

Telstra's Comments on the Implementation Recommendation Team's Final Report on Trade Mark Protection in New gTLDs

Telstra Corporation Limited ('Telstra') welcomes the opportunity to provide comments to ICANN on the Final Report of the Implementation Recommendation Team ('IRT').

Telstra is Australia's leading telecommunications and information service company, providing customers with a truly integrated experience across fixed line, mobiles, broadband, information, transaction, search and pay TV.

In its 2009 report entitled '*Best Australian Brands 2009*', leading international brand consultancy firm Interbrand ranked the TELSTRA brand first, with a value of AU\$9,700 million. Telstra supports its house brand with both Australian and overseas trade mark and domain name registrations. In addition, Telstra owns significant product and service brands and supporting trade marks including *Next G*, *Next IP*, *BigPond*, *Yellow Pages* and *White Pages*

Summary:

If new gTLDs are to be introduced, Telstra fully supports the introduction of trade mark rights protection mechanisms of the type suggested by the IRT. As a leading Australian brand and trade mark owner, we believe it is imperative that clear and transparent protection mechanisms are in place to help combat trade mark infringement and dilution, and also to protect consumers from misleading and deceptive practices.

Comments on Specific Rights Protection Mechanisms:

IP Clearinghouse

The IRT has recommended that ICANN create an IP 'clearinghouse' to operate as a neutral centralised database of IP rights and to provide validated data to domain name registries. The effect of this is likely to be reduced costs and increased administrative efficiency associated with trade mark protection. This will benefit trade mark owners, registries and registrars.

Telstra strongly supports this recommendation. However, we would caution that as new registries have the option of a traditional Sunrise period or using the new Clearinghouse, trade mark owners would need to ensure that they were listed on the clearinghouse database *and* that they applied during any sunrise periods. If the fees for listing a trade mark on the clearinghouse database are set too high, this may defeat its aim of reducing

costs for trade mark owners. As it is not yet clear the extent to which the Clearinghouse will be used by new registries, we believe that a minimal fee would be the most appropriate.

Globally Protected Marks List ('GPML')

It has been proposed that trade marks which are registered in numerous trade mark registries across the world be placed on a GPML list. Inclusion in the list will give rise to a modified approval process for a third party applying for a domain name corresponding to the GPML mark.

Telstra supports the proposal that global trade marks - which require significant investment to register, maintain and protect - warrant focussed consideration. In the absence of any such consideration, global trade mark owners face the need for extensive defensive registrations and enforcement in order to protect their brands. There is also a serious risk that consumers will be confused or misled by domain names which appear to be related to established global trade marks but may not be, and are open to exploitation by the registrants of these names. These practices undermine the integrity of the domain name and trade mark systems as a whole.

Telstra supports the recommendation, but is concerned that its utility and effectiveness will depend on the criteria for inclusion, which are still to be finalised. Perhaps further consultation may be appropriate once the details of the criteria are determined.

Uniform Rapid Suspension system ('URS')

The URS is designed to be a fast, efficient and fair mechanism for taking down blatant instances where domain name registrations infringe trade mark rights. It is envisaged that the URS will allow trade mark owners to take action against clear trade mark infringement or abuse, without the expense of using the UDRP or judicial remedies. The registrant's interests are preserved by the right to a hearing and/or appeal, and the fact that the trade mark owner is not permitted to gain possession of the domain name via this process. Furthermore, if there is evidence of the trade mark owner repeatedly misusing the URS, they would be denied access to the system for a set period.

Telstra supports this recommendation, as it believes the URS has the potential to strike a reasonable balance between the rights of the parties. We suggest that the details and operation of the URS be evaluated after a trial period, to ensure that it is fulfilling its intended purpose of being fast, efficient and fair.

Thick WHOIS model

The proposed mandatory obligation for all new registries to provide WHOIS information under the Thick WHOIS model, would mean that one WHOIS service stores the complete WHOIS information for all registrars. This information is essential for the transparent and effective operation of the URS in an environment of potentially hundreds of new gTLDs.

Telstra strongly supports this proposal.

In summary, Telstra urges ICANN to adopt and implement all the recommendations for the trade mark protection set out by the IRT in its Final Report.

Yours sincerely,



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