Special Trademark Issues Review Team

Draft Recommendations

STATUS OF THIS DOCUMENT

These are the recommendations for the Generic Names Supporting Organization (GNSO) from the Special Trademark Issues Review Team (STI) on the policy implications of certain rights protection mechanisms proposed for the New GTLD Program.

BACKGROUND AND APPROACH TAKEN

On 12 October 2009, the ICANN Board sent a letter[1] to the GNSO requesting its review of the policy implications of certain trademark protection mechanisms proposed for the New gTLD Program, as described in the Draft Applicant Guidebook and accompanying memoranda. Specifically, the Board Letter requested that the GNSO provide input on whether it approves the proposed staff model, or, in the alternative, the GNSO could propose an alternative that is equivalent or more effective and implementable. In response, the GNSO adopted a resolution creating the Special Trademarks Issues review team (STI) on 28 October 2009[2] which included representatives from each Stakeholder Group (identified on **Annex 3)**, to analyze the specific rights protection mechanisms that have been proposed for inclusion into the Draft Applicant Guidebook.

At its initial meeting in Seoul, the STI decided to proceed by developing an alternative proposal for the GNSO's consideration.   Since Seoul, the STI has participated in multiple telephone conferences per week in an effort to identify an alternative model that would reflect the consensus position of the members of the STI. The alternative model described below reflects compromises made by each of the stakeholder representatives in an effort to find a solution that would be more effective and implementable than the Staff Model.

This STI alternative proposal does not reflect the opinion or approval of any constituency or stakeholder group.   Given the limited amount of time allocated to developing the proposal, it was not feasible for the representatives to solicit the prior approval of their stakeholder group members.   Instead, it is expected that such approval will be sought by the time the GNSO Council votes on the recommendations contained in this Report.

The STI work focused its attention on the areas of the Staff Model that raised concerns for the members of the STI.   Identified below are principles that address these concerns, along with an assessment of the level of consensus achieved within the STI for each of these principles.   For the purposes of this Report, the STI has adopted the following conventions to describe the level of agreement among the STI for each principle:

- Unanimous Consensus
- Rough consensus - a position where a small minority disagrees but most agree
- Strong Support- where there may be significant opposition
- No Consensus

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[1] A copy of the Board Letter is attached as **Annex 1** to this Report.

[2] The text of the GNSO Council Resolution is contained in **Annex 2** to this Report.

TRADEMARK CLEARINGHOUSE PROPOSAL

There is a rough consensus among the members of STI that creation of a Trademark Clearinghouse (TC), while not a rights protection mechanism itself, would be a beneficial implementation tool for rights protection mechanism for inclusionmechanisms, such as sunrise or trademark claims, and should therefore be included in the New GTLD program. The STI recognizes that a Trademark Clearinghouse could serve as a convenient mechanismlocation to store trademark information in a centralized location on behalf of trademark holders, and could create efficiencies for registries, that benefit from having one database from which to interact to obtain the necessary trademark information to support its pre-launch rights protections mechanisms.

The STI Trademark Clearinghouse Model includes the following features:

	Feature	STI Principles	Level of Consensus
1	**Name**		
1.1	Trademark Clearinghouse	The name of the rights protection mechanism should be the "Trademark Clearinghouse" to signify that only trademarks are to be included in the database.	*Unanimous Consensus*
2	**Functionality of Trademark Clearinghouse**		
2.1	Separation of Functions	The TC should be required to separate its two primary functions: (i) validation of the trademarks included in the TC, and (ii) serving as a database to provide information to the new gTLD registries. Staff should have the discretion to determine whether the same provider could serve both functions, or whether two providers would be more appropriate.	*Unanimous Consensus*

