



**International Trademark Association**  
*Representing the Trademark Community since 1878*

Comments of the  
Internet Committee of  
the International Trademark Association  
on the Implementation Recommendation Team (IRT) Report

<b>INTRODUCTION .....</b>	<b>1</b>
<b>POSSIBLE IMPROVEMENTS TO THE IRT RECOMMENDATIONS .....</b>	<b>2</b>
UNIFORM RAPID SUSPENSION SYSTEM (URS).....	2
REQUIRING A "THICK" WHOIS MODEL IN NEW gTLDs .....	4
THE IP CLEARINGHOUSE .....	4
THE GLOBALLY PROTECTED MARKS LIST ("GPML") .....	5
OTHER TOP AND SECOND-LEVEL RIGHTS PROTECTION MECHANISMS.....	8
<b>ADDITIONAL PROTECTIONS FOR TRADEMARK RIGHTS BEYOND THE gTLD ROLL-OUT.....</b>	<b>8</b>
PROXY AND PRIVACY SERVICES .....	8
<b>ABOUT INTA AND ITS INTERNET COMMITTEE .....</b>	<b>9</b>

## **Introduction**

Numerous comments on the Draft Applicant Guidebook (DAG) for the new gTLD application process focused on consumer and intellectual property ("IP") protection. The IRT's formation by the ICANN Board highlights the significant need for trademark protection in the Internet DNS and for the establishment of additional rights protection mechanisms in the introduction of new gTLDs. In announcing the creation of the IRT, ICANN Board Chair made clear the importance of not only soliciting the input of trademark owners, but that action be taken to address their concerns, saying, "The Board has clearly heard and believes strongly that the concerns of trademark holders must be addressed before this process is opened for applications." These mechanisms must address, in particular, two issues that arise in the context of new gTLD applications: 1) trademark rights must be protected in the evaluation of new gTLD applications and 2) critically, rights protection mechanisms for the launch and post-launch phase of a new gTLD's introduction must scale to the anticipated volumes of abusive registrations in new gTLDs, as well as the increased aggregate volume of abuse across new and existing gTLDs.

With this background in mind, the Internet Committee of the International Trademark Association (INTA) commends the IRT members who have clearly invested a tremendous amount of hard work and thought in a short period of time in developing the IRT's recommendations. We are pleased to endorse the mechanisms proposed in the IRT report for protecting trademarks and consumers in the introduction of new gTLDs.

While the IRT recommendations are very constructive, in our preliminary comments,<sup>1</sup> and in the discussion below, we offer suggestions for further measures that we believe should be taken to make the recommendations of the IRT report stronger, more effective, less costly and less subject to "gaming."

However, our endorsement of these mechanisms, including our recommended enhancements, is **not**, we hasten to add, tantamount to saying that the IRT's recommendations resolve the overarching concern with protecting trademarks in the new gTLD launch. The Internet Committee continues to believe that this threshold question can not be adequately answered until a number of important issues related to ICANN's new gTLD program are addressed. These open issues cover a broad range of technical, economic and legal matters, including but not limited to, the major "Overarching Issues" identified in the DAG. Until ICANN addresses this broad spectrum of policy and implementation matters, and until the Committee has the appropriate time to evaluate the subsequent changes made to the DAG, it reserves judgment beyond the comments set forth below.

## **Possible Improvements to the IRT Recommendations**

As mentioned above, while supporting the IRT recommendations, we would like particularly to emphasize the importance of three of the proposals:

- **The Uniform Rapid Suspension System ("URS")** – This proposal may be the solution available to the largest numbers of trademark owners to provide quick relief for the prevention of abusive registrations and consumer confusion.
- **The "Thick" Whois Requirement** – Simplifying access to domain ownership information is critical to promoting transparency and confidence in the Internet marketplace. That the thick registry model is an existing, proven technology only makes it more important to implement in the new gTLD space. We are encouraged to have seen ICANN adopt the requirement for thick Whois service in the portions of the DAG III that have been published for comment.
- **The IP Clearinghouse** – This repository for information on intellectual property rights provides a critical platform for increasing the scalability of all other rights protection mechanisms, including potentially other mechanisms not specific to the new gTLD launch, such as the UDRP or claims of reasonable evidence of actionable harm under RAA 3.7.7.3.

