



6 May 2009

Dear all,

MARQUES is the European Association of Trade Mark Owners, representing the interests of intellectual property owners and the communities that identify with and trust their marks across a region that has over 600 million inhabitants.

MARQUES members feature over 750 trade mark professionals and they spend many hours dealing with domain name matters.

The ICANN new gTLD initiative has stimulated debate and provoked criticism and reaction amongst MARQUES members. While MARQUES has already submitted comments to the first and second draft, MARQUES wish to continue supporting ICANN to make the new gTLD process a success.

MARQUES and its members welcome the IRT proposal which is offering practical, useful and legally convincing propositions that take into account the launch programme of the new gTLDs as well as the future of the Internet and this in the interest of all stakeholders.

In addition MARQUES would like to submit following comments and questions:

1. IP Clearinghouse

The creation of such a tool is welcome. Obviously the cost of including a record in the IP Clearinghouse should not be prohibitive on brand owners. We support IRT's statement that any tool should not be a heavy financial or administrative burden on trademark owners (and on registries-registrars). The registration of domain names is per se an easy task in comparison to trademark filing and it should stay simple and accessible.

It is also important to brand owners that the IP Clearinghouse process should not have for consequence that trademark owners must register names that are brought to them through the Watch Service or against which they used the URS System. Complaining against a third party's domain must not lead to add the domain in the brand owner's portfolio.

We understand that the IRT offers to implement two types of lists within the IP Clearinghouse:

- Data list that can be used for Watch Service, IP Claims Service and URS
- Globally Protected Marks List subject to stricter requirements

- 1.1. **Watch Service:** The watching service throws up questions about the correlation between a domain name and a trade mark in the IP Clearinghouse. We would favor using confusing similarity as the threshold instead of the "corresponding term". We also wonder whether typo errors or variations are included (e.g. is RABIT the corresponding term for RABBIT?)

- 1.2. **IP Claims Service:** We ask the IRT to precise whether a combined trademark (logo or additional words) falls under the definition of an "identical match". We would like IRT to precise the details of the notice sent to registrants and brand owners. What is foreseen: a fee paid upon notice? Will this service be included in the fee paid to add the trademark in the List or will there be a "common" fee to be paid to the ICANN before the first gTLD application round?

- 1.3. **Globally Protected Marks List:** MARQUES supports its application to both the top and second levels. With such a tool we would target the new gTLDs and solve a real problem: the main issue for brand owners with the introduction of the new gTLDs is not (only) the registration of the brand as gTLD, but the fresh registration of the brand under all new extensions.
 - 1.3.1. One of the requirements is the ownership of 200 trademark registrations of national effect at least in 90 countries. Does this include marks combined with device, colors, as well as any other words (eg. BLUE RABBIT, RABBIT with device)?

In Appendix One page 12/14, we suggest to include "graphical elements" to the definition of "Variations of the rights".
 - 1.3.2. The requirement on the registration of second level domains in 50 TLDs is satisfying. If the GPM is RABBIT, does <rabbit-promotion.com> count as a domain? What about the domains registered under several second level of extensions like .co.uk, .me.uk, etc. Does it count as 1 or 2 domains?
 - 1.3.3. The third requirement is very difficult to provide. It is a trademark law principle that a well-known trademark is a trademark with a reputation for certain type of products or services. There are very few trademarks that benefit from a reputation covering any kind of products. Furthermore the notion of "well-known trademark" varies according to the local legislation.

The alternative proof of well-known character is agreeable, but it is necessary to precise what is understood under "three different courts". Does it imply 3 different countries? Decisions from the Highest Instance?

- 1.4. **Further comments:** There is an issue with the matching of trade mark records to IDN domains because in many languages one sound can represent a concept or a word. Indeed there is a huge potential for massive misunderstanding and disruption in the future relates to non-Latin alphabet renderings of domain names which assimilate or pose as either registered or unregistered trade marks.

In particular in Chinese language a number of different formulations of Chinese characters can all reproduce the same sound and it is possible to see problems of protection and control when applying this difficulty to IDN programmes. In addition infringers take Latin alphabet rendered famous names or word marks and convert them into Chinese characters with the same or a very similar sound and register them as trade marks, domain names or Chinese keywords. Clearly an availability of Chinese character IDN would enable the proprietor of the infringing Chinese character mark – which by this time may well be a Well Known Trade Mark in its own right – to register in a way which will not enable the foreign Latin alphabet mark proprietor to object.

2. URS System

MARQUES supports this very innovative tool because it could enable brand owners to react swiftly against clear misappropriation of domain names and decrease the costs of defense of their brands. We note that URS has similar effects than UDRP, except the fact that the complainant cannot recover the name once the complaint is granted (no transfer).

The cost of filing a URS (Uniform Rapid Suspension claim) should not be prohibitive. This could be perhaps subsidized by the Registries, Registrars or indeed ICANN. We also would like to point to the experience of Nominet who charge £200. We think that a fee of USD 100-300 would be acceptable to brand owners.

Legacy is of foremost importance: fair notice and opportunity to answer make the process a "legal" tool which comply with most law principles.

Additional questions/comments:

- What are the real benefits of pre-registration? Where should the trademark owner pre-register? Who receives the fee (Registry?)?
- Notice per email and certified letter are enough. As WHOIS data must be accurate, mail address must be correct and someone should pick up the mail (business standard rule).
- Number of domain name registrations: about 15-20 should be sufficient.

3. Whois Model: We agree with the proposal that it should be implemented at Registry level and not at a Registrar level. It should be the policy of the Registry to show a full Whois and registrars should also be under the obligation of providing the information too.

If any specific data, such as email or phone (to avoid spam and so on), is not showed there should be a way for a legitimate enquirer to obtain the information on a reasonable length of time and speed.

We also like the idea mentioned on the IRT of a Universal Whois database maintained by ICANN and for all gTLDs.

4. **Post-Delegation Dispute Mechanism:** MARQUES fully supports this proposal.
5. **Algorithm for String Confusion:** MARQUES fully supports this proposal.

Submitted by
Cyberspace Team, MARQUES