2.2	Use of Regional Expertise	The TC Service Provider(s) should utilize regional Marks Validation Service Providers (VSP) (whether directly or through sub-contractors) to take advantage of local experts who understand the nuances of the trademark rights in question.	*Unanimous Consensus*
2.3	Segregation of TC Database	The TC Service Provider should be required to maintain a separate TC database, and may not use the TC database to provide ancillary services.	*Unanimous Consensus*
2.4	Global Submission of Data into the TC	The TC should be able to accommodate submissions from all over the world. To accommodate this principle, the entry point for trademark holders to submit their data into the TC database could be regional entities or one entity (provided that can demonstrate it can accommodate language/currency/cultural issues globally). The system to be adopted by the TC Service Provider for submissions from trademark holders should allow for different/local languages, with the exact implementation details to be left to Staff. Multiple portals for entry of data to be submitted into the TC Database would be acceptable.	*Unanimous Consensus*
2.5	Trademark Holder Submission Through One Entry Point	The trademark holder would only be required to submit to one entry point if it has multiple registrations covering many regions. If multiple entities used, ICANN should host an information page describing how to locate regional submission points.	*Unanimous Consensus*

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2.6	One Centralized Database for Registry Use	Registry should only need to connect with one centralized database to obtain the information it needs to conduct its sunrise processes or IP Claims Services, regardless of whether ICANN contracts with more than one TC Service Provider.	*Unanimous Consensus*
3	**Relationship with ICANN**		
3.1	ICANN Accreditation Agreement for Validation Services	The Service Provider(s) providing the validation of the trademarks submitted into the TC should adhere to rigorous standards and requirements that would be specified in an ICANN accreditation agreement. The model to be suggested for this contractual relationship would be similar to the detailed registrar accreditation agreement, rather than the minimal accreditation agreement currently used by ICANN for UDRP providers (WIPO or NAF).	*Unanimous Consensus*
3.2	ICANN Agreement for Database Services	The TC Service Provider responsible for maintaining the centralized database should have formal, detailed contract with ICANN. The contract should include service level agreement metrics, customer service availability (seven days per week, 24 hours per day, 365 days per year), and data escrow requirements. The Agreement should also include indemnification by Service Provider for errors such as false positives for participants, such as Registries, ICANN and Registrars.	*Unanimous Consensus*
4	**Marks Eligible for Inclusion in the TC**		

4.1	Nationally Registered Marks	The TC Database should be required to include nationally registered trademarks, from all jurisdictions, (including countries where there is no substantive review).	*Unanimous Consensus*
4.2	Common Law Rights	No common law rights should be included in the TC Database, except for court validated common law marks. The TC Service Provider could charge higher fees to reflect the additional costs associated with verifying these common law rights.	Rough Consensus BC minority position that TC should include additional common law rights, specifically, combinations of registered marks plus additional words.

4.3	Conversion of Mark into TC Database	The TC Database should be structured to report to registries stings that are considered an "Identical Match" with the validated trademarks. "Identical Match' means that the domain name consists of the complete and identical textual elements of the Mark. In this regard: (a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted, (b) only certain special characters contained within a trademark are spelt out with appropriate words describing it (@ and &.), (c) punctuation or special characters contained within a mark that are unable to be used in a second-level domain name may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches, and (d) no plural and no "marks contained" would qualify for inclusion.	Rough Consensus BC Minority Position that the Database should be structured to allow registry to expand coverage to include "marks contained" although use of this expanded version would be voluntary, not mandatory.
5	**Mandatory Pre-Launch Use of the Trademark Clearinghouse**		
5.1	IP Claims or Sunrise Use	All new gTLD registries should be required to use the TC to support its pre-launch rights protection mechanisms (RPMs) that should, at a minimum, consist of ~~a sunrise process or an IP Claims Service.~~ an IP Claims Service, or a sunrise process which complies with the following minimum sunrise eligibility standards: (a)	*Unanimous Consensus*

| | | Ownership of a registration of national effect that issued on or before [the date of the Registry Agreement] and was applied for on or before [the date that ICANN publishes the list of applications received in the round] for a mark that identically matches the applied-for domain name; (b) the registry may impose any further requirements relating to the International Class of goods and/or services covered by the relevant registration that it deems appropriate to its TLD; for instance, a registry could require that trademark registrations relied upon by Sunrise applicants must cover certain categories of goods or services (e.g., the .shoe registry could restrict participation in its Sunrise process to owners of trademark registrations that cover shoes or other goods in International Class 25); (c) | |

