

Comments of Kathryn Kleiman, Esq.

To the Open Comment Period of the Implementation Recommendation Team (IRT)

Period Open Through 5/24/2009

My name is Kathy Kleiman. I am a final drafter of ICANN's Uniform Dispute Resolution Policy (UDRP), co-chair of ICANN's Working Group B on Famous Marks, and a trademark attorney specializing in protection of trademark rights and the traditional, legal limits of trademark rights -- including the protection of free speech (freedom of expression internationally) and fair use.

Introduction:

Under law today, trademark owners have a legal obligation to protect their trademarks (and service marks). That trademark owners would seek to create a private policing service is not unusual. That they would seek to impose their duties of policing on ICANN is a surprise.

In brief,

- The IRT Proposals are outside the scope of trademark law;
- The IRT Proposals are outside the scope of ICANN; and
- The IRT Proposals do not meet the guidelines and consideration criteria established by IRT itself.

I. The IRT Proposals are outside the scope of trademark law.

Nowhere within the IRT Report does it describe the existing rights of trademark owners, and the limits of those rights. A decade ago, in preparation for the UDRP and under a grant from the Ford Foundation, I studied them closely. In brief:

1. Trademark rights are limited rights. They are grants of a limited commercial right for a limited term of years for ***a specific set of goods and services as used in commerce by the trademark owner***. A trademark, according to the US Patent and Trademark Office (USPTO), is only “a legal presumption of the registrant's ownership of the mark” and the limited right to use that mark “in connection with the goods and/or services listed in the registrant.” U.S. Patent & Trademark Office (USPTO), ***Basic Facts About Trademarks***, www.uspot.gov/web/offices/tac/doc/basic (accessed 5/23/2009).
2. It is a basic right for all people, organizations and businesses (old and new) to use dictionary words in their normal sense. By law, US Trademark Office Examining Attorneys must refuse registration if a proposed trademark is:
 - “* primarily merely descriptive or deceptively misdescriptive of the goods/services;
 - * primarily geographically descriptive or primarily geographically deceptively; misdescriptive of the goods/services;
 - * primarily merely a surname; or
 - * ornamental.”

(USPTO, ***Are there other reasons the examining attorney might refuse my mark?***, www.uspto.gov/web/offices/tac/doc/basic (accessed 5/23/2009).

This right for all members of the public to use words in their normal, generic sense is not invalidated by the existence of a trademark using the same set of characters. Milk producers, for

example, have the right to use the word “milk” to label their dairy products regardless of the existence of a trademark of the same word – perhaps a line of children's clothing under the trademark “Milk.”

The right of those living in the Mississippi Delta to use the geographic description of “delta” is assured regardless of the trademarks issued to Delta Faucets and Delta Airlines.

3. The legal obligation to protect and police a trademark belongs squarely in the private hands of the trademark owner. ***“Once a registration issues, it is up to the owner of a mark to enforce its rights in the mark based on ownership of a federal registration.”*** USPTO, www.uspot.gov/web/offices/tac/doc/basic (accessed May 23, 2009).

Simply put, trademark owners do not have the right, under law, to remove from our language basic words like pony, sun, tide and cheer. Neither do they have the right of “first dibs” or rights of first refusal to these ordinary words in new gTLDs.

The IP Clearinghouse is based on the assumption that a trademark owner owns a string of characters and can, and should, be allowed to prevent others from using that string. The IRT asks that ICANN provide a new service to:

- ◆ Notify trademark owners when “their string” is being used in top and second level domains; and
- ◆ Warn domain name owners away if they happen to register “that string of characters,” in any top or second level domain (of any sort and for any purpose)

But trademark owners don't own strings of characters; their trademark is only a limited right to use the mark for an applied-for set of goods and services. That's the agreement trademark owners accept when they apply for and receive a trademark.