### ***Uniform Rapid Suspension System (URS)***

The proposed URS is an important remedy for trademark owners. As the proliferation of new gTLD registries greatly increases the scale of abusive domain name registrations, the ability to put a quick end, at minimal cost, to clear cases of cybersquatting is critical. In particular, the following features are welcome:

---

<sup>1</sup> Preliminary Comments from the Internet Committee of the International Trademark Association on the Draft Implementation Recommendation Team (IRT) Report, <http://forum.icann.org/lists/irt-draft-report/msg00029.html>.

- A) the incorporation of a low cost pre-registration system (so the brand owner's trademark is "on file" for future disputes – but see note 5 below);
- B) the ability to initiate the URS by filling out a simple form;
- C) The opportunity for the Complainant to apply a URS proceeding to multiple registrants if they are related, e.g., as shell companies.
- D) the fact that fees can be lower for batches of domain names owned by the entity;
- E) the fact that names are locked as soon as the URS is initiated;
- F) the provision of notice to the registry operator within 24 hours of filing the complaint with the third party provider;
- G) the fact that the third party provider works on a cost-recovery basis; and
- H) the inclusion of a limited 'loser pays' system, where the registrant of 26 or more domains bears the filing fee if it answers the complaint and loses.

The URS will prove particularly useful in cases involving numerous domain names, particularly ones displaying paid advertising, where the trademark owner's interest is not necessary in owning the domains but merely in ceasing the registrant's abusive use of the domains. Given the expected volume it will not be feasible to bring UDRP proceedings in all new domains. Thus, without the URS, the end result would be the persistence of sites that profit by confusing consumers and diverting them from the legitimate brand owner whose trademark is reflected in the domain, to infringers and competitors.

However, we continue to urge that the following issues be clarified or revised:

1. *Domain suspension on ServerHold should be indefinite.* – The Committee continues to believe that the URS should allow for the transfer of domains as a remedy. However, in perhaps the most significant change that is needed to the IRT's recommendations, if the URS does not provide for transfer, the suspension of the domain should at least last indefinitely, or so long as the successful Complainant continues to periodically re-verify the validity of its own trademark rights (such as through the periodic re-verification process for the trademark's data in the IP Clearinghouse). Otherwise the URS will suffer from the same malady that saddles trademark owners with expensive portfolios of domains that were acquired defensively to eliminate consumer confusion but which have no business use—that serial enforcement actions are required over the same domain as it expires and is released. Instead, if the Complainant does not have the option of obtaining the transfer of the domain, it should at least be placed on indefinite ServerHold with no expiration.
2. *The Respondent Should Bear the Burden of Proving it has Legitimate Rights in the Domain.* – By allowing the registrant merely to supply "evidence" that they have some legitimate right in the domain name, and by allowing the registrant to answer at any time during the registration, the IRT invites registrants to delay the deactivation or transfer of the name by filing deficient or fabricated answers.
3. *Examination factors (trademark examination).* – The requirement that the complainant's registered trademark must have been issued by a jurisdiction that conducts substantive examination of trademark applications should make clear that it

only requires examination on absolute grounds (of descriptiveness, functionality, etc.). While the IRT points out that reliance on registrations that undergo no substantive evaluation resulted in gaming the system during, for example, the .eu launch,<sup>2</sup> this concern does not require relative examination, and requiring it would, as an example, render one of the world's most meaningful trademark registrations, a European Community Trade Mark (with an opposition system but no examination on relative grounds) an improper basis for a URS proceeding.

