

**New gTLD Program: Rights
Protection Mechanisms
Review**
Draft Report

2 February 2015

TABLE OF CONTENTS

1	Introduction	3
1.1	Rights Protection in the New gTLD Program.....	3
1.2	Goals of this Review.....	6
2	Background	7
3	The Trademark Clearinghouse	10
3.1	Trademark Verification Process.....	13
3.2	Trademark Clearinghouse Guidelines.....	17
3.2.1	Treatment of Marks across Jurisdictions	17
3.2.2	Word Marks	19
3.2.3	The “dot” Rule.....	20
3.3	Proof of Use.....	22
3.4	Matching Rules.....	25
3.5	Misuse of Data.....	26
3.6	Communications.....	27
4	Sunrise Period	31
4.1	General Feedback.....	34
4.2	Limited Registration Periods	35
4.3	Approved Launch Programs & Qualified Launch Program	37
4.4	Sunrise Dispute Resolution Policy	38
4.5	Reserved Names.....	39
5	Trademark Claims Service	41
5.1	General Feedback.....	45
5.2	Inclusion of Previously Abused Labels.....	45
5.3	Extensions of Trademark Claims Service	46
6	Uniform Rapid Suspension	49
7	Post-Delegation Dispute Resolution Procedures	60
8	Conclusion	62
9	References	63

Draft: Rights Protection Mechanisms Review

1 Introduction

This paper is intended to provide an outline for an initial review of the effectiveness of the rights protection mechanisms (RPMs) established as safeguards in the New gTLD Program. Particularly, this paper will review the data and input collected in many of the key areas relating to protection of trademark rights in the domain name system (DNS), including the Trademark Clearinghouse, Uniform Rapid Suspension (URS) system, and Trademark Post-Delegation Dispute Resolution Procedure (PDDRP). This review and analysis is being published for public comment, and will be updated and revised based on the feedback received before being completed to help inform various reviews and activities within ICANN.

1.1 Rights Protection in the New gTLD Program

In June 2011, ICANN's Board of Directors [approved](#) the launch of the New gTLD Program. The Program's goals in expanding the generic top-level domain (gTLD) space included enhancing competition and consumer choice, and enabling the benefits of innovation via the introduction of new gTLDs, including both new ASCII and internationalized domain name (IDN) top-level domains.

As part of the gTLD application process, an objection procedure was established to protect various rights and interests, including the Legal Rights Objection (LRO) process to provide for protection of legal rights at the top level. This dispute resolution procedure was used to determine whether an applicant's potential use of the applied-for new gTLD would cause infringement of the objector's existing trademark.

In developing the Program, consideration was also given to protection of rights in domain names registered in new gTLDs. Intellectual property experts

worked with many other key stakeholders to create new rights protection mechanisms in support of a stable and secure Internet for users. As a result, several new RPMs were implemented to mitigate potential risks and costs to rights holders that could arise in the expansion of the new gTLD namespace, and to help create efficiencies for registration service providers among gTLD launches.

The RPMs are designed to be applicable at various times over the life of a TLD. For example, TLD launch processes include a Sunrise period and a Trademark Claims period, supported by verified trademark rights information as recorded in the Trademark Clearinghouse. Once these processes are completed and the TLD is in a steady state of operations in terms of domain name registration, rights holders have mechanisms such as the Uniform Domain Name Dispute Resolution Policy (UDRP), URS, and PDDRP to address complaints about infringement. An infographic overview of the RPMs is included on the following page.

The Internet is Expanding

Learn how to protect your trademark

.нлайн



.cooking

شبكة

+3

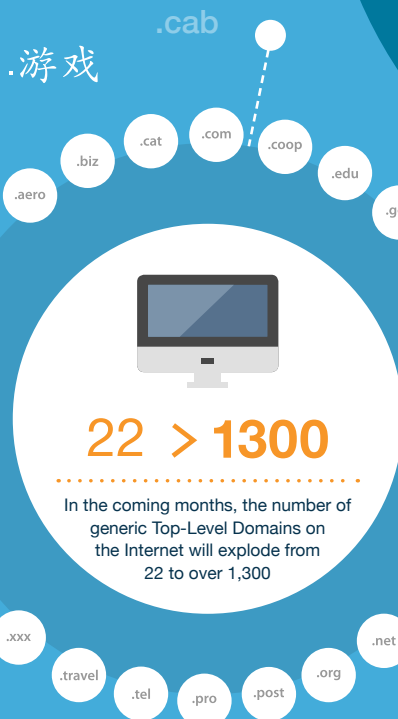
Rights Protection Mechanisms

are now in place to support and protect trademark holders - before anything happens, and in case something does in the future

みんな

STAGE 01

BEFORE THE NEW DOMAINS GO LIVE



22 > 1300

In the coming months, the number of generic Top-Level Domains on the Internet will explode from 22 to over 1,300

Trademark Clearinghouse

The Trademark Clearinghouse is a one-stop-solution to help protect a trademark across every new generic Top-Level domain that comes online

The first stage in protecting your rights is to submit a mark to the Trademark Clearinghouse

Submit your Trademark

<http://trademark-clearinghouse.com>

Rights Protections



Sunrise Services

Priority access to request domain names associated with your trademark(s)



Trademark Claims Service

Notification to a Rights Holder after registration, allowing for immediate action if the domain registered is infringing rights

STAGE 02

AFTER THE DOMAINS GO LIVE

Uniform Rapid Suspension System

If rights infringement occurs after a domain goes live, the URS comes into effect



Within 24 hours of a valid complaint, an infringing domain will be locked

STAGE 03

AFTER THE DOMAINS GO LIVE

Trademark PDDRP*

Trademark infringement is often portrayed as being a registrant problem, such as cyber-squatting. But what if a Registry Operator were to be involved?



The Trademark Post-Delegation Dispute Resolution Procedure addresses instances where a Registry Operator is complicit in trademark infringement

Find out more @ <http://newgtlds.icann.org/urs>

ICANN and the Internet community are laying the foundation for a broader, more mature Domain Name System

Find out more @ <http://newgtlds.icann.org/pddrp>

To find out more about the biggest change to the Internet since it was created visit

<http://newgtlds.icann.org>



New Generic Top-Level Domains

* Post-Delegation Dispute Resolution Procedure

© 2013 Internet Corporation For Assigned Names and Numbers

1.2 Goals of this Review

As of this writing, over 350 TLDs have launched and there are many more to come, creating new experiences and challenges. This paper accounts for approximately the first year of experience with the new RPMs, and it is expected that patterns will continue to emerge as the new namespace develops.

This review paper includes the following sections:

- **Section 2** summarizes the process by which the RPMs were developed for the New gTLD Program.
- **Section 3** discusses the Trademark Clearinghouse, a global repository for trademark data to support rights protection processes.
- **Section 4** examines the Sunrise service, a period in which trademark holders receive an advance opportunity to register domain names corresponding to their marks in new gTLDs before names are generally available to the public. In addition, this section examines other areas associated with this service such as Limited Registration Periods, the Qualified Launch Program, the Sunrise Dispute Resolution Policy, and questions concerning reserved names.
- **Section 5** reviews the Trademark Claims service, which runs for at least the first 90 days of general registration in a new gTLD, during which anyone attempting to register a domain name matching a mark that is recorded in the Trademark Clearinghouse will receive a notification displaying the relevant mark information. This section also discusses the additional services relating to Trademark Claims, such as inclusion of previously abused labels, and extension of the Trademark Claims services.
- **Section 6** discusses the URS as a complement to the UDRP, for the resolution of disputes regarding the registration of domain names that may infringe trademark rights.

- **Section 7** looks briefly at Post-Delegation Dispute Resolution Procedures, mechanisms developed to address potential registry conduct issues by providing an avenue for complaints from parties alleging harm by a new gTLD Registry Operator's conduct.
- **Section 8** describes the foreseen next steps for the review process.

For each of the RPMs, the paper calls out questions where feedback is specifically encouraged. However, feedback is welcomed on any of the topics and issues described in this paper, as well as additional issues that might be included. In addition to being specified in each of the relevant sections, the questions are compiled and listed in the Appendix to this paper.

Publication of this draft for public comment is important to capturing the experience of users of the RPMs and to consideration of how they affect the variety of stakeholders in the context of the DNS. Feedback is especially important to ensure that all issues that need to be considered are identified, and to help determine those issues that have most impact, and accordingly, the areas where community resources will be best focused. To help execute an effective review process, ICANN encourages thoughtful input from a diverse set of stakeholders.

The areas identified from the review process may take different paths: some may be subjects for policy discussion; others may be operational or service enhancements that can be considered with the stakeholder community. Outputs from this review and comment process are expected to inform possible policy discussions in the GNSO (with an Issue Report on RPMs scheduled for Q3 of 2015), as well reviews of the Program's impact on competition, consumer trust, and consumer choice (with the Review Team scheduled to be formed beginning in Q3 of 2015).

2 Background

During the development phases of the Program, in public discussions of new gTLD implementation models, rights holders and other interested parties identified

potential risks and costs to rights holders that should be mitigated in the expansion of the gTLD namespace. On 6 March 2009, the Board [convened an Implementation Recommendation Team \(IRT\)](#) to develop proposed solutions to address the most pressing and key issues for trademark holders.

The Board asked the IRT to develop proposed solutions for potential risks to trademark holders in the implementation of new gTLDs. The IRT was comprised of 18 experienced and geographically diverse individuals knowledgeable in trademark protection on the Internet. The IRT identified five areas to address some of the immediate concerns:

- The IP Clearinghouse (later, the Trademark Clearinghouse), Globally Protected Marks List and associated rights protection mechanisms, standardized pre-launch rights protection mechanisms;
- Uniform Rapid Suspension System;
- Post-delegation dispute resolution mechanisms at the top level;
- Whois requirements for new TLDs; and
- Use of algorithm in string confusion review during initial evaluation.

In developing its recommendations to address the five proposed solutions mentioned above, the IRT applied the following framework and considerations:

- The recommendation should satisfy the checklist criteria agreed on by the IRT;
- The recommendation should protect the existing rights of trademark owners, but neither expand those rights nor create additional legal rights;
- The recommendation should provide clear benefits to trademark owners and new gTLD registries, such that as many as possible will be incentivized to use the recommended solution;
- The recommendation should accommodate user and consumer concerns, in particular the need to ensure consumer protection both in terms of preventing unnecessary confusion and of permitting (and not derogating from) the lawful use of marks;
- The recommendation should be sufficiently flexible and scalable so as to ensure its sustainability as an effective RPM; and
- The recommendation should not result in unnecessary or undue costs, either to trademark owners, gTLD registries, registrars or to legitimate users and

consumers.

In developing its recommendations, the IRT evaluated the public comments received in response to the posting of the [Draft IRT Report](#) on 24 April 2009, and consulted with and examined the practices, experiences and recommendations of various registries, Internet service providers, and dispute resolution services that it considered relevant to its task, including for example sunrise registrations, suspension practices, and the costs associated with implementing a rights protection mechanism.

These recommendations were intended to satisfy most of the concerns and to provide a balanced, flexible and sustainable solution to effectively protect the legal rights of trademark owners upon the introduction of new gTLDs. On 26 May 2009, the IRT published its [Final Report](#).

To ensure policy consistency, the ICANN Board requested that the Generic Names Supporting Organization (GNSO) Council evaluate the recommendations from the IRT, public comments, and additional analysis undertaken by ICANN staff, as well as review the policy implications of certain RPMs proposed for the New gTLD Program. In particular, the Board requested that the GNSO provide input on whether it approved the proposed model, or, alternatively, propose a new model that would be the equivalent or more effective and implementable.

On 28 October 2009, the GNSO adopted a [resolution](#) creating the Special Trademarks Issues review team (STI) to analyze the specific RPMs proposed for inclusion in the draft Applicant Guidebook. The STI review team included representatives from each Stakeholder Group, At-Large, Nominating Committee Appointees, and the Governmental Advisory Committee (GAC).

While the STI did not reach unanimous consensus on every element, it did reach such consensus on many aspects and broad consensus on many others. The GNSO unanimously approved the concept of a Trademark Clearinghouse required to support startup periods in all new gTLDs, either a Sunrise period or a Trademark Claims period. These [recommendations](#) were provided to the GNSO Council on 11 December 2009.

On 23 February 2011, the GAC [advised](#) the Board that both Sunrise and Trademark Claims services should be mandatory for registry operators because they serve different functions, with IP claims (i.e., Trademark Claims) serving a useful notice function beyond the introductory phase. Various community groups also recommended that both Trademark Claims and Sunrise services be mandatory for registries to provide.

After consultation with the GAC as well as multiple community stakeholders, the Board determined to make both Sunrise and Trademark Claims services mandatory for all new gTLDs. This approach was intended to provide flexibility for trademark holders around the world, in that they could elect to receive notices through the Clearinghouse-facilitated Trademark Claims service, rather than paying to obtain a Sunrise registration in each new gTLD.

The GAC advice in relation to URS was also considered and taken into account in incorporating the URS as an additional tool for rights holders in the Program. Following this phase, ICANN worked to implement the Trademark Clearinghouse and URS processes to be available before new gTLDs opened for registration. This implementation work also involved extensive consultations on the [details of elements of the Trademark Clearinghouse](#), and [registry requirements](#) for implementation of Sunrise and Trademark Claims.

With the delegation of the first new gTLD in October 2013 came the opportunity to operate the rights protection processes designed by the community. This paper is intended to capture that experience and consider it in light of the community discussions contributing to these mechanisms.

3 The Trademark Clearinghouse

The Trademark Clearinghouse is a database of verified trademark information from around the world. The verified data in the Trademark Clearinghouse is used to support both Trademark Claims and Sunrise Services, required in all new gTLDs.

The Trademark Clearinghouse performs several important functions, including authenticating global rights information, maintaining a centralized database, and providing this information to registries and registrars during the domain name registration process. Under contract with ICANN, Deloitte provides the verification services for the Trademark Clearinghouse, and IBM provides technical database administration and support services, as shown in Figure 3-1 below.

Trademark Clearinghouse Functions and Roles Performed

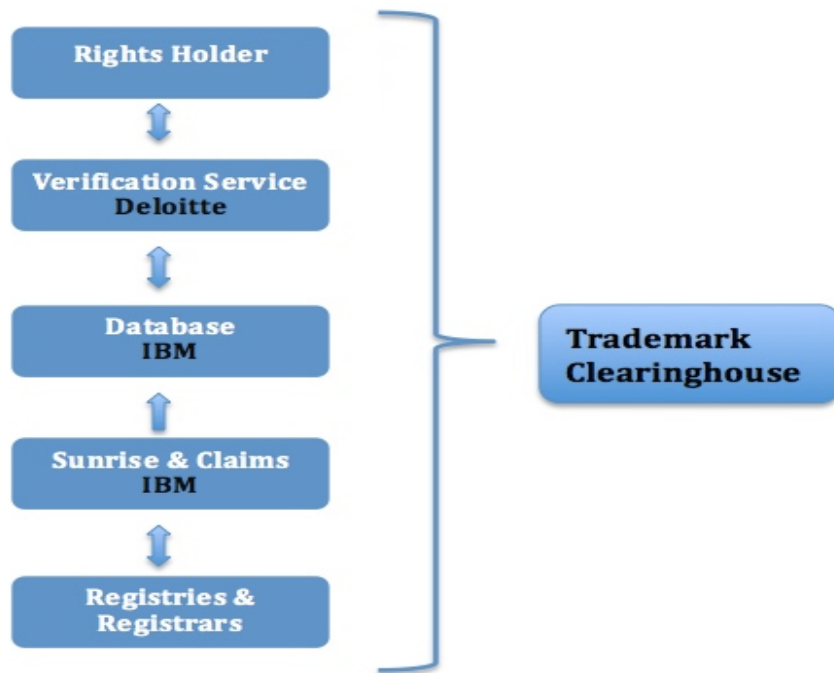


Figure 3-1
Source: icann.org

This section will focus on the verification functions of the Clearinghouse; while Sunrise and Claims functions are discussed in sections 4 and 5.

