



INTERNATIONAL
OLYMPIC
COMMITTEE

Internet Corporation for Assigned
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Legal Affairs

Lausanne, 26 January 2010

SPECIAL TRADEMARK ISSUES REVIEW TEAM RECOMMENDATIONS:

The Trademark Clearinghouse and Uniform Rapid Suspension System.

Dear Sir/Madam,

The International Olympic Committee ("IOC") submits this letter in response to ICANN's invitation for public comment on the Special Trademark Issues Review Team Recommendations (the "team's report") on trademark protection mechanisms in new gTLDs.

I. INTRODUCTION

The IOC remains opposed to the introduction of new gTLDs as a whole. However, the IOC has sought to contribute helpful information to ICANN regarding proposed trademark protection mechanisms in new gTLDs.

Accordingly, we are pleased to see that the Special Trademark Issues Review Team has reached consensus on utilizing both the Trademark Clearinghouse and Uniform Rapid Suspension system. We are particularly relieved to see that the team reached "unanimous consensus" on mandatory use of the Uniform Rapid Suspension System. In the IOC's continued – and qualified – effort to provide insight and information regarding ICANN's proposed new gTLD program, we submit the following comments. These comments identify persisting deficiencies in the Trademark Clearinghouse and Uniform Rapid Suspension system and identify other new short-comings as well:

II. COMMENTS

A. THE TRADEMARK CLEARINGHOUSE

The Trademark Clearinghouse Must Recognize Special Statutory Trademark Protection (Sections 4.1 and 4.2).



Special trademark legislation from across the globe, such as the Olympic and Amateur Sports Act in the United States, recognizes the unique, non-profit nature of the Olympic Movement, and grants enhanced statutory protection to the Olympic Trademarks.¹ Numerous courts throughout the world have applied and upheld such legislation.²

Domain name registration authorities have also recognized special protection for the Olympic Trademarks, and have endeavored to abide by such national legislation. On 23 July, 1996, Network Solutions agreed with the United States Olympic Committee to memorialize its commitment to the Amateur and Olympic Sports Act:

Upon formal written notification from the Olympic Committee that a third-party has registered a second-level domain name which incorporates Olympic Committee Insignia protected under the Amateur Sports Act without the authorization of the Olympic Committee, Network solutions will, in turn, notify the third-party registrant that said domain name will be deleted within five (5) business days.³

In addition Network Solutions took “the added step of blocking domain name registration of the literal words ‘Olympic’, ‘Olympiad’, and ‘Citius Altius Fortius’, consistent with 36 U.S.C. § 380(a).” More recently, Nominet, the ccTLD registry for .UK, has explicitly warned its customers regarding the London 2012 Olympics and “Olympics-related domains”:

In preparation for the 2012 Olympics and Paralympics, the Government has introduced new rights and powers to help the organizers of the Games protect their sponsor’s investment and the reputation of the Games. These rights will apply to uses of various words and symbols with links to the 2012 Games, and can therefore affect .uk domain names.⁴

Moreover, Sedo.com blocks attempts to park domain names containing the Olympic Trademarks and informs customers, “Inserting this domain violates German trademark law.” Indeed, online domain name auction houses – including Sedo, GoDaddy, eBay and Afternic – regularly remove names containing Olympic Trademarks upon request.

The team’s report ignores special trademark legislation, despite the IOC’s consistent advocacy of – and the lack of **any** opposition to – this issue. It is incumbent upon ICANN staff to recognize and account for the global, enhanced statutory protection of the Olympic Trademarks. Specifically, the Trademark Clearinghouse must include a reserved names list for the Olympic Trademarks and/or recognize special statutory protection as a basis for inclusion in the clearinghouse.

¹ 36 U.S.C. §22051 et seq.

² See e.g. *San Francisco Arts & Athletics, et al. v. United States Olympic Committee et al.*, 483 U.S. 522 (1987); *Deutsche Telekom AG v. Comité International Olympique*, OHIM Second Board of Appeal Case R 145/2003-2; *Benetton Group S.P.A. v. International Olympic Committee*, Court of Venice, Industrial and Intellectual Property Section, Case RG 6047/04 (2006); *Internationales Olympisches Komitee v. Alexandre SA Zurich*, Handelsgericht des Kantons Zurich, Geschäfts-Nr. HE040007 (2004).

³ Agreement between United States Olympic Committee and Network Solutions, Exhibit A.

⁴ Nominet, *.uk domain names and the 2012 Olympics*, available at <http://www.nominet.org.uk/disputes/legalinfo/olympics/> (last visited January 21, 2010).



