



INTERNATIONAL
OLYMPIC
COMMITTEE

Legal Affairs
Ref. No 550

Internet Corporation for Assigned
Names and Numbers (ICANN)
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FINAL REPORT ON TRADEMARK PROTECTION IN NEW GTLDS

Dear Sir/Madam,

The International Olympic Committee (the "IOC") submits the following comments in response to ICANN's invitation for public comment regarding the Implementation Recommendation Team's Final Report on Trademark Protection in New generic top level domains (the "Final Report").

I. INTRODUCTION

The IOC has previously submitted comments to ICANN regarding the first and second drafts of the gTLD Applicant Guidebook (see the IOC comments submitted on 5th December 2008 and 9th April 2009, respectively) as well as the preliminary report of the Implementation Recommendation Team (the "IRT") on Trademark Protection in New generic top level domains (see the IOC comments submitted on 6th May 2009).

In each of its comments to ICANN, the IOC has announced its opposition to the New gTLD Program as a whole because it creates an unnecessary invitation for pervasive cybersquatting. The IOC has, moreover, detailed its grave concerns about the program's shortcomings in protection for trademark owners in general and for non-profit trademark owners in particular.

The IOC shares the sentiment expressed by the IRT that participation in this process is in no way an endorsement of the New gTLD Program and thanks the members of the IRT for their diligence and hard work. The IRT's Final Report is a meaningful foundation--a starting point--toward addressing the potential for otherwise unmitigated cybersquatting in new gTLDs. The Final Report does not, however, sufficiently address or protect the interests of non-profit trademark owners like the IOC.

Despite the IOC's expressed concerns, which were shared by numerous other trademark owners, the Final Report continues to exhibit a dangerous disregard for the circumstances of trademark owners--particularly non-profit trademark owners. These non-profit trademark owners could be forced to divert their financial resources from fulfilling their missions to preventing gTLD cybersquatting upon their trademarks.

The IOC, as a non-profit trademark owner, has striven to emphasize the unique nature of the Olympic Marks (including OLYMPIC, THE OLYMPICS and OLYMPIAD) and the need for broad and complete protection of such marks in new gTLDs. By virtue of the unique



nature of the Olympic Movement, the IOC's Olympic Marks are unquestionably both well known and protected the world over. Yet the system proposed in the Final Report – which severely limits the criteria for protection of a “globally protected mark” – unduly prejudices the IOC in its efforts to protect the Olympic Marks.

For this reason, the IOC submits the following recommendations and comments regarding the Globally Protected Marks List and the Uniform Rapid Suspension System as well as other generalized comments.

II. COMMENTS

A. The Globally Protected Marks List.

The Olympic Marks have many unique indicia of global recognition that the Final Report's Globally Protected Marks List fails to acknowledge.

- ***The Unique Nature Of The Olympic Marks: Statutory Protection, Registrations, Court Rulings, and Marketing Evidence of Global Recognition.***

The Olympic Marks are protected by national legislation in many countries including Argentina, Austria, Australia, Canada, China, France, Belgium, Brazil, Chile, Costa Rica, Czech Republic, Ecuador, Greece, Guatemala, Hungary, Lebanon, Luxembourg, Mexico, Poland, Portugal, Puerto Rico, Romania, Russia, Slovak Republic, South Korea, Spain, Turkey, the United Kingdom, the United States, Uruguay and Venezuela.

Indeed, in the United States, the Olympic and Amateur Sports Act (36 U.S.C. §220501 et seq.) specifically prohibits any unauthorized commercial or promotional use of the words OLYMPIC and OLYMPIAD, as well as any simulations or derivations thereof. The United States Supreme Court has explained “[i]n the special circumstance of the USOC, Congress has a broader public interest in promoting, through the activities of the USOC, the participation of amateur athletes from the United States in ‘the great four-yearly sport festival, the Olympic Games.’” *San Francisco Arts & Athletics, et al. v. United States Olympic Committee et al.*, 483 U.S. 522, 538 (1987). The Olympic and Amateur Sports Act “directly advances these governmental interests by supplying the USOC with the means to raise money to support the Olympics and encourages the USOC’s activities by ensuring that it will receive the benefit of its efforts.” *Id.* at 539. “The [U.S. Supreme] Court construes this section to give the USOC authority over the word ‘Olympic’ which far surpasses that provided by a standard trademark.” *Id.* at 560-561, Justice BRENNAN *dissenting*.