Benefits of recording a trademark with the Clearinghouse include access to Sunrise registration with new gTLD registries. This involves an initial period of at least 30 days before domain names are offered to the general public. The Clearinghouse also includes a Trademark Claims service that runs for at least the

first 90 days of general registration. During this period, the Trademark Clearinghouse sends a notice to those trademark holders with relevant records in the Clearinghouse, informing them when someone has registered a matching domain name.

A key requirement of the Clearinghouse is to serve rights holders from all regions of the world. This repository for rights data was designed to be accessible to prospective users in all regions and to create a resource for streamlining protection of trademarks across new gTLD launches.

The Clearinghouse opened for submission of trademark records in March 2013, in advance of delegation of the first new gTLD in October 2013, thus rights holders were granted a seven month window of opportunity to submit trademark records into the Clearinghouse prior to registering their desired domain names in October and following. Many rights holders took advantage of this period with a total of 13,261 verified trademarks submitted as shown in Figure 3-2 below.

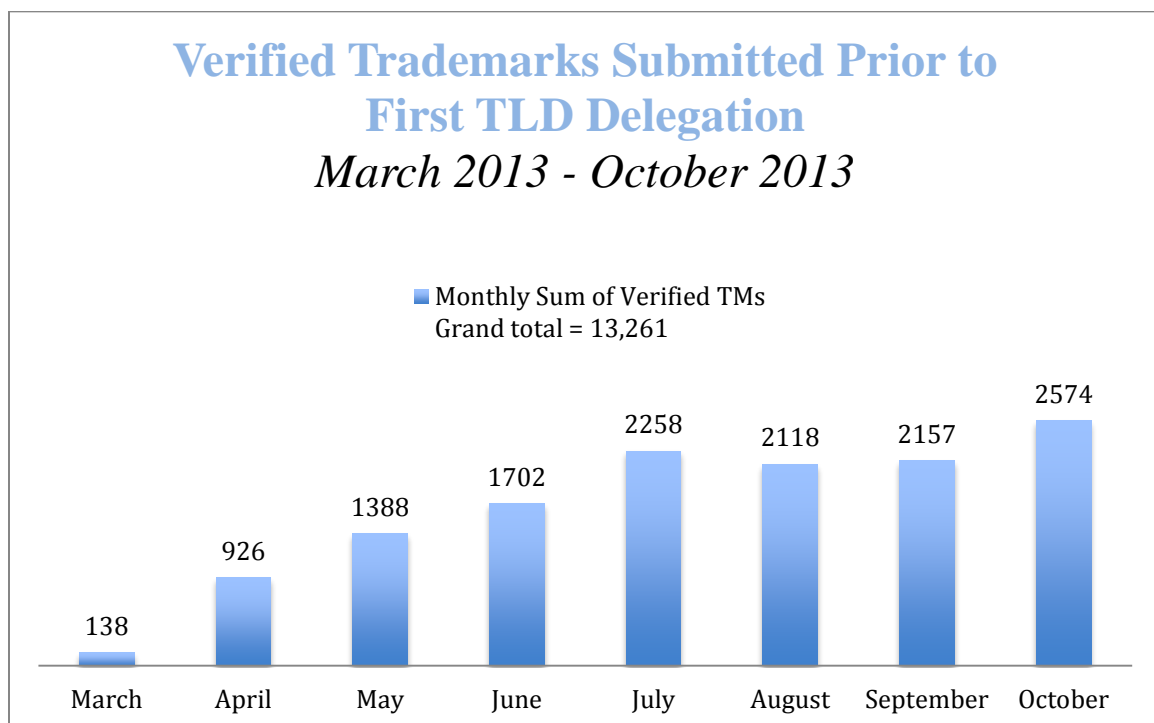


Figure 3-2
Source: Deloitte Monthly Trademark Activity Reports

As of 22 January 2015, Deloitte reported 34,400 marks submitted to the Clearinghouse from 118 jurisdictions, for a total of 85,952 trademark years (a trademark record can be recorded for 1, 3, or 5-year terms). While a one-year registration requires the renewal of a record, when recording a trademark record for three or five years the trademark record will automatically be renewed.

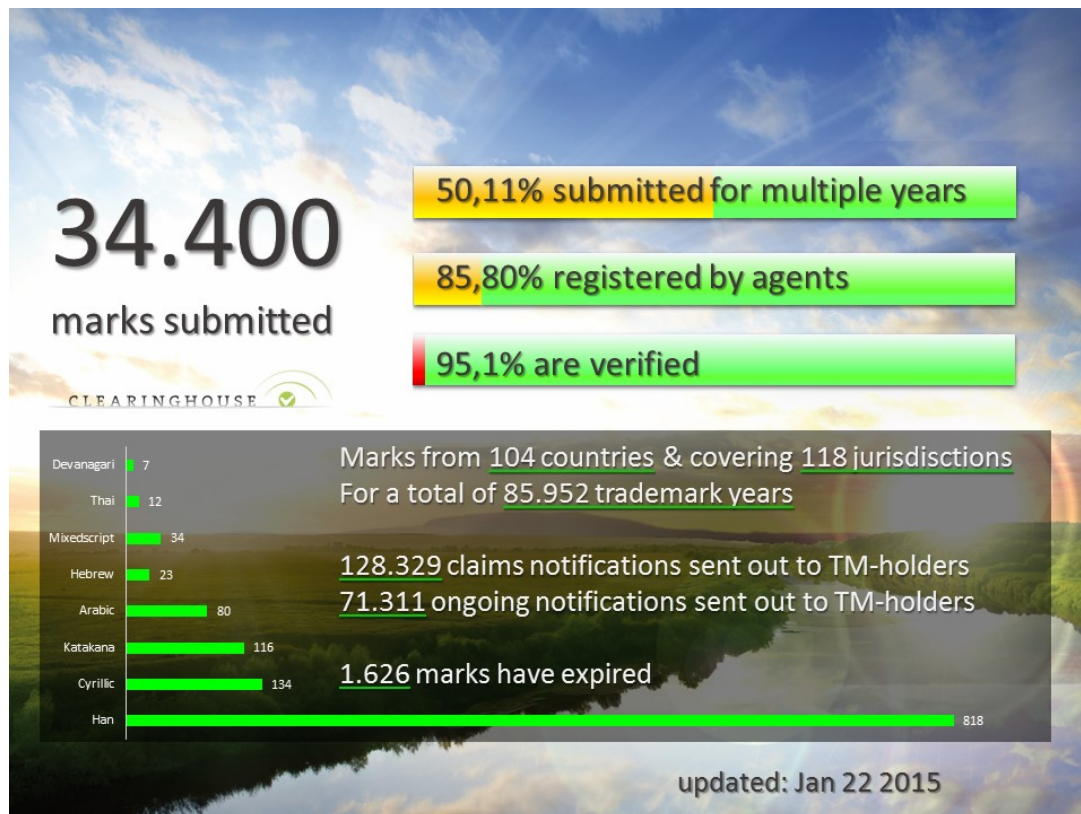


Figure 3-3

Source: [Clearinghouse stats-page](#)

3.1 Trademark Verification Process

The first step towards inclusion of a trademark in the Clearinghouse is the verification process. During this process, the Clearinghouse must obtain sufficient information to confirm the validity of the submitted trademark as well as the trademark holder contact information. To confirm the validity of trademarks, the relevant information must be provided according to the type of trademark. It is important to note that the Trademark Clearinghouse does not make legal

determinations concerning trademark rights, but functions as a repository of verified trademark data.

Figure 3-4 below shows a monthly breakdown of successfully verified trademarks that have been submitted into the Clearinghouse since it opened in March of 2013:

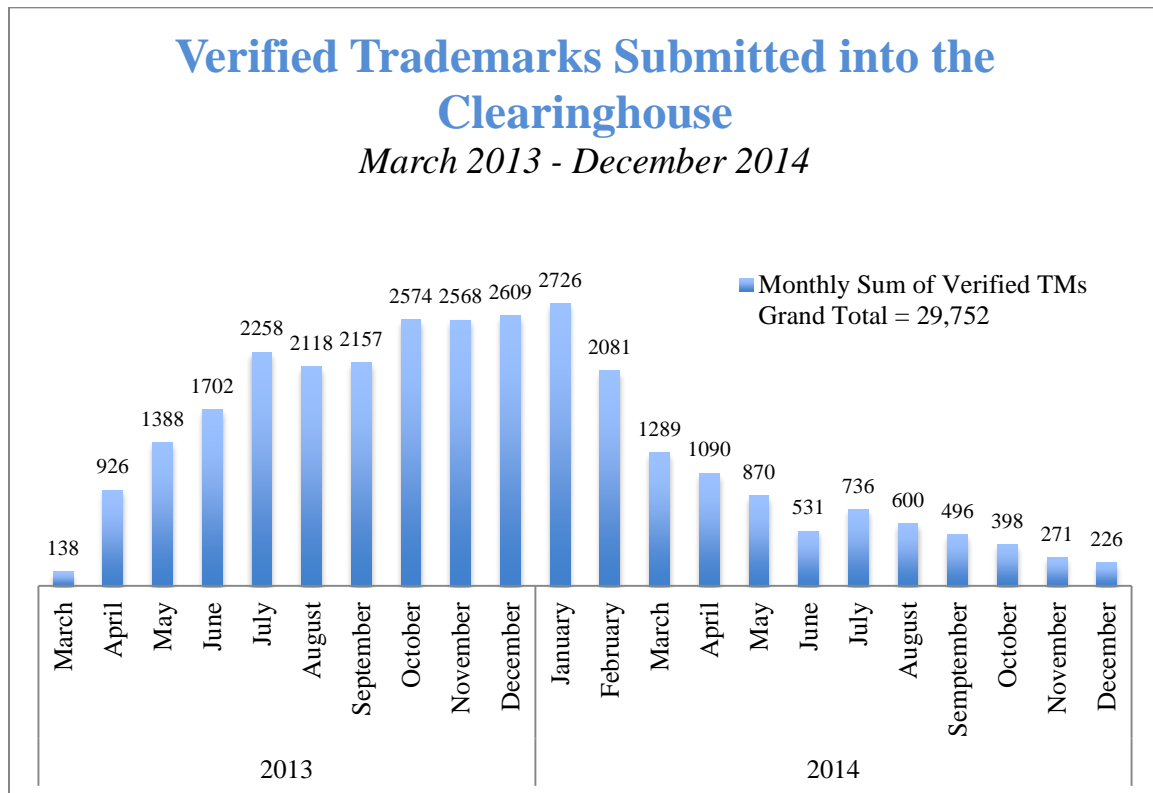


Figure 3-4

Source: Deloitte Monthly Trademark Activity Reports

The basic fee for verification is USD 150 per trademark record per year. The advanced fee structure offers discounted pricing based on volume, as low as USD 95 per registration. See <http://trademark-clearinghouse.com/content/trademark-clearinghouse-fees>.

The Clearinghouse accepts and verifies the following types of intellectual property rights:

- (i) nationally or regionally registered trademarks;
- (ii) court-validated marks; and
- (iii) marks protected by statute or treaty (such as geographical indications)

or designations of origin).

In addition, the Clearinghouse may accept and verify other types of marks upon the request of individual registries. To date, no such requests have been received.

In each case, the trademark information submitted is reviewed by the Trademark Clearinghouse and confirmed against the records in the relevant jurisdiction. Detailed Clearinghouse Guidelines are at <http://trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2.0.pdf>. If sufficient information is provided and the trademark record meets the requirements, the trademark is eligible for inclusion in the Clearinghouse and will receive access to the Claims services. Furthermore, if a registered trademark has also been verified for proof of use (see section 3.3 below), it is eligible to participate in Sunrise periods.

Between March 2013 and December 2014, the Clearinghouse verified and accepted for inclusion 30,237 nationally or regionally or registered trademarks, 42 trademarks protected by statute or treaty, and two court-validated trademarks.

The majority of the verified trademark records in the Clearinghouse are nationally or regionally or registered trademarks. Table 3.1 below lists the top 20 jurisdictions for registered trademarks, according to number of records accepted for inclusion in the Clearinghouse between March 2013 and December 2014.

Jurisdiction	Verified Registered Trademarks
1. United States	11,747
2. European Trademark Office	5,556
3. France	1,567
4. World Intellectual Property Organization	1,773
5. Germany	1,356
6. United Kingdom	1,196
7. Australia	847
8. Japan	689
9. Spain	681
10. Canada	671

Jurisdiction	Verified Registered Trademarks
11. China	613
12. Benelux Trademarks and Designs Office	471
13. Sweden	306
14. Switzerland	297
15. New Zealand	180
16. Hong Kong	167
17. Italy	159
18. South Africa	153
19. Russian Federation	145
20. Denmark	121

Table 3-1

Source: Deloitte Monthly Trademark Activity Reports

Figure 3.4 below illustrates the proportion of marks that were verified and accepted by the Clearinghouse versus marks that were not verified and thus ineligible for inclusion in the Clearinghouse, out of the total number of marks submitted, for the period March 2013 through December 2014.

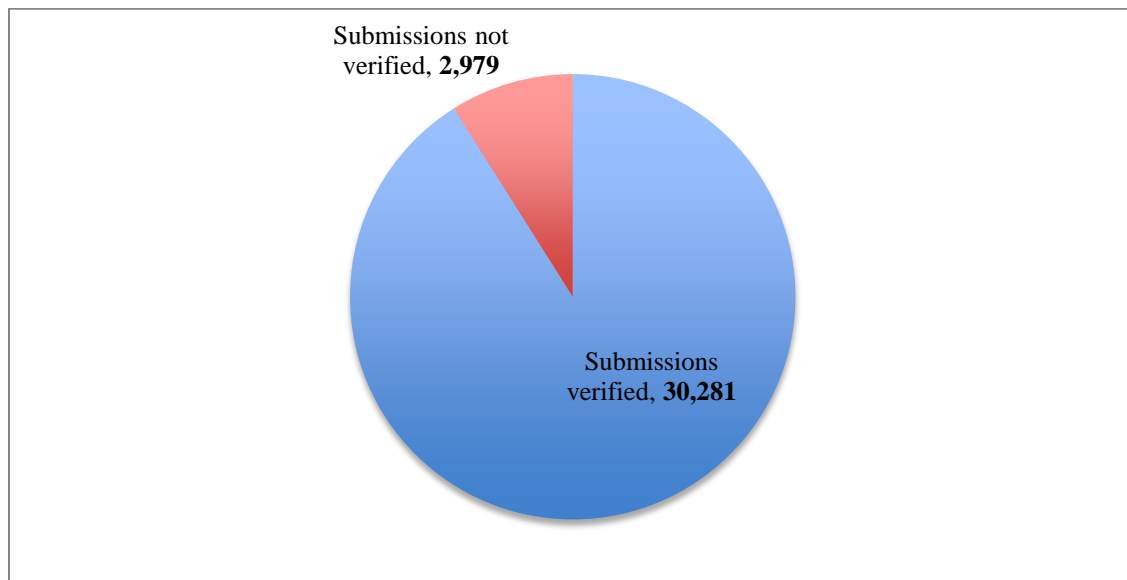


Figure 3-4

Source: Deloitte Monthly Trademark Activity Reports

Verified Registered Trademarks	30,237
Verified Trademarks Protected by	42

Statute or Treaty	
Verified Court-Validated Trademarks	2
Submissions Not Verified	2,979
Total submissions	33,260

Table 3.2 below is a customer service ticket summary chart illustrating the sum and types of complaints received by the Clearinghouse. As reported by Deloitte, the overall error rate in submissions is approximately 19.3% and the average length of time that it takes to fix an incorrect submission is 26 days.