II. The IRT Proposals are outside the scope of ICANN;

According to the U.S. Government "White Paper" in 1998, the purpose of ICANN is “to manage and perform a specific set of functions related to coordination of the domain name system, including the authority necessary to:

- 1) set policy for and direct allocation of IP number blocks to regional Internet number registries;
- 2) oversee operation of the authoritative Internet root server system;
- 3) oversee policy for determining the circumstances under which new TLDs are added to the root system; and
- 4) coordinate the assignment of other Internet technical parameters as needed to maintain universal connectivity on the Internet.

What the IRT Report advocates is a new role for ICANN as global policeman of national trademarks, a purpose far beyond the scope and mission of ICANN. The IP Clearinghouse with associated watch services, a Globally Protected Marks List, a Standard Sunrise Registration Process and a Post-Launch Second-Level Rights Protection Mechanisms are services never envisioned by the White Paper.

The IRT Report's larger vision of ICANN providing a “platform upon which a tapestry of globally-effective [intellectual property] RPMs [Rights Protection Mechanisms] can be based” is similarly far beyond the scope and mission of ICANN (*For ICANN*, IRT Report, p. 4 of 14).

As the US Government does not police trademark rights, but instead provides access to the courts which allow trademark owners to police their trademarks for themselves, so too ICANN should not police trademarks, but instead continue to provide access to UDRP processes (privately run) as well as courts which allow trademark owners to police their own trademark rights within the domain names system.

III. The IRT Proposals do not meet the guidelines and consideration criteria established by IRT itself.

In its opening criteria, the IRT set out clear goals which include that *the IRT proposals must “not create additional legal rights” for trademark owners (Introduction & Overview*, IRT Report, p. 1). But the IRT Proposals clearly create additionally legal rights for trademark owners. As discussed above, the IP Clearinghouse creates broad new rights of trademark owners. So too does the Globally Protected Marks List.

In Section 3 of its report, the IRT urges ICANN to create “The Globally Protected Marks List.” The Globally Protected Marks List is roughly the same as an International Famous Marks list – a set of specially high protections for super trademark owners – for those those with well-known marks. But there is no global consensus on the protection of famous marks. Such a list does not exist at the present time, and many countries do not have famous mark protection.

Thus the idea of ICANN creating such a list is not only out of scope for ICANN, it is outside the rights and guidelines promised by the IRT Committee.

IV. Closing Comment on Lack of Fair Process

This proceeding has moved too quickly. The comment period was posted for 30 days, publicized for 30 days, yet only the first 12 days seemed to count. Reflecting the lack of time to prepare, comments reflect disclaimers about lack of full review and sign-off, apologies, and even revocation by Intellectual Property owners of their signatures from comments in support of the IRT proposals. Many did not even have the time to comment. This process is, therefore, incomplete.

On such an important issue, the establishment of mechanisms to protect one constituency above all, there is precedence in ICANN for *slowing down the speed to allow full and fair consideration and review*.

A full and fair 60 day public notice period – with special notice to all the Data Protections Commissioners who have participated in past Whois proceedings – would provide a minimum of the input needed for the IRT's new “Whois requirements for new TLDs” section.

Before we change the rights and equities for all to protect the world's largest IP owners, let's conduct this process in a full, fair and fully open manner.

V. Agreement with Other Comments

In closing, comments of Attorney Brett Fausett and Anthony van Couvering deserve special attention. Attorney Brett Fausett wrote:

“ICANN can welcome the creation of a worldwide trademark database, either by WIPO or through a private, market-based solution, but should neither makes this task its own nor delay its own work while others build and populate an 'IP Clearinghouse.’”
(Comments of Brett Fausett, 5/6/2009)

ICANN Founding Member Anthony Couvering wrote:

“a more practical -- and less litigious -- method for achieving much of what the IRT seeks to accomplish, by making it easier for communities to police their own spaces according to the values of that community.” (Comments of Antony Van Couvering, 5/22/2009).