



01 Apr 2010

Trademark Clearing House Proposal

Please accept the following comments in response to the publication of the proposed Trademark Clearinghouse System (TMCH)¹. Go Daddy reserves the right to future comments on this issue and our positions include, but are not necessarily limited to, the text herein.

Go Daddy thanks the STI and appreciates their efforts to address the issues surrounding Rights Protection Mechanisms in New gTLDs. We look forward to the successful resolution of this and other Overarching Issues.

General Comments

In principle, we cautiously support the proposed Trademark Clearinghouse as an aid for new gTLD registry operators to conducting their "sunrise" registration periods, or equivalent early opening for marks holders. A centralized database will provide some element of uniformity by establishing standardized eligibility requirements and registration methods.

Nevertheless, we are concerned with some implementation aspects regarding the TMCH proposal. As an example, the evaluation and deployment of the TMCH could be a lengthy process, involving perhaps 12-18 months. Will this work occur in parallel with the evaluation and delegation (but not launch) of new gTLDs? Or must the TMCH be operational in advance of the delegation of new strings? These are important clarifications that applicants should be informed of as soon as possible.

Also, we would express our concern that the ICANN Board of Directors approved the inclusion of TMCH in the next version of the Applicant Guidebook while the topic remained open for public comment. It is impossible to know if this action deterred additional comments or material contributions to the proposal, or if the Staff and Board will fully consider the comments that are made.

Specific Questions and Comments

1. Section 2 concludes with the statement that inclusion in the TMCH does not create or prove any rights, and that failure to submit should not be seen as a lack of vigilance. Considering that there will be a cost associated with each submission, what is the incentive for marks holders to participate? Will failure to include marks in the TMCH have any consequences, or will it be a point of consideration during future proceedings under the URS, and possibly the UDRP? We believe that Mark holders should participate in the full gamut of

protection mechanisms, after all these were developed at their request.

2. As described in Section 3 (and others) one function of the TMCH provider is to “authenticate” claims. Is there any plan or process to address the problem of competing or overlapping claims to the same mark, either in different jurisdictions or for different commercial purposes?
3. Section 6 states that all new gTLD registry operators must use the TMCH in support of their pre-launch RPMs, such as a “sunrise” period. At the same time, Section 8 states that the cost of operating the TMCH should be borne by the parties utilizing the system. While both Registries and Marks Holders will “utilize” the TMCH system, the latter are its chief beneficiaries. Therefore, we recommend that these statements be clarified: gTLD Registries are required to use the system, and the costs are borne by Marks Holders.
4. Finally, we note that the definition of “Identical Match” in Section 6 could generate problems and needs to be clarified. Part (a) notes the interchangeability of spaces and hyphens, or their omission. But this could result in a repeat of some of the problems encountered in the launch of the .EU ccTLD, which saw confusion between “famous mark” and “famous-mark” and “famous-m-a-r-k.” We recommend that Staff revisit this section and consider clarifications to minimize this type of gaming.

Also, part (c)(ii) states that any disallowed characters that are replaced by “spaces, hyphens or underscores” be considered a match. But the current protocol supports only hyphens in domain names strings. Spaces and underscore characters should be removed from this list.

Conclusion

Again, we extend our appreciation to the IRT and STI for their efforts to develop the Proposal for the TMCH, and look forward to the resolution of this Overarching Issue.

Sincerely,
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1. <http://www.icann.org/en/announcements/announcement-4-15feb10-en.htm>