



January 15, 2013

To: ICANN (tmch-strawman@icann.org)

From: National Cable & Telecommunications Association

Re: New gTLDs Program – Comments on Proposed “Strawman Solution”

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The National Cable & Telecommunications Association (“NCTA”) appreciates the opportunity to submit the following comments on the “strawman” proposal to amend certain elements of the New gTLD Applicant Guidebook in order to address some of the concerns expressed by the Business Constituency and Intellectual Property Constituency concerning the Trademark Clearinghouse and other Rights Protection Mechanisms (“RPMs”).

### **Introductory Statement**

The [National Cable & Telecommunications Association](#) is the principal trade association representing the cable television industry in the United States. Its members include cable operators serving more than 90% of the nation’s cable television subscribers, more than 200 cable program networks, and suppliers of equipment and providers of services to the cable industry.

NCTA’s program network members have invested literally billions of dollars to establish and promote some of the best-known and most trusted brands nationally and internationally in cable programming and broadband content. Moreover, the cable operator members of NCTA are the nation’s largest providers of high-speed Internet access. From 1996 to 2012, the cable industry invested over \$200 billion in building out advanced hybrid fiber-coaxial cable (HFC) networks and other infrastructure.

Numerous products resulting from the efforts and investments by members of the cable industry provide the means by which the new gTLDs will operate. Accordingly, NCTA’s members have a special expertise that enables them to appreciate many of the issues that would be presented by ICANN’s New gTLD Program (the “Program”).

NCTA’s members also share the concerns of other trademark owners about the potential impact of the Program, as well as the potentially overwhelming efforts that will be required of them to police their marks in the new gTLDs. As a starting point, in order to employ the new Rights Protection Mechanisms, trademark owners will need to register their valuable marks with the Trademark Clearinghouse. Further, if experience with the limited number of gTLDs in existence to date provides any indication of what can be expected in the hundreds of expected new gTLDs,

trademark owners will face the choice of either expending significant resources and incurring substantial expenses to police their marks and take action against abusive registrations of second-level domains in the new gTLDs, or permitting the use of these domain names, which are likely to cause damage to the goodwill associated with their marks and to consumers who may be victimized by fraudulent activities conducted in association with these domain names.

## **I. Introduction**

NCTA and its members appreciate that ICANN continues to be receptive to the concerns of trademark owners. We are aware that some stakeholders object to any further consideration of the Rights Protection Mechanisms, on the ground that policies are being adopted outside the GNSO process. Such complaints ignore the fact that the instant request for comments is wholly consistent with the process described in Section 1.2.11 of the New gTLD Applicant Guidebook and the supporting materials. *See, e.g.*, “Change Review Process: gTLD Applicant Guidebook” <<http://archive.icann.org/en/topics/new-gtlds/change-review-applicant-guidebook-19sep11-en.pdf>>. Ultimately, the process will ensure that all interested stakeholders have the opportunity to provide their views before any decisions are made.

Moreover, there has been little progress made on implementing some aspects of the existing RPMs, notably the Uniform Rapid Suspension System (“URS”). The overall package of RPMs was premised on the URS being available at a cost of \$300-500. *See* <<http://newgtlds.icann.org/en/applicants/urs>>. To date, however, it appears that service providers are not willing to operate the service on the terms promised to the trademark community. *See* <<http://toronto45.icann.org/meetings/toronto2012/presentation-urs-naf-suggestions-18oct12-en.pdf>>. There is a need for an effective and low cost URS. For example, as NCTA has previously stated in its comments to ICANN on the Applicant Guidebook, the burden of proof on trademark owners in a URS proceeding is set extremely high. In addition, the provisions allowing a registrant that defaults to obtaining review of a decision are far too liberal. Moreover, the only remedy that is available under the URS, namely, suspension of the domain name until the registration expires, is no more than a temporary remedy. Absent these changes, it may be appropriate to consider yet additional remedies or solutions to address abusive domain name registrations.

