



Introduction

MarkMonitor welcomes the opportunity to comment on the “Proposal for a Specification 13 to the ICANN Registry Agreement to Contractually Reflect Certain Limited Aspects of ‘.BRAND’ new gTLDs.”¹

MarkMonitor encourages ICANN to adopt Specification 13, in recognition of the unique nature, needs and operational concerns of .BRAND applicants. MarkMonitor believes the criteria are appropriate, narrowly tailored, and have sufficient safeguards in place to help avoid any abuse. MarkMonitor supports the work of the Brand Registry Group in this regard, and thanks ICANN for its cooperation in developing this necessary and welcome contractual amendment to the Registry Agreement.

Comments

Is it appropriate to classify certain TLDs as “.BRAND TLDs”?

Yes. It has become clear, over the course of evaluating new gTLD applications that the program has succeeded in spurring innovative ideas for new and potentially exciting TLD spaces. The communities, industries and companies that seek to use TLDs for directed and/or limited purposes should have the right to group and classify themselves as they identify certain useful commonalities. They should also be able to advocate for certain contractual amendments, owing to any unique operational concerns of the group.

.BRANDs, insofar as they correspond to legitimate, registered trademarks (that meet the eligibility requirements contained in Section 5.1 of proposed Specification 13), are appropriately classified, and certain contractual modifications, as in proposed Specification 13 are appropriate.

Additionally, we believe this classification is an important measure to put in place for future gTLD rounds which will undoubtedly attract .BRAND applicants as well.

Is the definition of “.BRAND TLD” sufficiently narrow to capture only what is commonly recognized as a corporate brand?

Yes. The criteria contained in proposed Specification 13 is appropriately tailored to accommodate international trademark standards, while avoiding inclusion of trademark

¹ Proposal for a Specification 13 to the ICANN Registry Agreement to Contractually Reflect Certain Limited Aspects of “.Brand” new gTLDs, December 6, 2013, at <http://www.icann.org/en/news/public-comment/spec13-06dec13-en.htm>.

registrations which seek to “game” the system in order to take advantage of the benefits of Specification 13. There is also sufficient room for ICANN to evaluate certain borderline cases. In that respect, we join with Valideus in encouraging ICANN to “take a holistic, considered approach...in assessing whether a TLD is a bona fide .BRAND registry.”² We additionally support the inclusion of the words “or its Affiliate” at 5.1(i)f to reflect the range of legitimate and well-known corporate structures that trademark owners generally, and .BRAND applicants in particular, ordinarily employ.

Will there be unintended consequences associated with the implementation of draft Specification 13?

It is impossible to answer a question that asks us to look in to a crystal ball. However, Specification 13 has many safeguards in place for ICANN to use its discretion to qualify or disqualify registries from opting into the amendment (including a relevant Registry Operator audit/self-certification). In addition, there are appropriate safeguards in place to ensure that any TLD or brand failure is accommodated without eliminating the possibility of other brands to apply for TLDs in the future.

As with any contract, the Registry Agreement as a whole has an element of fluidity built in, to accommodate for unintended or unforeseen consequences, and MarkMonitor considers those to be appropriate to address any future issues.

Is it appropriate to permit a Registry Operator for a “.BRAND TLD” to limit its registrar use to one or more preferred ICANN accredited registrar(s)?

Yes. In further recognition of the unique nature of .BRANDs, limiting registrar use to one preferred ICANN accredited registrar is appropriate. It is commonplace in the domain name market today for corporations to use a single, trusted registrar and this practice should be extended to the registry agreement as proposed.

Is a two-year “cooling off” period prior to re-delegation of the “.BRAND TLD” upon expiration or termination of the Registry Agreement appropriate (subject to the limitation provided in the draft Specification)?

Yes. International trademark law allows for the coexistence of brands where there is no likelihood of consumer confusion. In this regard, some may consider it inappropriate for .BRAND TLDs to maintain a monopoly over a term *in perpetuity*, where that TLD is no longer in use and where there is genuine legitimate coexistence. In this regard, the agreement appropriately considers and accommodates the scope of existing trademark law, and does not expand it.

The two-year “cooling off” period is appropriate to ensure that consumer confusion does not result from too quickly transferring the TLD from one brand to another.

² Valideus Comment on Proposal for a Specification 13 to the ICANN Registry Agreement, p. 3, December 30, 2013, at <http://forum.icann.org/lists/comments-spec13-06dec13/msg00003.html>.

About MarkMonitor

MarkMonitor, the world leader in enterprise brand protection and a Thomson Reuters Intellectual Property & Science business, uses a SaaS delivery model to provide advanced technology and expertise that protects the revenues and reputations of the world's leading brands. In the digital world, brands face new risks due to the web's anonymity, global reach and shifting consumption patterns for digital content, goods and services. Customers choose MarkMonitor for its unique combination of industry-leading expertise, advanced technology and extensive industry relationships to preserve their marketing investments, revenues and customer trust. Learn more at www.markmonitor.com.

Respectfully Submitted,

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