



European Communities Trade Mark Association



Comments of MARQUES, the Association of European Trade Mark Owners and ECTA, the European Community Trade Marks Association on Trademark Post-Delegation Dispute Resolution Procedure.

1 April 2010

Introduction

MARQUES and ECTA appreciate this opportunity to comment on Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP) Revised – February 2010.

About MARQUES and ECTA

ECTA is the European Communities Trade Mark Association. ECTA numbers approximately 1500 members, coming from the Member States of the European Union, with associate members from all over the world. It brings together all those persons practising professionally in the Member States of the European Community in the field of trade marks, designs and related IP matters.

MARQUES represents trade mark owners across Europe who together own more than two million domain names (a conservative estimate). These domain names are relied upon by consumers across Europe as signposts of genuine goods and services.

Need to strengthen the PDDRP

Whilst understanding that Implementation Recommendation Team¹ designed the PDDRP to encourage responsible registry behaviour without placing an onerous burden upon legitimate registry operators, we are concerned that the current proposals need strengthening.

In particular, we would like to see the criteria for a PDDRP expanded to include a definition of **wilful blindness**.

This is important, so that action can be taken against bad actor registries that either act as cyber squatters themselves (as some registrars have been known to do) or that actively encourage cyber squatting.

¹ <http://www.icann.org/en/announcements/announcement-4-29may09-en.htm>



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We have read the comments made by WIPO in this regard. We believe that the list of factors for consideration in assessing wilful blindness that it has set out in its letter of 26 March 2010 to the ICANN Board is to be commended, namely:

- Whether the registry operator intentionally induced, knowingly permitted, or could not have reasonably been unaware of domain name registrations in the TLD that meet [the substantive criteria];
- Whether the registry operator specified and effectively implemented processes and procedures for launch of the TLD and initial registration-related and ongoing protection of third parties' mark rights (Rights Protection Mechanisms) to reasonably avoid the conduct described in [the substantive criteria];
- Whether the registry operator's manner of operation or use of the TLD is consistent with the representations made in the TLD application as approved by ICANN or the terms of the New gTLD Agreement.

Conclusion

We believe that a PDDRP complaint should be a mechanism of last resort for trademark owners and strongly support the comments from WIPO.

We recommend that ICANN invest further in its Contract Compliance department to ensure that it can take preventative action under the contract that exists between a registry operator and ICANN to forestall the need for a PDDRP.

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