## **II. NCTA Supports the Strawman Proposals**

Based on the summaries of the proposals, in principle and as a general matter, NCTA supports these proposals, as follows:

- All new gTLD operators would be required to give at least thirty days’ notice of the dates and requirements of their **Sunrise Launch** period. During the Sunrise Launch period, trademark owners will have the exclusive opportunity to register second level domain names that are identical to any of their marks that are registered with the Trademark Clearinghouse. The duration of the claims period would still be thirty days, but it would

be preceded by the thirty day notice period. Adoption of this proposal would provide some breathing room for trademark owners and enable them to proceed on a more considered and orderly basis. **NCTA supports this change.**

- The **Trademark Claims** period for each new gTLD would be extended to ninety days from the launch of the registry, rather than the current sixty days. During this period, applicants for a second level domain name that is identical to a mark in the Trademark Clearinghouse will be given notice that there is the potential for a claim by the trademark holder and that the application can be withdrawn. The applicant will need to acknowledge receipt of the notice. If the domain name is registered, the trademark owner will then receive notice of the registration and will have the opportunity to bring a claim. In addition, a new **Claims 2 service** would be created that, during a 6-12 month period and for an additional fee, will result in a notice to such applicants that the applied-for second level domain matches a mark in the Trademark Clearinghouse and provide them with other generic information, but will not require any response. NCTA hopes that extending the Trademark Claims period and providing additional applicants with information concerning potential disputes will reduce the number of actual disputes. In its previous comments on the various proposals for the New gTLD Handbook, NCTA has taken the position and continues to believe that participation in the Trademark Claims service should be made permanent for each new gTLD registry. The current proposals are more limited in scope, but **NCTA supports these changes.**
- Second level domains that have been determined to be abusive as the result of a UDRP or court proceeding would be eligible to be added to the **Trademark Clearinghouse**, up to a maximum of 50 per trademark. NCTA has previously supported and continues to support the position that the Trademark Clearinghouse should include not just word marks, exactly as registered, but also “exact + goods/services/other generic words.” **NCTA supports this proposal**, but it is too limited. If, for example, the domain name TRADEMARKstore.tld has been found to be abusive, at a minimum, TRADEMARK-store.tld, TRADEMARKstores.tld and TRADEMARK-stores.tld should be eligible to be added to the Trademark Clearinghouse. In addition, if a particular trademark owner has the misfortune of being a common target for abusive registrations of variations on its mark or marks, it should be able obtain protection through the Trademark Clearinghouse for all of those second level domains in all the new gTLDs through a streamlined and cost-sensitive procedure.

### **III. NCTA Supports the Limited Preventive Registration Mechanism Proposal**

In addition to the proposals summarized above, ICANN has asked for comments on a Limited Preventive Registration Mechanism. Under the LPR, unless another trademark owner with a mark registered in the Trademark Clearinghouse has registered the corresponding domain name during a new gTLD Sunrise period, trademark owners could block for a set period of time the registration of second-level domain names that match their marks, across all registries, without

having to register the domain name themselves, upon payment of a reasonable fee, with appropriate safeguards for registrants with a legitimate right or interest in the domain name. Significantly, however, this proposal perpetuates the approach that trademark owners must bear the burden and expense of policing and NCTA believes that it is fairer to shift some of these costs to other stakeholders. That said, **NCTA supports the proposal for a Limited Preventive Registration Mechanism.**

### **Conclusion**

NCTA and its members appreciate the opportunity to provide their comments to ICANN on the proposals discussed above. We view ICANN as having taken a positive step towards providing trademark owners with reasonable options and are supportive of the aforementioned efforts that would make the menu of available Rights Protection Mechanisms more effective while balancing the interests of the various affected constituencies. NCTA would also be supportive of further steps by ICANN toward enhancing Rights Protection Mechanisms to the benefit of the trademark owning community.

Respectfully submitted,

**/s/ Jill Luckett**

Senior Vice President, Program Network Policy  
National Cable & Telecommunications Association  
25 Massachusetts Avenue, N.W.  
Suite 100  
Washington, D.C. 20001-1431  
www.ncta.com

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Counsel:

Mitchell H. Stabbe  
Edwards Wildman Palmer LLP  
1255-23rd Street, N.W. Eighth Floor  
Washington, D.C. 20037  
(202) 478-7378 (p)  
(866) 320-9766 (f)  
www.edwardswildman.com  
mstabbe@edwardswildman.com