Ticket Summary	Count
API Issues	431
Claims Notification Issue	243
Other Issues	2,178
Profile Management Issues	496
Sunrise File Issues	898
Sunrise Notification Issues	112
Trademark Management Issues	3,513
Grand Total	7,871

Table 3-2

Source: Deloitte Ticket Summary Report

3.2 Trademark Clearinghouse Guidelines

The Trademark Clearinghouse Guidelines describe the eligibility requirements for inclusion of trademarks in the Clearinghouse and for participation in Sunrise and Trademark Claims services. These Guidelines were drafted based on the requirements specified for the Clearinghouse in the gTLD Applicant Guidebook and are intended to provide users an overview of the eligibility requirements and what type of marks are accepted for inclusion in the Clearinghouse. Specific areas of the Guidelines where ICANN has received feedback and questions to date are enumerated below.

3.2.1 Treatment of Marks across Jurisdictions

In the development of the New gTLD Program, numerous discussions took

place with a wide range of stakeholders regarding the types of marks that should be eligible for inclusion in the Clearinghouse, including the standard for the proof of use requirement for trademark holders to qualify for participation in the Sunrise domain name registration processes.

A significant consideration in these discussions was the principle that mark holders around the world should undergo the same verification process, rather than imposing different types of scrutiny according to where a trademark was registered. An early iteration of the Trademark Clearinghouse proposal included different procedures for marks based on whether they were granted by a jurisdiction that employed “substantive review” in granting the trademark, or a jurisdiction that did not. This approach was modified in response to concerns that rights holders from certain jurisdictions might undergo a more burdensome verification process for admission into the Clearinghouse than others, similarly situated, in other jurisdictions.

ICANN has received feedback that inclusion of marks from some jurisdictions in the Trademark Clearinghouse may be problematic as it could lead to gaming of the Sunrise period, for example, by parties “forum shopping” to seek trademark protection for generic terms or highly sought-after terms. Additionally, ICANN has received questions about verification standards and generic marks.

Generic terms are common words or terms that identify a general class of products and services and are not specific to any particular source. For example, “soymilk” is a generic phrase that describes a kind of milk; it defines the product itself rather than its source.

However, it should be noted that what is generic in one context may not be in another; for example, the trademark “Windows” might be generic for windows, but not for software. Laws differ per jurisdiction as to what is considered generic or eligible for protection. As the Clearinghouse records marks from any jurisdiction, it accepts all marks that meet the criteria in the Guidelines. Clearinghouse processes are designed to verify trademark information as it has been issued by the

authorities in the various jurisdictions; the Clearinghouse does not play the role of trademark examiners.

ICANN has also received feedback suggesting employment of a date restriction for entry into the Trademark Clearinghouse, e.g., marks issued after a particular date would not be accepted. While this would eliminate the possibility of parties registering marks to try to claim domain names in certain TLD sunrises, it would also prohibit any new marks from receiving this protection.

With this in mind, community input is being requested on the verification standards for inclusion of trademarks in the Clearinghouse.

3.2.2 Word Marks

Section 5.2.1 of the Guidelines describes how the name of a mark is verified:

In order to determine whether the recorded name of the Trademark is identical to the reported name of the Trademark, Deloitte will apply the following rules:

1. *For a Trademark exclusively consisting of letters, words, numerals and/or special characters: The recorded name of the mark is an identical match to the reported name as long as all characters are included in the Trademark Record provided to the Clearinghouse, and in the same order in which they appear on the Trademark certificate.*
2. *For marks that do not exclusively consist of letters, words, numerals, special characters: The recorded name of the Trademark is an identical match to the reported name as long as the name of the Trademark includes letters, words, numerals, keyboard signs, and punctuation marks (“Characters”) that are:*
 - *predominant; and*
 - *clearly separable or distinguishable from the device element; and*
 - *all predominant characters are included in the Trademark Record submitted to the Clearinghouse in the same order they appear in the mark.*

The Guidelines are designed for review of trademark submissions according to a standard that does not favor one jurisdiction over another. ICANN has received

feedback that only “word marks” as defined by a particular jurisdiction should be accepted in the Trademark Clearinghouse. While there is no generally accepted or international definition of a word mark, there are multiple laws that distinguish between a mark that is comprised of characters versus a mark that protects the manner in which those characters are presented.

There are over 100 definitions of a “word mark” across trademark jurisdictions. Because trademark rights are regional in nature, what qualifies for protection in one place, may not in another. The territorial component of trademark rights does not lend itself to any one definition of universal applicability. For example, the World Intellectual Property Organization (WIPO) does not define a “word” mark, nor do any of the decisions of the UDRP.

While trademark laws make various distinctions between “word marks” and design or figurative marks, a domain name can only be presented in plain text. A review of UDRP case law indicates that the analysis of whether a domain name is confusingly similar in terms of a mark that incorporates graphic or design elements occurs on a case by case basis. Trademark law seeks to prevent consumer confusion. That is, the likelihood that consumers would perceive an association where none exists is dependent on case by case analysis.

Relying on multiple different definitions of types of marks per submission would further complicate the verification process and could also lead to a preferential bias toward one jurisdiction or another. Thus, it is important that the guidelines be clear in order to avoid any misinterpretation issues when authenticating or validating a specific mark.

ICANN seeks feedback on the Clearinghouse Guidelines, including recommendations for additional considerations that could be applied.

3.2.3 The “dot” Rule

As provided in the gTLD Applicant Guidebook, the Clearinghouse will generally not accept marks that include top-level domains such as “icann.org” or “.icann” or marks starting with a “dot” (.) or containing a “dot” (.).

This prohibition does not apply, however, to registered trademarks including a “dot” when the dot functions as: punctuation (e.g., period), an abbreviation, or a figurative part of the registered trademark.

The verification agents of the Clearinghouse examine the function of a “dot” character contained in a trademark and apply the rule accordingly.

Whether a “dot-TLD” mark (e.g., ICANN.ORG or .ICANN) should be included in the Clearinghouse was the subject of discussion during the development of the Clearinghouse. The Clearinghouse is designed to be a repository for trademarks. To fulfill the objectives of the Clearinghouse as a repository for trademarks, the goal is that those marks that actually function as trademarks, i.e., indicate source, are those that will be eligible for inclusion. Many safeguards have been established to prevent abuse and to ensure neutral application of validation standards, including objectively verifiable data.

Generally speaking, TLDs standing alone do not serve the trademark function of source identification. Instead of telling consumers "what" a product is or who makes it, they tell consumers where to get it. Because the TLD, standing alone, does generally not indicate source, and because it was believed that allowing marks in the Clearinghouse that include a TLD would increase the potential for confusion, abuse and gaming, on balance they were excluded as the most conservative approach.

ICANN has received feedback that there should be no prohibition on the “dot” character and that marks such as “.icann” and “icann.org” should be accepted, as the rule excludes a number of active trademarks. Consideration of domain names with regard to trademarks is an evolving area: for example, the United States Patent and Trademark Office (USPTO) developed instituted a rule change in its Trademark Manual of Examining Procedure relating to marks composed, in whole or in part, of domain names. See section 1215 of the Manual at

http://www.uspto.gov/trademarks/resources/TMEP_archives.jsp.

3.3 Proof of Use

Proof of use is required to qualify for participation in Sunrise domain name registration processes. Throughout the development of the Program, numerous discussions took place between the GAC, the Board, and stakeholder groups regarding the standard for the proof of use requirement for trademark holders.

With respect to the issue of whether demonstration of use should be required in various new gTLD RPMs, on 23 February 2011, the [GAC recommended](#) to the Board that trademarks from all jurisdictions should be treated equally, specifically, that “All trademark registrations of national and supranational effect, regardless of whether examined on substantive or relative grounds, must be eligible to participate in the pre-launch sunrise mechanisms.”

After listening to the GAC and others, the Board agreed that “substantive examination” or “substantive evaluation” should not be included in the Guidebook as it relates to RPMs. However, the Board specified that a registered trademark holder must demonstrate current use of the mark to be entitled to take advantage of some (but not all) RPMs. ICANN described in more detail the rationale for employing a proof of use standard to be eligible for Sunrise protection in an [explanatory memorandum](#) published in 2011.

As described in the memorandum, requiring demonstration of use from all registered trademark holders is intended to help ensure that all registered trademarks receiving the same type of advantage from a particular RPM are evaluated at substantially the same level. In other words, all registered trademarks are treated equally. This requirement is intended to ensure that only holders of marks that demonstrate “use” are given the exclusionary right of Sunrise eligibility, in order to prevent abuses and provide equal treatment to all rights holders. This requirement is intended to benefit trademark holders in that it helps a trademark holder that has truly used its mark to identify and distinguish its products or services from others.

To be verified for proof of use in order to participate in Sunrise services, a

Clearinghouse submission must include a signed declaration of use and a single sample of use, which are uploaded into the Clearinghouse interface with the trademark record submission. The text of the required declaration of use is included below:

[Name of submitting party] hereby certifies that the information submitted to the Clearinghouse is, to the best of [Name of submitting party] knowledge, complete and accurate, that the trademarks set forth in this submission are currently in use in the manner set forth in the accompanying specimen, in connection with the class of goods or services specified when this submission was made to the Clearinghouse; that this information is not being presented for any improper purpose; and that if, at any time, the information contained in this submission is no longer accurate, the [Name of submitting party] will notify the Clearinghouse within a reasonable time of that information which is no longer accurate, and to the extent necessary, provide that additional information necessary for the submission to be accurate. Furthermore, if any Clearinghouse-verified mark subsequently becomes abandoned by the Trademark Holder, the Trademark Holder will notify the Clearinghouse within a reasonable time that the mark has been abandoned, or has been the subject of successful opposition, invalidation, cancellation, or rectification proceedings.

A single sample of use must accompany this declaration. In establishing the list of accepted samples, the guiding principle used was that a sample should be an item that evidences an effort on behalf of the trademark holder to communicate to a consumer so that the consumer can distinguish the products or services of one from those of another.

Accordingly, examples of acceptable evidence include items from either of the following categories:

- A. Labels, tags, or containers from a product; or
- B. Advertising and marketing materials (including brochures, pamphlets, catalogues, product manuals, displays or signage, press releases, screen shots, or social media marketing materials).

Examples of samples not accepted as adequate proof of use include:

1. Inclusion of a trademark in a domain name;
2. Email messages;
3. Licenses to use a trademark or applications for business licenses that include the trademark as part of the business name; or
4. Business cards.

The sample submitted must contain the complete name of the registered trademark as issued by the relevant jurisdiction, and as verified by the Clearinghouse.

A registered trademark that has been verified for acceptable proof of use and thus has met the eligibility requirements for Sunrise as verified by the Trademark Clearinghouse (i.e., a “Sunrise-eligible rights holder”) has the opportunity to register domain names in new gTLD registries prior to the start of General Registration of domain names in the TLD. The trademark record that has been verified for proof of use will be issued a Signed Mark Data (SMD) file generated by the Clearinghouse. An SMD file is a token demonstrating that the Clearinghouse has verified minimum eligibility requirements for Sunrise; all registration of domain names during Sunrise periods must utilize SMD files. Essentially, having a verified trademark in the Clearinghouse gives rights holders the option to qualify for Sunrise eligibility by providing proof of use in order to participate in the Sunrise period, which is the maximum amount of protection offered by the Clearinghouse.

As shown by Figure 3-5 below, most rights holders submitting verified trademarks to the Clearinghouse (92%) also opted to have their marks verified for proof of use and be able to take advantage of the Sunrise period:

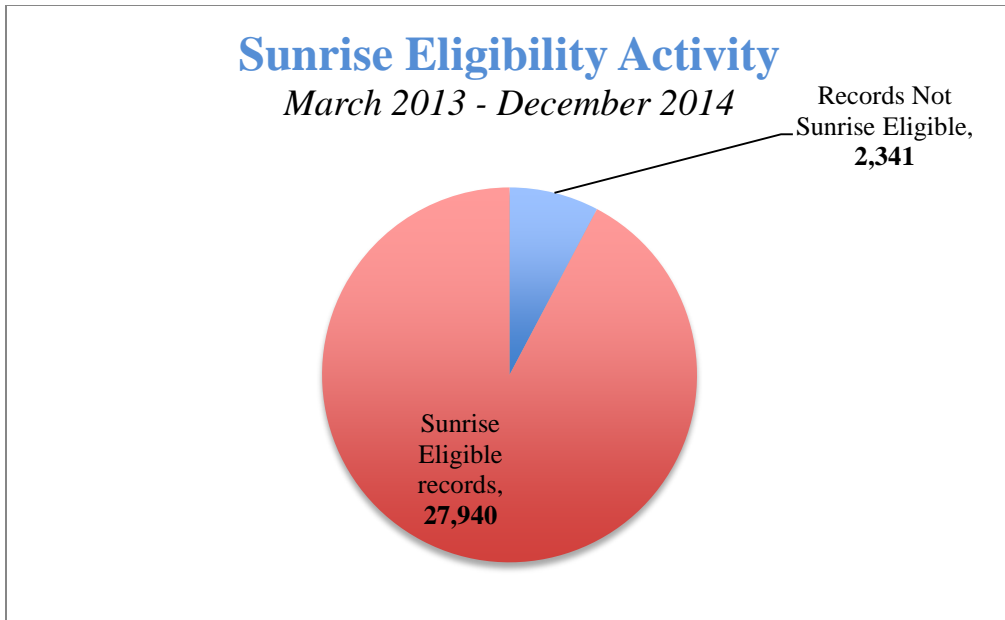


Figure 3-5
Source: Deloitte Monthly Trademark Activity Reports

In light of the above discussions on proof of use, community feedback is being requested concerning the experience with this requirement as part of Clearinghouse verification and Sunrise registration processes.

3.4 Matching Rules

When trademark information is submitted to the Clearinghouse, a set of matching domain names labels is generated, corresponding to that trademark record. The domain names associated with each Clearinghouse record are generated according to a defined set of matching rules.

The Clearinghouse database is structured to identify when a domain name is considered an “identical match” with the mark in the Clearinghouse. For purposes of the Sunrise and Trademark Claims services, “identical match” means that a domain name consists of the complete and identical textual elements of the mark. In this regard:

- (i) Special characters “@” and “&” contained within a trademark may be spelled out with appropriate words; and

- (ii) Other special characters contained within a mark that are unable to be used in a second-level domain name may either be: (a) omitted; or (b) replaced by hyphens.

Plural versions of a mark or domain names containing the mark are not considered an identical match for purposes of these services. The matching rules are intended to provide an objective, automatable way of determining a match, rather than the Clearinghouse making subjective determinations.

Up to ten domain names corresponding to one trademark record are included in the initial cost of verification by the Clearinghouse. If there are more than ten domain names corresponding to the record, the user can pay a fee to have those additional names associated with the record.

