

Public Administrations Program (“PAP”)

The Comunidad de Madrid (the Government of the Region of Madrid), Registry Operator for the .madrid TLD, welcomes all the comments received on its Public Administration Launch Program (“PAP”). As a general remark we would like to stress that all these comments refer to geographic names and public services in abstract and isolation, that is, across any TLD. The Registry Operator is convinced that domain names like *madrid.com* or *policia.com* are quite different than names like *gobierno.madrid* and *policia.madrid*. The responses and observations below are based upon this premise and exclusively refer and are limited to (i) the meaning of .madrid names as *whole string*, thus including the .madrid TLD, and (ii) their likelihood of confusing the general public in the Region of Madrid. Hence the following comments do not claim any general right applicable to any TLD.

| COMMENT | SUPPORTED BY | .Madrid Registry Operator’s Response |
|---|---|--|
| <p>Numerical element.</p> <p>Despite the references to the Spanish administrative law in defining the categories of Public Authorities and Public Services, the PAP’s number of eligible names is too high. This would nullify the intent of the Qualified Launch Program to limit registration of non-right holders (including Public Administrations) to 100 domain names</p> | <p>IPC, p. 3 and 4 MARQUES, p. 2, 3 INTA, p. 1 GNSO//CSC//BC, p.1</p> | <ul style="list-style-type: none">• The PAP was submitted pursuant to Section 4.5.2 of the TMCH Requirements, not pursuant to Section 5.4.1. It is thus independent from the Qualified Launch Program under Section 4.5.1 of the TMCH Requirements (Pioneer Program) that the Comunidad de Madrid intends to conduct, as both programs have a completely different purpose. They are structurally and functionally different.• Specifically, while the aim of the Qualified Launch Program (“QLP”) under Section 4.5.1 of the TMCH Requirements is the promotion of the registry services at its launch, the purpose of launch programs (and of this PAP) is the protection of legitimate rights. Because of the nature and purpose of the QLP, which is the promotion of the registry services at launch, the .madrid QLP will entitle the registration of not only |

| | | |
|--|--|---|
| | | <p>public administration names but also trademark names.</p> <ul style="list-style-type: none"> • As a result, the limitation of 100 names does not apply to Section 4.5.2 of the TMCH Requirements. ICANN has never limited the number of names *with prior rights*, which may be registered with priority over Sunrise eligible names under an ALP previously approved by ICANN. On the contrary, the mere fact that the TMCH Requirements foresee the possibility to submit applications like this one to ICANN's approval supports the contrary position. • Limiting the number of eligible registrations to 100 names seems totally arbitrary and unjustified. In fact, restricting the number of names here would be as unreasonable as restricting the number of trademarks that could be registered during the Sunrise Period because "there are too many trademarks" or not allowing the registration of the names of one of the municipalities of the Region of Madrid because the application is number 101. • The above said, we do not expect thousands of applications under the PAP, for the following reasons: <ul style="list-style-type: none"> ○ Public Authorities' decision mechanisms are rather slow, and the program is limited to 70 days; ○ Most Public Authorities still mostly operate in the off-line environment. |
|--|--|---|

| | | |
|---|--|---|
| | | But as a matter of principle we cannot and should not discriminate against eligible Public Authorities. |
| <p>Not identical matches (clear variations and abbreviations) should be allowed.</p> <p>PAP circumvents ICANN's explicit rejection of the ability of Public Authorities to register domain names that are not identical matches to the Public Authority's name or acronym. Thus, "clear variations" and "abbreviations" should not be accepted.</p> | <p>IPC, p. 4 MARQUES, p.2 GNSO//CSC//BC, p.2</p> | <ul style="list-style-type: none"> • Trademarks need a sort of adaptation to be included in the TMCH and converted into a domain name: for example, the graphic element in figurative (word-graphic) trademarks disappears when submitted to the TMCH. See Section 5.2.2. of the TMCH Guidelines (re. marks that does not exclusively consist of letters, words, numerals, special characters). • For the same reason that trademarks need a normalization process to enter into the TMCH, a minimum adaptation is also required with respect to Public Authority names eligible under Public Administration program. For example, many of the names eligible under this PAP include a generic term, which when considered together with the .madrid string is either generic or redundant: For example: <ul style="list-style-type: none"> ○ While the name of the .madrid Registry Operator is "Comunidad de Madrid", it would be desirable that they could register Comunidad.madrid (instead of comunidademadrid.madrid); ○ While the official name of the municipality of Móstoles is "Ayuntamiento de Móstoles", |

