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VIA ELECTRONIC MAIL
(gtld-guide@icann.org)

Internet Corporation for Assigned Names and Numbers
4676 Admiralty Way
Suite 330
Marina Del Rey, CA 90292-6601

Re: Comments on the New gTLD Program: Draft Applicant Guidebook (Draft RFP)

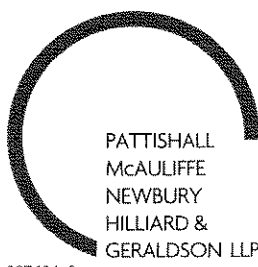
Dear Sir or Madam:

We are submitting the following comments on the Draft Applicant Guidebook published on October 24, 2008 setting forth the proposed procedures for expanding the availability of new generic top-level domain names (gTLDs). These comments are submitted on behalf of the firm only, do not necessarily reflect the view of any clients, and are directed at the process and not at the wisdom of the introduction of additional gTLDs.

Who We Are

Pattishall McAuliffe Newbury Hilliard & Geraldson LLP is one of the leading intellectual property firms in the United States. From its establishment in 1883 and continuing today, our lawyers have been leaders in all aspects of intellectual property law-as trial lawyers, mediators, counselors, leaders of professional associations, teachers and drafters of ground-breaking legislation. Members of the firm have appeared in trial and appellate courts on behalf of our clients in nearly every federal jurisdiction, including the U.S. Supreme Court, and with local counsel in many foreign jurisdictions. As a result, we have been recognized by our peers in the profession as one of the top ten firms in the country, and the leading firm in Chicago, for trademark litigation.

Our Firm has also been at the forefront of domain name issues, having litigated numerous cases under ICANN's Uniform Dispute Resolution Policy (UDRP), under the Anti-Cybersquatting Consumer Protection Act, and managed international domain name enforcement programs for our clients. Mark V.B. Partridge,



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one of our partners, was an expert advisor to WIPO on the first Domain Name Process and also serves as an arbitrator of UDRP disputes for WIPO.

Comments on the Draft Handbook

Module 1

Under the timeline set forth in Module 1, string contention resolution takes place *after* resolution of third party disputes, rather than before. This requires third parties (like trademark owners) to expend resources to challenge a proposed gTLD that may not even survive ICANN's string contention review. Conducting the string contention resolution *before* the third party dispute process allows those third parties who may have an interest in preventing registration of a proposed gTLD, but no desire to become a registry in their own right, to identify the names that ICANN has deemed to be entitled to registration. An analogy can be drawn to trademark registration practice in the United States and numerous other countries that refuse registration *ex parte* on the basis of previously registered or applied-for marks. In those countries, publication or advertisement of an application reflects a determination by the Trademark Office that the application is entitled to registration, which prevents unnecessary oppositions.

ICANN has not outlined any process for defensive registrations of gTLDs. We believe that ICANN should consider either creating a reserved name list of globally famous marks that could not be registered as gTLDs, creating a Sunrise process for trademark owners to apply to have certain names/marks placed on a list of prohibited gTLDs, or both.

Finally, we believe that applicants should be required to disclose their ownership of any legal rights that may be relevant to the gTLD being applied for including, but not limited to, any trademark rights. This disclosure would be part of the information published concerning the gTLD application when the legal rights objection period opens. Such a disclosure would allow third parties to better evaluate the merits of pursuing a legal rights objection.

Module 2

We believe that the standard for assessing string confusion is too narrow because it focuses only on visual similarity. Two gTLD strings that are phonetically or conceptually similar would not give rise to string confusion under ICANN's framework, even though confusion is likely. While we recognize that the Initial Evaluation, including the string review, is conducted *ex parte* and that interested parties with standing have an opportunity during the Initial Evaluation process to object to a proposed gTLD (see Module 3), we nonetheless believe that focusing only on visual similarity does not advance the goal of preventing concurrent registration of gTLDs that are likely to cause confusion, mistake or deception.

Module 3

General Comments

We believe that there should be a single organization or agency with which all objections should be filed, with that agency reviewing the objection to determine which DRSP should resolve it. We believe that this would be a more efficient and timely process, and would resolve the current ambiguity concerning where objections under multiple grounds should be filed. Even with this amendment, we believe ICANN should provide more guidance on how to resolve disputes arising on multiple grounds. In the absence of further clarification on this issue, it will be difficult for legal rights holders to conduct a cost-benefit analysis of pursuing or challenging a gTLD application.