ICANN continues to receive feedback regarding the “identical match” definition, specifically, that ICANN should consider expansion of the matching rules to include plurals, “marks contained” or mark+keyword, and common typos of a mark. The scope of matching was one area identified by the GAC in [recommending an independent review](#) of the Trademark Clearinghouse, and this topic is expected to be explored in that review as well.

3.5 Misuse of Data

During the implementation of the Trademark Clearinghouse, some rights holders expressed concerns related to the aggregation of mark data through the Clearinghouse, such as possible exposure of their brand protection strategies or competitive intelligence. If the Clearinghouse database were to be freely searchable and accessible, it could be possible to identify a rights holder’s gaps in its intellectual property protection strategies.

For example, it might be possible to identify jurisdictions in which a rights holder has and has not registered its trademarks, or in which TLDs it has and has not chosen to defensively register domain names. In this regard, this information

could also be used for purposes such as conducting phishing or other types of social engineering attacks.

These concerns were taken into account along with the need for provision of access to registration service providers to this data. For example, registrars need to be able to present the relevant trademark data to potential registrants in claims notices, as well as the ability to confirm that the registrant's trademark data is verified and correct during the Sunrise period.

To minimize potential for abuse, the Clearinghouse was not designed to facilitate extensive searching to be done in a manner where a trademark holder's entire portfolio could be easily accessed. Furthermore, to balance implementation of the service with data misuse concerns, the Clearinghouse applies varying levels of technological and contractual restrictions depending upon the type of data accessed and the sensitivity of the data.

ICANN continues to receive questions about search and query functions and requests for Clearinghouse data, and seeks feedback on the potential risks and benefits of such functions.

3.6 Communications

As part of launching the Trademark Clearinghouse, strategic communications efforts were undertaken by ICANN, Deloitte, and IBM, as well as many others, including registrars and TLD applicants, to achieve the desired public understanding and awareness level regarding the Clearinghouse. The goal was to reach trademark holders worldwide to inform them of the services related to the Clearinghouse via webinars and Q&A sessions.

Webinar topics varied according to the Trademark Clearinghouse functions performed by ICANN, IBM, and Deloitte. Specifically, ICANN webinars focused mostly on RPMs, and on providing an overall view of the ongoing Clearinghouse activities. For unanswered questions during the webinar due to time constraints, a

Q&A document was published on the [webinar page](#) by ICANN following each discussion.

Accordingly, IBM webinars tended to be Trademark Database related, while Deloitte’s webinars were mainly centered on the topics of eligibility requirements and the verification process. In addition, Deloitte was available to partner with registries and engaged in joint efforts with several registries to help increase awareness of the New gTLD Program and the availability of the Clearinghouse to trademark holders.

In order to further improve communication, support registries and TLD applicants, and provide notice of new gTLD related information early on for public viewing, ICANN created the [TLD Startup Information - Sunrise and Claims Period](#) page on the New gTLD microsite. This page provides rights holders with the latest information on new gTLDs that have been delegated, such as important dates for the Sunrise period, Trademark Claims and other periods, registration requirements and additional information, such as policy documents. Similarly, Deloitte also added a [Sunrise Dates](#) page to assist rights holders in the domain name registration process in any of the new gTLDs that have launched.

Table 3-3 below includes the communications efforts by topics most frequently presented on by ICANN, IBM, and Deloitte in an effort to explain to the community the various Trademark Clearinghouse functions:

ICANN Webinars/Announcements	(Jun 2013 - Jan 2014)
New gTLD Program Update RPMs	4
URS	2
RPMs	1
Clearinghouse & IDNs	1
IBM Webinars/Announcements	(Jul2013 - May 2014)
General Sunrise & Claims	2
TMDB registration, configuration and testing for Registries	2
TMDB web client registration (Registrar)	2

TMDB Claims services for Registrars	4
Introduction to Abused Name Labels and impact on Claims	2
TMDB Explained	2
Deloitte Webinars	(Mar2013 – May2014)
Clearinghouse User Interface: pre-launch	1
Eligibility Requirements & Registration process	4
Clearinghouse Renewals	6
Clearinghouse Agents	5
Educational Webinars	11
Educational Webinars + Introducing a TLD	11
API Test Environment	1
Protecting your trademark in Internationalized Domain Names (IDNs) and new gTLDs	1

Table 3-3

Source: ICANN, Deloitte, IBM

Table 3-4 below shows the topics most frequently included in the Q&A documents posted on the [webinar page](#) following ICANN presentations:

Webinar Question Topics

ICANN Q&A	(June 2013 - January 2014)
RPM Requirements	20
Trademark Clearinghouse	11
Trademark Verification Process	11
SMD Files	4
Sunrise and Claims Processes	6
URS	1
TLD Startup Information process	1

Table 3-4

Source: [icann.org](#)

Below is a series of questions relating to the topics discussed in section 3. Public comment is encouraged on these questions as well as any other topics relevant to this section.

Section 3 Questions

- a. What were the challenges, if any, in terms of satisfying the requirements for trademark inclusion into the Clearinghouse?
- b. Were there any challenges related to marks from specific jurisdictions in relation to the Clearinghouse guidelines?
- c. Was the verification process successful in restricting non-eligible trademarks?
- d. What factors could be considered to make the trademark verification process more effective?
- e. What factors could be considered to make the process of updating Clearinghouse records more effective?
- f. Did the Clearinghouse structure successfully balance implementation of the services with data misuse concerns?
- g. Do the Clearinghouse benefits outweigh the concerns about distribution of data?
- h. Were any issues identified relating to misuse of Clearinghouse data?
- i. Was the proof of use requirement helpful in meeting the goals of a creating a standard that accommodates practices from multiple jurisdictions?
- j. What were the challenges, if any, in terms of satisfying the proof of use requirement?
- k. Was the proof of use requirement successful in restricting the Sunrise period to Sunrise-eligible rights holders?
- l. What factors could be considered to make this process more effective?
- m. Should the verification standards in the Clearinghouse Guidelines be adjusted in one or more areas?
- n. Could verification standards used by the Clearinghouse be adjusted to better serve rights holders in all global regions?
- o. To the extent that gaming is occurring, could this be prevented by modification to the verification standards?

4 Sunrise Period

The Sunrise period allows trademark holders an advance opportunity to register domain names corresponding to their marks before names are generally available to the public. Registration of domain names in the TLD during the Sunrise period is restricted to Sunrise-eligible rights holders, as demonstrated by an SMD file generated by the Trademark Clearinghouse.

New gTLD registries are required to offer a Sunrise period of at least 30 days. This can occur in line with one of two options:

- (i) In the case of a **Start-Date Sunrise**, the Registry Operator must provide the service for a minimum of thirty (30) calendar days prior to General Registration and must provide thirty (30) calendar days' notice prior to the start of the Sunrise period.
- (ii) In the case of an **End-Date Sunrise**, the Registry has no advance notice requirement; however, the Registry Operator must provide the service for a minimum of sixty (60) calendar days prior to General Registration, and must not use a time-based allocation method (e.g., first come, first served).

The majority of registries who have launched to date have offered an End-Date Sunrise, as shown in Figure 4-1 below.

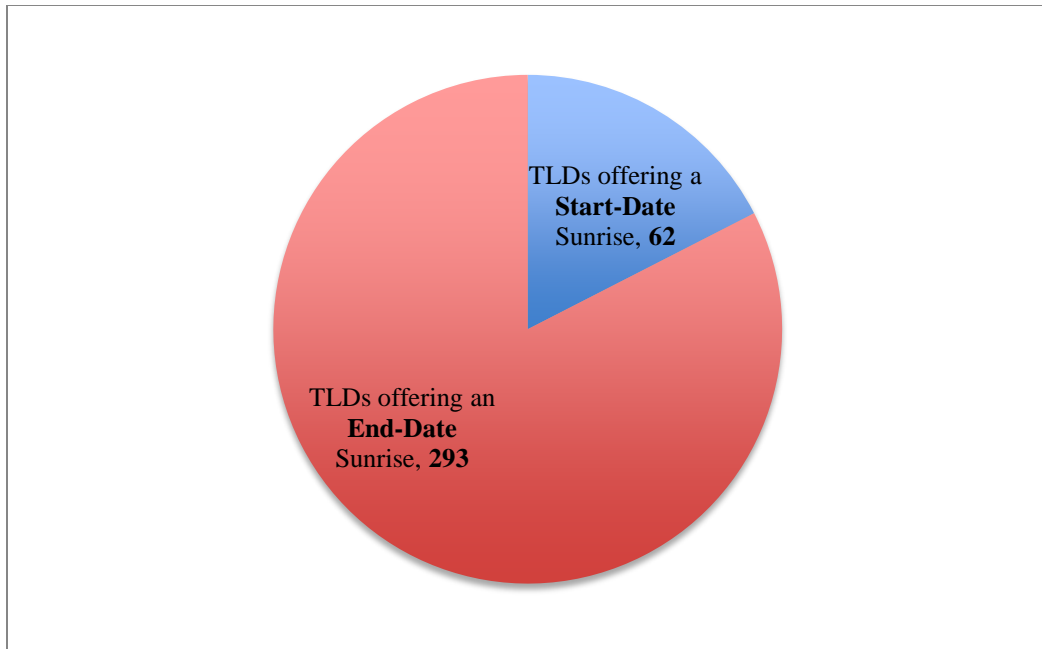


Figure 4-1

Source: TLD Startup Information submitted to ICANN

Although many previous TLD launches (for example, .ASIA, .MOBI, .XXX) included Sunrise periods, they were not mandatory. Rather, Registry Operators designed [Sunrise periods](#) in a variety of ways to fit their TLD models. With the introduction of a mandatory Sunrise period for all new gTLDs, ICANN worked with the community to create a set of [minimum requirements](#) for Sunrise processes, which are part of the obligations under the Registry Agreement.

Figure 4-2 below illustrates the number of monthly Sunrise period registrations in 2014, with an average of 3,383 registrations occurring per month:

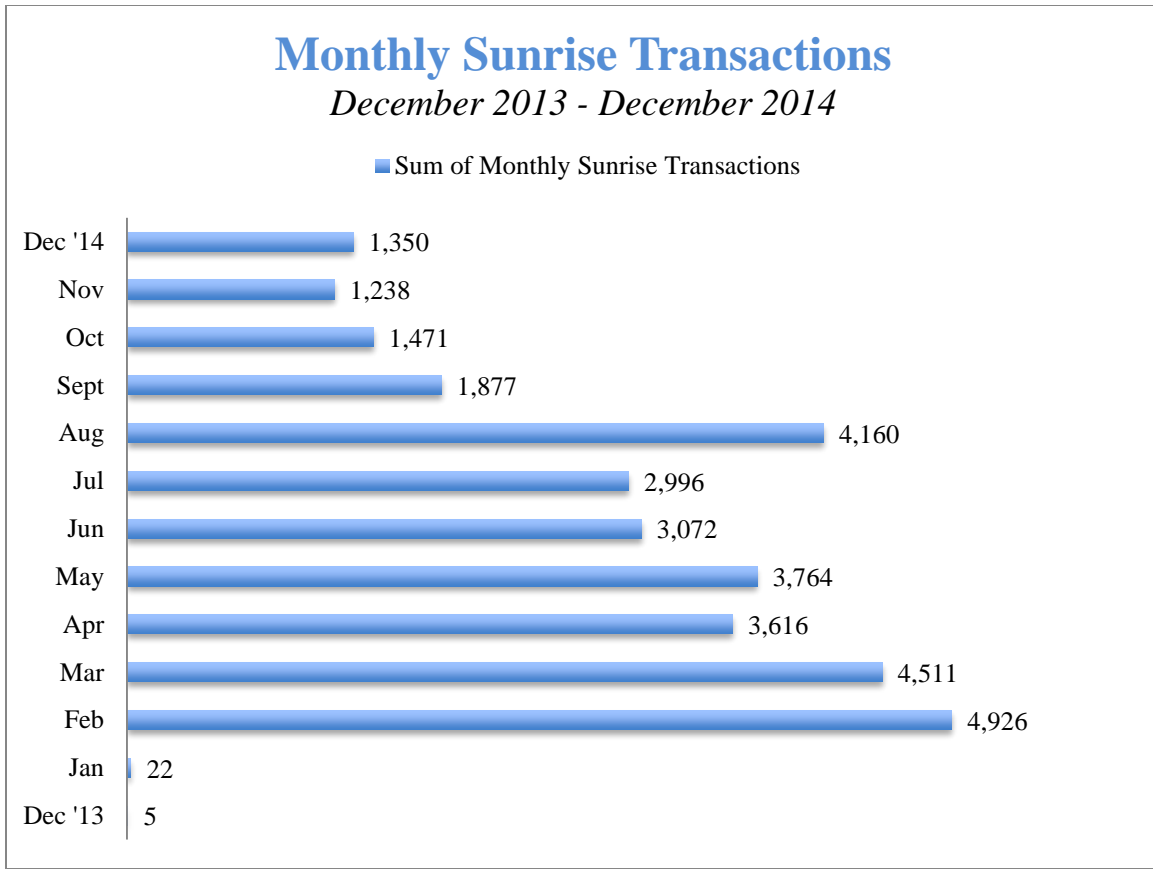


Figure 4-2
Source: IBM Monthly Invoice

Sum of TLDs with initiated Sunrise period	297
Sum of Sunrise Transactions	33,008

Table 4-1 below shows the gTLDs with the largest number of registrations occurring during the Sunrise period for the reporting periods between October 2013 and September 2014:

TLD	Sunrise Transactions
1. London	715
2. clothing	676
3. website	633
4. luxury	522
5. nyc	482
6. international	479
7. company	469
8. Tokyo	462
9. club	450

10. boutique	432
11. technology	432
12. reviews	431
13. social	409
14. watch	401
15. global	396
16. shoes	394
17. email	378
18. community	372
19. careers	346
20. gift	346

Table 4-1

Source: IBM Monthly Invoice

4.1 General Feedback

A variety of feedback has been received to date in terms of challenges faced during the Sunrise period, from the perspective of Sunrise registrants. Primarily, ICANN received feedback that it is sometimes difficult to identify an eligible registrar for a particular TLD, suggesting that all registries should provide a list of accredited registrars on their websites.

Another issue expressed by the community concerns the prices being charged for domain name registrations during the Sunrise period. Some feedback indicates that rights holders may be turning down the option to participate in certain Sunrise periods due to the cost, including cases where a domain name might be subject to an auction or other allocation mechanism for premium names by the registry. One suggestion received to mitigate this issue involves requiring a registry to publish its list of premium names on its website. It may be noted that a set of recommended metrics for assessing the New gTLD Program concerns wholesale and retail prices, including practices during startup, renewal and later phases. An [economic study is planned](#) that will provide further analysis in this area.

Furthermore, concern was expressed over the communications relating to treatment of names on SLD Block Lists (associated with the [name collision issue](#)), during the Sunrise period, for example, a registrar informing a rights holder that the

name requested is unavailable and that it has been frozen by ICANN, without additional context.

Lastly, feedback has been received regarding other possible uses for the SMD file. An SMD file is similar to a password in the sense that it allows you to identify yourself and request an action that requires privileges to be executed. As described in section 3, in the domain name registration process, the purpose of an SMD is to show that the Clearinghouse has verified a mark, and that the minimum eligibility requirements have been met to request the registration of domain names during the Sunrise period of a TLD. Consequently, an SMD file could be a useful verification tool in many processes, such as providing proof of verification by a complainant submitting a URS case.