4. *Examination factors (standard of proof)*. – Finally, as mentioned in our preliminary comment, we continue to prefer a “preponderance of the evidence” standard. We are very concerned that respondents will be able to game the system and that the barest scintilla of evidence will defeat a finding of entitlement if the standard is clear and convincing evidence. This is particularly true since, as with the UDRP, the “lack of legitimate interest” factor requires proving a negative proposition in a way that can rarely be done in more than a presumptive manner.

### ***Requiring a “Thick” Whois Model in New gTLDs***

We strongly support the IRT's proposal to require all new TLD registries to implement a “thick” Whois model, and commend ICANN for adopting this recommendation in the latest DAG amendments.<sup>3</sup> Simplifying access to accurate and reliable contact details for the true owner of the domain name registration is necessary to prevent abuses of intellectual property and to protect the public by preventing consumer confusion and consumer fraud in the Internet marketplace. INTA supports open access to accurate ownership information for every domain name in every top-level domain registry, for addressing legal and other issues related to the registration and use of the domain name. (See: INTA Board Resolution. Continued Open Access to the Whois Database. <http://www.inta.org>)

Even though thick Whois is not a novel idea, this should not in any way diminish its importance. The fact that the thick registry model is an existing, proven technology that registrars and registries already implement in every gTLD registry except .com, .net, and .jobs suggests that there is no reason not to implement it in the new gTLD space. Assuming large growth in both the number and geographic diversity of registrars, registries and registrants, accurate and thick Whois is a critical requirement if the gTLD space is expanded. Certainly, the public interest in easier access to domain ownership information that survives a registrar's failure or non-compliance should outweigh any interest by registrars in maintaining proprietary control over the data. Likewise, the availability of the data through other sources (registrars, and other sites displaying the data via Port 43) belies the assertion that the availability of the very same data from the registry's database implicates any protected privacy rights.

### ***The IP Clearinghouse***

The IP Clearinghouse performs a purely administrative function of collecting information on asserted intellectual property rights. Nevertheless, as mentioned above, one of the main

---

<sup>2</sup> “In addition, reliance on registrations issued immediately upon application without substantive examination on absolute or relative grounds may result in gaming of the system, as seemed to occur during the introduction of .eu domain names, for example.” Final Report, n.38.

<sup>3</sup> Applicant Guidebook: Public Comments Analysis and Revised Excerpts, <http://www.icann.org/en/announcements/announcement-2-31may09-en.htm>.

concerns that trademark owners have with the new gTLD rollout is that existing remedies such as the UDRP and the U.S. ACPA are too expensive to scale across the anticipated volume of abusive registrations. Therefore, the IP Clearinghouse is a critical platform for reducing the cost and time involved: a) for ICANN's contracting parties to implement rights protection mechanisms; and b) for intellectual property owners to obtain meaningful redress under other existing mechanisms (such as the UDRP or RAA 3.7.7.3, to the extent they can be adapted to take advantage of the Clearinghouse) or the IRT's other proposed mechanisms.

### ***The Globally Protected Marks List ("GPML")***

The Internet and, in particular, the domain name system, present unique challenges – both from the top level and the second level. Creating a list of protected marks that have global legal recognition and will be acceptable for blocking purposes by both trademark owners and Internet users is a challenge, one on which we believe the IRT has made a good start. We note that the IRT, in its final report, adopted several revisions that we proposed in our preliminary comments.<sup>4</sup> However, because the IRT has not finalized the numerical criteria for the GPML, we must reserve judgment. Nevertheless, it may be useful to reiterate why we believe the framework for a GPML is sound, and offer input to guide the attempt to settle on numerical criteria. The Committee also believes that in order for the GPML to accomplish the public policy objective of addressing end-user confusion in the DNS, trademarks that have been subject to repeated, widespread and systematic global abuse in the DNS should be eligible for inclusion on the GPML.