We also believe that the option to have three panelists hear a dispute should be available for all types of disputes and not be limited to morality and public order objections.

We also recommend that there be clearer guidelines about the availability of discovery and the procedure for requesting that discovery be permitted. It seems that in certain cases, discovery will be necessary, if not imperative, to evaluate the merits of the dispute.

We also believe that the rule allowing panels to appoint experts *sua sponte* should be rethought, especially as there are no provisions requiring advance notice to the parties of an expert's appointment or guidelines regarding the costs of such experts. For example, a party with notice might decide that the expense of an expert outweighs the value of obtaining a domain name and drop its case. Or, as another example, a party with notice might have a legitimate objection to the appointment of a particular expert. For these reasons, we believe that panelists should not have the authority to appoint experts unless requested by at least one party, with notice to the opposing party, before that party becomes responsible for the associated expense of the expert. Panels should not be permitted to appoint experts on their own initiative without, at a minimum, prior notice to the parties (including an estimate of costs) and a period during which either party can opt out of the proceeding without being responsible for the expert costs. If ICANN is going to appoint experts, it should establish a schedule of fees so that parties can make a cost-benefit analysis prior to filing objections.

Finally, we believe that some type of review/appellate process will be necessary to ensure rights to gTLDs are properly determined, particularly if the parties are not permitted to retain three panelists for string confusion, legal rights, and community objections.

Comments on Specific Grounds for Objection

String Confusion

Our views on string confusion are summarized in our comments to Module 2.

Legal Rights:

With respect to legal rights objections, it is not clear what happens if an objector with prior rights prevails in a dispute resolution proceeding, but either does not want or is not able to operate the gTLD registry. ICANN should establish a list of such gTLDs for which future third party applications to register will not be accepted except from applicants who demonstrate ownership of legal rights that give them a legitimate interest in the gTLD at issue. ICANN should also create procedures to determine what happens when two parties with legitimate rights in a name attempt to reserve the same gTLD at the same time.

Morality and Public Order

In the absence of any guidance as to the "generally accepted legal norms of morality and public order that are recognized under international principles of law" that will determine whether a morality and public order objection is valid, ICANN needs to clarify who would have standing to bring this type of challenge.

Community Objections

For community objections, the Handbook states that it is a complete defense if the applicant is a member of the community to which the domain name refers or relates. This could create a land rush for generic names.

The Handbook is also very vague on the subject of what constitutes a "community." We recommend that ICANN provide more specific instructions regarding how to determine what constitutes a community, examples of groups that would merit classification as a community and groups that would not, or both. Without such guidance, businesses otherwise interested in acquiring a gTLD will be dissuaded from making the substantial investment in application fees and other costs because of uncertainty regarding who might be able raise a community-based challenge.

Module 4

Our thoughts concerning the standards for assessing string confusion and the timing of the string contention review in the application process are set forth above. In addition, we are concerned that the process for resolving string contention in open domain names is completely undeveloped. For contending community applications, there is at least a scoring system. At a minimum, some guidelines as

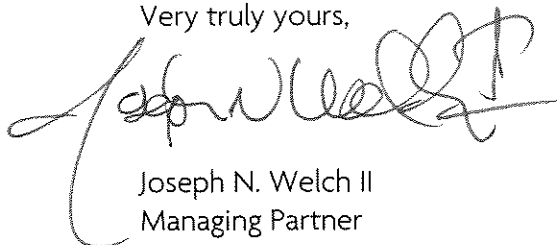
to what factors (other than the financial wherewithal to win an auction) should be considered in resolving string contention issues should be outlined so that applicants have some idea of what they may be expected to prove.

Module 6

We believe that Module 6 should include a statement from the applicant representing and warranting that it is not seeking to register a gTLD that infringes another party's rights, or for the purpose of trading on another's goodwill. It may be anticipated that such a representation will appear in the application form itself (which has not been created), and would therefore be swept in with the applicant's representation that the statements made in the application are true. However, this is an oversight that should be corrected somewhere.

We anticipate that ICANN will prepare a revised draft of the Guidebook after consideration of all comments received, and that further opportunity to comment on the proposed revisions will be provided. Thank you for the opportunity to comment on these proposed rules.

Very truly yours,

A handwritten signature in black ink, appearing to read "Joseph N. Welch II". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Joseph N. Welch II
Managing Partner

JNW/SS