Essentially, the goal of the Sunrise period is to protect intellectual property rights by allowing the rights holders to request desired domain names before they are available to be registered by the general public. With this in mind, community feedback is being requested on the effectiveness of the Sunrise period and whether it has achieved what it was intended to do, as detailed in the questions at the end of this section.

4.2 Limited Registration Periods

A Limited Registration Period (LRP) is any registration period between the end of the Sunrise Period and the start of General Registration. (In some cases this is referred to as a “landrush” period, although this term is used in various ways and is not a defined term by ICANN. “Landrush” is also sometimes used to refer to an initial phase of General Registration. If a “landrush period” has eligibility requirements that limit the availability of domain names to registrants satisfying certain conditions, then the “landrush period” would be considered an LRP and not the beginning of General Registration.) LRPs are optional for registries. It is possible for an LRP to overlap with the Sunrise period, so long as all Sunrise registrations are allocated prior to any LRP allocations (i.e., a registry could accept requests for domain names meeting the LRP requirements during its Sunrise period,

but all eligible Sunrise registration requests would receive priority over LRP registration requests).

The LRP is intended to provide additional flexibilities for registries who may wish to make domain names available for registration during an early phase, usually to a closed group based on requirements other than trademark rights. As per the RPM requirements in the Registry Agreement, an LRP must have some registration restriction that limits domain names from being generally available to all registrants that are qualified to register domain names within the TLD. In addition, any registration during an LRP must be subject to the Trademark Claims services in the same manner as occurs during the mandatory Trademark Claims period.

Approximately 20% of new gTLDs launched to date have implemented an LRP, as shown below. On average, LRPs have lasted around 50 days with some domain names being auctioned or given out on a “first come, first-served” basis.

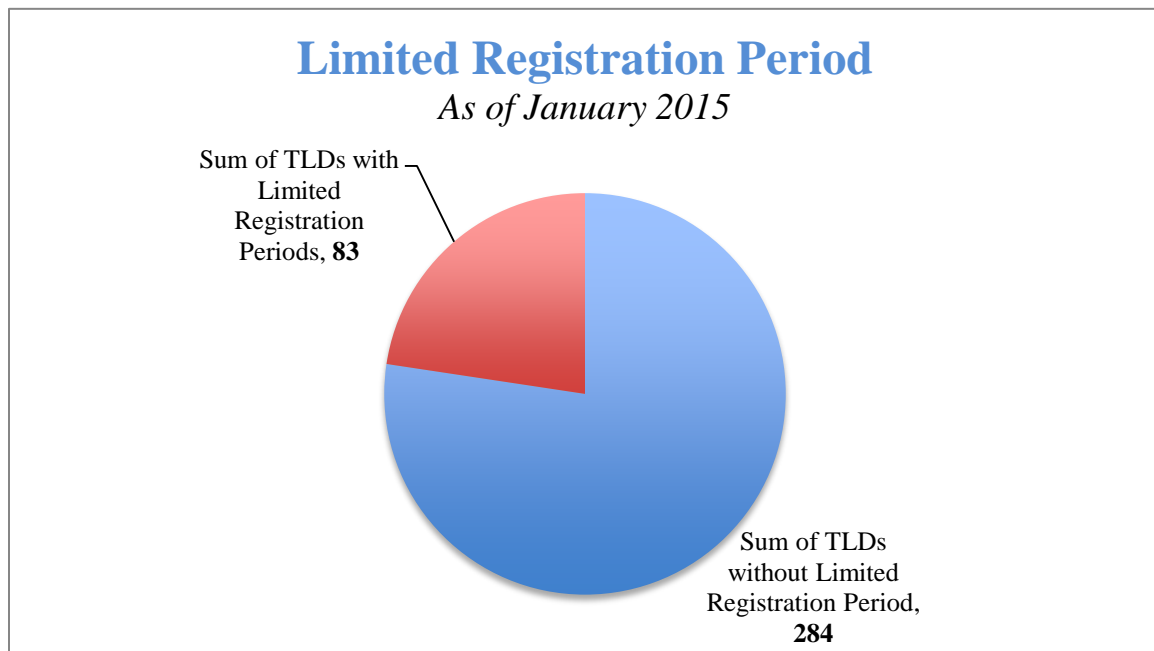


Figure 4-2
Source: TLD Startup Information submitted to ICANN

4.3 Approved Launch Programs & Qualified Launch Program

In regard to the requirements for Sunrise periods, ICANN has received feedback from registry operators requesting greater flexibility and fewer restrictions as to how to set up TLD launch processes. In many cases, registries believed they were hampered by the requirement to grant Sunrise registrations priority over any other registrations in the TLD.

As provided for in the RPM Requirements, registries had the ability to submit a request for an Approved Launch Program (ALP). If a program was approved by ICANN according to this process, the Registry would be allowed to conduct a registration process not otherwise permitted under the Trademark Clearinghouse Requirements specified in the Registry Agreement. ICANN [posted a process](#) by which Registry Operators and applicants were able to apply for ALPs in November 2013. To date, ICANN has received 41 applications for ALPs. Common themes among many of the proposed launch programs included the desired allocation of domain names as additional marketing tools prior to Sunrise, and desired protections for “public authority” categories of names, such as subdivisions or districts of a city or region.

With this in mind, ICANN consulted with the community to develop a solution that would take into account these comments while retaining the required intellectual property protections. The result was to permit registries to use a limited number of names in connection with registry launch activities, so long as those names did not conflict with the rights protection mechanisms required by the Registry Agreement.

The [Qualified Launch Program](#) (QLP), launched on 10 April 2014, gives registry operators the opportunity to register up to 100 domain names to third parties prior to the Sunrise Period for purposes of promoting the TLD, under certain conditions. The QLP was developed to support the goals of a number of Launch Program applications received by ICANN and was intended to be a more efficient mechanism than asking registries to apply individually for ALPs.

Under the QLP, a limited number of names may be allocated by the registry in advance of the Sunrise period. If a domain name matches a label in the Clearinghouse, the domain name may be registered to a Sunrise-eligible rights holder, as defined in the Trademark Clearinghouse Requirements. If a domain name does not match a label in the Trademark Clearinghouse, the domain name may be registered in a QLP to any third party. Names may also be registered to public authorities under the QLP, subject to certain requirements.

Out of the 41 Launch Program applications received, 10 of them successfully transitioned to a Qualified Launch Program and an additional 24 requests were received from registries seeking to run a Qualified Launch Program.

Sum of ALP applications	41
Sum of ALPs withdrawn/closed	39
Sum of pending ALP applications	2
Sum of ALPs that transitioned to QLP	10
Sum of QLPs approved	34

4.4 Sunrise Dispute Resolution Policy

As specified in the Registry Agreement, each Registry Operator must provide a mechanism to resolve disputes regarding its registrations of Sunrise registrations. Each Registry Operator must develop a Sunrise Dispute Resolution Policy (“SDRP”) to allow challenges to Sunrise Registrations related to Registry Operator’s allocation and registration policies, including on the grounds that the domain name that was registered does not match the trademark record on which the Sunrise-eligible rights holder based its Sunrise registration. The SDRP is a required element of each registry’s TLD Startup Information and is published on ICANN’s website; however, registries are not currently required to report data relating to this policy, such as the outcome of disputes.

With this in mind, ICANN is seeking input from the community in order to better understand how this procedure is working. Feedback is being requested from registries and trademark holders regarding the effectiveness of the SDRP.

4.5 Reserved Names

ICANN has received a number of questions and comments on the topic of reserved names and their interaction with the required Sunrise period and RPM Requirements.

Under Section 2.6 of the Registry Agreement, registries have discretion to establish reserved name policies. Under Specification 5 to the agreement, a registry operator may activate in the DNS at all levels up to one hundred names necessary for the operation or the promotion of the TLD. As provided in the QLP (discussed above), registries may use some of the 100 names for allocation prior to Sunrise.

In addition, a registry operator may withhold from registration or allocate to itself names at all levels of the TLD. These names may not be activated in the DNS, but may be released for registration to another person or entity at Registry Operator's discretion.

Figure 4-3 below shows the provisions regarding reserved names under Specification 5 as well as the provision for QLP names under Specification 7.

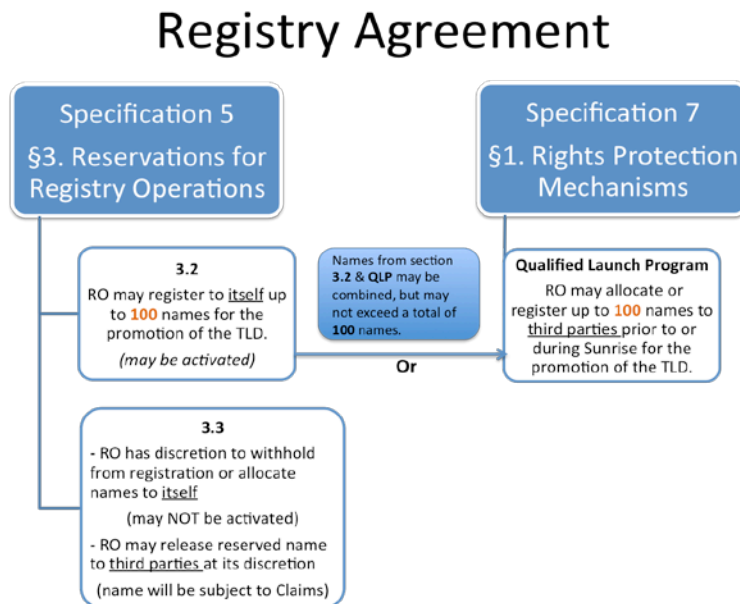


Figure 4-3
Source: ICANN

All domain names that are released from reservation for registration are subject to Section 2.4.3 of the Trademark Clearinghouse Rights Protection Mechanism Requirements. Under section 2.4.3 of the RPM Requirements, a reserved name released during the Claims period must be subject to the Claims service. If a reserved name is released after the Claims period, it must also be subject to the Claims service for 90 days. The Claims service will result in a notification of registered name (NORN) to any rights holders with matching records in the Trademark Clearinghouse. The Claims requirement was put in place to ensure a minimum level of protection, especially if a reserved name is allocated to a third party without having been available for the Sunrise period.

ICANN has heard some concerns over the technical feasibilities of operating a Claims period for reserved names that are released at a later date,

Additionally, ICANN has heard concerns over the discretion of registries to reserve names and release them at a later time, thus potentially deliberately circumventing the Sunrise period. ICANN has received suggestions such as limitations on the number of names that can be reserved, and establishing procedures for challenges to a registry's reserved names list, or time constraints on activating previously reserved names. Community input is being requested on the considerations relating to reserved names.

Below is a series of questions relating to the topics discussed in section 3. Public comment is encouraged on these questions as well as any other topics relevant to this section.

Section 4 Questions

- a. How effective is the Sunrise period for protecting intellectual property rights?
- b. Are the Start-Date Sunrise and End-Date Sunrise alternatives useful?
- c. What were the challenges, if any, in terms of registering a domain name during the Sunrise period?
- d. What factors can be addressed to make Sunrise processes more effective?

- e. Did having a set of Sunrise minimum requirements across TLDs provide for increased efficiencies in registration processes? Were there advantages and disadvantages to the required Sunrise for rights holders? For Registry Operators?
- f. Did the use of SMD files help streamline the process? Were there any technical issues encountered, and if so, what were they?
- g. Is there an appropriate balance of registry discretion to reserve names from registration and the inclusion of names in the required RPMs? Should additional considerations be applied around registry allocation practices and their interaction with the required RPMs?
- h. Were Limited Registration Periods a useful part of registry launch processes?
- i. What were the challenges, if any, in terms of registering domain names during Limited Registration Periods?
- j. Did registries find that registrants took advantage of Limited Registration periods?
- k. Was the QLP useful for registries in launching and promoting their TLDs? What were the challenges, if any, in terms of operating a QLP? What factors, if any, would make it more effective?
- l. Did the QLP succeed in maintaining safeguards against intellectual property infringement? Were any intellectual property infringement issues noted with regard to names issued as part of a QLP?
- m. Are there similar programs that could be built into TLD Startup processes that would support registry startup while maintaining safeguards against intellectual property infringement?
- n. How useful was the SDRP in resolving disputes?
- o. What were the most common types of disputes?
- p. What were the challenges, if any, in using the SDRP?
- q. What factors could be addressed to make Sunrise processes more effective?

5 Trademark Claims Service

The Trademark Claims period follows the Sunrise period and runs for at least the first 90 days of general registration. “General Registration” in a TLD is deemed to occur on the first day following the Sunrise Period in which domain names are generally made available to all registrants that are qualified to register domain names within the TLD.

During the Trademark Claims period for a TLD, anyone attempting to register a domain name matching a mark that is recorded in the Trademark Clearinghouse will receive a notification displaying the relevant mark information. The Claims Notice is intended to provide clear notice to the prospective domain name registrant of the scope of the Trademark Holder's rights. A sample Claims Notice is as follows:

TRADEMARK NOTICE

You have received this Trademark Notice because you have applied for a domain name which matches at least one trademark record submitted to the Trademark Clearinghouse.

You may or may not be entitled to register the domain name depending on your intended use and whether it is the same or significantly overlaps with the trademarks listed below. Your rights to register this domain name may or may not be protected as noncommercial use or "fair use" by the laws of your country.

Please read the trademark information below carefully, including the trademarks, jurisdictions, and goods and services for which the trademarks are registered. Please be aware that not all jurisdictions review trademark applications closely, so some of the trademark information below may exist in a national or regional registry which does not conduct a thorough or substantive review of trademark rights prior to registration. If you have questions, you may want to consult an attorney or legal expert on trademarks and intellectual property for guidance.

If you continue with this registration, you represent that, you have received and you understand this notice and to the best of your knowledge, your registration and use of the requested domain name will not infringe on the trademark rights listed below. The following marks are listed in the Trademark Clearinghouse:

1. Mark: Example One
Jurisdiction: UNITED STATES OF AMERICA
Goods and Services: Bardus populorum circumdabit se cum captiosus populum.
International Class of Goods and Services or Equivalent if applicable:
35 - Advertising; business management; business administration.
36 - Insurance; financial affairs; monetary affairs; real estate.
Trademark Registrant:
Organization: Example Inc.
Address: 123 Example Dr. Suite 100
City: Reston
State: VA
Postal Code: 20190
Country: US Trademark Registrant Contact:
Name: Joe Doe
Organization: Example Inc.
Address: 123 Example Dr. Suite 100
City: Reston

State: VA
Postal Code: 20190
Country: US
Phone: +1.7035555555x4321
Email: jdoe@example.com

This domain name label has previously been found to be used or registered abusively against the following trademarks according to the referenced decisions:

Decision Number: 234235
Court Name: Supreme Court of Justice of Costa Rica
Court Jurisdiction: CR

1. Mark: One Inc
Jurisdiction: ARGENTINA
Goods and Services:
Bardus populorum circumdabit se cum captiosus populum.
Smert populorum circumdabit se cum captiosus populum qui eis differimus.
International Class of Goods and Services or Equivalent if applicable:
35 - Advertising; business management; business administration.
36 - Insurance; financial affairs; monetary affairs; real estate.
Trademark Registrant:
Organization: One SA de CV
Address: La calle
City: La ciudad
State: CD
Postal Code: 34323
Country: AR
Phone: +54.5582269330
Email: contact@oneinc.com.ar

For more information concerning the records included in this notice, see <http://trademark-clearinghouse.com/content/claims-notice>.

