to the losing party, and see no reason why such a change would disrupt the speed or cost-efficiency that distinguishes the URS from the UDRP. Short of that, another possible alternative could include extending the length of the suspension to something like 5 years (as opposed to the current duration – remainder of the registration period – which, depending on the facts, could be only a few weeks or months) and then allowing losing respondents to voluntarily transfer the domain(s) at issue to the prevailing complainant during that time (as of now, such a transfer is not allowed during the suspension). Either of these possibilities would be an improvement over the status quo, and would offer a more meaningful remedy for trademark owners while still maintaining the quick, low-cost structure of the URS.

2. Extend the response fee to all cases.

¹⁰ See http://www.wipo.int/amc/en/domains/statistics/gtlds_yr.jsp?year=2015
http://www.wipo.int/amc/en/domains/statistics/gtlds_yr.jsp?year=2014; and
<http://domains.adrforum.com/decision.aspx>.

¹¹See <http://www.thedomains.com/2014/07/06/have-trademark-holders-given-up-on-the-urs-last-17-disputes-filed-15-were-udrps/>.

¹² Report at 59.

INTA sees no reason why the requirement that a respondent pay a response fee – which is ultimately refundable to the prevailing party – should be limited to those URS complaints listing 15 or more domain names registered by the same registrant. Rather, one surefire way to increase trademark owner usage of the URS would be to apply that same response-fee requirement to all URS complaints, without regard to the number of domain names at issue. Feedback suggests that more trademark owners would use the URS if there was a possibility that their costs to do so would be refunded – especially given that the Draft Report shows that trademark owners have prevailed in 87% of URS proceedings thus far (albeit in a small sample size).¹³ Of course, eliminating the current 15-domain minimum may increase the number of defaults from the current 52% rate¹⁴ – potential respondents who view their case as weak may rationally choose to default rather than to pay the response fee. But that is not a bad thing. Although all determinations – including defaults – are evaluated by a URS panel on the merits, making this change would, over time, allow providers to focus more of their resources on those URS disputes for which the respondent thinks enough of its arguments to risk the response fee. In other words, elimination of the 15-domain minimum would benefit trademark owners, providers, and “legitimate” respondents alike. The only group it would harm would be cybersquatters.

Recommendation 8: As the IRT noted back 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.¹⁵ It is still early, but so far the URS has not met that standard. While there are many possible ways to promote trademark-owner buy-in, and to increase the usage of the URS,¹⁶INTA submits that the two outlined here – improvement of the remedy and removal of the 15-domain minimum for collection of response fees – are the most likely to do so. Moreover, both proposals still appropriately balance costs between trademark owners, providers, registries, registrars, and legitimate users.

E. Registry-Specific RPMs

Many of the INTA respondents reported that they have made use of registry-specific RPMs in the new gTLDs, either on their own behalf or on behalf of their clients. This demonstrates the importance, when reviewing the RPMs in the new gTLD program, to look not just at the ICANN-mandated RPMs but to review the overall RPM ecosystem.

¹³ Draft Report at 56-57.

¹⁴ Draft Report at 58.

¹⁵ Draft Report at 8.

¹⁶ One easy way to increase usage of the URS would be to expand the scope of eligible domains covered by it to cover, for example, legacy gTLDs such as .com.

The most commonly-used registry specific RPM was the Domains Protected Marks List (DPML) operated by registry operator, Donuts, and the feedback received from INTA respondents consequently demonstrated greater familiarity with that offering. Some also had experience of the DPML offered by Rightside, or the similar block mechanism offered by Minds & Machines (MPML) (together referred to as Registry Blocks).

In considering whether to utilize Registry Blocks, INTA respondents refer to the cost and the number of TLDs likely to be covered as being the deciding factors. The perceived benefits of the Registry Blocks, for those who used them, were considered to be the efficiency and relative cost-effectiveness of being able to protect across multiple TLDs in one go, when compared to making numerous defensive registrations or having to bring enforcement proceedings. Some reported that, for their clients, bearing in mind the number and nature of the TLD strings, the Registry Blocks were not cost-effective and that they had opted instead to target, for defensive registrations, specific TLDs most relevant to the area of interest of the company.

Although many INTA respondents considered the Registry Blocks to be a useful RPM mechanism, these same respondents also identified the following challenges:

- Where a registry reserves the right to withdraw or change the block at any time, trademark owners are concerned that the block they have purchased could be unilaterally removed in the future.
- Where specific names, which may include trademarks, have been designated as Premium names some or all of these (depending on the registry operator) are not eligible for the Registry Block. This could significantly reduce the value of the Block, depending in the extent to which the term is considered Premium.
- Where the registry operator transfers the registry to another operator, the Registry Block will not apply. Trademark owners reported difficulties in keeping track of registry transfers, with the risk of being unaware that the block was no longer effective in a particular TLD. A number of respondents considered that additional publicity of such transfers would be beneficial.
- The uncertainty of how much Internet “real estate” a given registry operator would ultimately occupy, due for example to string contentions and registry transfers. This has made it extremely difficult for trademark owners to accurately assess the usefulness and value of any individual Registry Block at the outset. For example, initially an applicant applied for relatively few registries, such that many may have concluded that their DPML was not good value for money. Subsequently, with the transfer of a number of registries from one applicant to another, that assessment might be different but the opportunity to block in some of the earlier applicant’s registries will already have been missed.

Recommendation 9: As stated above, INTA considers it important that the registry-specific RPMs are taken into account by ICANN when reviewing the overall effectiveness of the RPMs for new gTLDs. Despite the challenges noted, INTA respondents have utilized the Registry Blocks and found them of use as part of an overall suite of protective measures. Those respondents did note, however, that they would welcome clearer rules to address some of these challenges, and that wider publicity would be beneficial for brand owners. Many view the fact that individual registry operators have been able to introduce effective Registry Blocks as demonstrating that there is a very real desire among trademark owners for a more global blocking mechanism operating across all TLDs. In reviewing the RPMs, ICANN is urged to investigate the possibility of establishing a global blocking mechanism which operates across all TLDs.

F. Post-Delegation DRPs

To date, INTA is unaware, of anybody trying to use any of the Post-Delegation DRPs adopted as part of the new gTLD program. Awareness of this RPM among trademark owners is extremely low, as neither ICANN nor its contracted parties have taken any significant steps to raise awareness either of the Public Interest Commitments (PICs) adopted by some new registries, or the Post-Delegation DRPs available to address registry abuses. In particular, PICs seem almost worthless if there is no community awareness of them and their significance or value as RPMs. The preliminary view of INTA respondents is that, as to each and every of the Post-Delegation DRP options, there may be fundamental problems relating to the burden of proof, cost of these proceedings, and the remedies available. This may well explain why there has been no use of these procedures to date, though it is still very early in the new gTLD program.

Recommendation 10: INTA encourages ICANN to raise awareness of these DRP options, and evaluate whether amendments may be appropriate to encourage that the underlying goals of these new policies are achieved.

INTA is a 136 year-old global not for profit association with more than 6,400 member organizations from over 190 countries. One of INTA's goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. INTA has also been the leading voice of trademark owners within the Internet Community, serving as a founding member of the Intellectual Property Constituency of ICANN. INTA's Internet Committee is a group of over 200 trademark owners and professionals from around the world charged with evaluating treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet, whose mission is to advance the balanced protection of trademarks on the Internet.