| | | |
|---|--|--|
| | | <p>(ayuntamiento meaning city hall) it would be desirable that they could register mostoles.madrid (instead of ayuntamientodemostoles.madrid).</p> <ul style="list-style-type: none"> • Please note that “clear variations” and “abbreviations” would not include fantasy names, but only variations commonly used in day to day life by the community of the Region of Madrid to refer to relevant Public Authorities, which may or may not match the complete legal name. |
| <p>Further restrictions to transfers. PAP .madrid domains should not be transferred to third parties since, “although the PAP proposes that such transfers would only occur to (i) another eligible Public Authority or (ii) in the event of a sale of all or substantially all of the assets of the registrant, there is no restriction in the proposal that any such receiving party must have taken on the responsibility for the operation of the relevant public authority activity...”.</p> | <p>IPC, p.4 MARQUES, p.3 INTA, 2</p> | <ul style="list-style-type: none"> • The level of restrictions in this regard will be part of the Launch-Phase specific part of the registration policy. |
| <p>Further restrictions to transfers (II) In addition, IPC argues that for the transfer to be allowed the domain name should still match the receiving body’s name or acronym.</p> | <p>IPC, p.4</p> | <ul style="list-style-type: none"> • This further restriction does not seem justified as, for example, it is the own Government of Madrid through its “Consejería de Interior” the Public Authority in charge of the police service. In other words, imposing this requirements would be as unfounded as requiring that the trademark matches the name of the entity holding it. |

| | | |
|--|------------------------|--|
| | | <ul style="list-style-type: none"> Note that only IPC has made this request. For MARQUES, for example, it would suffice that “the terms is still the most appropriate naming match for the new operational activity” (see MARQUES, p. 3) |
| The PAP is unnecessary , as evidenced by other new gTLDs Registry Operators which have used LRPs and QLPs to accomplish the same goals (e.g. .nyc, .melbourne, .sydney). | IPC, p.5 INTA, p. 3 | <ul style="list-style-type: none"> The .madrid Registry Operator .madrid cannot and should not discuss the legal, policy and operational requirements of other countries and/or TLDs. The .madrid Registry Operator can only speak about the legal and policy requirements relating to its own TLD. Notwithstanding the above, it must be noted that other ALPs have been requested and have not been decided by ICANN in either way due to time constraints on the Registry side. |
| Other arguments: There is trademark protection for Public Authorities. “The assertion that there is no trademark protection for “the relevant Public Authorities” is incorrect’.” | IPC, p.4 INTA, p.2 | <ul style="list-style-type: none"> This is a question of Spanish Law that we believe should not be discussed in this forum. However, we must clarify that the Registry Operator has never made such a categorical assertion. On the contrary, in the PAP applications we explained that “trademark registration is either unavailable or inadequate to protect these names for the relevant Public Authorities in relation to the goods or services within its primary meaning (for which they are the non-distinctive)”. INTA acknowledges that “trademark protection is not available for a term for those goods/services for which it is generic”. |

| | | |
|--|------------|--|
| | | <ul style="list-style-type: none"> • In fact, even in the limited number of cases where names of public authorities and public services could be protected as trademarks, as a matter of fact, Public Authorities have not considered it necessary to seek trademark protection to peacefully continue using these names. A reason for this has to do with the purpose of the trademark system and how public administrations perceive this system. Trademark law serves to identify and protect the reputation of products and services in the marketplace. However, many Public Authorities do not see themselves as “providing products or services in the marketplace” or as participating in commercial activity. Thus, they may have never considered trademark protection as appropriate or needed. The .madrid TLD is certainly not limited to commercial uses. • Precisely the tourism activity mentioned by INTA on p.2 is considered a commercial activity, which is the exception to this principle. |
| <p>If a third party had attempted to register as a trademark an expression matching the name of a Spanish public authority the Spanish PTO would have expected to reject the application pursuant to the absolute prohibition on the registration of signs which may mislead consumers or are contrary to law or public policy, as laid down in article 5 of the Trademark Act of Spain.</p> | INTA, p. 3 | <ul style="list-style-type: none"> • This is a debatable question of Spanish Law that we believe should not be discussed in this forum. • It must be noted that due to the principle of specialty, signs which in the off line world may not lead to confusion, in the online world, and in conjunction with a string like .madrid, may well vary their meaning (e.g. taxi.madrid, metro.madrid). |

| | | |
|--|--|--|
| | | <ul style="list-style-type: none"> • But even more relevant: the prohibition affects word (nominative) trademarks. Figurative (“word with graphic”) trademarks may circumvent the absolute prohibition, as the graphical element serves the distinction purposes for avoiding confusion. But the TMCH only can take into account the textual elements of figurative trademarks (as it could not be otherwise). This effectively circumvents for this specific purpose the intent of the referred norm. Two of the many examples of figurative trademarks in the Spanish Patent and Trademark Office that would be granted the “madrid” label in the TMCH if they applied for are: <ul style="list-style-type: none"> • http://sitadex.oepm.es/SitadexWS/index.jsp?numExp=M2988041 • http://sitadex.oepm.es/SitadexWS/index.jsp?numExp=M2988041 |
|--|--|--|