If the notified party acknowledges the notice and proceeds to register the domain name, the Trademark Clearinghouse will send a notice to those trademark holders with matching records in the Clearinghouse, informing them that someone has registered the domain name.

The registrar must provide the Trademark Notice to the potential domain name registrant in English, as well as the language of the registrant's registration

agreement. Currently, the Trademark Notice is being offered in the 6 UN languages: Arabic, Chinese, English, French, Russian, and Spanish.

Between January and December of 2014, the reported numbers indicate a high percentage of Claims Notices generated as compared to the numbers of Claims transactions (that is, transactions where a domain name subject to Claims services was registered); however, the reasons for this are not known, e.g., registrants being dissuaded from the registration by Claims notices, use of the process as an alternative to other sources of trademark information.

Sum of TLDs with initiated Claims periods	297
Sum of Claims Transactions	96,471
Sum of Claims Notices Generated	25,221,479

Below is a graph illustrating the 20 gTLDs with the highest number of registrations occurring during the Claims period, for the reporting periods between October 2013 and September 2014:

TLD	Claims Transactions
1. club	3,431
2. xyz	2,530
3. nyc	2,302
4. wang	1,998
5. email	1,934
6. guru	1,639
7. link	1,421
8. moscow	1,283
9. london	1,279
10. tips	1,180
11. clothing	1,147
12. click	1,060
13. company	1,043
14. photography	1,019
15. today	970
16. bike	932
17. technology	927
18. top	905

TLD	Claims Transactions
19. rocks	891
20. solutions	863

Table 5-1

Source: IBM Monthly Invoice

5.1 General Feedback

ICANN has not received extensive feedback relating to the Claims period to date. Positive comments were received in regard to the Claims service continuing beyond the initial Claims period. Suggestions for improving this service included providing a history of notices to clients. In other words, it might be useful if the Clearinghouse were to create a query or search function in order to provide right holders access to this information if needed. Additionally, ICANN has heard concern expressed over the Claims notices being inappropriately worded, and suggestions that some registrars may be acknowledging notices without having displayed them to the registrants.

5.2 Inclusion of Previously Abused Labels

The inclusion of up to 50 previously abused labels (sometimes referred to as “plus 50”) was also implemented to strengthen trademark protection available through the Clearinghouse. Community stakeholders helped develop the Trademark Clearinghouse “Strawman Solution” in November 2012, which included this element. The discussion leading to this proposal was convened to address feedback and comments from several stakeholders in relation to the RPMs in the New gTLD Program.

This component was an add-on to the Claims service, whereby up to 50 abused domain labels that have been found to be the subject of abusive registrations on the basis of a verified UDRP proceeding or court proceeding may be added to a Clearinghouse record. These names may be mapped to an existing record where the Clearinghouse has already verified the trademark. Attempts to register domain

names matching these labels will generate the Claims notices as well as the notices to the rights holder if the registration proceeds.

Domain names based on previous findings of abuse are accepted only for association with an existing Clearinghouse record, and only on the basis of a determination made under the UDRP or national laws. Additionally, the provision of notifications concerning associated domain names is limited to the Claims service only: the addition of previously abused labels does not provide eligibility for Sunrise or other priority registrations, nor does it have a blocking effect on registration of these names by other parties. Rather, the names become the subject of notification under the Claims service.

Since the introduction of the Abused Domain Name Label service in [October 2013](#), 324 domain labels based on 158 cases have been added.

[Current costs](#) for this service range from USD 150-200 for verification of a court case, and USD50-75 for verification of a UDRP case, plus USD1 per label per year, and an additional USD25 when the Clearinghouse record is renewed.

ICANN has received some feedback in regard to the documentation required to verify UDRP cases. To verify that the mark that was the subject of the case is the same as the mark in the Trademark Clearinghouse record is difficult in some cases if the rights holder no longer has the UDRP or court filings or records, or where the trademark information was not included in the original complaints.

5.3 Extensions of Trademark Claims Service

The Trademark Claims service must be offered by the registry operator for at least the first 90 days of general registration (the “Trademark Claims period”). The Registry Operator must not shorten the duration of the Claims period; however, the Registry Operator may extend the duration of the Claims period.

The possibility of extending the Claims period gives registries the opportunity to offer the Claims service for a definite or indefinite amount of time (for example, a registry could offer the Claims service for the first 120 days of

registration, or it could offer the Claims service in its TLD indefinitely). In these cases, prospective registrants in the TLD continue to receive notifications of domain names matching marks in the Trademark Clearinghouse, and trademark holders continue to receive notices informing them when a matching domain name has been registered. To date, approximately 93% of registries have operated Claims periods for either the minimum 90 days or for up to a week of additional days, while a small percentage (7%) have offered longer Claims periods. Figure 5-1 below shows the number of registries who have offered the minimum Claims period and who have extended the Claims period beyond the minimum.

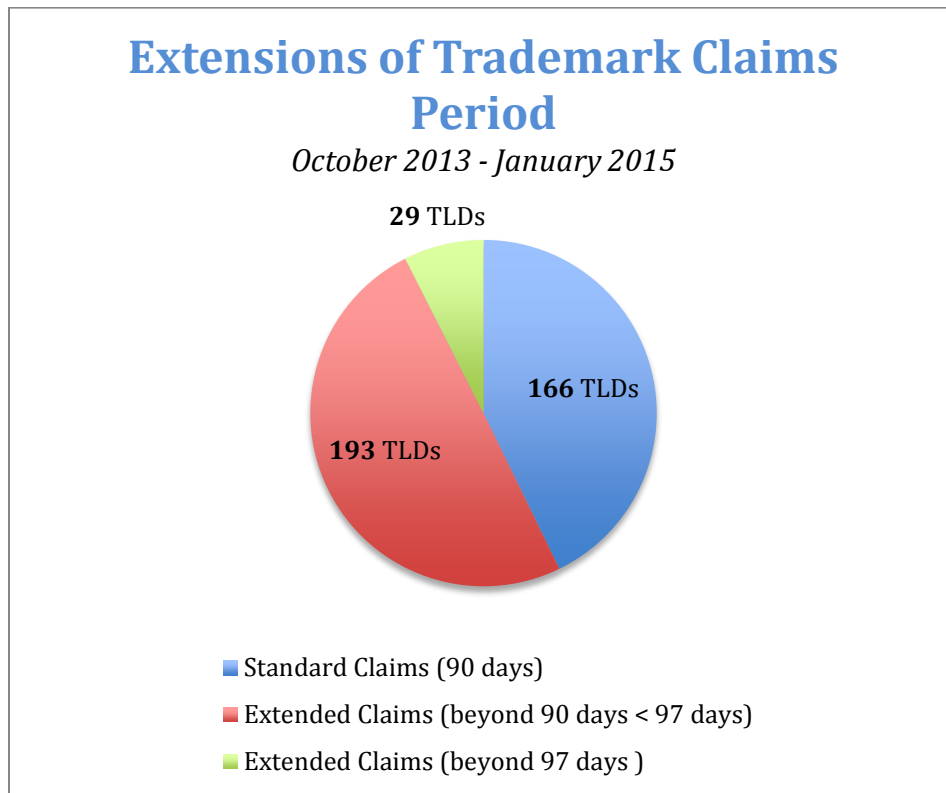


Figure 5-1
Source: TLD Startup Information submitted to ICANN

The Trademark Clearinghouse also offers an [Ongoing Notifications](#) service at no additional cost that informs the trademark holder whenever someone has activated a domain name in a new gTLD that matches a term that is recorded in

the Trademark Clearinghouse. When opting in to this service, the trademark holder will receive a notice informing them of the matching domain name, so the trademark holder can determine whether it wishes to take action. This is a non-mandatory service provided following the 90-day Claims Period for each new gTLD whereby trademark holders are notified of potential intellectual property infringement for an indefinite period of time beyond the required 90-day period. Deloitte provides this service to trademark holders and agents for the duration of their trademark record registration into the Trademark Clearinghouse regardless of whether the Registry Operator is offering an extended Claims period. As of October 2014, 500 users have opted to add this service.

Section 5 Questions

- a. Is the Claims notice an effective form of communication?
- b. For those with registrant/customer interactions, what has been the customer response to Claims notices?
- c. Were any technical issues identified relating to the Claims service?
- d. Is there any other piece of information that should be included in the Claims notice?
- e. How helpful is it to have the Trademark Notice in English and in the language of the registrant's registration agreement? Should additional language considerations be applied?
- f. How could the Claims service be improved?
- g. How useful are extended Claims services?
- h. What were the challenges, if any, in terms of extended Claims services?
- i. How effective is the inclusion of previously abused labels in protecting against trademark abuse and infringement?
- j. Should the standards for verification of previously abused labels be modified?
- k. How clear is the Notice of Registered Names to the trademark holder? Is there any other piece of information that should be included in the Notice of Registered Name?
- l. Is the Notice of Registered Names received in a timely manner?
- m. Did the Notice of Registered Names help trademark holders decide on next steps?

6 Uniform Rapid Suspension

Prior to the introduction of the Uniform Rapid Suspension (URS) procedure, the Uniform Domain-Name Dispute-Resolution Policy (UDRP) was the primary process established by ICANN for the resolution of disputes regarding the registration of domain names that infringe trademark rights.

Launched in 1999, the UDRP provides trademark holders an avenue to initiate a proceeding by electronically filing a complaint with an approved [UDRP provider](#). The cost to a complainant for a UDRP proceeding is approximately USD 1000-5000. Decisions can take up to two months, and those in favor of the person or entity that filed the complaint, result in either cancellation of the domain name registration or transfer of the domain name to that person or entity. The UDRP is applicable to all names registered in gTLDs as imposed through the Registrar Accreditation Agreement (RAA).

The URS was designed as a complement to the UDRP, to provide trademark owners with a quick and low-cost process to take down websites infringing on their intellectual property rights as well as to combat cybersquatting. Much like the UDRP, trademark holders may initiate a URS proceeding by electronically filing a complaint with a URS provider. To date, two providers have been approved for the URS: National Arbitration Forum ([FORUM](#)) and the Asian Domain Name Dispute Resolution Centre ([ADNDRC](#)). The fees associated with a URS proceeding range from USD300 - 500.

When a trademark holder files a URS complaint, the registry operator immediately locks the domain against changes. The provider then notifies the registrant against whom the complaint has been filed, who has 14 days to submit a response. Complaints listing fifteen or more disputed domain names registered by the same registrant are subject to a response fee, which is refundable to the prevailing party in the proceeding.

If there is no reply in 14 days, the complaint proceeds to default. All default cases proceed to examination for review on the merits of the claim. If the

determination is in favor of the complainant, the domain name will point to a mandatory URS placeholder page for the remaining time in the registration period, unless the decision is reversed. An example of this page is below:



A comparison of several elements of the URS with the UDRP is shown here:

Provision	URS	UDRP
Elements of Claim	<p>(1) The registered domain name is identical or confusingly similar to a word mark (a) for which the Complainant holds a valid national or regional registration and that is in current use, or (b) that has been validated through a court proceeding, or (c) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed;</p> <p>(2) The Registrant has no legitimate right or interest to the domain name; and</p> <p>(3) The domain was registered and is being used in bad faith. Art. 1.2.6.</p>	<p>(1) The domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights;</p> <p>(2) The Respondent (domain-name holder) has no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint; and</p> <p>(3) The domain name(s) was/were registered and being used in bad faith. Art. 4(a).</p>

Provision	URS	UDRP
<p data-bbox="232 237 448 300">Evidence of Bad Faith</p>	<p data-bbox="464 237 914 678">(1) Registrant has registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name;</p> <p data-bbox="464 720 914 993">(2) Registrant has registered the domain name in order to prevent the trademark holder or service mark from reflecting the mark in a corresponding domain name, provided that Registrant has engaged in a pattern of such conduct;</p> <p data-bbox="464 1035 914 1161">(3) Registrant registered the domain name primarily for the purpose of disrupting the business of a competitor; or</p> <p data-bbox="464 1203 914 1675">(4) By using the domain name Registrant has intentionally attempted to attract for commercial gain, Internet users to Registrant’s web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Registrant’s web site or location or of a product or service on that web site or location. Art. 1.2.6.3.</p> <p data-bbox="464 1717 914 1780"><u>Possible Additional Indicia of Bad Faith:</u></p> <p data-bbox="464 1822 914 1843">(1) Trading in domain names for</p>	<p data-bbox="930 237 1380 646">(1) Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the Registrant’s documented out-of-pocket costs directly related to the domain name;</p> <p data-bbox="930 688 1380 951">(2) Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant have engaged in a pattern of such conduct;</p> <p data-bbox="930 993 1380 1129">(3) Registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or</p> <p data-bbox="930 1171 1380 1644">(4) By using the domain name, Registrant has intentionally attempted to attract, for commercial gain, Internet users to Registrant’s web site or other on-line location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s web site or location or of a product or service on your web site or location. Art. 4(b).</p>

Provision	URS	UDRP
	<p>profit, and holding a large portfolio of domain names, are of themselves not indicia of bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute;</p> <p>(2) Sale of traffic (i.e. connecting domain names to parking pages and earning click- per-view revenue) does not in and of itself constitute bad faith under the URS. Such conduct, however, may be abusive in a given case depending on the circumstances of the dispute. Art. 5.9.</p>	
Defenses to Claim	<p>(1) Before any notice to Registrant of the dispute, Registrant’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;</p> <p>(2) Registrant (as an individual, business or other organization) has been commonly known by the domain name, even if Registrant has acquired no trademark or service mark rights;</p> <p>(3) Registrant is making a legitimate or fair use of the domain name, without intent for commercial gain to misleadingly</p>	<p>(1) Before any notice to Registrant of the dispute, Registrant’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services;</p> <p>(2) Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if Registrant has acquired no trademark or service mark rights; or</p> <p>(3) Registrant is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to</p>

Provision	URS	UDRP
	<p>divert consumers or to tarnish the trademark or service mark at issue;</p> <p>(4) The domain name is generic or descriptive and the Registrant is making fair use of it;</p> <p>(5) The domain name sites are operated solely in tribute to or in criticism of a person or business that is found by the Examiner to be fair use;</p> <p>(6) Registrant’s holding of the domain name is consistent with an express term of a written agreement entered into by the disputing Parties and that is still in effect;</p> <p>(7) The domain name is not part of a wider pattern or series of abusive registrations because the Domain Name is of a significantly different type or character to other domain names registered by the Registrant. Arts. 5.7-5.8.</p>	<p>misleadingly divert consumers or to tarnish the trademark or service mark at issue. Art. 4(c).</p>
Administrative Review	2 Business Days; Complaint Dismissed w/o Prejudice if Deficient. Arts. 3.2, 3.4.	3 Calendar Days; Complainant has 5 Calendar Days to Correct Filing if Deficient. Art. 4(a)-(b).
Registrant Response	14 Calendar Days from Date of Notice of Complaint to File Response. Art. 5.1.	20 Calendar Days from Commencement of Proceeding to File Response. Art. 5(a).
Response Extension	7 Calendar Days or Less Upon Request from Registrant. Art. 5.3.	No Express Limit for Extensions Upon Request from Registrant or Approved Stipulation of Parties. Art. 5(d).
Response Length Limit	2,500 Words or Less, Excluding Attachments. Art. 5.4.	No Express Length Limit. See Art. 5.
Examined By	1 Examiner, Selected By URS Provider. Art. 7.1.	1 Panelist, Selected by the UDRP Provider; or 3-Member Panel, at the Option of the Complainant or Respondent. If a 3-Member Panel is Requested,

Provision	URS	UDRP
		Each Party Submits a List of 3 Candidates to Serve as 1 Member of the Panel (1 Members Chosen by Complainant, 1 by Respondent, 1 by Provider); if 3-Member Panel Requested by Respondent, Respondent Shares Fees. Art. 4(e); UDRP Rules 3(b)(iv), 5(b)(iv)-(v), 5(c), 6.
Standard of Proof	Clear and convincing evidence that no genuine issue of material fact exists as to any of the elements of the claim. Arts. 8.2-8.3.	The complainant must prove that each of the three elements of the claim is present. Art. 4(a). A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable. UDRP Rule 15(a).
Decisional Timeframe	Within 3 Business Days and No Later Than 5 Business Days from the Start Date of the Examination, Absent Extraordinary Circumstances. Art. 9.6.	Within 14 Days of the Panel's Appointment, Absent Exceptional Circumstances. UDRP Rule 15(b).
Remedies	Suspension of the Domain Name for the Balance of the Registration Period, With the Complainant's Option to Extend the Period for 1 Additional Year. Arts. 10.2-10.3.	(1) Cancellation of the Domain Name; or (2) Transfer of the Domain Name Registration to the Complainant. Art. 4(i)
Appeals and Other Proceedings	Right of Either Party to <i>De Novo</i> Appeal, if Requested Within 14 Days of Default or Final Determination, by URS Appeal Panel Selected by URS Provider and Subject to Provider Appeals Rules; Either Party May Seek UDRP or Court Proceeding. Arts. 12.1, 12.4, 13.	Registrant or Complainant May Submit the Dispute to a Court of Competent Jurisdiction for Independent Resolution Before or After UDRP Proceeding is Concluded. Art. 4(k).
Status of Domain During Proceedings	Domain Immediately Locked Upon Complaint's Administrative Review Compliance; If Registrant Succeeds, Domain is Unlocked and Control Returned – Locked or Unlocked Status Resulting from Final	Status Quo Maintained Until Cancellation or Transfer Order is Received from Registrant or Its Authorized Agent, Court or Arbitral Tribunal, or UDRP Panel. Arts. 3, 7.