Additionally, the IOC holds over eighty (80) trademark registrations of national effect issued in more than sixty (60) countries around the world for the word OLYMPIC, and another eighty (80) trademark registrations of national effect issued in more than sixty (60) countries for the words THE OLYMPICS. These figures are in addition to the trademark registrations held by various National Olympic Committees, such as the United States Olympic Committee. There are, in addition to that, numerous registrations for other Olympic Marks.

Moreover, numerous courts throughout the world have recognized the vital importance of protecting the Olympic trademarks, and thus the Olympic Movement. *San Francisco Arts & Athletics, et al. v. United States Olympic Committee et al.*, 483 U.S. 522, 538 (1987)(acknowledging the “special circumstances” of the USOC and the Olympic Games);



Deutsche Telekom AG v. Comité International Olympique (Association), OHIM Second Board of Appeal Case R 145/2003-2 (Considering "that the word 'OLYMPIC' has been used as the title of the games for more than a century and that the popularity and success of the games exceeds that enjoyed by any other sports event, it is concluded that internationally there is a high degree of recognition of the sign 'OLYMPIC' by the public at large..."); *Benetton Group S.P.A. and Bencom S.R.L. v. International Olympic Committee*, Court of Venice, Industrial and intellectual Property Section, Case RG 6047/04 (2006)(As confirmed several times by OHIM "and by courts of foreign states, the IOC's 'Olympic' mark enjoys a high degree of recognition by virtue of its immediate association by the general public of the entire world ... not only with the organization of the modern Olympic Games but with all the activities and sports infrastructure in general at world level covered by the words "Olympic Movement", of which the Games are the main manifestation") See also *Internationales Olympisches Komitee v. Alexandre SA Zurich*, Handelsgericht des Kantons Zurich, Geschäfts-Nr. HE040007 (2004).

"Almost all the countries in the world participate in the games ... Considering that the word "OLYMPIC" has been used as the title of the Olympics for more than a century and the popularity and success the games enjoy, it may be concluded that there is a high degree of recognition of the sign 'OLYMPIC' internationally, by the public at large." *Comité International Olympique v. Belmont Olympic S.A.*, OHIM Decision No. 81/2000 ("Since their revival in 1896, the Olympic Games have been the most celebrated international athletic event, with ever increasing participation, media coverage and turnover").

As one scholar has stated, "one of the great values of the Olympics is its international quality, allowing people from different countries to form bonds of commonality, both directly through participation by athletes and indirectly through shared viewing and interest." Cass R. Sunstein, *Republic.com 2.0*, p. 102, Princeton University Press (2007). Indeed, "the IOC takes all necessary steps to ensure the fullest news coverage of the different media and the widest possible audience in the world for the Olympic Games." Paragraph 1 of Rule 49, Olympic Charter: July 2007. In fact, the 2008 Beijing Olympic Games were broadcast to over 220 countries/territories around the world to an audience of over four billion viewers. IOC, *IOC Marketing Guide: Beijing 2008*, available at http://multimedia.olympic.org/pdf/en_report_1428.pdf (last visited June 23, 2009). In 2008, "[m]ore than two out of three people worldwide tuned in for the Beijing Olympic Games ... In the United States, where NBC and several sister networks aired extensive coverage [a record 3,600 hours], the 2008 Olympics took the record as the most-viewed event in American television history." Associated Press, *Beijing TV Coverage 4.7 Billion Viewers Worldwide*, available at <http://sports.espn.go.com/espn/print?id=3571042&type=story> (last visited June 23, 2009).

