



BBC / BBC Worldwide Limited Comments on the Trademark Clearinghouse Strawman Solution and the Proposal for Limited Preventative Registrations

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Introduction

The British Broadcasting Corporation (BBC) is the United Kingdom's Public Service television and radio broadcaster established by Royal Charter and publicly funded by a licence fee. BBC Worldwide Limited is a wholly owned company within the BBC group, responsible for the commercial exploitation of the BBC's output in order to generate revenue for the BBC.

Overall, the BBC reaches 93% of the UK public each week with information, education and entertainment provided via TV, radio and online platforms. It is also a global broadcaster, as Europe's largest exporter of TV programmes and the provider of trusted, independent and impartial international news to a weekly audience of around 250 million households, with over 17 million unique users online.

The BBC is also the applicant for the new gTLD string .BBC.

The IRT Report, produced by a group of experts in the field, originally proposed establishing an IP Clearinghouse (now the Trademark Clearinghouse) "in order to reduce the cost and administrative burden of protecting trademarks in the new gTLDs for all trademark owners – with a very few "trademark supernovas" which suffer extraordinarily high levels of infringement finding relief through the Globally Protected Marks List."

The IP Clearinghouse was designed "to function as a central entity with which all new gTLD registries and possibly registrars interact in relation to the Globally Protected Marks List and the Pre-Launch IP Claims Service also recommended by the IRT".

As the proposals developed over time, the original suite of protections recommended by the experts was so completely watered down that it fails to offer an effective rights protection solution, and in particular offers no effective alternative to registering domains defensively in the new gTLD platforms. The current Trademark Clearinghouse (TMCH) is merely a database, promoting the need for defensive registrations, and thus fails to address the original intentions behind the work on the overarching issues, ie to lessen the administrative and financial burden on trade mark owners. This situation was bad enough when it was anticipated that there would be in the region of 500 new gTLDs. In fact the actual number of gTLD applications was in excess of 1900 and somewhere in the region of 1400 strings seem likely to launch. Rights protection mechanisms, which may have been deemed adequate (by ICANN, if not by the brand owners) for 500 strings, are not adequate now that there has been a significantly higher take up.

The BBC welcomes the opportunity to support both the proposals to modify the existing Rights Protection Mechanisms (RPMs) as set out in the Strawman solution, and the proposal for Limited Preventative Registration (LPR). We believe that these measures provide some limited improvements to the rights protections for brand owners, and attendant benefits for consumers.

Strawman Model

1. Minimum 30 days advance notice of dates and sunrise requirements.

Sufficient advance notice is necessary to ensure that brand owners are informed about the requirements for a new gTLD launch and are capable of participating in any relevant Sunrise application period. As the owner of many trademarks, 30 days notice seems to us to be an absolute minimum in order to meet this goal. In addition, given the large number of gTLDs which will be launching over the coming months and years, it would be helpful if this



information were published in a centralized location, such as a dedicated part of the ICANN website.

2. Trademark Claims to last for at least the first 90 days.

We are supportive of extending the duration of the Trademark Claims period, and the proposed extension to 90 days is therefore an improvement, of which we are in favour. However, we do consider that the 90 day period is an arbitrary one, for which there is no real justification. The risk from brand-infringing domain name registrations is a permanent one, which does not end after 90 days, and therefore both brand owners and registrants would benefit from having such potential infringements drawn to their attention at any time after the launch of the new gTLD registry.

The Trademark Claim, in any event, does not act as a bar to registration, since the registrant is still able to continue with the application provided that they acknowledge the notice and confirm that they do not consider that their application will infringe the rights of the brand owner. The brand owner is also given no notice of the application until after registration, so there is no opportunity for the brand owner to use the Trademark Claims service as a means of blocking applications. The Trademark Claims service does however serve as a protection for the registrant who is unaware of the brand owner's rights, who may have selected a name in good faith but, on receiving the Trademark Claims notice, has an opportunity to reconsider their application and withdraw it if appropriate.

Extending the duration of the Trademark Claims service also extends the value of the TMCH. A great deal of work will be done by ICANN and the TMCH operators in developing and setting up the TMCH, but the value of any registrations recorded in it will drop off significantly once all the new gTLDs have launched if the Trademark Claims service operates only for a short finite period. In this case, it is likely that most brand owners would not go to the significant expense of renewing their marks in the TMCH beyond a couple of years.

3. Optional fee for a Claims 2 service.

As set out above, in our view Trademark Claims service should continue indefinitely for all marks. If this is not the case, then having the option to pay for an additional period beyond the initial 90 days may be of benefit to some brand owners. In order to be of value, however, the fee in question would need to be reasonable, and the applicant for the domain name should receive the same information about the trade mark as during the Claims 1 period, and be required to acknowledge in the same way. There seems little benefit either to the brand owner or the registrant in providing a lesser level of information.

4. Domains previously determined to have been abusively registered may be added to the TMCH record.

We are in favour of this proposal, which will help to meet the obligation that strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.

Limited Preventative Registration

Of all the proposals, the Limited Preventative Registration (LPR) is, in our view, the most beneficial, since this is the only quasi-preventative solution in that it provides a means by which brand owners might more effectively make defensive registrations within the new gTLDs. This is similar to the Sunrise solution offered to brand owners within the recently-launched .XXX Registry.

Like other brand owners, the BBC is the owner of a sizeable portfolio of domain registrations. These domain names include the name of the BBC's television and radio channels and other services, programme titles, characters, organisations and locations within programmes. The vast majority of these are purely defensive, with either no active site at all, or resolving to an informational message only, intended to assist the consumer to navigate to the correct active site. Inevitably, where we do not



register, third parties will do so, generally using the domains for pay per click sites but on a significant number of occasions for sites which purport to be genuine BBC sites such as fake BBC News websites, thereby impugning the BBC's reputation for impartiality, or which carry material that is inappropriate to the brand, a particular risk on sites relating to our Children's brands. This poses a real risk to the public, either that they will be misled by a fake site, believing it to be genuine, or that they or their children will inadvertently access offensive material. Inevitably, the public would expect to be protected from this, but even with the current number of gTLDs (and ccTLDs) the BBC, which is publicly funded, simply cannot afford to register every potential domain name, nor can it afford to bring UDRP actions except in the most damaging circumstances. This situation will only get worse once the new gTLDs launch.

Although the LPR proposal still requires the brand owner to make defensive registrations, there is some benefit to being able to secure a longer-term inactive registration, provided that the cost of such registrations is set at an appropriately low level, ie significantly lower than the cost of a standard registration within the relevant gTLD.

Susan Payne, Head of Brand Protection Lawyer, on behalf of BBC Worldwide Limited

Diane Hamer, Trade Mark Lawyer, on behalf of the British Broadcasting Corporation