Provision	URS	UDRP
	Determination Persists During Appeal. Arts. 4.1, 10.5, 12.3.	
Fees	Set By Provider. Art. 2.1. Fees start at about \$350-\$500, and can rise to about \$1,300 depending on the provider chosen, the number of domain names involved, and whether there are re-examinations and/or appeals. Current approved URS providers are National Arbitration Forum and Asian Domain Name Dispute Resolution Centre.	<p>Set By Provider; Provider Schedules of Fees Contained in Provider Supplemental Rules. Art. 4(g).</p> <p>National Arbitration Forum: Base Fee of \$1,300 to \$4,500 for Proceedings Involving Up To 15 Domains. NAF Supplemental UDRP Rule 17.</p> <p>WIPO: Base Fee of \$1,500 to \$5,000 for Proceedings Involving Up To 10 Domains. WIPO Schedule of Fees under the UDRP.</p> <p>Arbitration Center for Internet Disputes (Czech Arbitration Court): Base Fee of \$500 to \$7,100 for Proceedings Involving Up To 50 Domains. UDRP Supplemental Rules of the Czech Arbitration Court, Annex A: Fee Schedule.</p> <p>Asian Domain Name Dispute Resolution Centre: Base Fee of \$1,300 to \$3,800 for Proceedings Involving up to 10 Domain Names. Fees Set by Individual Offices for Disputes Involving 10 Domain Names or More. ADNDRC Supplemental Rules: Schedule of Fees.</p>

Table 6-1

Source: James L. Bikoff, Smith, Gambrell & Russell

To date, approximately 200 URS complaints have been filed. Table 6-2 below includes monthly data from the current URS providers on the cases concluded, including the number of names suspended and the number of complaints denied

(Note that a case may involve more than one domain name).

As of Month End		Total	ADNDRC	FORUM
201404	Cases Concluded	19	2	17
	Default Determinations	10	2	8
	Names Suspended	18	2	16
	Complaint Denied	3	0	3
201405	Cases Concluded	18	1	17
	Default Determinations	10	0	10
	Names Suspended	18	1	17
	Complaint Denied	1	0	1
201406	Cases Concluded	15	1	14
	Default Determinations	5	1	4
	Names Suspended	16	1	15
	Complaint Denied	1	0	1
201407	Cases Concluded	16	0	16
	Default Determinations	7	0	7
	Names Suspended	16	0	16
	Complaint Denied	2	0	2
201408	Cases Concluded	23	5	18
	Default Determinations	15	3	12
	Names Suspended	23	5	18
	Complaint Denied	7	0	7
201409	Cases Concluded	22	1	21
	Default Determinations	16	2	14
	Names Suspended	23	2	21
	Complaint Denied	1	0	1

Table 6-2

Source: Provider reports

Overall, the majority of URS proceedings (approximately 87%) filed within this period have been successful in obtaining suspension of the domain name registration, as shown in Figure 6-3 below.

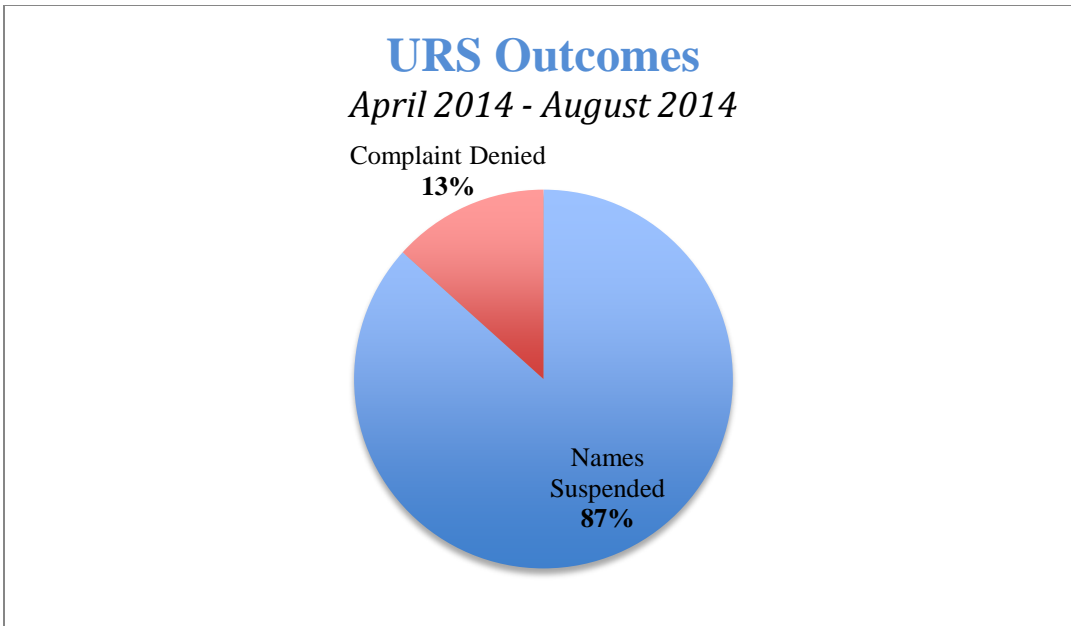


Figure 6-2

Source: Reports from ADNDRC, FORUM

As described above, if a registrant does not file a response to a URS complaint within 14 days, the complaint will be in default. A default determination still is evaluated by the panel on the merits. As shown in Figure 6-3 below, approximately half of the determinations to date have been default determinations, i.e., the determination was made without a response from the registrant.

Default URS Determinations

April 2014 - August 2014

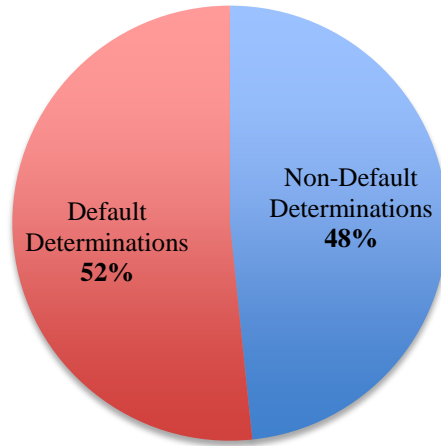


Figure 6-3

Source: Reports from ADNDRC, FORUM

As shown in Figure 6-4 below, most URS complaints are filed within the first few months after the domain name in question is registered; however, the URS can continue to be used at any point in the life of a registration.

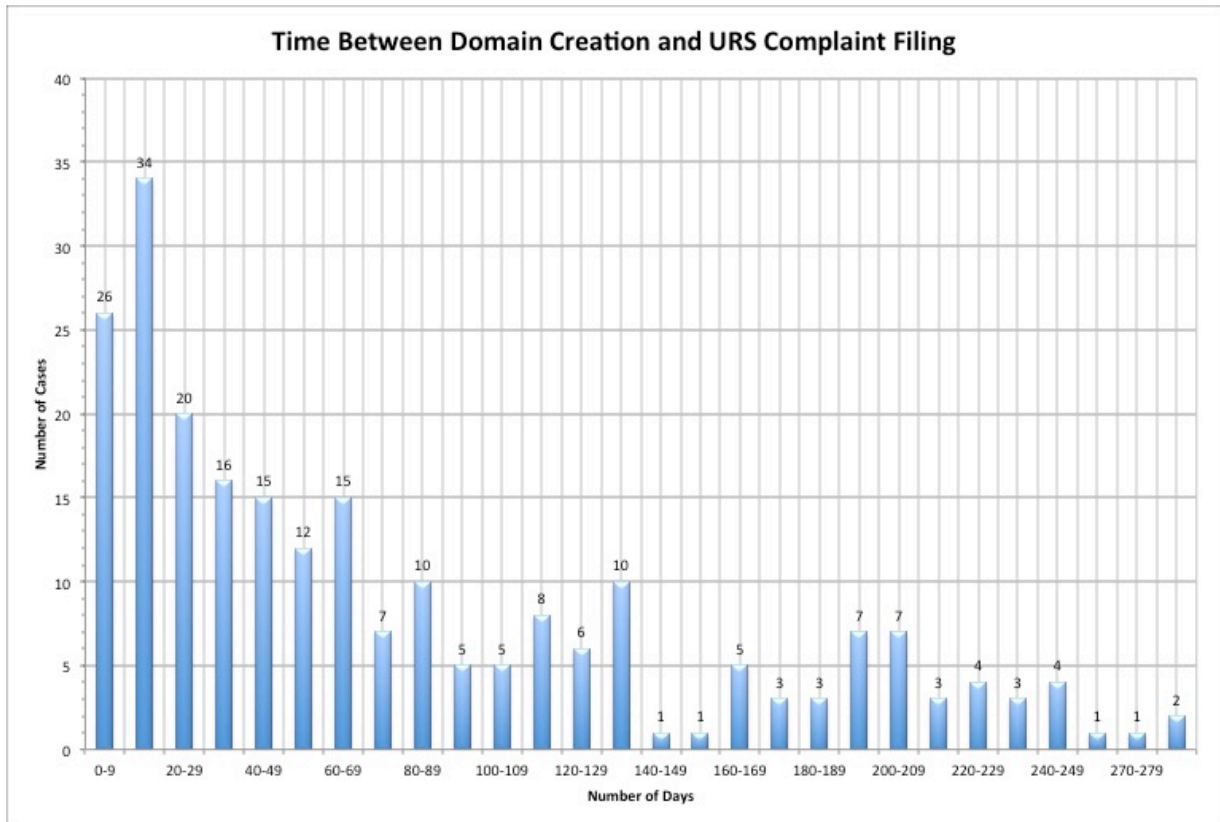


Figure 6-4
 Source: Whois records; Published case data

Overall, ICANN has received feedback received from the community is that the URS has produced positive results and that it works fairly well in terms of what it is designed to accomplish. It is quick, inexpensive and caters to those who have slam-dunk cases or are indifferent towards the suspension of the name solution, perhaps due to the fact they are unable to register that name. However, some rights holders have not opted to use this service due to the remedy being limited to suspension only.

There is also concern over the possibility of the domain name being registered once more by another potential infringer once it is released, thus some rights holders feel more comfortable having the domain name in their portfolio, which can be achieved via a UDRP. Indeed, initial feedback has indicated that suspension of the domain name is not a long-term solution.

With this in mind, community feedback is being requesting regarding the

URS procedures to date:

Section 6 Questions

- a. How effective is this service in providing a quick and low-cost process for addressing infringement?
- b. What were the challenges, if any, in terms of using the URS?
- c. Are translation and language elements of the notification processes effective?
- d. How could communication processes be improved among URS providers, registry operators, registrars, and registrants?
- e. What factors could be addressed to make the URS more effective?

7 Post-Delegation Dispute Resolution Procedures

Post-Delegation Dispute Resolution Procedures have been developed to provide parties potentially harmed by a new gTLD Registry Operator's conduct an avenue to pursue a complaint about that conduct. These dispute resolution procedures are administered by qualified providers external to ICANN and may require that complainants take specific steps to address their issues before filing a formal complaint. An Expert Panel will determine whether a Registry Operator is at fault and if so, recommend remedies to ICANN.

The Trademark PDDRP is intended to address trademark-related issues in the registry. The RRDRP and PIC-DRP were not specifically designed as RPMs; however, they could serve this function in certain circumstances. Currently, there are three Post-Delegation Dispute Resolution Procedures:

1. Trademark Post-Delegation Dispute Resolution Procedure (Trademark PDDRP)

The [Trademark PDDRP](#) generally addresses a Registry Operator's complicity in trademark infringement on the first or second level of a new gTLD. At least 30 days prior to filing a formal complaint, a rights holder must notify the

Registry of the alleged infringing conduct and express a willingness to meet to resolve the issue.

2. Registration Restriction Dispute Resolution Procedure (RRDRP)

The [RRDRP](#) is intended to address circumstances in which a community-based New gTLD Registry Operator deviates from the registration restrictions outlined in its Registry Agreement. An RRDRP complaint may only be filed by an established institution. Prior to filing a formal RRDRP proceeding, a complainant may [submit a report](#) to ICANN, who will conduct a preliminary review of the complaint to ensure it is complete, states a claim of non-compliance with at least one Registration Restriction, and that the reporter is in good standing.

3. Public Interest Commitments Dispute Resolution Procedure (PICDRP)

The [PICDRP](#) addresses complaints that a registry may not be complying with the Public Interest Commitment(s) in Specification 11 of its Registry Agreement. Prior to filing a formal PICDRP proceeding, the procedure envisions that a complainant will first utilize an [online complaint system](#). This allows for the submittal of an initial report claiming that a Registry may not be complying with one or more of its PICs per Specification 11 of its Registry Agreement with ICANN. ICANN will conduct a preliminary review of the initial report to ensure that it is complete, it states a claim of non-compliance with at least one PIC, and that the Reporter is in good standing.

As per the Registry Agreement, a registry operator must participate in these procedures and is bound by the resulting determinations. Provider information for these procedures is available at <http://newgtlds.icann.org/en/program-status/pddrp>.

To date, there have been no complaint filings under these procedures, making analysis premature at this time; however, more discussions are expected on the PDDRP at a later point.

8 Conclusion

This paper has described the data and input collected in many of the important areas relating to RPMs, including the Trademark Clearinghouse, Uniform Rapid Suspension system, and Post-Delegation Dispute Resolution Procedure.