Finally, the IOC and its National Olympic Committees have successfully taken action to protect the IOC's OLYMPIC Marks in numerous UDRP Proceedings. See *U. S. Olympic Comm. v. TRI B-U-N ECO. Project*, WIPO Case No. D2000-0435 (July 13, 2000)(transferring domain names usaolympiconlinestore.com and olympiconlinestore.com); *Int'l Olympic Comm. v. More Virtual Agency*, NAF Case No. FA0204000112584 (June 13, 2002)(transferring domain name olympic.biz); *Int'l Olympic Comm. and the U. S. Olympic Comm. v. Domain for Sale, Inc., a/k/a John Barry*, NAF Case No. FA0208000117893 (October 1, 2002)(transferring domain name olympiccommittee.com); *Int'l Olympic Comm. v. Richard Freeman a/k/a Return Pty Ltd.*, NAF Case No. FA0210000127799 (December 19, 2002)(transferring domain name olympic.tv); *Int'l Olympic Comm. and U. S. Olympic Comm. v. Russell Ritchey d/b/a EZ Fixin's*, NAF Claim NO. FA0211000128817 (January 20, 2003)(transferring domain names olympicbrand.com, olympicsbrand.com, olympic-brand.com, olympics-brand.com, and



olympianbrand.com); *Int'l Olympic Comm., U.S. Olympic Comm. and CTV Inc., v. Texas Int'l Prop. Ass. NA-NA*, NAF Claim NO. FA0903001253280 (May 6, 2009)(transferring domain name ctvolympics.com).

- ***The Globally Protected Marks List Must Account For Special Statutory Trademark Protection And Other Indicia Of Global Recognition.***

It is clear that the envisioned Globally Protected Marks List is not intended to be “a consolidated list of what may constitute ‘well known’ or ‘famous’ marks under national trademark laws.” Rather, according to the Final Report, “only marks that are globally protected”, or in other words “trademark supernovas”, will find a place on the Globally Protected Marks List.

It is, however, unreasonable for the Globally Protected Marks List to adopt such narrow qualification criteria that it fails to recognize the unique nature of the Olympic Marks. The International Trademark Association (INTA) has argued – and the IOC agrees – that the criteria for the Globally Protected Marks List should be more inclusive “in terms of not arbitrarily favoring one type of mark or legal regime over another, and in terms of accommodating those marks with true global scope, while at the same time keeping the bar high.” In other words, while the criterion of trademark registrations of national effect may remain high, another criterion – special statutory protection – must be considered to determine the true global scope and strength of a mark.

The worldwide legislative protection accorded the Olympic Trademarks demonstrates an unparalleled level of strength and “global protection.” This legislative protection is, in fact, a much stronger indicator of global protection than national registrations, which, in some jurisdictions, may be granted without use in commerce. Recognizing such widespread legislative protection in the Globally Protected Marks List would reflect the intent of the multiple national legislatures that expressly provided this protection, and thus better adhere to the Final Report’s policy of “protect[ing] the existing rights of trademark owners” while not creating additional rights and “accommodat[ing] territorial variations in trademark rights.”

Lastly, failure to consider global statutory protection of trademarks ignores the special circumstances of non-profit entities like the IOC, as explained above. If the Globally Protected Marks List focuses exclusively on a specific number of national registrations held, the effect is to unduly prejudice such non-profit entities who may rely more on special statutory protection – and less on national registrations – for global protection of their trademarks.

Given the statutes, court rulings, UDRP panel rulings and popularity referenced above, any Globally Protected Marks List that denies protection of the Olympic Marks is inherently flawed.

- ***The Globally Protected Marks List Should Protect Against Typosquatting.***

By its terms, inclusion on the List would not protect a trademark against the common practice of typosquatting. The IOC firmly believes that the Globally Protected Marks List should initially block registration of both new gTLDs and Second-Level Domains in instances of clear-cut typosquatting.

In June 2000, the IOC joined by the United States Olympic Committee and the Salt Lake Organizing Committee for the Olympic Games, commenced an *in rem* lawsuit filed under



the Anti-Cybersquatting Consumer Protection Act against the unauthorized use of the OLYMPIC Mark in over 1,800 domain names. *U.S Olympic Comm., Int'l Olympic Comm., and Salt Lake Org. Comm. For the Olympic Winter Games of 2002 v. 2000Olympic.com et al.*, 00-CV-1018-A (E.D.Va., filed 2000). Many of these domain names were slight misspellings of the word OLYMPIC or the phrase THE OLYMPICS – including “olimpic” and “olympix”. Certainly both judicial resources and funding for the Olympic Movement can be conserved in the future through a Globally Protected Marks List which initially blocks registration in obvious instances of typosquatting.

