

COA Comments on IRT Draft Report

The Coalition for Online Accountability (COA) appreciates the opportunity to comment on the draft report of the Implementation Recommendation Team (IRT) regarding trademark issues in the new gTLD process. See <http://www.icann.org/en/topics/new-gtlds/irt-draft-report-trademark-protection-24apr09-en.pdf>.

COA consists of nine leading copyright industry companies, trade associations and member organizations of copyright owners. These are the American Society of Composers, Authors and Publishers (ASCAP); the Business Software Alliance (BSA); Broadcast Music, Inc. (BMI); the Entertainment Software Association (ESA); the Motion Picture Association of America (MPAA); the Recording Industry Association of America (RIAA); the Software and Information Industry Association (SIIA); Time Warner Inc.; and the Walt Disney Company. COA is a member of the Intellectual Property Constituency of ICANN's Generic Names Supporting Organization (GNSO). COA and its participants have engaged actively in many aspects of ICANN's work since the inception of the organization, and has commented extensively on the new gTLD process.

COA commends ICANN for convening the IRT, and thanks the members of the team for their hard work in preparing the draft report on an extremely challenging deadline. We believe the draft IRT report is an important step forward in addressing the trademark protection problems posed by the new gTLD process, as spelled out in the first two versions of the Draft Applicant Guidebook. While there are still many unanswered questions and matters requiring clarification, overall the framework proposed by the IRT in the draft report is a positive one.

In particular, COA wishes to stress its support in principle for three key elements of the draft IRT report:

1. Globally protected marks list. In its comments on DAG version 1, COA stressed that "ICANN could and must do much more to encourage, or even to require, new TLD applicants to put on the shelf at least some set of globally recognized brands and trademarks whose registration by anyone other than their owner (or a third party with the owner's non-objection) would present an unacceptable risk to the public." The IRT's proposal to develop a global protected marks list (GPML) is a major step in that direction. Under this proposal, registration at the second level in a new gTLD of a domain name identical to a brand appearing on a restricted and highly qualified list of globally recognized marks would be "initially blocked"; registration could proceed only if the would-be registrant could demonstrate to an independent third party that the registration would not infringe the legal rights of the GPM owner. We also assume that registration would be allowed with the consent or non-objection of the mark owner. While this and many other details remain to be spelled out, COA supports the concept of using a GPML to restrict second-level domain registrations in all new gTLDs. It is also critical to ensure that the criteria for inclusion on the GPML are appropriately but not excessively strict; COA urges that the particular criteria suggested by the IRT be further reviewed.

2. Greater uniformity of pre-launch rights protection mechanisms. COA is gratified that the IRT recommends the formation of a single IP clearinghouse upon which all new gTLDs will draw in administering their pre-launch rights protection mechanisms, including "IP claims

services” and “sunrise periods.” This closely resembles the “common authoritative repository” for which COA advocated in its comments on DAG v.1. COA believes that ICANN should go further toward promoting greater consistency among pre-launch RPMs, although we recognize, as the IRT draft report states, that “there is no universal RPM that can be imposed.” In particular, ICANN should require all new gTLD registries to participate in a common portal through which their various pre-launch RPM mechanisms can be invoked. The IRT should also strive for greater clarity in its final report about how the proposed pre-launch RPMs of new gTLD applicants should be evaluated by ICANN, applying the criterion that the applicant must “demonstrate that its selected RPM meets or exceeds the minimum protections described herein.” Finally, the IP clearinghouse should be designed to minimize costs to right holders participating in it; new gTLD applicants, and ICANN itself, should be primarily responsible for funding this mechanism to mitigate the adverse impact of the new gTLD process on non-applicants.

3. Thick Whois. COA strongly supports the recommendation in the IRT draft report that all new gTLDs provide a “thick Whois” service to the public. This restores the status quo that has prevailed in nearly all new gTLDs previously recognized by ICANN. It will, of course, have a beneficial impact far beyond the area of trademark protection, since a wide range of government agencies, consumer organizations, copyright owners, anti-fraud and anti-spam investigators, parents, consumers, and members of the general public rely upon public access to as robust a Whois database as possible. It is also worth noting the procedure adopted by ICANN more than a year ago – but not yet invoked by any gTLD registry or registrar – in case of perceived conflicts between contractual Whois obligations and local privacy laws. Finally, COA commends the draft report’s support for a centralized, cross-TLD authoritative and public accessible Whois service, a long-standing but long-neglected ICANN goal whose revitalization is long overdue.

COA also notes with approval the draft report’s discussion of a uniform rapid suspension system, and looks forward to learning more about the details of the URS’s operation, including a balanced method to discourage both frivolous claims and unsupported answers. With regard to the proposed new post-delegation dispute mechanism, more detail is also needed. COA believes that it is essential that the contracts between ICANN and the new gTLD registries clearly spell out what is required of the latter, and that these contractual obligations be rigorously and transparently enforced. There also must be a reliable and user-friendly means for affected third parties to bring apparent contractual shortfalls to the attention of ICANN, and ICANN’s contract compliance efforts must instill confidence that such reports will be thoroughly and promptly investigated and problems addressed. If this compliance environment can be achieved, then the need for a formal post-delegation dispute mechanism may diminish. COA strongly supports the incorporation of graduated enforcement sanctions into the ICANN-registry agreement, since the ultimate sanction of revoking the delegation should be reserved for the most egregious circumstances.

Finally, COA notes with interest the bullet list on pages 4 and 5 of the draft report of issues that the IRT believes warrant further consideration. It is quite understandable that, in the very limited time allocated to it by the Board resolution, the IRT was unable to incorporate any analysis or discussion of these into its draft report. However, COA believes that some of these are essential ingredients for addressing the challenges of the new gTLD process to intellectual

property enforcement online. In our view, the “overarching issue” in this area identified by the ICANN staff cannot be considered fully resolved without full consideration of some of these tools. In particular, COA believes that ICANN should require the new gTLD registries to ensure that registrars that qualify to sponsor registrations within the new registries also fulfill relevant obligations, with regard to issues such as registrant verification and proxy/private registration services. We also reiterate our proposal from our comments on DAG v. 1 on this issue, as follows:

“ICANN should also take this opportunity to provide incentives for the new registries to take on some of the responsibility for ensuring that the ICANN-accredited registrars which they employ to sponsor registrations live up to their obligations with regard to Whois. Registries should also be encouraged to require that their registrars take proactive steps to improve the accuracy of Whois data; that they consistently cancel the registrations of those supplying false Whois data; and, if they provide proxy or private registration services, that they include and implement a process enabling copyright or trademark owners who present reasonable evidence of actionable harm to obtain access to the actual contact data of registrants.”

We urge the IRT to consider this issue in preparing its final report; and if the very short deadlines set by the Board do not permit this, we urge ICANN to supplement the draft registry agreement to include such “pass-through” obligations on registrars, building on the established precedent cited in our previous comments. See, e.g., <http://www.icann.org/en/tlds/agreements/asia/appendix-s-06dec06.htm#6>.

Thank you etc.