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VIA EMAIL: gtld-guide@icann.org
Internet Corporation for Assigned Names and Numbers
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RE: Comments to Draft Applicant Guidebook

Dear ICANN:

Greenberg Traurig, LLP on behalf of undisclosed client A, submits the following comments on the "Draft Applicant Guidebook" materials (the "Guidebook") released by ICANN with regard to the launch of new generic Top Level Domains (gTLDs):

1. Consent to Co-Existence. The determination of whether or not two strings are in contention has been assigned to String Similarity Examiners ("SSE") who have been charged with the difficult task of determining, without the taking of evidence and perhaps without even familiarity with the market sectors, intellectual property rights, or communities involved, whether or not two strings are "so similar that they would create a probability of user confusion if allowed to coexist." As currently written, the Guidebook results in a scenario where there must be a loser: either (a) an applicant who withdraws its application because it is not in a financial position to compete successfully in an auction process and desires to recover some fraction of its application fee; (b) an applicant whose applicant is "trumped" by a community application in the contention set prior to auction; or (c) an applicant who participates in, and loses under, the auction mechanism.

These are unfortunate "win/lose" outcomes, especially if the parties, who have involuntarily become adversaries in the "win/lose" scenario, agree with each other that there is no real likelihood of confusion given the differences between the strings or other factors such as the long standing co-existence of two brands around the world or the nature of the TLD, e.g. community or single enterprise open TLDs.
In order to alleviate these unnecessarily harsh outcomes, the string contention process should include the possibility of parties who are in string contention with each other within a particular contention set to "consent" to the co-existence of the two top level strings if the contending parties, who may more fully understand the true comparison factors, believe that there is little or no likelihood of confusion should the two strings co-exist. ICANN would not be alone in adopting such a model. Many trademark offices throughout the world have adopted such models, allowing the co-existence of marks on

their respective registries through consent of the parties, even in cases where an examiner has objected to an application for a mark on relative grounds citing the prior right.

Further, consent to co-existence should be allowed at anytime during a dispute process as a means of resolving an objection based upon prior rights. It is entirely conceivable that an objector, who is also an applicant, will file an objection based on prior rights against any string which is even remotely similar in the hopes of knocking the string(s) out of any possible contention set, real or imagined, in order to reduce the chance of a loss of their own application due to a "community application trump" or an auction process against a better funded applicant. The way the Guidebook is currently drafted will likely increase the number of strings that are subject to an objection process. By allowing consent to co-existence as a means of resolution, even after an expert panel decision, ICANN creates a thoughtful means of discussing the dispute and arriving to a solution which allows both parties to "win." The approach reflected in the current version of the Guidebook bogs the process down in unneeded objection processes and increases the likelihood of wasteful litigation.

2. Single Applicants in Contention Sets.

The Guidebook hints, but is not clear that a single applicant with multiple applications for related strings, will not be the subject of a contention set in which its own applications are in contention with each other. The Staff should clarify the Guidebook in a manner that explicitly allows for an applicant to express a "family of marks" in the DNS. Otherwise, an applicant which does not have limitless resources to pay multiple application fees under a risk that the fees, or a fraction thereof, will be lost due to withdrawal forced by its various strings being placed into contention with each other, must limit its application to a single TLD comprised of a root mark. Yet, given the lack of concrete guidance over whether or not a particular root mark will be confusingly similar to another mark in the "family" of marks, the practical limitation forcing the filing of a single root mark leaves the others in the family exposed to application by third parties, who may or may not have any prior trademark rights in such strings.

A mechanism by which a rights holder could apply for a string consisting of a root mark and other marks in the family, without fear of all of the applications being placed in string contention with each other, serves the triune purposes of (1) protecting a family of marks in the new strings against abusive applications; (2) providing certainty to the applicant that its application fees will not be wasted should it apply for all strings necessary to express its family of marks; and (3) enhances ICANN operating revenue due to multiple applications from single, financially stable and technologically sophisticated sources, most of whom will not operate the strings with controversial registry services of

industry content in mind, thus reducing ICANN's costs in evaluating the strings. In other words, groups of applications from a single entity for strings consisting of a family of marks which will not be in string contention with each other will be high margin applications for ICANN.

