



14 January 2013

Re: Com Laude comments on ICANN's Trademark Clearinghouse: Strawman Solution

We have consulted with our clients, who are some of the world's best known brands and our comments include their views.

We have not commented on the topic of whether ICANN's *Trademark Clearinghouse: Strawman Solution* relates to "policy" or "implementation." We believe that this is far too complex a topic to be addressed substantively here, but encourage ICANN's timely consideration of this topic for the benefit of all Stakeholders. For present purposes, we accept ICANN's view that the Strawman Solution is apparently consistent with GNSO policy advice concerning protection of the legal rights of others including trademarks.

Set out below are our comments on ICANN's Trademark Clearinghouse: Strawman Solution.

Sunrise Notice Period

Whilst we support a 30-day sunrise notice period as a minimum, we prefer a longer period of 60 days in order to enable rights owners and the ICANN community to more adequately prepare for a series of rolling launches of as many as 20 new gTLD per week.

We believe it would benefit all involved if ICANN coordinated publication of a 30-day sunrise notice.

Trademark Claims

We support requiring Trademark Claims to operate for 90 days. We would also support those Trademark Claims including up to 50 previously-abused mark variations, but see no reason to arbitrarily limit the scope of these Claims at 50. Many brands may only have one or two abused variations, but it is unfair to others with more to impose an arbitrary limit. We stress that these Claims do not prevent new legitimate registrations which may correspond to previously-abused mark variations, but merely provide notice of a possible conflict to prospective domain name registrants – which we feel provides a valuable service for both trademark owners and domain name registrants who may be able to avoid conflict down the road.

Trademark "Claims 2" service

We believe that a registry-provided monitoring tool like Nominet's subscription-based Public Register Search Service (PRSS) would be more useful. Additionally, in the event the Claims 2 service is implemented by ICANN, we do not think that trademark owners should bear any costs.

Limited Preventative Registration

We support ICANN's implementation of a Limited Preventative Registration tool. In fact, we would go further and suggest that this mechanism be prioritized as an RPM. This is the very type of mechanism that has been sought from the start of the New gTLD Programme to avoid unwanted costly defensive registrations. It is only because a mechanism such as an LPR is lacking that many in the trademark community feel the current RPMs will be inadequate to address their enforcement concerns. If ICANN fails to get this aspect of its New gTLD launch right, it is brands, and the millions of consumers who turn to them every day for online commerce, who will pay the price.

We urge ICANN to promptly consider the LPR as a critical part of its New gTLD launch.

ICANN has committed to a review of RPMs relatively soon after new gTLDs launch. If the LPR were to prove overly restrictive with respect to legitimate registrants, registration experiences can guide a path to adapting it to better suit the registration community; on the other hand, you cannot un-ring a bell: if an LPR is not in place, and brands are faced with scores of defensive registrations and infringements, it will be practically impossible to bolster existing RPMs after-the-fact.

We also feel it is important to highlight that an important part of any LPR involves safeguards for legitimate registrants (whether business or individuals), such as a mechanism that would allow for the registration of a domain name upon certain warranties/representations.

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Finally, as ICANN reviews the results of the String Similarity Panel, we would also like to take this opportunity to draw ICANN's attention to the critical issue of co-existence/contention sets. It is concerning to our clients, who include 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-based co-existence agreements.

We urge ICANN to expeditiously consider a path forward on this issue. Allowing applicants to provide letters of co-existence would be a welcome solution, as a way for legitimate rights owners with similar strings who co-exist in the real world of avoiding contention sets.

Thank you for your consideration of the above suggestions; please do not hesitate to contact us if we can be of further assistance.

Yours sincerely,

/s/

Nick Wood
Managing Director
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