



Comments of ECTA, the European Community Trade Marks Association and MARQUES, the Association of European Trade Mark Owners on “April 2011 Discussion Draft of the New gTLD Applicant Guidebook”.

15 May 2011

Introduction

The purpose of this document is to thank ICANN for the newly drafted clauses that help tackling Rights Protection issues in the new gTLD program.

About ECTA and MARQUES

MARQUES is the Association of European Trade Mark Owners representing the interests of brand owners worldwide in the protection and utilization of trademarks as essential elements of commerce. Its current membership of trade mark owners and trade mark and design law practitioners is in excess of 750 members in 84 countries. Membership crosses all industry lines. MARQUES' industry members together own more than two million domain names (a conservative estimate). These domain names are relied upon by consumers across Europe as signposts of genuine goods and services.

ECTA is the European Communities Trade Mark Association. ECTA numbers approximately 1500 members, coming from all 27 Member States of the European Union, with associate members from all over the world. It brings together all those persons practising professionally in the Member States of the European Community in the field of trade marks, designs and related IP matters.

Comments

In order for the proposed Rights Protection Measures to remain effective, the implementation of them is as important as the measures themselves. Accordingly, we would like to address ICANN with a few additional comments.

Clearinghouse & IP Claims

Both systems are important for brand owners. Implementation of both is central, nevertheless the costs related to the Clearinghouse need to be reasonable in order to remain an effective tool.



Uniform Rapid Suspension

This mechanism must be rapid per se, and ICANN is proposing a more acceptable solution in our view. If the URS is not a cheap, quick alternative, brand owners will probably be forced into expensive defensive registrations of domains.

With the aim of making a truly effective mechanism to remove and/or recover domain names that infringe one's trademark in a blatant way, we would like the mechanism to include the option of transfer of domain name. There must be an incentive in using this system, especially if the URS is uncontested and the trademark owner will like to close the matter" by recovering the domain if so wished. The "Loser Pays" model is definitively welcome and we would have liked the model to be more widely available.

Use Requirement

The requirement of use is an additional evidence measure on the trademark owner. It must not become a deterrent measure for newly registered marks which are not in use yet. This is in favour of all kind of enterprises, including small companies with less means. We would welcome a date being set later than 2008.

Co-existence

The Draft Applicant Guidebook 6 does not take into account either co-existence agreements or natural co-existence. Currently a successful application from NBC in round one would preclude ABC or BBC or NBA in future years. Equally, should both EMI, the music company and ENI, the energy company apply, they would be placed in a Contention Set and could in theory face each other in an auction. In the real world these companies co-exist. There should be a mechanism so that trade mark owners that co-exist in the real world without causing consumers any confusion can co-exist at the top level of the domain name system.

County codes at the second level

ICANN proposes prohibiting the registration of country names at the second level. This means that an applicant for a "Dot Brand" domain could not, in its own registry, have us.mycompany, uk.mycompany etc. This prohibition severely limits brand owners unnecessarily. On the contrary a .brand domain should provide clients with an intuitive replacement for ccTLDs. It would seem to be more logical if Internet users could replace www.mycompany.de with www.de.mycompany rather than having to type www.mycompany/de.



The rationale for ICANN's country requirement is not clear. As there is no prohibition on the creation of folders (for example www.budweiser/uk) this is an artificial restriction that should be lifted.

The voice of other experts in the intellectual property world

ECTA and MARQUES would again encourage ICANN to take serious account of the very detailed comments either already submitted, or shortly to be submitted, by the Intellectual Property Constituency and WIPO on this particular public comment. More generally, both MARQUES and ECTA consider that far greater weight should be given to the view's of WIPO as the leading non-profit, intra-governmental organisation with extensive experience in resolving IP disputes in the domain name space and wider.

Finally we wish to raise once more the question as to whether it would not be better if ICANN postponed implementation of gTLDs until all rights protection issues have been satisfactorily addressed.

Conclusion

Again as mentioned in our previous comments and above, we believe that it is paramount that the processes that ICANN sets be both practical and capable of implementation in order to make the process fully reliable.

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