		If the registry permits Sunrise registrations to be based court validated rights, those other legal rights must be capable of being authenticated and must be recognized under the laws of the country in which the registry is organized; (d) and Sunrise registration applicants must affirm that all information provided is true and correct, and must acknowledge that the provision of false information may result in the cancellation of any resulting domain name registration. Each sunrise process shall allow challenges based on at least the following four grounds:	
		▪ At the time the challenged domain name was registered, the domain name registrant did not own a trademark registration of national effect or, if common law rights, were not court validated;	
		▪ The domain name is not identical to the trademark on which	

		the domain name registrant based its Sunrise registration; ▪ The trademark registration on which the domain name registrant based its Sunrise registration is not of national effect; and ▪ The trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before [the date of the Registry Agreement] and was not applied for on or before [the date that ICANN publishes the list of applications received in the round]. There is no requirement that a registry adopt both of these RPMs.	
5.2	Protection for all Trademarks in the TC	New gTLD registries should provide equal protection to all trademarks in the TC for their RPMs, with one exception. ICANN could allow specialized gTLDs to restrict eligibility for sunrise registrations to fit the purpose of the registry as described in the charter (example, .shoe could restrict sunrise to only trademark registrations in shoe-related class of goods and services).	*Unanimous Consensus*

6	**Voluntary Use of the Trademark Clearinghouse**		.
6.1	Use of TC For Ancillary Services	There should be no bar on the TC Service Provider or other third party service providers providing ancillary services on a non-exclusive basis. Such services could include, without limitation, a "marks contained" service, or a TM watch service. In order not to have a competitive advantage over competitors, the TC database should be licensed to competitors interested in providing ancillary services on reasonable terms. The implementation details should be left to Staff to address possible monopoly and competition concerns. If the TC Service Provider provides such ancillary services, any information should be stored in a separate database.	Rough Consensus BC Minority Position that the TC should support voluntary use by registries to protect additional common law rights, including "marks contained," for pre-launch protections.
6.2	Pre-Registration of URS	The TC could be used to enable URS Procedures by allowing trademark holders to preregister their trademark information to support a future URS action based on rights in jurisdictions where there is substantive review of trademark registrations.	*Unanimous Consensus*
7	**Mandatory Post-Launch Use of the TC**		

7.1	No Required IP Claims Notices	Use of the TC Database to support post-launch IP Claims should not be required.	Rough Consensus BC minority position that ICANN should recommend as a best practice for Registries to adopt an IP Claims Service for use after the initial launch of the Registry.
8	**Required Elements of IP Claims Notice**		

8.1	IP Claims Notice to provide clarity to Registrant	The IP Claims Notice should provide clear notice to the Registrant of the scope of the trademark holder's rights, in order to minimize the chilling effect on registrants. A form IP Claims Notice that describes the required elements is attached as **Annex 4**. If feasible, the IP Claims Notice should provide links, or provide alternative methods of providing access, to the registrant for accessing the TC Database information referenced in the IP Claims Notice. The implementation details should be left to ICANN Staff to determine how to easily provide access to registrants to this information.	*Unanimous Consensus*
9	**Effect of Filing with the TC**		
9.1	TC is a depository of information and does not create legal rights	It should be clearly stated in mandate of the TC that inclusion of a TC validated mark into the Database is not proof of any right, nor does it confer any legal rights on the trademark holder	*Unanimous Consensus*
10	**Costs of Operating the TC**		
10.1	Costs of Operating Clearinghouse	Costs should be completely borne by the parties utilizing the services. ICANN should not be expected to fund the costs of the operating the TC. The TC should not be expected to fund ICANN from its fees.	Rough Consensus RySG Minority Position that Registries should not bear any of the costs of the TC.