Parallel TMCH/Local Trademark Sunrise Launch Program (“PSP”)

| COMMENT | SUPPORTED BY | .Madrid Registry Operator’s Response |
|--|---------------------|--|
| <p>The argument that the RPM Requirements discriminated against Local Trademark is incorrect as the priority granted to TMCH-validated trademark registrations is not a right, but a benefit associated with TMCH validation.</p> | <p>INTA, p. 3-4</p> | <ul style="list-style-type: none"> • We are not quite sure about the practical difference between right and benefit in this precise context. Here we are dealing with relative priorities (not about absolute rights). It is clear that giving priority to some trademarks over some others leads to an effective discrimination of the effective trademark rights of some trademarks over some other. • In any event, precisely because the TMCH mechanism is not meant to alter any IP rights, the Comunidad de Madrid (the Government of the Region of Madrid), as a public organism, cannot discriminate against any valid trademark in Spain, even when it has not been submitted to the TMCH. • This PSP ensures that a Spanish TMCH trademark-GI holder will never see a .madrid domain registered in favor of a Spanish trademark-GI, which has not previously been (re)validated in the TMCH. This is so because in case of contention, the trademark-GI holder will be *required* to revalidate the trademark |

| | | |
|--|-------------------|--|
| | | through the standard TMCH procedure. |
| <p>The citation to a quote from ICANNs CEO during the Beijing Public Forum does not apply as it predates by 5 month the final RPM Requirements, which specifically reject alternative clearinghouses.</p> | <p>INTA, p. 4</p> | <ul style="list-style-type: none"> What ICANN's CEO and legal counsel sustained is that there may be *additional* right protection mechanisms. This is also supported by the Guidebook and its preparatory documentation, as well as by Specification 7 of the TLD Agreement. <p>Specifically, paragraph 2.4.1 of the TMCH RPM Requirements state that a Registry Operator must not allocate or register domain names during or in connection with the Sunrise Period except to holders of a validated trademark recorded in the TMCH. In other words, TMCH trademarks have priority over the general public without priority rights. The goal intended by the process leading to the TMCH: protecting legitimate right holders against competing registrations from non-right holders (the "general public"). But Specification 7 of the TLD Agreement allows the registry operator to implement *additional* right protection mechanisms. A holder of a valid Spanish trademark has a clear, objective and undeniable prior right regarding its use as a legitimate .madrid domain-name which cannot be characterized as either "general public" nor "inferior right" with regard to TMCH-validated trademarks in this very concrete context (while it certainly</p> |

| | | |
|---|-----------|--|
| | | <p>makes sense to limit protection to non-TMCH validated trademarks in global, non-geographically oriented TLDs as validation of such rights in any jurisdiction is unfeasible in practice without a tool such as the TMCH, and this is why it was created).</p> <p>Thus, this PSP meets all the requirements of the Guidebook, Specification 7 of the Registry Agreement and the TMCH Requirements, as it expands the rights-protection mechanisms set forth there while fully respecting the minimum requirements established there (and not restricting them in any way).</p> <ul style="list-style-type: none"> • What was clearly agreed was that ICANN would only appoint one clearinghouse for the global validation, with the purpose of simplifying and lowering the cost of the process aimed at obtaining global sunrise protection (and other ancillary services such as the Claims services). As said, this does not exclude the possibility to add further trademarks or other rights additional protection mechanisms. |
| <p>The PSP is a redundant mechanism. The PSP is redundant as all four rights to which it affects can be validated through the TMCH recordal.</p> | IPC, p. 2 | <ul style="list-style-type: none"> • The PSP is not redundant because it takes into account valid rights under Spanish Law, which otherwise would be discriminated for the mere fact of not being in the TMCH. |