B. The Uniform Rapid Suspension System.

- ***The Limited Duration Of The Uniform Rapid Suspension System Creates Additional Burdens On Trademark Owners.***

As proposed, the Uniform Rapid Suspension System creates an unreasonable situation whereby trademark owners actually face increased costs in filing repetitive complaints for the same domain names after a locked registration expires. Indeed, the World Intellectual Property Organization has argued that “the proposed remedy would not appear to meaningfully address the burdens on trademark owners” and this “ ‘remedy’ is of limited effectiveness, lasting in most cases no more than a few months.” The IOC agrees with this point, and recommends that ICANN revise the Uniform Rapid Suspension System to strengthen this remedy.

- ***The Draconian “Three Strikes” Policy Ignores Practical Considerations And Should Be Dropped.***

The proposed “three strikes” policy against trademark owners under the Uniform Rapid Suspension system pays no regard to the sheer quantity of infringements that a famous trademark suffers on a regular basis. Moreover, the IOC knows of no other enforcement policy in the world that periodically suspends a trademark owner’s right to enforce their valid, registered trademarks.

No “strike” policy should be implemented, but if it is, it should also account for the number of successful challenges brought by a trademark owner.

- ***The Uniform Rapid Suspension System Should Adopt a Bad Faith Registration “OR” Use Standard.***

The “bad faith registration and use” standard of the UDRP is ill fit for the evolving nature of cybersquatting. Indeed, the “and” standard has been rejected by a number of ccTLD registries in favor of the “or” standard.

“Normally speaking, when a domain name is registered before a trademark right is established, the registration of the domain name was not in bad faith because the registrant could not have contemplated the complainant’s non-existent right. *However, [i]n certain situations, when the respondent is clearly aware of the complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any potential complainant rights, bad faith can be found. This often occurs after a merger between two companies, before the new trademark rights can arise, or when the respondent is aware of the complainant’s potential rights, and registers the domain name to take advantage of any rights that may arise from the complainant’s enterprises.*” WIPO,



WIPO Overview of WIPO Panel Views on Selected UDRP Questions, available at <http://www.wipo.int/amc/en/domains/search/overview/index.html#31> (last visited July 1, 2009). Such "cyberpsychics" or "cyber-speculators" troll the internet looking for potential trademark rights of others and register corresponding domain names, thus creating a real problem for trademark owners.

The "bad faith registration or use" standard foils would be "cyberpsychics" by allowing trademark owners to fall back solely on bad faith uses exhibited by egregious patterns of past and present cybersquatting.

- ***Default Cases Should Not Warrant Appointment Of A Panel.***

In its qualified participation in and commentary to ICANN's New gTLD Program, the IOC recommends that default cases in the Uniform Rapid Suspension System do not warrant appointment of a panel. The World Intellectual Property Organization has also noted that "[i]t remains then an open question whether appointing a panel in default cases responds to trademark owner needs." The ultimate goals of the Uniform Rapid Suspension System would be well served by dropping the unnecessary time and expense a panel determination entails in default cases.

C. The New gTLD Program Should Adopt A "Thick" WHOIS Model And Universal Proxy Standards.

The current WHOIS model is unsatisfactory to most trademark owners – including the IOC. Information under a "thin" model is indeed limited and current proxy domain name practices frustrate efforts to track down cybersquatters. In its qualified participation in and commentary to ICANN's New gTLD Program, the IOC supports both a "thick", i.e. robust registry-level model, and universal proxy standards.

III. CONCLUSION

Subject to the foregoing, the IOC maintains its position that ICANN's New gTLD Program is inherently flawed and injurious to owners of famous trademarks. Again, the IOC's recommendations should not be taken as a waiver of the IOC's right to proceed against ICANN for damages resulting to the IOC or the Olympic Movement from the implementation of the New gTLD Program.

Yours Sincerely,

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Director General

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Legal Affairs Director

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