#### **General Concerns with a GPML**

Once again, we appreciate the IRT's revisions to distinguish the criteria and purpose for a "globally-protected" marks list from a list purporting to list "famous" or "well known" marks. This is significant because whether a mark is famous or well-known is a question of fact, and not of law, at a particular point in time and in a specific geographical region. In any attempt to list globally famous marks, it would be necessary—but extremely difficult—to take into account a conglomeration of laws and individual and corporate rights to be adopted by potentially all courts and mediation bodies simultaneously. The mark must be recognized by not just trademark owners and experts, but individuals with no trademark expertise whatsoever.

Focusing on the number and diversity of countries in which a mark is protected appears to be the best approach because it limits the list to only those marks that can obtain protection across a broad range of national laws and rights. The number and geographic diversity of trademark registrations is also a good indicator in light of the limited purposes for which the IRT proposes to use the GPML: a) to block second-level domain registrations that are an "identical match" for the GPM, and b) to subject new gTLD applications to comparison with the GPM at the string review stage. The former use requires near identity of the marks (hyphens and special characters aside), and the latter involves a "visual," "aural" and commercial impression (meaning) comparison. Neither of these tests takes into consideration the goods and services of the parties. Therefore, we agree that the criteria should be stringent because, if the bar is set too low, the GPML may unfairly lock out

---

<sup>4</sup> These revisions include eliminating all references to the list as even purporting to compile "well known" or "famous" marks," as opposed to merely ones that are "globally protected," and clarifying that the GPML should not have any precedential value in any dispute or resolution.

legitimate, but smaller trademark owners from obtaining domain names reflective of their own trademarks, on a global basis. That will occur irrespective of whether the owner of a listed GPM has a commercial interest in a particular domain name (or indeed if it is entitled to apply for a domain name in a specific registry due to geographic or industry requirements, for example), or whether its interests are secondary to a rights owner with prior or superior rights in a particular jurisdiction or jurisdictions. Therefore, the aim of the GPML should be to encompass all those marks that are indeed so “globally protected,” that few if any legitimate rights will be affected.

With these concerns in mind, in settling on particular GPML criteria, it is critical to choose criteria that does not favor one region or one legal regime over another. Moreover, the GPML criteria must be inclusive of the appropriate trademarks to ensure that its public policy objectives are met. For this to be accomplished, the Committee believes that the criteria for inclusion on the GPML should be receptive of trademarks that have been subjected to widespread, global and repeated abuse across the Internet DNS.

1. **Number of countries versus registrations** – We appreciate that the IRT’s final report places greater emphasis on the number of countries in which a mark is protected. However, upon further review, we suggest that the criterion can both be simplified and made more equitable by focusing **exclusively** on the number of countries (and the diversity of such countries) where a trademark is registered. In other words, we would suggest the criterion on the top of page 17 of the report be edited as follows:

- Ownership by the trademark owner of [number] trademark registrations of national effect<sup>5</sup> for the applied-for GPM that have issued in at least [number] countries across all 5 ICANN Regions with at least:
  - [number] ~~registrations~~ **countries** in the North American region
  - [number] ~~registrations~~ **countries** in the European region
  - [number] ~~registrations~~ **countries** in the African region
  - [number] ~~registrations~~ **countries** in the Asian/Australian/Pacific region
  - [number] ~~registrations~~ **countries** in the Latin American/Caribbean region

We suggest this change because variations in national laws may result in marks protected in an array of countries being covered by a significantly different number of registrations. For instance, some countries allow and even encourage<sup>6</sup> registrations that cover multiple classes of goods or services, while others require a single registration for each class. In other countries, marks in certain industries

---

<sup>5</sup> We agree with the comments in IRT footnotes 9, 10, and 11 on page 17, requiring that the mark be on the superior register, in countries with two registers, that design marks be counted, so long as the GPM is identical to the registration’s textual elements, and that registrations of supranational effect be counted for every country in which the registration provides national protection, respectively.