Of course, Staff may be concerned that end users may encounter confusion in the market place should the applicant attempt to sell off parts of the "family of strings" at some point in the future. Given the nature of trademarks and the basic policy underlying them, namely that trademarks should be used to reduce the likelihood of consumer confusion, not enhance it, it would be highly unlikely that any string family holder would assign part of its family of marks and therefore, part of its strings. Even so, it would be entirely reasonable for ICANN to require that the single applicant registries, which operate strings which would otherwise be in contention with each other, to agree that such registries be "bundled" in a manner prohibiting acquisitions by third parties without acquisition of the entire family of registries. This would eliminate the likelihood of downstream confusion between the strings and is consistent with the practical realities of the assignment of trademark portfolios consisting of "families of marks." The "family of marks" exception to String Contention would only apply to applicants who can evidence:

a. a family of marks prior to the filing date of the applications through the existence of trademark registrations or evidence of common law use consisting of a common element, (e.g. .STUDEBAKER, .STUDEBAKERCHAMPION, .STUDEBAKERPRESIDENT, .STUDEBAKERSCOTSMAN, etc.); and/or

b. a single trademark registration consisting of a single element but whose specification of goods and services gives rise to the corresponding generic elements of the string(s) (e.g. .STUDEBAKER; .STUDEBAKER[AUTOMOBILES], STUDEBAKER[CARS], etc.); and/or

c. a root mark and a secondary mark used in conjunction with each other (e.g. .STUDEBAKER, .STUDEBAKERPACKARD).

3. **DNS Wildcarding on for Uninstantiated Domain Names in Single Enterprise Top Level Domain Name Registries**

ICANN should determine in advance of the filing deadline whether or not a single enterprise top level domain name ("seTLD") registry may employ DNS wildcarding on for uninstantiated domain names. For purposes of this comment, seTLDs are defined as open gTLD's whose strings in the top level consist primarily of the brand of the applicant. seTLDs will be heavily restricted and will not accept registrations from the

general public nor provide any registry services to the general public. No party, except the seTLD registry and those business entities related to such registry within a "family of companies" will have email addresses incorporation the seTLD. An seTLD will have less than 5,000 domain names registered in the second level at any point during the life of the registry agreement.

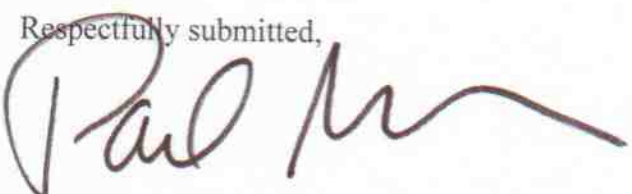
The obvious benefit to the seTLD registry will be increased direct navigation traffic as more consumers who are looking for the goods and services of the seTLD are routed to a live page rather than an error page.

We understand that, historically, when other larger registries have attempted to employ DNS wildcarding, they have met with resistance from ICANN and the Internet community. We understand that ICANN reacted negatively at least in part due to the unintended consequences related to the privacy of electronic mail associated with addresses which contained references to those particular top level domain names. Unlike prior efforts of larger registrars, there are no such privacy concerns for the reasons noted above.

The SSAC report reacting to prior registry DNS wildcarding efforts service does acknowledge that such DNS Wildcarding is "used in top-level domains that are generally small and well-organized." We believe that seTLDs should fall within the exception suggested in the SSAC report and that the Guidebook should be amended to reflect the same. seTLDs which wish to take advantage of DNS Wildcarding should be prepared to have their registry contract reflect some of the limitations noted above.

GREENBERG TRAURIG, LLP

Respectfully submitted,



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