The Trademark Clearinghouse Should Consider Confusing Similarity and Foreign Equivalents (Section 4.3).

The team's report also ignores domain name registrations that are confusingly similar to, or foreign equivalents of trademarks, with an oblivious focus on mere "identical matches." This approach improperly encourages cybersquatting, predominantly in the form of typo-squatting, and fails to ameliorate the significant burden trademark owners bear to register domain names defensively.⁵ An effective and efficient Trademark Clearinghouse must apply to both confusingly similar domain names, to protect against typo-squatting, and foreign equivalents, for protection in Internationalized Domain Names.

Trademark Owners Must Not Fund The Clearinghouse (Section 10.1).

ICANN is securing its long-term financial future with the New gTLD Program through application fees, fees under Registry and Registrar Agreements, and pre-registration fees for new gTLDs. Potential Registries and Registrars are poised to receive payment for each and every second-level domain name registration in each new gTLD. Registrants eagerly anticipate a virgin frontier in which to expand their speculation and trading practices. It is only fitting that the Trademark Clearinghouse be funded *entirely* by these parties and not by trademark owners.

B. UNIFORM RAPID SUSPENSION SYSTEM

Temporary Domain Name Suspension Is Not A Meaningful Remedy (Section 7.1).

As proposed by the team, if a complainant prevails under the Uniform Rapid Suspension system, "the domain name should be suspended for the balance of the registration period and would not resolve to the original website." However, the team ignores what will happen upon expiration. Will the domain name enter redemption or fall victim to back-ordering or auction by a domain name registrar? Either way, temporary domain name suspension – without more – leads to a perpetual cycle of registration and suspension under the Uniform Rapid Suspension system.⁶

The proper remedy under the Uniform Rapid Suspension system should be transfer of the domain name to the trademark owner. In the alternative, subsequent registrants should receive notice of prior suspensions, and should bear the burden of overcoming a presumption of bad faith in order to register.

Any Draconian "Strike" Policy Should Be Dropped (Section 9.1).

⁵ In the launch of a new gTLD, approximately forty-one percent (41%) of new domain names are registered by trademark owners for defensive purposes. Summit Strategies International, *Evaluation of the New gTLDs: Policy and Legal Issues* (July 10, 2004), available at <http://www.icann.org/en/tlds/new-gtld-eval-31aug04.pdf> (last visited December 16, 2009).

⁶ On June 18, 2009, the World Intellectual Property Organization noted, "the proposed remedy would not appear to meaningfully address the burdens on trademark owners" and this "remedy" is of limited effectiveness, lasting no more than a few months." WIPO, ICANN Implementation Recommendation Team Final Report, available at <http://www.wipo.int/export/sites/www/amc/en/docs/icann180609.pdf> (last visited January 21, 2010).



If one aim of the Uniform Rapid Suspension system is to help redress the hundreds of thousands of unauthorized – and infringing – domain name registrations that plague individual owners of well-known trademarks, then it is improper to have a quantitative “strike” policy for abuse of the process. This is especially true where the terms “abusive complaints” and “deliberate material falsehood” are left undefined.

The Proposed Safe Harbors Send The Wrong Message (Annex 6, ¶ 3).

Taken together, the proposed Safe Harbors to the Uniform Rapid Suspension system instruct that registrants may “trade in domain names for profit,” “hold[] a large portfolio of domain names,” and “connect[] domain names to parking pages and earn[] click-per-view revenue,” so long as any one putative domain name “is of a significantly different type or character to the other domain names registered by the Registrant.”

Without delving into the merits of which particular types of conduct evince bad faith registration and use of a domain name, the IOC submits that such safe harbors improperly distract from the original intent of the Uniform Rapid Suspension system – to address clear-cut cases of cybersquatting, reducing the need for expensive and protracted Uniform Domain Name Dispute Resolution procedures, which almost invariably result in respondent default. These safe harbors unnecessarily add obstacles to a system that was intended to be straight-forward and simple.

III. CONCLUSION

Subject to the foregoing, the IOC maintains its position that ICANN's introduction of new gTLDs is inherently flawed and injurious to owners of famous trademarks – particularly non-profit trademark owners that rely in part on special statutory protection for their brands. If the new gTLD implementation does proceed, the IOC wishes to stress the need for a reserved names list of Olympic Trademarks, similar to the list previously recognized by Network Solutions.

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 an unlimited number of new gTLDs.

Yours Sincerely,

A handwritten signature in blue ink, appearing to read "Urs LACOTTE".

Urs LACOTTE
Director General

A handwritten signature in blue ink, appearing to read "Howard M. Stupp".

Howard M. Stupp
Legal Affairs Director