<sup>6</sup> Most significantly, both the European Community Trade Mark (CTM) system and the Madrid System for the International Registration of Marks not only allows multi-class applications, but charge set fees for up to three classes of goods or services, encouraging applicants to apply for fewer registrations with broader coverage.

are more or less likely to be filed in single or multiple-class applications than marks in other industries.<sup>7</sup>

We will reserve comment on the precise number of countries in which a mark should be protected until the proposed numbers have been released. However, we encourage ICANN and the IRT, in setting the criteria, to take into account not only the number of countries and trademark offices that exist in the world (194 independent states,<sup>8</sup> albeit many of them lacking trademark service mark registers), but also the marketplace realities of global commerce. For instance, 90 or 100, or 120 countries may represent nearly half to less than two-thirds the number, but may represent all but a small percentage of economic activity. It may not be commercially reasonable to expect even the most globally-protected marks to be registered in more countries than this.

2. **Repeatably Abused Trademarks** - The Committee recommends that a second criterion be established to ensure that the public policy objectives of the GPML - minimizing Internet end-user confusion and addressing the targeted fraud of consumers in the DNS – are met. To meet these important public policy objectives, protection should be extended to trademarks that have been the subject of widespread and systematic abuse in the Internet DNS. As INTA commented on the first iteration of the DAG, this criterion can be established by a “demonstration (and supporting documentation) that the mark at issue has been the subject of repeated cybersquatting, as established by successful proceedings under the UDRP, other dispute resolution policies applicable to other TLDs, or applicable national law.”<sup>9</sup> The Committee remains committed to working with the IRT and ICANN in further refining this criterion as necessary.
3. **Deadline for registration** – We also agree that there should be a deadline after which registrations would not be applicable, to prevent gaming of the top level and second level process. The deadline should allow possibility for new GPMs to be added to the list later, perhaps by being set to “roll” to a particular time period before relevant application deadlines.
4. **Principal URL Corresponding to Mark** – Requiring the second-level domain for the principal online presence to be identical to the trademark appears to be a reasonable standard.

---

<sup>7</sup> For instance, the immensely broad Class 9 covers all manner of computer hardware and software, many electrical appliances—from toasters to televisions, while “coasters,” may be classified in four different classes based on material (paper, leather, plastic or cloth). In addition, the U.S. practice of allowing advertising as a specimen of use for service marks but not trademarks for goods makes services more likely to be applied for in multiple class applications.

<sup>8</sup> See <http://www.state.gov/s/inr/rls/4250.htm>.

<sup>9</sup> Comments of International Trademark Association on Draft Applicant Guidebook. December 15, 2008. See <http://forum.icann.org/lists/gtld-guide/msg00147.html>

## ***Other Top and Second-Level Rights Protection Mechanisms***

### **Post-Delegation Dispute Mechanism**

In general, we agree that there should be a meaningful post-delegation review in cases where a registry, as a result of the string itself, or of the registry's policies, becomes a haven for cybersquatting. Furthermore, we applaud the IRT's agreement with our proposal to allow the third party to participate in the proceeding and press forward with the action against the registry if ICANN fails to find that the registry is in material breach of its agreement. Despite gains, the room that is left for improvement in ICANN's contractual enforcement suggests that the post-delegation procedure—and the participation of the complaining third party—may be necessary.

### **Pre-Launch Second-Level Rights Protection: The IP Claims Service**

As outlined in the report, the IP Claims Service would provide the following benefits with respect to new second-level domains:

- *Identical match of a GPM*: registration blocked, unless registrant can claim that use would be consistent with generally accepted trademark laws.
- *Identical match of a mark in the IP Clearinghouse*: notice provided to IP owner and registrant; registrant must then opt to register the domain and make additional representations and warranties.
- Non-identical match of a GPM: no effect.
- Non-identical match of a mark in the IP Clearinghouse: no effect.

