

**Comments of National Basketball Association, National Football League,  
and NHL Enterprises, L.P. on Trademark Clearinghouse “Strawman Solution” and  
Limited Preventative Registration Proposal**

The National Basketball Association (“NBA”), National Football League (“NFL”), and NHL Enterprises, L.P. appreciate the opportunity to comment on the Trademark Clearinghouse “Strawman Solution” and the Limited Preventative Registration proposal put forward by the Business Constituency and Intellectual Property Constituency.

Our fans are the lifeblood of our sports and our leagues. Every year, hundreds of millions of fans in the United States and hundreds of countries across the globe watch teams in our sports leagues compete. Our fans support our leagues year-round by wearing team-branded apparel, decorating their homes and offices with branded merchandise, and reading the latest news about their favorite teams and players.

Our leagues are as well-known online as they are offline. Collectively, our principal websites average tens of millions of page views per day, with a significant percentage of visitors coming from outside North America. Our principal websites routinely rank among the most-visited sites in the United States.

We each work tirelessly to protect our fans from online fraud and abuse by unscrupulous third parties who try to benefit unlawfully from our leagues and our fans. We each devote significant resources to policing for online fraud and abuse (including counterfeit merchandise sold online) and taking enforcement actions against bad actors, often joining forces with law enforcement. Each of us has focused on protecting our fans from abusive domain names that infringe our league or team marks in an effort to confuse or defraud our fans.

We are concerned that the trademark rights protection mechanisms for new gTLDs and ICANN’s proposed implementation of those RPMs are insufficient in light of the volume of gTLDs at issue – over 1900 applications for over 1400 unique gTLD strings. The potential scope and cost of defensive second-level registrations for each of us is massive. It is simply not feasible – particularly in today’s economic environment – to expend the resources necessary to secure defensive registrations for and to pursue the infringing use of every one of our league and team brands in domain names registered in such an expanded offering of gTLDs. Adoption and implementation of the Limited Preventative Registration proposal and the Trademark Clearinghouse “Strawman Solution” are essential to our efforts to ensure that consumers are not confused, to prevent cybersquatting on our trademarks, and to allow us to enforce effectively against those who violate our intellectual property rights.

Limited Preventative Registration Proposal. We strongly support the Limited Preventative Registration (“LPR”) proposal advanced by the Intellectual Property and Business Constituencies. LPR is the only mechanism for addressing the need for defensive registrations – a need that will only increase in an Internet of more than 1400

new gTLDs.<sup>1</sup> We collectively have thousands of defensive registrations, many of which were recovered from third parties.

The LPR is narrowly tailored. It applies only to identical matches of registered trademarks that are eligible for inclusion in the Trademark Clearinghouse and for a registry's Sunrise. In other words, LPR applies only to the domain names a brand owner could have registered in Sunrise anyway. A trademark owner cannot use LPR to take away a domain name from an existing registrant and cannot use LPR to preclude a Sunrise registrant (e.g., a registrant with Clearinghouse-validated trademark rights that also meets the Sunrise criteria) from obtaining a domain name. By definition, LPR is not a block. The LPR proposal contains important registrant safeguards that don't apply to "regular" Sunrise registrations.

We participated in ICM Registry's Sunrise B, to which the LPR is closely analogous. ICM Registry effectively established that it is possible to operate LPR as a second phase of Sunrise or even simultaneously with "regular" Sunrise registrations to be processed before LPRs.

Enhanced Trademark Claims Service. We strongly support the proposed enhancement to the Trademark Claims service ("Enhanced Trademark Claims Service" or "ETCS") under which a trademark owner can associate with a Clearinghouse record up to 50 domain labels that have previously been determined to have been abusively registered or used.

We are pleased to see consideration of a rights protection mechanism that is not limited to identical matches. Our experience with cybersquatters has shown that they do not limit themselves to identical matches. Equally importantly, trademark law does not limit protection from infringement to identical marks. To the contrary, the standard – which is worded differently from country to country – is whether there is a likelihood of confusion. It flouts common sense that a potential registrant's efforts to register clearly infringing domain names would prompt no action – not even a Claims notice. Our experience demonstrates that infringing domain names are often used for fraud or other unlawful purposes, and may cause confusion or harm to our fans.

The ETCS is narrowly focused on only those domain labels that have been the subject of previous determinations of abusive registration or use. It does not create new trademark rights. Instead, ETCS provides only a notice and only for those labels that are the subject of formal, objective, third-party determinations that the domains at issue are confusingly similar to a trademark.

30-Day Sunrise Notice Requirement. We support the 30-day Sunrise notice requirement, which will help us to prepare (and will help us assist the teams in our respective leagues to prepare) for over 1400 Sunrise periods that we expect will occur within the next 12-18 months. The Sunrise notices must be centrally located and clearly written.

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<sup>1</sup> Affiliates of the NBA and NFL have applied for the .nba and .nfl gTLDs, respectively, to have the opportunity to create a more secure and authentic online experience for their fans and to protect their intellectual property rights. The NBA and NFL expect it could take several years before our fans and Internet users generally recognize .brand gTLDs such as .nba and .nfl as trusted namespaces. For that reason, defensive second-level domains will likely remain necessary for years to come.

30-Day Extension of Trademark Claims Process (“Claims 1”). We also support the 30-day extension of the Trademark Claims process (referred to as “Claims 1” in ICANN’s document). This extension protects potential registrants who may inadvertently seek to register a domain name that matches a trademark registration in the Trademark Clearinghouse, improves the probability that our respective league and team trademarks will be protected from inadvertent infringement, and consequently, decreases the probability of fan and Internet user confusion.

Proposed Trademark Claims Subscription Process (“Claims 2”). We generally support the newly proposed Claims 2 in concept and are willing to pay a reasonable “subscription” fee for Claims 2, as long as the benefit it creates exceeds the cost. To achieve that benefit-cost ratio, however, Claims 2 needs two changes. First, the Claims 2 notice should include the same trademark information as the Claims 1 notice. If it does not, a potential registrant will be unable to assess if his desired domain name is a potential infringement. The absence of trademark-specific information not only will result in registrant confusion and uncertainty, it may also result in the oft-predicted “chilling effect” that some in the ICANN community contend will be caused by all of the current trademark rights protection mechanisms. Second, the Claims 2 notice must include the same type of acknowledgement contained in the Claims 1 notice. Absent this acknowledgement, potential registrants, registrars, and trademark owners may well find themselves embroiled in disputes about whether or not a particular registrant did, in fact, receive the notice.

Original BC/IPC Consensus Proposal. In addition, we wish to emphasize our support for several points from the original BC/IPC consensus proposal that were deferred in discussions leading to the Trademark Clearinghouse “Strawman Solution,” namely:

1. Complete the URS as a low cost alternative and improve its usefulness - if necessary, ICANN could underwrite for an initial period.
2. Validate contact information for registrants in WHOIS.
3. All registrars active in new gTLD registrations must adhere to an amended RAA for all gTLD registrations they sponsor.
4. Enforce compliance of all registry commitments for Standard applications.

NTAG Comments. Finally, the NBA and NFL wish to state for the record that their respective Applicant-Affiliates, both of which are NTAG members, do not support those NTAG comments on the Trademark Clearinghouse “Strawman Solution” that contradict the positions the NBA and NFL have described here.