UNIFORM RAPID SUSPENSION PROCEDURE

There is a unanimous consensus among the members of STI that creation of a Uniform Rapid Suspension (URS) procedure would be a beneficial rights protection mechanism for inclusion in the New GTLD program. The STI recognizes that the URS could provide trademark holders with a cost effective, expedited process in instances of clear cut instances of trademark abuse, provided that the procedure includes appropriate safeguards to protect registrants who may engage in legitimate uses of domain names.

The STI URS Model includes the following features:

	Feature	**Principle**	**Level of Consensus**
1	**Mandatory RPM**		
1.1	Mandatory Use	Use of the URS should be a required RPM for all New gTLDs	*Unanimous Consensus*
2	**Pleadings and Evaluation Standards**		
2.1	Elements of the Complaint	The elements to be alleged in the complaint should be the same as the UDRP, to take advantage of the body of precedent available. The URS Complaint should require the trademark holder to satisfy the same elements as the UDRP.	*Unanimous Consensus*
2.2	Format of Complaint and Answer	The form of the complaint should be simple and as formulaic as possible. There should be reasonable limits on the length of complaint and answer. The complaint should allow space for some explanation, and should not be solely a check box.	*Unanimous Consensus*

2.3	Safe Harbors for Registrants	The URS should include safe harbors to protect legitimate uses of domain names. The URS should include language from Nominet that explains safe harbors available to registrants. These requirements are described in **Annex 5.**	*Unanimous Consensus*
2.4	Examination of the Case	ICANN should provide the examiners with instructions on how to conduct the examination of a URS case. These instructions are described in **Annex 5.**	*Unanimous Consensus*
2.5	Standard of Review	A URS Complaint needs to establish by clear and convincing evidence that there is no genuine issue of material fact requiring further consideration. **Annex 6** provides an explanation of how this standard should be applied to URS cases.	*Unanimous Consensus*
3	**Notice to Registrant**		
3.1	Mode of Notice	Notices should be sent through all the following available modes to increase the likelihood that the registrant will receive notice of the Complaint: E-mail, fax, hardcopy.	*Unanimous Consensus*
3.2	Notice Contents	Notices should be clear to the registrant, and understandable to registrants located globally. ICANN Staff should have the discretion to evaluate options to implement this requirement, including language issues, in an efficient manner.	*Unanimous Consensus*
4	**Effect on Domain Name**		

4.1	Effect of Filing Complaint	Upon passing initial examination of the Complaint, an "Initial Freeze" status is applied to the domain name, meaning that the domain name cannot be transferred, the WHOIS record cannot change, but the domain name still resolves and other features would function (e.g. e-mail).	*Unanimous Consensus*
4.2	Effect of Filing a Answer after Default	Filing an answer after a Default decision should cause the domain name to resolve immediately to original website.	*Unanimous Consensus*
5	**Answer**		
5.1	Time to Answer	The Registrant should have twenty (20) days to file its answer.	*Unanimous Consensus*
5.2	Answer Fee	No answer fee will be charged if the Registrant files its answer in a timely manner.	*Unanimous Consensus*
5.3	Default Answer Fee	If an answer is filed within thirty (30) days of default decision, no answer fee should be due from the Registrant. If an answer is filed after thirty (30) days, respondent should pay a reasonable answer fee.	*Unanimous Consensus*
6	**Evaluation of URS Cases**		

6.1	Commencement of Evaluation	Evaluation of a URS case should be conducted on an expedited basis. Evaluation should begin immediately upon the earlier of the expiration of twenty (20) answer period, or upon the submission of answer. A decision should be rendered on an expedited basis, with the stated goal that they should be completed within three (3) business days. Staff should have the discretion to develop the implementation details in this regard, in order to accommodate the needs of the service providers.	*Unanimous Consensus*
6.2	Number of Examiners	Examination of URS Cases should be conducted by one Examiner with legal background.	*Unanimous Consensus*
6.3	Training of Examiners	Examiners should have legal background and should be trained and certified.	*Unanimous Consensus*
6.4	Assignment of Examiners	ICANN should discourage forum shopping among URS service providers. Examiners within a service provider should be rotated to avoid forum shopping. There is no requirement that there be a random assignment among service providers. ICANN Staff should examine as an implementation option whether it is feasible to have a pool of examiners shared by multiple service providers.	*Unanimous Consensus*

