

## Comments of the Noncommercial Stakeholders Group

Thank you for the publication of the DRAFT Rights Protection Mechanisms Review paper. Clearly an enormous amount of work was done to compile and analyze quantitative and qualitative data on the use of specially-created mechanisms in the New gTLDs, such as the Trademark Clearinghouse, Trademark Claims and Uniform Rapid Suspension.

It is very important, however, that the questions being asked in the report, and all future reports on this subject, be expanded to reflect the whole of the GNSO and ICANN's goals in passing these rules: were existing rights protected, were existing fair use protections maintained and did ICANN avoid the creation of new or expanded intellectual property rights (which ICANN has no power or authority to create)?

With the details as set out below, we urge that the final report expand its inquiry to see if the balance and fairness included in these mechanisms worked for all parties: both rights holders and registrants. Did these programs reflect the full range of goals and commitments for all parties that ICANN set out in their adoption?

*We respectfully request that we would like to see more of these issues of balance and fairness raised in the final report. For example, when the final report goes out to the Community with questions of whether the URS (Uniform Rapid Suspension) worked for trademark owners, we also should be asking whether the URS worked for New gTLD Registrants and what obstacles they faced to education and information in responding to URS claims.*

*So the comments below both respond to questions raised by ICANN Staff – and new ones that we would like ICANN Staff to raise in the final version of this RPM Review to ensure that all sides and concerns are heard in the feedback that ICANN seeks.*

### Specifically:

1. In Section 3.2.2 **Trademark Clearinghouse Word Marks:** The section raises some good points that should be addressed more directly. The GNSO adopted rules for the protection of “word marks” – as in the specific text of a mark and the letters, numbers and symbols it may use, e.g., HASBRO. The GNSO rules specifically did not embrace the registration of “design marks,” a mark containing both wording and design features in which the font, the colors and the artistic elements are all part of the features protected by the trademark – and the individual letters and words are expressly NOT protected outside of the design packaging in which they are presented.

The GNSO's STI Recommendation specifically **did not** consider it fair to provide the extensive protection of the Sunrise Period and the Trademark Claims notices to lettering within a design mark – lettering offering “disclaimed” and expressly not protected as text alone and in isolation of its design – and yet that is precisely what the Trademark Clearinghouse (TMCH) has gone ahead and accepted. Domain names and URLs don't have design elements.

We strongly request further inquiry into: how many design marks have been accepted? How many of them expressly disclaim the very letters and words that the TMCH is now protecting?

How can we return to the original intent of the GNSO/STI rules and the limits adopted by the GNSO Council and ICANN Board?

2. **Section 3.3 Proof of Use** is an important feature of the TMCH; it is designed to prevent gaming of the system and unfair advantage to certain new registrants over others. In addition to requesting feedback from those who have used the Clearinghouse verification and Sunrise registration processes, it is important to request input from those who have observed these practices and wish to comment on whether the balance and intent to prevent individuals/organizations/companies from grabbing Sunrise spots without any existing trademark use has been met. Should the use requirements be expanded – e.g., to trademarks of a certain age such as one year?
3. **Section 3.4 Matching Rules:** This is an important section as the rules of the GNSO's STI were specially crafted to allow only exact matches. What the section does not include, and should, is why that decision was made. Going beyond "exact matches" created a firestorm of trouble for what is one person's "mark contained" is another person word. Inclusion of examples in the next version of this paper would be key to illustrating the point. Thus, an existing trademark in ENOM (an ICANN-Accredited Registrar), but such rules, would create a bar on the domain name registration of VENOM – and entirely different word (and one itself also trademarked now and it will be again and again in the future). Similarly, the \_\_\_ registrations of GOGGLE in the US Trademark Office did not prevent the registration of the domain name GOOGLE.COM or the registration of GOOGLE as a trademark in the US Trademark Office.

