

**FairWinds Partners Comment on “Draft Report: Rights Protection Mechanisms”
May 1, 2015**

FairWinds Partners appreciates the opportunity to offer its comments on ICANN’s “Draft Report: Rights Protection Mechanisms,” published on February 2, 2015. FairWinds is a new gTLD Registry Operator for the .FAIRWINDS gTLD and serves as a consultant to numerous .BRAND registries and applicants, as well as other brand owners. A significant aspect of our role as advisors to brand owners is advising clients on issues related to domain names and Intellectual Property protection. It is in this latter capacity, as an advisor to brand owners and advocate for their IP interests in the domain name space, that we are submitting these comments.

Below, we will offer our responses to certain questions posed within the Draft Report. In order to keep this comment concise, we have only provided responses to the questions on which we feel we can provide constructive feedback.

Trademark Clearinghouse

Question b. Were there any challenges related to marks from specific jurisdictions in relation to the Clearinghouse guidelines?

Yes. In instances where a given jurisdiction did not have an online trademark database, the Trademark Clearinghouse (TMCH) required trademark holders to supply additional documentation for their marks. These additional requirements were sometimes onerous for trademark owners, especially when they were attempting to file their marks under a time constraint (e.g., in time for a specific Sunrise period).

Question d. What factors could be considered to make the trademark verification process more effective?

In a number of cases, the TMCH conducted a subsequent review of marks that it had originally verified and deemed correct, which later led to these marks being labeled as incorrect if errors were discovered. While we understand and appreciate the need to perfect the review process, we disagree with the TMCH’s practice of suspending the trademark owner’s access to Sunrise registrations and Claims notices without offering a grace period for the owner to correct the errors. The TMCH also suspended access when a trademark’s TMCH registration was still valid, but the trademark registration had been expired if proof of renewal was not provided.

Going forward, FairWinds strongly recommends that the TMCH build in a grace period of at least 14 days for trademark owners to correct problems with their TMCH registrations that had originally been deemed acceptable by the TMCH, or to provide evidence of renewal for a trademark registration that has expired.

Question g. Do the Clearinghouse benefits outweigh the concerns about distribution of data?

FairWinds recognizes the delicate balance that the TMCH must strike between providing benefits to trademark owners while preventing the misuse and abuse of private data. While we believe that there should be limits on who is able to access TMCH data, FairWinds

recommends that the TMCH implement search functionality for trademark holders and qualified Trademark Agents. At a minimum, these groups should be able to search for and access the records of the marks they have registered (to view them all in one place), as well as any marks that are an exact match for the trademarks they have registered. For the latter case, we recognize that certain data points should be kept private; however, it would be invaluable for a trademark owner (or an Agent, working on behalf of its client) to be able to know if another entity has registered an exact match of one of its trademarks.

Sunrise Period

Question c. What were the challenges, if any, in terms of registering a domain name during the Sunrise period?

One major challenge that FairWinds encountered on behalf of our clients during Sunrise was a lack of information. In many instances, it was unclear which registrars would be offering registrations in specific gTLDs and at what time (i.e., during Sunrise or only during General Availability). Secondly, there were multiple occasions where a registry chose to reserve a non-generic trademark from Sunrise registration, but this was not made clear until the trademark owner attempted to register the name during Sunrise. Both of these factors presented challenges for brand owners to effectively take advantage of the Sunrise period for some gTLDs.

Question g. Is there an appropriate balance of registry discretion to reserve names from registration and the inclusion of names in the required RPMs? Should additional considerations be applied around registry allocation practices and their interaction with the required RPMs?

While FairWinds acknowledges the value that registries can extract from reserving certain names from registration, the practice on the part of some registries of reserving non-generic, unambiguous, and well-known trademarks from registration is an over-reach on their part. Making these kinds of trademarks unavailable for Sunrise registrations or charging exorbitant registration fees for these names during Sunrise or General Availability violates the spirit of the required RPMs and presents a real obstacle to trademark owners who are trying to protect their marks within the parameters available to them. It is worth noting that a number of registries, when approached directly, would remove these names from their reserved list or decrease the registration fees upon request.

Trademark Claims

Question c. Were any technical issues identified relating to the Claims service?

FairWinds observed numerous instances where trademark holders did not receive Claims notices for all registrations matching their trademark. When such an occurrence happened to our clients, FairWinds contacted representatives of the TMCH, who stated that this was an issue with the registry. Unfortunately, when trademark owners not receive Claims notices, there is no way for them to review the notices after the fact and access the data contained in the Claims notice.



Question f. How could the Claims service be improved?

To address the issue raised in our response to question c, above, FairWinds recommends that the TMCH create a searchable database of Claims notices so that trademark owners or their Agents can view all of the historical Claims notices that have been issued on their trademarks in a centralized location.

Question g. How useful are extended Claims services?

Generally speaking, FairWinds has found that longer-running Claims services are useful to trademark owners. However, we acknowledge that it is technically onerous for Registry Operators to offer this function for extended periods of time. As such, going forward, FairWinds urges the TMCH to continue to provide ongoing Claims notifications after the required 90-day Claims period.