



*Intellectual Property Law
1 North Castle Drive
North Castle, New York 10504-1785*

*voice: +1 (914) 765-4353
fax: +1 (914) 765-4290
e-mail: leonora@us.ibm.com*

January 26, 2010
Internet Corporation for Assigned Name and Numbers
International Square
1875 I Street, NW, Suite 501
Washington D.C., 20006

Via Electronic Mail to policy-staff@icann.org

Attention: Denise Michel

Re: International Business Machines response to Special Trademark Issues Review Team Recommendations, dated 11 December 2009

International Business Machines (IBM) appreciates the opportunity to comment on the Special Trademark Issues Review Team Recommendations, dated 11 December 2009. IBM is encouraged by the progress made by the Special Trademark Issues (STI) review team on the policy implications of certain rights protection mechanisms proposed for the new Generic Top Level Domain (GTLN) program.

Brands play a vital role in the global economy. International protection of a brand is an essential part of any brand owner investment in a brand, but especially internationally recognized brands. The IBM brand is a vital asset in the IBM intellectual property portfolio. IBM appreciates the measures that STI has taken in the aforementioned STI team recommendations.

IBM has limited our response with respect to the Trademark Clearing House Proposal to features 4.1, 4.3, 5.2 and 10.1 and the Uniform Rapid Suspension Procedure to features 7.1 and 7.2.

TRADEMARK CLEARINGHOUSE PROPOSAL

Feature 4.1: National or Multinational Registered Marks

IBM Comments on Feature 4.1: IBM recommends that the Trademark Clearinghouse (TC) database include design marks that are primarily text based but perhaps have a de minimus design characteristic, such as fanciful or stylized treatment of the font. The design characteristic of such design marks must not overshadow the text base of such marks. IBM recommends inclusion of design marks with de minimus design characteristic because otherwise, the TC database would unfairly preclude design marks that would otherwise be easily recognized in plain text and attractive to cyber squatters to appropriate.

Feature 4.3: Conversion of Mark into TC Database

IBM Comment on Feature 4.3: IBM supports the proposal that the TC database should report to the registries strings that are very minor variations that could be seen as typosquatting such as, but not limited to, the examples delineated in the definition of "Identical Match." IBM supports the further proposal that registries should have the opportunity to make a determination of brand misuse. IBM cautions, however that the TC should not be used to expand scope of trademark owner rights normally afforded under the Lanham Act and/or international treaties affecting trademark rights.

Feature 5.2: Protection for all Trademarks in the TC

IBM Comment on Feature 5.2: IBM has cause for concern about this Feature 5.2.; the registries should not unilaterally have discretion to decide whether to grant protections to the trademarks in the TC. Famous trademarks may be known, and even used by the owner or its licensees in a promotional manner beyond the core products and services. Not only is this of particular concern for famous marks, but also for any well known brand or three letter acronym brand, which, historically, studies have shown are more likely to suffer from brand misuse.

Feature 10.1: Costs of Operating Clearinghouse

IBM Comment on Feature 10.1: IBM agrees that the cost of running the TC should be borne by the parties utilizing the service, however IBM recommends that the cost of running the TC should be nominal and the cost of establishing the TC should assumed by ICANN. Every study indicates that the new GTLD program will be a significant cost to brand owners for enforcement and cessation of brand misuse, which are forecast to increase by at least an order of magnitude.

UNIFORM RAPID SUSPENSION PROCEDURE

Feature 7.1 & 7.2: Remedy if Successful on the Merits and Additional Remedies

IBM Comment on Feature 7.1 & 7.2: IBM agrees with the treatment detailed in these Features 7.1 & 7.2, as such treatment applies to public GTLDs. However, this may not be appropriate for private or limited GTLDs. IBM recommends that, if the .brand is either a private or limited GTLD, the GTLD should not be automatically transferred to the prevailing party, or even resolve to a page detailing the URS proceeding, but instead could be cancelled.

Respectfully submitted,



Leonora Hoicka

Associate General Counsel

Intellectual Property Law

IBM Corporation

leonora@us.ibm.com

Voice: 914-765-4353 / Fax: 914-765-4290