| | | |
|---|--|---|
| <p>The PSP is unnecessary.</p> <p>1) There is no good reason for the holder of a Spanish trademark or eligible Spanish GI to prefer validation through the Parallel Sunrise Program rather than through the TMCH. The PSP would disadvantage the local non-TMCH trademark holder further, as they will need to bear the costs of validation twice.</p> | <p>IPC, p. 3 MARQUES, p.4 INTA, p. 4</p> | <ul style="list-style-type: none"> • This may be possible; this is why the Registry Operator is committed to inform potential applicants in about the TMCH option (both in general when promoting the TLD, and each individual applicant in according to this PSP). • Without prejudice to this, since the reality is that an overwhelming majority of Spanish trademark owners have not registered their trademarks at the TMCH yet, the .madrid Registry Operator must offer this possibility to avoid discrimination. • In addition, if it is true that in practice for the holder of a Spanish trademark or eligible Spanish GI there is no good reason to prefer validation through the PSP rather than through the TMCH, then what is the fear? • The PSP we propose only makes sense for an individual TLD with a clearly marked geographic area of reference like .madrid. The PSP is not meant to be a parallel validation mechanisms across any TLDs, or for geographically-indifferent TLDs. |
| <p>2) The Registry Operator could achieve the desired result simply by restricting Sunrise eligiility to TMCH-validated registrations with effect in Spain, and then providing an additional</p> | <p>GNSO//CSC//BC, p.2 INTA, p. 4</p> | <ul style="list-style-type: none"> • This is just an opinion. In ours, this would be treating different and inferiorly trademarks with the same legal value in Spain for no good reason (as the TMCH-validated trademark rights and benefits would be fully |

| | | |
|--|--|---|
| registration period (subservient to the Sunrise) for registrations not validated by the TMCH. | | preserved) and without this being required by ICANN. |
| The PSP conflicts with the TMCH requirements section 2.4.1, which prohibits allocating names during sunrise except pursuant to a TMCH-issued SMD file. | IPC, p. 2 MARQUES, p. 4 eBrand Services, p.2 GNSO//CSC//BC, p.1 INTA, p. 4 | <ul style="list-style-type: none"> It is true Section 2.4.1 of the TMCH Requirements prohibits allocating names during sunrise except pursuant to a TMCH-issued SMD file, except in the exceptions referred to in 4.5.1, 4.5.2. and 4.5.3. |
| The PSP creates potential inefficiency. The PSP leads to a splintering of sunrise rights protection procedures in new gTLDs, which is what the TMCH was meant to avoid. | IPC, p. 3 | <ul style="list-style-type: none"> The PSP fully preserves the value of the Sunrise and simply adds further protection for other valid rights, which otherwise would have less priority; and all this without jeopardizing. The Sunrise provides protection against registrations from the non-rights holding general public, not among right holders. |
| The PSP would lead to an unfair treatment of the holders of trademarks recorded in the TMCH. | MARQUES, p. 5 | <ul style="list-style-type: none"> We respectfully disagree. Once again, the PSP fully preserves the priority of trademark rights registered at the TMCH. We must insist that, in practice, this PSP ensures that a Spanish TMCH trademark-GI holder will never see a .madrid domain registered in favor of a Spanish trademark-GI, which has not previously been (re)validated in the TMCH. This is so because in case of contention, trademark-GI holder will be <i>*required*</i> to validate the trademark through the standard TMCH procedure. Thus we fail to see where trademark holder's interest are worsened by our proposal. |

| | | |
|---|-----------------------------------|--|
| | | <ul style="list-style-type: none"> • The TMCH grants priority (and priority is fully preserved by this PAP) over general public, not exclusivity. This is clear as there may be, for example, more than one identical trademark in the TMCH. If somebody has created confusion about this, thus creating false expectations in the market, this is not .madrid Registry Operator's responsibility. • The starting point for the discussions about RPMs was, and had to be: ICANN will not create a different class of trademarks, or discriminate among trademarks. This was, is, and we hope will remain the consensus. |
| <p>TMCH Awareness.</p> <p>There is no lack of awareness of the TMCH in the Madrid geographical area. There are 2 TMCH agents in Spain.</p> | eBrand Services, p.1 INTA, p.4 | <ul style="list-style-type: none"> • The .madrid Registry Operator would wish this is true. But the reality is that a trademark is a trademark and that most trademark holders in Spain are either unaware of the TMCH or for some reason have not decided to use the TMCH. In practice, those who register their trademark at the TMCH do so because they are interested in at least more than one TLD. We simply refer to the statistics. • The .madrid Registry Operator hereby restates its commitment to promote the benefits of the global protection provided by the TMCH, while at the same time |

| | | |
|--|--|---|
| | | guaranteeing the protection of all trademarks and GIs against abusive registration by non-entitled third parties. |
|--|--|---|