

Comments on Special Trademark Issues Review Team Recommendations

The Coalition Against Domain Name Abuse (CADNA) appreciates the opportunity to comment and provide feedback on the recommendations made by the Special Trademark Issues Review Team regarding trademark protection in new gTLDs.

Overall, CADNA would like to commend the STI team on taking the time to consider these issues and develop a thoughtful set of recommendations. As CADNA has expressed previously, the introduction of new gTLDs could pose a significant threat to brand owners in terms of trademark infringement and abuse. Therefore, it is absolutely crucial that adequate protection mechanisms be established before gTLDs are rolled out on a large scale.

Clearinghouse Model

The Trademark Clearinghouse model described in the recommendations needs to be improved to better protect the rights of trademark holders and brand owners.

For one, the Clearinghouse will only cover nationally or multi-nationally registered “text mark” trademarks. These will not include common law rights (except those validated by a court), plurals of trademarks, marks that are contained within a domain name that includes other characters or words, or typos of any of the above. The exclusion of those aforementioned marks will limit the scope of the Clearinghouse in such a way that will seriously decrease its effectiveness. Brands will not be adequately protected from infringement on domain names that make use of their mark.

Similarly, CADNA is of the opinion that the Clearinghouse database should be utilized throughout the life of the gTLD registries. In the proposed model, gTLDs will be required to use the Clearinghouse to support their pre-launch rights protections mechanisms, which will consist of either a trademarks claims process *or* a sunrise process. This again represents an



underutilization of the benefits the Clearinghouse can offer. CADNA believes the Clearinghouse should be checked for *all* gTLD new registrations.

CADNA disagrees with the allowance for exceptions for trademark protection built into the proposed model, namely the stipulation in 5.2(i) that states that Registries will have discretion to decide whether to grant protection to trademarks in the Clearinghouse. If the purpose of establishing the Clearinghouse is to establish a widely recognized database of protected trademarks, then allowing individual Registries that degree of discretion more or less defeats the point of having a Clearinghouse in the first place.

Additionally, CADNA believed that one of the main motivations for establishing a Trademark Clearinghouse was not only to deter cybersquatting, but also to prevent the need for trademark owners to defensively register domains in new gTLDs. If, as the STI recommends, the Clearinghouse is only required for sunrise and pre-registration periods, the Clearinghouse will only really serve those trademark owners who would be inclined to register during the sunrise period. The Clearinghouse will provide little benefit to trademark owners during regular registration periods, whereas otherwise it could be used to decrease the need for defensive registrations on an ongoing basis.

Finally, in addition to developing a Clearinghouse model that adequately protects trademark holders and brand owners, ICANN should develop a model that does not place the costs of operating the Clearinghouse on the shoulders of trademark holders (as the current model does). Trademark holders already carry the burden of policing the domain name space, and more should be done on the part of the regulating body of the Internet to ensure a safe and stable domain name space.

Uniform Rapid Suspension Model

The STI recommends that, if a complaint filed over a domain name is resolved in favor of the complainant (in other words, the domain name is found to be abusive), the domain name



should be suspended for the balance of its registration period. CADNA recommends that language be added to the URS model that would allow the transfer of a domain name that is found to be abusive to the complainant, should it be determined appropriate through a UDRP decision or court order.

CADNA also disagrees with the dispute resolution timeframe set out by this model of the URS. According to this model, filing a complaint puts the domain name on a “freeze,” which means that the domain cannot be transferred but will continue to resolve to the same content during a 20-day response period granted to the registrant. This response time is not nearly rapid enough in the case of truly harmful content. CADNA proposes that the 20-day window be shortened to a 5-day window in order to expedite the process of resolving the complaint and to create a truly “rapid” response.

Although CADNA appreciates the time and effort the STI has put into developing this model for the Clearinghouse and understands that the recommendations are being made in light of the need for consensus and passage, but it does not go quite far enough in establishing an adequate means of protecting trademark owners. CADNA hopes that the STI team will consider its recommendations and increase the scope and overall effectiveness of the Clearinghouse.