

Jeff, all,

I propose that we discuss Chuck's comments on the phone later, but I would like to briefly reply to Jeff as he will not be able to make the call.

Am 22.08.2012 um 11:01 schrieb Neuman, Jeff:

All,

I just wanted to offer my personal (non-chair) feedback on this although I will not be able to make the call today. Options 1 and 5 are not mutually exclusive and I believe should be considered as a joint option if the group is leaning towards option 1.

Recall option 1 is maintain the status quo (no changes to reserved names schedule) and option 5 is to consider possible additional protections as part of broader PDP for international organization. So, in essence, it is maintain the status quo for now, but include this in the broader PDP.

I agree that these could or should be combined.

I do also have some questions on Thomas' points.

1. Thomas states: "data provided to the DT has shown that abuse predominantly takes place with similar strings or where the designations in question are combined with more elements and that such abuse cannot be prevented by reserving identical strings." I actually do not believe this is a fair statement nor accurate in the new world of the new gTLDs nor really relevant when looking at the issue of reserving the exact matches at the second level. Yes, when asked to provide evidence of abuse, the IOC provided evidence of marks that are similar or combined. But one of the reasons could be that all of the actual marks themselves were registered by the IOC in the land rushes/Sunrise processes of the other TLDs. Thus, since they already owned the identical names, then there could not by definition, be any current abuse. This doesn't dilute the argument against adopting options 1 or 5, but rather is just an opinion that we should not be issuing any finding about where abuse takes place.

We are discussing potential protections for identical matches now. ICANN is already requiring certain RPMs to be implemented by the new registries. In my view the risk of identical names being taken by third parties is addressed by these new mechanisms - at least this risk also exists for many other rights holders. Even if your assumption were correct that identical matches do not constitute issues due to the fact that the organizations in question have registered them, I guess it is fair to put the issue in perspective. The GAC may (or may not) believe that by following their request, we would solve the issue of the IOC / RCRC designations being abused. However, I got the impression that similar strings or combined strings outnumber the identical strings by far. I deem it necessary to clarify that even if the GNSO did follow the request, we would not solve the issue, but only address that part of the issue (identical names) that ICANN has already responded to with new RPMs/DRMs.

2. While the legal case in Germany is interesting, as another lawyer, I am not sure I find it to be particularly relevant when considering the exact matches in the domain name context. We, as a group, are not looking at whether to add "olympicdiscounts" to the reserved names list, but rather just "Olympic." I am not familiar with German law, but I would presume that if the contact lens dealer changed its name to just "Olympic", and advertised its new name as "Olympic" the case may not have turned out the same. Nor am I so sure that a domain name would be viewed merely as a promotional use vs a designation of origin.

I guess it is relevant as we are not talking about olympicdiscounts.TLD, but I could imagine olympic.discount or other combinations that might be legal to use. Without a profound legal analysis, I guess it would not be appropriate to move forward. Also, there would be many follow-up questions, such as why - if any - an exemption procedure is needed for a use that is permitted by law in the first place and who controls such process, to name only two.

I hope that even if you might not agree with my statements that this helped clarify my points.

Best,
Thomas

I agree with the other points – Namely, that:

1. We need to ensure that the marks contained within the GAC list are all eligible for protection under the existing rights protection mechanisms and dispute processes.
2. We can recommend that registries should be encouraged to provide additional protections to these organizations where applicable, including maintaining these marks on a reserved list; and
3. A concise summary of the discussions and considerations by the group (at both the top and second levels) should be drafted.

Jeffrey J. Neuman
Neustar, Inc. / Vice President, Business Affairs

From: owner-gnso-iocrc-dt@icann.org [<mailto:owner-gnso-iocrc-dt@icann.org>] **On Behalf Of** Gomes, Chuck
Sent: Tuesday, August 21, 2012 6:01 PM
To: Thomas Rickert
Cc: Brian Peck; gnso-iocrc-dt@icann.org
Subject: RE: [gnso-iocrc-dt] RE: Red Cross/IOC: List of possible approaches to respond to GAC proposal

Thanks for the feedback Thomas. Please see my responses below, including a couple questions.

Chuck

From: Thomas Rickert [<mailto:rickert@anwaelte.de>]
Sent: Tuesday, August 21, 2012 4:39 PM

To: Gomes, Chuck

Cc: Brian Peck; gns0-iocrc-dt@icann.org

Subject: Re: [gns0-iocrc-dt] RE: Red Cross/IOC: List of possible approaches to respond to GAC proposal

Chuck, all,
thanks for putting this together.

I believe that option 3 a is not acceptable, unless that were the outcome of a PDP. I share Avri's concerns with this. If such protections were the the outcome of a PDP, that would be fine, but there should be no shortcut.

Also, I would like to add to the exchange of thoughts between Chuck and Kiran on the legal situation that there was a recent court decision in Germany made by the regional court of Kiel, which stated that an advertisement of a contact lense dealer with "olympic prices" and an "olympic discount" does not constitute an infringement of the Olympiaschutzgesetz (Olympia Protection Act).

Olympic designations cannot be protected against any type of promotional use. Combined with the word "discount" and "price" the olympic designation only conveys that the offers are very good and according to which current occasion such discounts are offered (LG Kiel, Decision of June 21, 2012 - 15 O 158/11).

Thus, the number of cases in which legitimate use of the designations in question is possible is getting bigger. We should therefore not shortcut a comprehensive assessment. You might say that the court talked about the combination of two words while we are talking about identical matches. I would think that a the combination of the identical string under a TLD as a promotional statement would also constitute legitimate use.

As a consequence, I think that option 1 is the one to go. We could amalgamate what Chuck wrote with (some) of the suggestions I made and I am happy to discuss this further tomorrow. **[Gomes, Chuck]** Should I take this to mean that you would support the approach I described from the RySG, i.e., recommending that the Council inform the GAC that option 1 is the current position of the GNSO Council, provide a rationale for that position (expanded by the discussion group) and ask the GAC to provide any additional information they might want to provide for Council consideration?

It would be imperative to write a comprehensive rationale. **[Gomes, Chuck]** Definitely agree. In addition to what Chuck wrote, we should add that:

- there is a GNSO policy on reserved names, which does not grant special treatment to certain groups or rights holders **[Gomes, Chuck]** I would word this a little differently. There is a GNSO approved policy for introducing new gTLDs that includes a list of reserved names that 'does not grant special treatment to certain groups or rights holders'.
- that where the use of RPMs and DRMs may not be accessible to IOC-RCRC, such use should be made possible **[Gomes, Chuck]** I don't understand what you mean here. Please explain.

- data provided to the DT has shown that abuse predominantly takes place with similar strings or where the designations in question are combined with more elements and that such abuse cannot be prevented by reserving identical strings
- that ICANN staff should help the organizations to reach out to applicants to encourage voluntary inclusion in the reserved names lists of the new registries. **[Gomes, Chuck]** Are you suggesting that this be part of the discussion group recommendation to the Council?
I am fine with that but want to make sure that is your intent.
[Gomes, Chuck] *If the discussion group decides to pursue this approach further, I encourage others to add to the rationale.*

Also, a summary of the discussions and considerations of the DT should be included so show the level of complexity and thinking that went into this subject. **[Gomes, Chuck]** Agreed, although I think we should make it as concise as possible, while still being thorough.

Thanks,
Thomas