The IP Claims Service has the potential to be a very useful tool for most trademark owners, but, as discussed above, owners of marks in the IP Clearinghouse should be able to receive notices on matches of the trademarked term embedded within multi-word domains. In such cases, the registrant should similarly have to make the additional representations and warranties (particularly if the occurrence of false positives, like a hypothetical mark ERA within the domain parameters.tld can be avoided).

## **Additional Protections for Trademark Rights Beyond the gTLD Roll-Out**

As mentioned above, part of the over-arching trademark issue with the launch of new gTLD registries is that it will likely exacerbate issues that currently exist in the domain name system. Because those issues may apply to all gTLDs, they may not have been within the scope of the proposals the IRT was chartered to address. For the same reason, it may be most appropriate to address these issues through RAA amendments, the PDP process, or other means. Nevertheless, we mention them here as a reminder that actions outside the new gTLD launch process may be necessary to address trademark concerns with the proliferation of abusive registrations expected following the new gTLD roll-out.

### ***Proxy and Privacy Services***

The most prominent of these is the need to enforce and enhance the means of obtaining the



name and contact information for the underlying user of a domain registered to a proxy service. We agree, with the IRT, when it urged ICANN to consider the “development of universal standards and practices for proxy domain name registration services.” As recently pointed out by the IPC,<sup>10</sup> the spirit and language of RAA 3.7.7.3 is widely circumvented by registrar and registrant non-compliance. This issue affects all gTLD registries, and should be addressed on a holistic basis. Thus, we recognize that it may have been outside the scope of the IRT’s mandate, or even outside the scope of the new gTLD process. Nevertheless, providing meaningful trademark protection as the scale of domain name abuse escalates will require this issue to be addressed.

## **Conclusion**

In these comments and elsewhere, INTA has argued that the unlimited expansion of new gTLDs should not go forward on the timetable presently contemplated by ICANN, particularly with so many threshold issues currently unaddressed in the DAG. In the event that the schedule being proposed by ICANN is adhered to, we strongly recommend the adoption of the IRT recommendations as supplemented by the suggestions contained herein.

However, even with the measures outlined in the IRT report, trademark owners may still face difficulties in obtaining meaningful relief in protecting their marks, and/or may see the costs of protecting their brands (and protecting consumers from confusion and on-line fraud involving their brands) skyrocket. The Committee recommends that ICANN study the extent of the problem in two ways: Before ICANN makes a decision to proceed with any large-scale launch of new gTLDs, it should consider the results of a study of the additional costs to trademark owners, assuming that the IRT recommendations were implemented (both from costs in taking advantage of the IRT’s mechanisms, and the projected increase in enforcement proceedings overall). Second, if a decision is made to proceed with a gTLD launch, ICANN should commit, within six months to a year of the launch of the first round of new gTLDs, to study the costs that trademark owners have incurred in practice.

Such a review would be designed to evaluate whether the IRT recommendations were successful in providing adequate protection for trademarks in the new gTLDs without permitting abuses by those using the various mechanisms. To the extent the proper balance had not been maintained, adjustments could be made to improve the system.

Thank you for considering our views on these important issues. If you have any questions regarding our submission, please contact External Relations Manager, Claudio DiGangi, at: [cdigangi@inta.org](mailto:cdigangi@inta.org)

### ***About INTA and its Internet Committee***

The International Trademark Association (INTA) is a 131 year-old not-for-profit membership association of more than 5,500 trademark owners, from more than 190 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. Over the last decade, INTA has been a leading voice for trademark owners on the future of the Internet DNS, and it

---

<sup>10</sup> Intellectual Property Constituency, Letter to Doug Brent Re: Circumvention of Registrar Accreditation Agreement Section 3.7.7.3, Apr. 24, 2009.

is a founding member of ICANN's Intellectual Property Constituency (IPC). INTA's Internet Committee consists of over 125 trademark professionals who evaluate treaties, laws, regulations and procedures relating to domain name assignment, use of trademarks on the Internet, and unfair competition on the Internet and develop and advocate policies to advance the balanced protection of trademarks on the Internet.