

AIPLA Comments Regarding the
Draft Applicant Guidebook for New gTLDs

December 15, 2008

These comments are submitted on behalf of the American Intellectual Property Law Association (“AIPLA”) to the ICANN Board and its Generic Names Supporting Organization (“GNSO”) regarding the Draft Applicant Guidebook for New gTLDs (the “Guidebook”).

AIPLA is a national bar association whose more than 16,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of trademark, copyright, patent, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

The Guidebook, which consists of six individual modules and seven discussion areas, presents numerous issues that could ultimately affect IP owners. AIPLA supports the detailed and extensive comments submitted by the Intellectual Property Interests Constituency. AIPLA focuses its comments on those issues it considers most important to the interests of its members.

Dispute Resolution Procedure

1. Legal Rights Objection (“LRO”) procedure should, consistent with the procedure for morality and public order objections, provide the option for a three-member panel rather than a single panelist.
2. A party filing a LRO should not be barred from challenging in court ICANN’s decision regarding the objectionable application.
3. Experts in LRO proceedings should be subject to the approval of both parties.
4. All Dispute Resolution Service Provider (“DRSP”) panel decisions, without exception, should be published on the DRSP’s website. This is imperative in order to ensure transparency and assist in attempting to achieve consistency in terms of how these disputes are resolved.

5. The circumstances and extent to which ICANN will “consider” the DRSP panel’s decision, including whether ICANN will overrule a decision, should be more explicitly detailed. Standards concerning LRO appeals should be established.

Dispute Resolution Principles

1. AIPLA supports the likelihood of confusion standards for a LRO. Factor no. 2 should be clarified to read: “Whether the objector’s acquisition of rights in the mark, and use of the mark, has been bona fide.”

2. Clarification should be provided as to whether dilution-type protection will be afforded without requiring a showing that the applicant’s mark is famous.

3. AIPLA supports mandatory, rather than optional, comparative evaluation on string contention.

4. AIPLA supports priority rights of “Community-Based” over “Open” applicants.

Post Launch Protections

1. New gTLDs should operate as “thick” registries, and should commit to making a full set of Whois data publicly available on each registration in the new gTLD so that trademark and copyright owners, among others, will have ready access to this information.

2. Applicants should be required to implement expedited procedures for rapid takedown of registrations that infringe intellectual property rights.

3. Policies should be established concerning enforcement of Whois data accuracy and use of proxy or private registrations.

AIPLA looks forward to the opportunity to provide further comments to the revised draft applicant guidebook.

Sincerely yours,



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Executive Director