6.5	Providing Fair Examiners	The URS should avoid "cherry picking" of examiners that are likely to rule in a certain way. Providers should have the right to drop nonperforming examiners. Service Providers should be required to work with all certified examiners, with reasonable exceptions (such as language needs or malfeasance). ICANN Staff has the discretion to determine whether this feature is implementable.	*Unanimous Consensus*
6.6	Evaluation on the Merits	Unless withdrawn by complainant, the examiner should evaluate the claim on the merits in every case -- regardless if the registrant defaults or answers.	*Unanimous Consensus*
7	**URS Remedies**		
7.1	Remedy if Successful on the Merits	If the complainant prevails, the domain name should be suspended for the balance of the registration period and would not resolve to the original website. The WHOIS for the domain name should reflect that the domain name is on hold and cannot be transferred.	*Unanimous Consensus*
7.2	No Additional Remedies	No other remedies should be available in the event of a decision in favor of the complainant.	Strong Support BC Minority Position that transfer of a domain name should be an option for the trademark holder IPC Minority Position that there should be an extension of the registration period for one year
8	**Appeal**		

8.1	Filing Answer After Default Judgment	If Registrant fails to file an answer within twenty (20) days and the examiner rules in favor of complainant, the Registrant should have the right to seek de novo review by filing an answer at any time. If filed within thirty (30) days of default decision, no answer fee would be applicable. If an answer is filed after such 30 day period, the Registrant should pay a reasonable answer fee. In either case, filing an answer should cause the domain name to resolve immediately to original website.	*Unanimous Consensus*
8.2	Appeal of Decision	After a decision in any case (default or contested), either party should have a~~a~~n appeal right in order to seek a de novo ~~appeal~~review of the record, as it existed at the time of the initial decision, within the URS process for a reasonable fee to cover the costs of the appeal. The fees for an appeal should be borne by the appellant.	*Unanimous Consent*
8.3	Effect of Appeal on the Domain Name	Filing of an appeal should not change the domain name' s resolution (except in the instance of a default-related decision). For example, if the domain name was down because of a decision in favor of the complainant, it stays down. If the domain name resolves because of a decision in favor of the Registrant, it continues to resolve.	*Unanimous Consensus*

8.3	Effect of Decision in appeal or UDRP	A URS decision should not preclude any other remedies available to the appellant, such as UDRP, or other remedies as may be available in a court of competent jurisdiction. A finding in URS for or against a party should not prejudice the party in UDRP.	*Unanimous Consensus*
8.4	Evaluation of Appeal	The URS should not use an ombudsman for appeals of URS decisions. URS appeals should be conducted by either: (i) a three (3) person panel selected from a preselected pool of panelists, or (ii) three (3) panelists, with one appointed by each of the parties and third panellist selected by the other two panellists or by the service provider.	*Unanimous Consensus*
9	**Abuse of Process**		
9.1	Abuse by trademark holders	The URS should incorporate penalties for abuse of the process by trademark holders. In the event of two (2) abusive complaints, or one (1) finding of a "deliberate material falsehood," the party should be barred for one (1) year from URS. Two (2) findings of "deliberate material falsehood" should permanently bar the party from the URS. Multiple complaints must be against the same entity and should not include affiliates. Staff should have discretion to implement guidelines for what constitutes abuse.	*Unanimous Consensus*
9.1	Abuse by Panelists	The URS should incorporate penalties for abuse of the process by panelists. Three (3) or more findings of abuse of process or discretion against a panelist should cause the panelist to lose its certification to serve as a panelist. Staff to implement guidelines for what constitutes abuse.	*Unanimous Consensus*