A few clear illustrations would convey the ambiguity and difficulty of going beyond an "exact match" and shed light on the rationale of the existing rule – a balanced approach as the next draft asks for additional input and possible changes.

4. **Section 3.5 Trademark Clearinghouse Communications:** In the next version and other related inquiries, we would like ICANN Staff to reflect a much broader question. Should the goal have been only "to reach trademark holders worldwide to inform them of the services related to the Clearinghouse via webinars and Q&F sessions" or should it have been to inform the worldwide community of a massive change in the rules of registration of domain names in the New gTLDs and a new set of protections and notices that ALL registrants should know about and understand. Did the TMCH devote even one second or one dollar to outreach, webinars and Q&A session to explain the impact of the Trademark [Claims] Notice to those receiving it, to answer questions that may arise from ambiguities or the publication of this new type of notice, or to ensure that those registrants who the Trademark Notice was meant to protect were not artificially "chilled" from moving forward with the registration of a domain name if they had the rights to do so.

While the TMCH has highly publicized that many potential registrants fail to "click through" a Trademark Claim, where is the additional information about why – so that the forms and notices can be tweaked to be fairer and more balanced?

Our concern is of course that no education and no information was provided to the global community by ICANN or the TMCH. This has left noncommercial registrants, small businesses, and individuals without the guidance that these rules and policies are designed to protect all legitimate overlapping uses of words, names, phrases, acronyms for future domain names, just as they have been protected for existing ones (see e.g., ACM as the Association for Computing Machinery and the Academy of Country Music, and DELTA as Delta Faucets, Delta Airlines, Delta Sigma Theta and Delta the symbol for change in mathematics).

Is the TMCH only helping one side, and shouldn't it be educating and communicating its rules, policies, protections and balances with all and for all users of the new gTLD domain name system?

5. **Section 4 Sunrise Period:** We request that the questions in the next draft and related reports be expanded to see if the sunrise period gives unfair advantage to trademark owners far outside their categories of goods and services. In cases where a New gTLD caters to .PIZZA should Delta Airlines really have a right of first registration? For New gTLDs and future gTLDs catering to individuals, noncommercial organizations, religious groups, etc., should the Sunrise Period exist at all?

Inquiry into whether an automatic and upfront registration benefit for existing trademark owners unfairly benefits McDonalds Restaurant in a .FAMILY or .CATHOLIC gTLD is a question that truly needs to be added and asked. Further, how can Sunrise Periods in future rounds be more narrowly tailored to the limited rights of existing trademark owners?

6. **Section 4.2 Limited Registration Periods** is an important section and one that fairly highlights the legitimate reasons why registries may want to open registrations to those who are not trademark owners, but otherwise fit into a category, such as football players seeking to register their names in .FOOTBALL prior to the opening in General Availability.
7. **Section 4.5 Reserved Names.** Reserved names policy is one that raises a lot of questions and should be clarified in the future rounds. The idea of reserved unlimited numbers of domain names in a gTLD and releasing them to any "person or entity at Registry Operator's discretion" may and has led to gaming and anticompetitive activity. Can these Reserved Name policies be used to cherry-pick all of the best names by one industry competitor and bypass ICANN's rules barring closed generics? This is an important inquiry for the next round.
8. **Section 5 Trademark Claims Service:** The Trademark Claims Services, as discussed above, has raised a number of questions and concerns. Questions we request be asked in future drafts and related reports include:
  - a) Is the Trademark Notice being shown to all Registrants?
  - b) Do all registrants understand the trademark claims notice?

