Trademarks & New gTLDs
18 September 2012 – Washington D.C.

Discussion Summary

Audience
- We had participation from a diverse group of industry stakeholders – including new gTLD applicants, new gTLD back-end registry operators, ICANN accredited registrars, industry associations, and law firms that manage legal rights infringements on behalf of their clients

Overall Tone
- There was generally a willingness to work together to improve the system
- Among the various proposals, there are some common elements that can form the basis of a solution supported by the majority of stakeholders
- The solution can be implemented voluntarily by many of the new gTLD registry operators, and can form the basis for a policy development process to become applicable to both new gTLDs and existing gTLDs

Top 5 Specific Proposals (from Panel)
- Make the trademark claims process a part of ongoing registration rather than just the first 60 days
- Email authentication of registrants and possible centralization of other forms of validation (e.g. address validation)
- Various forms of criteria for rights holders to take a reservation (without annual renewal) out across multiple open gTLDs, or have a centralized sunrise process
- Extend the eligibility to register in the trademark clearinghouse beyond exact match of trademarks (e.g including terms related to the class of service of the trademark such as "**PayPal**payments") and then using these names in sunrise or trademark claims processes. The choice of such terms could be based on terms used in a trademark registration, or terms frequently associated with a brand in online infringement decisions (e.g. UDRP, court cases).
- Various improvements to the URS process (e.g. stronger loser pays mechanisms, faster or cheaper processes in cases when a registrant does not respond). There was common agreement that the costs of URS should stay within the limit recommended by ICANN.

Top 3 Specific Proposals (from Attendees)
- Need a RAPID suspension for security issues – in minutes, not hours or days. The half-life of a phishing scam is currently 24 hours and current suspension processes

often rely on personal industry contacts. There is no standardization of processes across the industry.

- Registrants need to be considered. May be setting bars too high for new gTLDs. Should let registry operators implement additional mechanisms and then determine what to make mandatory for the next round

- Need to think about impact of protecting dictionary words that include trademarks. What would Oprah Winfrey (who trademarked the letter "O") think?

General support in principle to…

- The trademark claims process should extend indefinitely during operation of a gTLD (new and existing), with associated improvements to the design and systems reliability of the trademark clearinghouse

- Combinations of exact matches and related industry terms should be included in the trademark clearinghouse and rights protection mechanisms, such as sunrise registrations and trademark claims

- Some form of reservation system should be allowed where a trademark holder can reserve a high risk mark from registration (and hence avoid ongoing defensive renewal fees), preferably across multiple open gTLDs (as Donuts have suggested for the TLDs they have applied for)

- With respect to the practical operation of a system that supports an extension to exact matches, the trademark clearinghouse would still need to have a defined list of such marks that a rights holder explicitly goes through a validation process to include in the clearinghouse, and that there would not be some automated process of matching trademarks to industry terms

Next Steps

- That various stakeholder groups meet together to agree to a common set of mechanisms at a principle level, and to flesh out the implementation details that will work in high volume and high reliability environments

- The hope is to conduct a follow-up meeting that could be held in Toronto to help crystalize the areas of agreement across the various stakeholder groups that participated in the seminar today

- Melbourne IT will be making available audio/video and a transcript of the session to help further work