10	**Review of URS**		
10.1	Mandatory Review of URS	ICANN should conduct a review of the URS one year after the first date of operation. There is no requirement that the URS should automatically expire or terminate after one year. ICANN should be required to publish examination statistics for use in the review of the URS.	*Unanimous Consensus*

ANNEX I – ICANN BOARD LETTER TO THE GNSO

ANNEX II- GNSO MOTION CREATING THE STI

20091028-3

Motion on Selected Trademark Issues from the ICANN Board of Directors

WHEREAS, the ICANN Board has requested that the GNSO Council evaluate certain ICANN staff implementation proposals for the protection of trademarks in new gTLDs based in part on the recommendations from the IRT, public comments, and additional analysis undertaken by ICANN Staff, as described in the letter dated 12 October 2009 Letter from Rod Beckstrom & Peter Dengate Thrush to GNSO Council.

WHEREAS, the ICANN Board letter requests the GNSO Council's view by December 14, 2009 on whether certain rights protection mechanisms for second level strings recommended by ICANN Staff based on public input are consistent with the GNSO Council's proposed policy on the introduction of new gTLDs, and are the appropriate a effective options for achieving the GNSO Council's stated principles and objectives;

WHEREAS, the GNSO Council has reviewed the ICANN Board letter and desires to approve the procedures for conducting such evaluation;

NOW THEREFORE BE IT RESOLVED that the GNSO Council adopts the following process to conduct the evaluation requested by the Board:

1.   GNSO REVIEW TEAM WILL BE COMPRISED OF REPRESENTATIVES DESIGNATED AS FOLLOWS: THE REGISTRAR AND REGISTRY STAKEHOLDER GROUPS WITH TWO (2) REPRESENTATIVES EACH, THE COMMERCIAL STAKEHOLDER GROUPS AND THE NON-COMMERCIAL STAKEHOLDER GROUPS WITH FOUR (4) REPRESENTATIVES EACH, AT-LARGE WITH ONE (1) REPRESENTATIVE, ONE REPRESENTATIVE FROM THE NOMINATING COMMITTEE APPOINTEES(1) AND THE GOVERNMENT ADVISORY COMMITTEE (GAC) WITH ONE (1) OBSERVER. ALTERNATE MEMBERS MAY PARTICIPATE IN CASE OF ABSENCE OF THE DESIGNATED REPRESENTATIVES;

2.   EACH OF THE STAKEHOLDER GROUPS WILL SOLICIT FROM THEIR MEMBERS THEIR INITIAL POSITION STATEMENTS ON THE QUESTIONS AND ISSUES RAISED BY THE ICANN BOARD LETTER AND THE ICANN STAFF PROPOSED MODELS FOR THE IMPLEMENTATION OF THE TRADEMARK CLEARINGHOUSE AND UNIFORM RAPID SUSPENSION MODEL, AND WILL DELIVER THEIR INITIAL POSITION STATEMENTS ON NOVEMBER 4, AND WITH FINAL POSITION STATEMENTS TO BE DELIVERED BY NOVEMBER 6, 2009;

3.   SUCH POSITION STATEMENTS WILL BE SUMMARIZED BY ICANN STAFF AND DISTRIBUTED TO THE GNSO REVIEW TEAM TO EVALUATE WHETHER A CONSENSUS CAN BE REACHED ON THE ICANN STAFF IMPLEMENTATION MODELS OR OTHER PROPOSALS FOR THE PROTECTION OF TRADEMARKS IN THE NEW GTLD PROGRAM; AND

