



## AT-LARGE ADVISORY COMMITTEE

**EN**

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STATUS: Final

### **Minority Report**

#### **On Selected Trademark Issues (STI) Report**

##### **Introduction**

By the Staff of ICANN

The ALAC Minority Report on Selected Trademark Issues (STI) Report was originally drafted by Alan Greenberg, Vice Chair of the At Large Advisory Committee (ALAC) and liaison to the council of the Generic Names Supporting Organisation (GNSO) and Olivier Crépin-Leblond on behalf of the At-Large Names Issues Taskforce.

The original document, which contained four minority issues, was published for community review on December 10th 2009. Following comments received on the original Draft, the members of the At-Large Names Issues Taskforce decided to delete one of the four minority issues.

Alan then tasked the Staff to start an ALAC online vote on the first revision (the present document) starting on December 14th, 2009 and ending on December 17th, 2009. The result of said vote being that the ALAC endorsed the Statement with a 11-0 vote. You may review the result of that vote online under:

<https://www.bigpulse.com/pollresults?code=Z4seccyealDGchh12jVm>

Alan Greenberg transmitted the document on behalf of the ALAC to the GNSO council during its teleconference on December 17th, 2009.

This ALAC report was further submitted to the ICANN public consultation on the Special Trademarks Issues Report with a copy going to the ICANN Board of Directors on January 18th, 2010.

(End of Introduction)

This document has been translated from English in order to reach a wider audience. While the Internet Corporation for Assigned Names and Numbers (ICANN) has made efforts to verify the accuracy of the translation, English is the working language of ICANN and the English original of this document is the only official and authoritative text. You may find the English original at: <http://www.atlarge.icann.org/correspondence>

## **Minority Report on Selected Trademark Issues (STI) Report – 11 Dec 2009**

The At-large Advisory Committee submits the following three statements to be attached to the STI Review Team report dated 11 December 2009

### **1. Additional Marks in the Clearinghouse – Report section Clearinghouse 4.2**

The TC should also allow the inclusion of names, for the purposes of sunrises, which would include a registered TM used in conjunction with:

- a dictionary word that is associated with the class of services trademarked (example: a chemical company XYZ could deposit in the TC the name "XYZ-Chemicals". This was allowed in the .asia sunrise.
- a dictionary word that is regularly used in clear association with the TM (example: Yahoo- Finance - see <http://finance.yahoo.com/>). There would need to be carefully worded rules, objection processes and **penalties** for depositing names in the TC that do not meet the criteria (example: Yahoo-stinks, unless Yahoo starts to manufacture and sell stink-bombs).

Rationale:

Brand owners want to be able to have clear right-of-first-refusal to reduce opportunities for cyber-squatting and to reduce the need for URS and UDRP proceedings. We believe that At-Large benefits from such legitimate registrations by reducing the opportunity for user confusion which results from cyber-squatters obtaining such names. From the perspective of a non-sophisticated user, if they enter a name that CLEARLY maps to a known brand, it should not resolve to a pay-per-click page or someone offering a competing product or service.

### **2. Transfer of a domain name after a successful URS – Report section URS 7.2**

We recommend that a transfer to the successful URS claimant at end-of registration be allowed.

Barring that being accepted, we suggest that a transfer be allowed after a second successful URS.

Rationale:

At-Large believes that this is a reasonable action to reduce cyber-squatting and the resultant user confusion.

A number of reasons for opposing such a transfer have been raised:

a) The URS was not originally envisioned by the IRT as a transfer mechanism - if the TM holder wants to take custody of the name, they should use the more expensive and slower UDRP either following a successful URS, or instead of the URS

ALAC Response: This should not be relevant. We have already changed MUCH in the original IRT proposal, and rightfully so. And it seems mean-spirited to force a TM holder to go through the UDRP just because of how the URS was originally envisioned.

b) We need to differentiate the URS from the UDRP

ALAC Response: Why? There is a good probability that over the next few years, the two procedures will be reviewed and merged into a single procedure with multiple paths.

c) It may be complex for the registry and/or registrar to implement if not carefully designed.

ALAC Response: This can be overcome with careful design. Since the domain is explicitly flagged as being the subject of a successful URS, the process should not be onerous if requested at URS-time by the claimant.

d) It may take a generic word domain name (which might have legitimate uses over and above those used by the current registrant (which resulted in a successful URS)

ALAC Response: Chances are that either through successive URS proceedings or a UDRP, the name will go out of circulation anyway.

The alternative implementation will not be as effective, but will be better than having to file a UDRP. The argument has been made that tracking URS duplicates would be to onerous.

However, if it is the responsibility of the TM holder to indicate that a URS is a 2nd one (with reference to the original URS), no tracking is required, other than on the part of the TM holder.

### **3. Post-Launch TM Claims – Report section Clearinghouse 7.1**

At-Large recommends further investigation with respect to the efficient and effecting implementation of post-launch IP claims and on the potential chilling effect on non-IP- professional registrants.

Rationale: If the chilling effect is not unreasonable, this could reduce cyber-squatting and when it fails, will increase the probability and speed of a successful URS against cyber-squatters.