- c) Why are so many potential registrants not registering domain names after reading the Trademark Notice? Are they actually cybersquatters or are potential legitimate customers being “chilled” by language of the notice or the inability to understand the notice (either the phrasing or not reading it in a language they speak)?
  - d) **\*\*How can we make the Trademark Notices better, clearer, fairer and more accessible so that those protected by the notices are protected and yet the limits, balances and fair use protections adopted by the GNSO Council and ICANN Board are achieved as well?**
9. **Section 5.2, Inclusion of Previously Abused Labels:** there is a lot of concern re: how this non-policy was created and implemented by ICANN. In light of the complaints brought against it, and apologies issues, shouldn't the report and future versions be asking if this “50+” policy should be reasonably limited, or rolled back completely?
10. **Section 5.3, Extensions of Trademark Claims Service, may be a completely invalid offering.** The GNSO's adopted rules and those of the ICANN Board were clearly limited in how long a Trademark Claims Service would last. Trademark Owners are responsible for the policing of their own marks and there are many private services and public tools they can use. Should the ICANN Community be subsidizing or allowing such an expanded and even unlimited extension of the Trademark Claims Service and what are the intended and unintended consequences to the most vulnerable of our potential future registrants: including noncommercial organizations, individuals and small businesses and entrepreneurs? What is the impact on those in developing countries? What is the impact of those who don't speak English (e.g., those now registering in our Internationalized Domain Names)? Is the TMCH unlimited extension fair, is it being invalidly subsidized or even paid for by the ICANN Community without authorization and should it be stopped?

We strongly request that the inquiry of the next and similar reports be expanded to include the questions above and whether the TMCH is allowed to write its own rules.

11. **Section 6, Uniform Rapid Suspension:** we would like to see the next and future reports reflect that the URS was a controversial mechanism -- an ultra-fast, ultra-cheap takedown mechanism for New gTLDs – and many were worried about whether registrants would be able to respond.

Clearly, registrants ARE responding, and in far greater numbers than we expected given that half the URS claims receive a response. Do Registrants have the information they need to respond? Do they understand the special defenses offered in the URS? Are they using them?

Additional questions that need to be asked in the next draft of this report and similar reports must reflect the education and rights of both sides, the claimant and the respondent, and they must include:

- A. Who is educating New gTLD Registrants globally on the existence of the URS?
- B. Who is educating registrants about the key differences of the UDRP and URS, including the much more rapid time needed for response, the different standards of

proof, and the much more expanded defenses? Where are the ICANN Webinars, ICANN LEARN Websites, FAQ pages and Q & A sheets?

- C. Who is educating Registrants about the appellate mechanism of the URS?
- D. Is anyone using the Appellate Mechanism of the URS?
- E. Are Panelists being rotated as required by the URS rules?
- F. Is the limitation of the URS to English proceedings – even in the Internationalized Domain Names (!! ) – operating a barrier to responses by Registrants? What percentage of URS cases are coming from the IDNs?
- G. How can ICANN and the URS Providers improve the education of Registrants around the URS rules, URS process, and special URS defenses and rights for registrants?
- H. How can we improve monitoring of the monitoring and reporting of the URS results?

## Conclusion

Our thanks again to the ICANN Staff for such a comprehensive report. A huge amount of work was done, but work still remains. As in every type of intellectual property rights protection system (legislative, regulatory, etc.), the questions are always asked: are the rights holders protected, but also is the public protected, are all future rights holders protected, are free speech, freedom of expression, fair use and the rights of all to use dictionary words, generic words, common acronyms and phrases as well as their first and last names protected to the fullest extent of national laws, and international treaties? Are these rights in balance, and carefully drafted by the IRT, the STI and when adopted by the GNSO and ICANN Board?

The next version of this report – and all future reports including the upcoming UDRP Review – must include this fair and comprehensively balanced inquiry. We must remain fully cognizant that we are adopting these rules and seeking to protect the balanced rights of the whole of the Internet Community, which is now the world. This is not just a world of commerce, it is a world of free speech, democratic development, and freedom of association, rights that are impacted by restrictions on the use of words.

Sincerely,

THE NONCOMMERCIAL STAKEHOLDERS GROUP, AS APPROVED BY THE POLICY COMMITTEE, AND

THE UNDERSIGNED MEMBERS OF THE NONCOMMERCIAL STAKEHOLDERS GROUP:

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