4.   THE GNSO REVIEW TEAM WILL CONDUCT ITS ANALYSIS, IDENTIFY THOSE AREAS WHERE CONSENSUS HAS ALREADY BEEN REACHED, AND SEEK TO DEVELOP CONSENSUS ON THOSE ISSUES FOR WHICH CONSENSUS COULD NOT BE DETERMINED. (THE ASSISTANCE OF MEMBERS OF THE IRT IN ANSWERING QUESTIONS ABOUT THE IP CLEARINGHOUSE AND UNIFORM RAPID SUSPENSION SYSTEM RECOMMENDATIONS MAY BE USEFUL TO THIS WORK. THE GNSO COUNCIL REQUESTS THAT MEMBERS OF THE IRT WHO WORKED ON THOSE RECOMMENDATIONS BE AVAILABLE TO ANSWER ANY SUCH QUESTIONS THAT MAY ARISE), AND

5.   THE GNSO REVIEW TEAM WILL PROVIDE A FINAL REPORT TO THE GNSO COUNCIL ON OR BEFORE THE GNSO COUNCIL'S MEETING IN LATE NOVEMBER, 2009.

ANNEX III - THE WORKING GROUP

In accordance with the GNSO Resolution approved on 28 October, 2009, the STI was comprised of the following representatives:

NAME	AFFILIATION
David Maher (Chair)	Ry SG
Jeff Neuman	Ry SG
Alan Greenberg	ALAC
Olivier Crépin-Leblond	ALAC (Alternate)
Paul McGrady	IPC, CSG
Mark Partridge	IPC, CSG
Kristina Rosette	IPC, CSG (Alternate)
Jeff Eckhous	Rr SG
Jon Nevett	Rr SG
Jean-Christophe Vignes	Rr (Alternate)
Mike Rodenbaugh	BCUC, CSG
Zahid Jamil	BCUC, CSG
Phil Corwin	BCUC (Alternate)
Robin Gross	NCSG
Kathy Kleiman	NCSG
Wendy Seltzer	NCSG
Konstantinos Komaitis	NCSG
Mary Wong	NCSG (Alternate)

Leslie Guanyuan	NCSG (Alternate)
Tony Harris	ISP Constituency, CSG
Andrei Kolesnikov	NCA
Maimouna Diop	GAC Observer

ANNEX IV – FORM IP CLAIMS NOTICE

TRADEMARK NOTICE

[In English and Local Language if IDN Application or as the subsequent STI recommendations direct re: choice of local language - perhaps the language of the registration agreement?]

You have received this Trademark Notice because you have applied for a domain name which matches at least one trademark record submitted to the Trademark Clearinghouse.

You may or may not be entitled to register the domain name depending on your intended use and whether it is the same or significantly overlaps with the trademarks listed below. Your rights to register this domain name may or may not be protected as noncommercial use or "fair use" by the laws of your country.

Please read the trademark information below carefully, including the trademarks, jurisdictions, and goods and service for which the trademarks are registered. *If you have questions, you may want to consult an attorney or legal expert on trademarks and intellectual property for guidance.*

If you continue with this registration, you represent that, you have received and you understand this notice and to the best of your knowledge, your registration and use of the requested domain name will not infringe on the trademark rights listed below.
The following [number] Trademarks are listed in the Trademark Clearinghouse:

1. Mark: Jurisdiction: Goods: [click here for more if maximum character count is exceeded] International Class of Goods and Services or Equivalent if applicable: Trademark Registrant: Trademark Registrant Contact:

2. Mark: Jurisdiction: Goods: [click here for more if maximum character count is exceeded] International Class of Goods and Services or Equivalent if applicable: Trademark Registrant:

Trademark Registrant Contact:
******
X. 1. Mark: Jurisdiction: Goods: [click here for more if maximum character count is exceeded] International Class of Goods and Services or Equivalent if applicable: Trademark Registrant: Trademark Registrant Contact:

ANNEX V – EVALUATION OF THE URS CASE

URS Examination Instructions

Evaluation of the Complaint

The Final Evaluation analysis involves consideration of three basic issues, similar to the standards for a UDRP decision, but requiring a much higher burden of proof. The Examiner shall consider each of the following factors:

- Whether the domain name is identical or confusingly similar to a mark in which the Complainant holds a valid trademark registration issued by a jurisdiction that conducts substantive examination of trademark applications prior to registration. A list of such jurisdictions shall be complied and made available to parties and Examiners; and

- Whether the domain name registrant lacks any right or legitimate interest in the domain name; and

- Whether the domain name has been registered and used in bad faith.

