

#13

**COMPLETE**

**Collector:** Web Link 1 (Web Link)  
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Page 1

**Q1** Proponent's Full Name If this proposal is jointly developed by more than one Working Group member, please write the full names of all proponents involved.

Michael Karanicolas

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**Q2** Does your recommendation address Sunrise, Trademark Claims, or both? **Sunrise only**

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**Q3** What type of recommendation are you proposing? **Policy**

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**Q4** What recommendation are you proposing? Please be succinct as well as substantially specific and not general in nature. One proposal for one recommendation only.

Where a top level domain is suggestive of a particular category of good or service, such as .bike or .pizza, sunrise registrations should require proof by the mark holder of actively doing business in that specific category.

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**Q5** What is your rationale for the proposal? (250 words max)

Owning a trademark does not grant a monopoly over the use of a particular word. In general, protections are limited to the types of commerce where a brandowner is active – hence the coexistence of Delta faucets, Delta Airlines, Delta Bank, Delta Hotels, etc. If the TMCH is an expression of legitimate trademark rights, a similar distinction should follow in how marks are registered and applied in this context.

While a number of TLDs might be viewed as being categorically neutral, such as .blog or .inc, where a TLD suggests a particular good or service brand owners should not be allowed to take advantage of the sunrise unless they are commercially active in that space, in line with the fact that, in a traditional legal context, their trademark protections would be unlikely to bind vendors active in this space.

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**Q6** What evidence do you have in support of your proposal? Please detail the source of your evidence. (250 words max) Such evidence may be information developed by the Sub Teams or documented in other sources.

Currently the system is open to abuse, allowing defensive sunrise registrations in gTLDs that are completely disconnected from a company's business, allowing for the exercise of protective rights that extend far beyond the actual protections offered under trademark law, and potentially preventing legitimate registrations. As a specific example, BMW, owner of a trademark over the common dictionary word "Mini", has used the sunrise to register a number of domains that are separate from their commercial activities, including mini.photo, mini.tattoo, mini.video, and mini.bike. I consider this last example to be particularly problematic, since not only does Mini not market any motorcycles, but because "minibikes" are a distinct category of product (defined on dictionary.com as "a small, lightweight motorcycle with a low frame and designed generally for off-highway use"). These are just a few examples I was able to manually find.

In addition, there is evidence that the system is being actively gamed, with the use of dummy trademarks to register dictionary words (see: <https://onlinedomain.com/2014/04/15/legal/fake-trademarks-stealing-generic-domains-in-new-gtld-sunrises/>). Requiring a proof of specific commercial activity would resolve these abusive practices.

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**Q7** In respect to which particular agreed Sunrise and/or Trademark Claims Charter Question(s) is your proposal relevant? (250 words max) A full list of agreed Sunrise Charter Questions can be downloaded here: <https://goo.gl/knQa2p> A full list of agreed Trademark Claims Charter Questions can be downloaded here: <https://goo.gl/FeAJpa>

Question 9 of the Sunrise charter.

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**Q8** Does the data reviewed by the Sub Teams show a need to address this issue and develop recommendations accordingly? (250 words max)

Yes – there are a number of articles submitted documenting abuses of the system, as noted in the responses to Q9, including those submitted by myself.

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**Q9** If not already addressed above, on the basis of what information, gathered from what source or Sub Team, is this proposal based, if any? Please provide details. (250 words max)

See above.

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