



14 January 2013

**MARQUES Cyberspace Team comments on ICANN's Trademark Clearinghouse: Strawman Solution**

While we are grateful for the opportunity to comment on ICANN's Trademark Clearinghouse Strawman Solution, we feel that overall, ICANN has missed an opportunity to implement more meaningful trademark protections in new gTLDs.

Furthermore, we agree with ICANN's assessment that the Strawman is consistent with the GNSO's original new gTLD policy advice (recommendation 3: Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law). Our more specific comments follow:

Sunrise Notice Period

Sunrise registration periods are often touted as some type of "extraordinary opportunity" for Trademark owners to purchase domain names before the general public; however, it is important to bear in mind that this so-called opportunity comes at significant cost to trademark owners (both in terms of entry into the Trademark Clearinghouse and the premium fees typically associated with sunrise registrations). In practice, businesses will be under pressure to purchase domains within new gTLDs purely to defend their brand with no real intention of using many of those domains. It is in no one's interests for this to happen – businesses see it as wasted money, consumers don't benefit as the domains are never used, registers are clogged with unwanted and unused domains.

For that reason, we support ICANN's provision of a Limited Preventative Registration mechanism (discussed in more detail below).

In lieu of ICANN's acceptance of a Limited Preventative Registration mechanism, we support the proposal for a minimum 30 day sunrise notice period. But we believe this to be unreasonably short especially when it must create the window for gTLD registry liaison with trademark owner registrants in the Trademark Clearinghouse and a 60 day period is in our view the appropriate grace period to allow for appropriate exchanges. (It should be noted though that this sunrise advertisement period would seem to benefit registration interests as much as trademark owners).

We suggest that this sunrise notice function be centrally coordinated. We also believe that ICANN should begin in earnest to coordinate the posting of registry-specific sunrise requirements so that Trademark owners are able to assess the relevance for them of specific registration risks and opportunities.

We further believe that particular care should be taken in monitoring and controlling the trademark use support evidence to be put forward to Deloitte Belgium as the Trademark Clearinghouse entry validation service provider.

Trademark Claims

We support the proposal to operate Trademark Claims for 90 days. We also support the extension of Trademark Claims to include previously-abused variations of a mark, but do not agree with the limit of 50 variations.

Trademark "Claims 2" service

We see this service as having limited utility in its current form. For example, it is not clear why a Claims 2 service would not display the Guidebook-agreed claims data; and we believe that it should. Potential registrants should be able to assess all the relevant Trademark data free of charge in order to make a fully informed decision on registration. (We note that by virtue of agreeing to UDRP paragraph 2, a registrant

already undertakes not to infringe third party rights.) Brand owners amongst MARQUES membership feel that take-up for the extra-fee Claims 2 service would probably be very low; such a watered-down measure has little support.

#### Limited Preventative Registration

We believe that a Limited Preventative Registration mechanism should be adopted by ICANN and should apply across all gTLDs to all sunrise periods everywhere. This would go towards meeting ICANN's obligations to the brand owners around the world a long way to addressing the legitimate concerns of trademark owners that they will not be able to keep pace with infringement in new gTLDs. A Limited Preventative Registration mechanism should go into effect in parallel with sunrise registration periods.

Additionally, we believe that the Limited Preventative Registration mechanism should be extended to include previously-harmed Trademark variations (as is being contemplated for Trademark Claims). We do not however agree that a Limited Preventative Registration mechanism should be limited to marks which are eligible for a particular sunrise.

We believe that there is an important missing element in the proposal for a Limited Preventative Registration mechanism, namely, a safeguard which allows for bona fide third-parties to register a domain name which is subject to a Limited Preventative Registration.

#### Co-existence/Contention Sets

We would also like to draw ICANN's attention to the critical issue of co-existence/contention sets which MARQUES has raised since at least as early as the Costa Rica Meeting in March 2012. It is concerning to MARQUES members, which includes present and likely future new gTLD applicants, that there is no apparent clarity on the standards ICANN's examiners are applying. We are also concerned that ICANN does not presently foresee an appeals process, nor does it seem open to accepting evidence of trademark co-existence agreement. We urge ICANN to expeditiously consider a path forward on this issue.

Thank you for considering our comments.

Finally, we look forward to ICANN's publication of the responses to its URS RFI.

Yours Sincerely,

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#### **About MARQUES:**

MARQUES – The Association of European Trademark Owners – represents Trademark owners' interests before the relevant EU and other international bodies in all relevant areas.

MARQUES represents Trademark owners and practitioners across Europe, who, together own more than three million domain names (a conservative estimate) and advise organisations of all sizes on rights protection in the domain name system. These domain names are relied upon by consumers across Europe as signposts of genuine goods and services.