A list of non-exclusive circumstances that demonstrate bad faith registration and use mirror the list stated in the UDRP, namely:

- circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

- you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

- you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

- by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source,

sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

Evaluation of the Answer

The Respondent may submit an Answer refuting the claim of abusive and bad faith registration by setting out any of the following circumstances which mirror the "Rights to and Legitimate Interests in the Domain Name" of the UDRP, namely:

- before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Such claims, if found by the Examiner to be proved based on its evaluation of all evidence presented, shall result in a finding in favor of the Respondent.

Safe Harbors available to the Respondent

The Respondent may further demonstrate that its use of the domain name is not in bad faith by showing one of the following factors:

- The Domain Name is generic or descriptive and the Respondent is making fair use of it.

- Domain Name sites operated solely in tribute to or in criticism of a person or business may constitute fair use and therefore shall not be considered abuse under this policy.

- Respondent's holding of the Domain Name is consistent with an express term of a written agreement entered into by the disputing Parties.

- Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under this policy. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner will review each case on its merits.

- The Domain Name is not part of a wider pattern or series of abusive registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.

- Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) does not in and of itself constitute abuse under the Policy. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. The Examiner will take into account:

  i. the nature of the Domain Name;

  ii. the nature of the advertising links on any parking page associated with the Domain Name; and

  iii. that the use of the Domain Name is ultimately the Respondent's responsibility.

Issuing a Decision

If the Examiner finds that *all three elements* are satisfied by clear and convincing evidence and that there is no genuine contestable issue, then the Examiner shall issue a decision in favor of the Complainant. If the Examiner finds that this test is not met, then the Examiner shall deny the relief requested terminating the URS process without prejudice to the ability of the Complainant to proceed with an action in court or under the UDRP.

ANNEX VI – STANDARD OF REVIEW

For a URS case to be successful based on:

1) the complaint;
2) the verified TM from a jurisdiction that performs substantial validation (including if applicable, its geographic limitations and class of service);
3) the domain name in question;
4) the contents of the web site or other evidence of the domain name usage; and
5) the registrant response (if received);

the Examiner, shall give a finding that there is no genuine issue of material fact. Such finding may include the finding that A) the complainant has rights to the name and B) the respondent has no rights or legitimate interest in the name.

This means that the complainant must present adequate evidence to substantiate its trademark rights in the domain name (e.g., evidence of a trademark registration and evidence that the domain name was registered and is being used in bad faith in violation of the URS.

If the Examiner finds that the complainant has not met its burden, or that genuine issues of material fact remain unsatisfied in regards any of the elements, the Examiner will reject the complaint as inappropriate for Rapid Suspension.

 1) (if a response was received) No evidence was presented to indicate that the use of the domain name in question is a non-infringing or fair use of the TM.
 or
 2) (if a response was not received) No defense can be imagined to indicate that the use of the domain name in question is a non-infringing or fair use the TM.

 In the absence of a clear belief of 1) or 2), the URS shall be rejected.

The following shall be added by ICANN staff at to the URS policy as additional guidance to the URS Examiner. It is a direct quotation from the IRT Report:

Where there is any genuine contestable issue as to whether a domain name registration and use is an abusive use of a trademark, the complaint will be denied terminating the URS process without prejudice to further action, e.g., a UDRP or court proceeding. The URS is not intended for use in any questionable proceedings, but only clear cases of trademark abuse.

Document comparison by Workshare Professional on Monday, December 07, 2009 7:36:43 AM

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Description	#58934673v3<CHI> - STI-WT - Draft Recommendations - v-2 (2).doc
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