The paper is being posted for public comment to help identify the relevant sets of issues for consideration in reviewing the RPMs in the New gTLD Program. The paper will be updated and revised based on the feedback received during the public comment period. ICANN appreciates the community's involvement in this process and looks forward to the community's input relating to the key RPM topics described here, and any other relevant areas that should be considered as part of this review.

9 References

Allemann, Andrew. "10 Takeaways from New Top Level Domain Name Sunrise Periods so Far." *Domain Name Wire*. 5 Feb. 2014. Web. 11 Nov. 2014. <<http://domainnamewire.com/2014/02/05/10-takeaways-from-new-top-level-domain-name-sunrise-periods-so-far/>>.

Allemann, Andrew. "A Little Bit More about the Trademark Clearinghouse's Extended Alert Service." *Domain Name Wire*. 13 Dec. 2013. Web. 11 Nov. 2014. <<http://domainnamewire.com/2013/12/13/a-little-bit-more-about-the-trademark-clearinghouses-extended-alert-service/>>.

Allemann, Andrew. "How Common Words like Pizza, Money, and Shopping Ended up in the Trademark Clearinghouse for New TLDs." *Domain Name Wire*. 10 Feb. 2014. Web. 11 Nov. 2014. <<http://domainnamewire.com/2014/02/10/how-common-words-like-pizza-money-and-shopping-ended-up-in-the-trademark-clearinghouse-for-new-tlds/>>.

Allemann, Andrew. "ICANN Publishes Final Rights Protection Mechanisms for New TLDs." *Domain Name Wire*. 1 Oct. 2013. Web. 11 Nov. 2014. <<http://domainnamewire.com/2013/10/01/icann-publishes-final-rights-protection-mechanisms-for-new-tlds/>>.

Allemann, Andrew. "Over 10,000 Records Now in Trademark Clearinghouse." *Domain Name Wire*. 20 Sept. 2013. Web. 11 Nov. 2014. <<http://domainnamewire.com/2013/09/20/over-10000-records-now-in-trademark-clearinghouse/>>.

Allemann, Andrew. "The New TLD Trademark Clearinghouse Is about to Get a Lot of Attention." *Domain Name Wire*. 22 Apr. 2013. Web. 11 Nov. 2014. <<http://domainnamewire.com/2013/04/22/trademark-clearinghouse/>>.

Allemann, Andrew. "TMCH Brags about Numbers, but What Do They Mean?" *Domain Name Wire*. 25 Mar. 2014. Web. 11 Nov. 2014. <<http://domainnamewire.com/2014/03/25/tmch-brag/>>.

Allemann, Andrew. "Trademark Clearinghouse Extends Alert Service beyond 90 Days." *Domain Name Wire*. 12 Dec. 2013. Web. 11 Nov. 2014. <<http://domainnamewire.com/2013/12/12/trademark-clearinghouse-extends-alert-service-beyond-90-days/>>.

Allemann, Andrew. "Why Cybersquatting Won't Be a Big Deal in New TLDs." *Domain Name Wire*. 31 Jan. 2014. Web. 11 Nov. 2014.

<<http://domainnamewire.com/2014/01/31/why-cybersquatting-wont-be-a-big-deal-in-new-tlds/>>.

Allemann, Andrew. "Trademark Clearinghouse Tops 5,000 Submissions." *Domain Name Wire*. 16 July 2013. Web. 10 Nov. 2014. <<http://domainnamewire.com/2013/07/16/trademark-clearinghouse-tops-5000-submissions/>>.

Bachman, Katy. "Brands Facing Dot-Com Domain Identity Crisis." *AdWeek*. 1 Apr. 2013. Web. 10 Nov. 2014. <http://www.adweek.com/news/advertising-branding/brands-facing-dot-com-domain-identity-crisis-148291?utm_source=newsletter&utm_medium=email&utm_content=04-01-2013&utm_campaign=brandweek>.

Chowdhury, Pamela. "ICANN's Trademark Clearinghouse Opens Its Doors for Registration." *Business Wire*. 26 Mar. 2013. Web. 18 Nov. 2014. <<http://www.businesswire.com/news/home/20130326006170/en/ICANN%E2%80%99s-Trademark-Clearinghouse-opens-Doors-Registration#.VGvyE9alYkE>>.

Corstens, Jan. "GTLDs: 'clearinghouse' Will Protect Brands." *The Telegraph*. Telegraph Media Group, 26 Mar. 2013. Web. 18 Nov. 2014. <<http://www.telegraph.co.uk/technology/internet/9953081/gTLDs-clearinghouse-will-protect-brands.html>>.

Corstens, Jan. "Guest View: Understanding the Key Offerings of the Trademark Clearinghouse." *CIO Asia*. 21 May 2013. Web. 10 Nov. 2014. <<http://www.cio-asia.com/resource/legal/guest-view-understanding-the-key-offerings-of-the-trademark-clearinghouse/>>.

Corstens, Jan. "New Web Domains Raise Risk of Cyber-Squatting - Today's General Counsel." *Today's General Counsel*. 01 June 2014. Web. 20 Nov. 2014. <<http://www.todaysgeneralcounsel.com/new-web-domains-raise-risk-cyber-squatting/>>.

Corstens, Jan. "Sorting Facts from Fiction in the Trademark Clearinghouse." *Domain Name Wire*. 23 July 2013. Web. 11 Nov. 2014. <<http://domainnamewire.com/2013/07/23/sorting-facts-from-fiction-in-the-trademark-clearinghouse-2/>>.

"Electronic Commerce & Law Report™." *Bloomberg BNA*. 6 Mar. 2013. Web. 10 Nov. 2014. <<http://www.bna.com/electronic-commerce-law-p6796/>>.

Gross, Grant. "ICANN's Trademark Clearinghouse to Launch Tuesday." *CIO*. 25 Mar. 2013. Web. 10 Nov. 2014. <<http://www.cio.com/article/2387277/internet/icann-s-trademark-clearinghouse-to-launch-tuesday.html>>.

Henderson, Nicole. "5,000 Trademark Owners Register Under Trademark Clearinghouse." *WHIR*. 16 July 2013. Web. 10 Nov. 2014. <<http://www.thewhir.com/web-hosting-news/5000-trademark-owners-register-under-trademark-clearinghouse>>.

"ICANN Clears Registry Hurdle for GTLDs." *World Intellectual Property Review*. 03 July 2013. Web. 18 Nov. 2014. <<http://www.worldipreview.com/news/icann-clears-registry-hurdle-for-gtlds>>.

"Icann Launches New Brand Database." *BBC News*. 26 Mar. 2013. Web. 10 Nov. 2014. <<http://www.bbc.com/news/technology-21938359>>.

"ICANN Releases First TLD Requests, Opens Trademarks Database." *Telecompaper*. 26 Mar. 2013. Web. 18 Nov. 2014. <<http://www.telecompaper.com/news/icann-releases-first-tld-requests-opens-trademarks-database--933558>>.

Lomas, Natasha. "Icann Launches Trademark Clearing House So Brands Can Pay To Register Their Marks Ahead Of The New .Brands TLD Era." *TechCrunch*. 26 Mar. 2013. Web. 18 Nov. 2014. <<http://techcrunch.com/2013/03/26/icann-tmch/>>.

London, James N. "Device Marks to Be Protected in New GTLD Clearinghouse." *Managing Intellectual Property*. 27 Feb. 2013. Web. 11 Nov. 2014. <<http://www.managingip.com/Article/3161241/Device-marks-to-be-protected-in-new-gTLD-Clearinghouse.html>>.

McCarthy, Bede. "Trademark Protection Grows as Net Expands - FT.com." *Financial Times*. 24 Mar. 2013. Web. 18 Nov. 2014. <<http://www.ft.com/cms/s/0/f417a670-92e8-11e2-b3be-00144feabdc0.html#axzz3JTLk7gYZ>>.

Mochiko, Thabiso. "Race to Safeguard Web Domain Name Trademarks." *Business Day Live*. 15 July 2013. Web. 10 Nov. 2014. <<http://www.bdlive.co.za/business/technology/2013/07/15/race-to-safeguard-web-domain-name-trademarks>>.

Murphy, Kevin. "Almost 15,000 Trademarks Registered in TMCH | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 4 Nov. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/14944-almost-15000-trademarks-registered-in-tmch>>.

Murphy, Kevin. "Businesses May Call for More New GTLD Trademark Protections | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 31 Dec. 2011. Web. 11 Nov. 2014. <<http://domainincite.com/7213-businesses-may-call-for-more-new-gtld-trademark-protections>>.

Murphy, Kevin. "Can ICANN Make a Trademark Deal with the GAC? | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 24 May 2011. Web. 11 Nov. 2014. <<http://domainincite.com/4870-can-icann-make-a-trademark-deal-with-the-gac>>.

Murphy, Kevin. "Downtime Emerges as Key Barrier to Trademark Clearinghouse Changes | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 10 Oct. 2012. Web. 11 Nov. 2014. <<http://domainincite.com/10716-downtime-emerges-as-key-barrier-to-trademark-clearinghouse-changes>>.

Murphy, Kevin. "First New GTLD Sunrise Ends with "very Few" Registrations | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 30 Dec. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/15435-first-new-gtld-sunrise-ends-with-very-few-registrations>>.

Murphy, Kevin. "First Seven TMCH Agents Approved | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 2 Apr. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/12533-first-seven-tmch-agents-approved>>.

Murphy, Kevin. "Governments to Take Trademark Concerns to ICANN | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 24 Jan. 2011. Web. 10 Nov. 2014. <<http://domainincite.com/3300-governments-to-take-trademark-concerns-to-icann>>.

Murphy, Kevin. "How Much Are New GTLDs Really Costing Trademark Owners? We Have Some Numbers. | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 29 Mar. 2014. Web. 11 Nov. 2014. <<http://domainincite.com/16718-how-much-are-new-gtlds-really-costing-trademark-owners-we-have-some-numbers>>.

Murphy, Kevin. "How One Guy Games New GTLD Sunrise Periods | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 17 Apr. 2014. Web. 11 Nov. 2014. <<http://domainincite.com/16492-how-one-guy-games-new-gtld-sunrise-periods>>.

Murphy, Kevin. "ICANN Brings "loser Pays" to Domain Disputes | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 16 Apr. 2011. Web. 11 Nov. 2014. <<http://domainincite.com/4291-icann-brings-loser-pays-to-domain-disputes>>.

Murphy, Kevin. "ICANN Takes Firm Stance on New TLD Delays | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 6 Mar. 2011. Web. 11 Nov. 2014. <<http://domainincite.com/3730-icann-takes-firm-stance-on-new-tld-delays>>.

Murphy, Kevin. "Loophole Gives Trademark Owners Unlimited Clearinghouse Records | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 27 Mar. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/12451-loophole-gives-trademark-owners-unlimited-clearinghouse-records>>.

Murphy, Kevin. "New GTLD "strawman" Splits Community | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 16 Jan. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/11619-new-gtld-strawman-splits-community>>.

Murphy, Kevin. "No Costs to Registries from TM Claims Extension | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 13 Dec. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/15317-no-costs-to-registries-from-tm-claims-extension>>.

Murphy, Kevin. "Over Half a Million Trademark Claims Notices Served | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 25 Mar. 2014. Web. 11 Nov. 2014. <<http://domainincite.com/16208-over-half-a-million-trademark-claims-notices-served>>.

Murphy, Kevin. "Strickling Urges ICANN to Bolster Trademark Protection for All GTLDs | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 5 Oct. 2012. Web. 11 Nov. 2014. <<http://domainincite.com/10700-strickling-urges-icann-to-bolster-trademark-protection-for-all-gtlds>>.

Murphy, Kevin. "TMCH Extends Trademark Claims Indefinitely, Kinda | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 11 Dec. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/15293-tmch-extends-trademark-claims-indefinitely-kinda>>.

Murphy, Kevin. "TMCH Sends out 17,500 Trademark Claims Notices in a Month | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 3 Mar. 2014. Web. 11 Nov. 2014. <<http://domainincite.com/15947-tmch-sends-out-17500-trademark-claims-notices-in-a-month>>.

Murphy, Kevin. "Tonkin Says Better New gTLD Trademark Protections Could Come in the First Round | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 24 Sept. 2012. Web. 11 Nov. 2014. <<http://domainincite.com/10563-tonkin-says-better-new-gtld-trademark-protections-could-come-in-the-first-round>>.

Murphy, Kevin. "Trademark+50 Coming in October | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 10 Sept. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/14418-trademark50-coming-in-october>>.

Murphy, Kevin. "Trademark Clearinghouse Coming in October | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 7 Jan. 2012. Web. 10 Nov. 2014. <<http://domainincite.com/7289-trademark-clearinghouse-coming-in-october>>.

Murphy, Kevin. "Trademark Clearinghouse Cutting It Fine for New GTLD Launches | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 16 July 2013. Web. 11

Nov. 2014. <<http://domainincite.com/13763-trademark-clearinghouse-cutting-it-fine-for-new-gtld-launches>>.

Murphy, Kevin. "Trademark Clearinghouse Lowers Prices | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 21 Mar. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/12339-trademark-clearinghouse-lowers-prices>>.

Murphy, Kevin. "Trademark Clearinghouse Signs up 40 Registrars | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 9 Nov. 2010. Web. 10 Nov. 2014. <<http://domainincite.com/2543-trademark-clearinghouse-signs-up-40-registrars>>.

Murphy, Kevin. "Trademarks Still Trump Founders in Latest TMCH Spec | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 7 Aug. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/14031-trademarks-still-trump-founders-in-latest-tmch-spec>>.

Murphy, Kevin. "Will the Trademark Clearinghouse Kill off Premium Domains? | DomainIncite - Domain Name News & Opinion." *DomainIncite*. 18 Apr. 2013. Web. 11 Nov. 2014. <<http://domainincite.com/12695-will-the-trademark-clearinghouse-kill-off-premium-domains>>.

"Neue Top-Level-Domains: Worauf Müssen Markeninhaber Jetzt Achten." *Checkdomain Blog*. 27 Mar. 2013. Web. 10 Nov. 2014. <<http://blog.checkdomain.de/domains/markeninhaber-und-neue-domainendungen/>>.

Shankland, Stephen. "From .coffee to .email to .xyz: The Web's Crazy New Reality Is Here - CNET." *CNET*. 13 Oct. 2014. Web. 15 Nov. 2014. <<http://www.cnet.com/news/from-coffee-to-email-to-xyz-the-webs-crazy-new-reality-is-here/>>.

"Steering Clear of Online Brand Protection Issues in the World of New GTLDs." *BiztechAfrica*. 18 July 2013. Web. 10 Nov. 2014. <<http://www.biztechafrika.com/article/steering-clear-online-brand-protection-issues-worl/6490/?section=internet#.VGEfi9alYkE>>.

"Trademark Clearinghouse Clarifies How Law Firms Can Act for Clients 04 Apr 13." *World Trademark Review*. 4 Apr. 2013. Web. 10 Nov. 2014. <<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=f9685198-a9a4-4c8f-a665-821be07fa906>>.

"Trademark Clearinghouse Für GTLDs Nimmt Betrieb Auf." *ADZINE*. 26 Mar. 2013. Web. 10 Nov. 2014. <<http://www.adzine.de/de/site/artikel/8412/online-media/2013/03/trademark-clearinghouse-fuer-gtdls-nimmt-betrieb-auf>>.

"Trademark Clearinghouse Passes 5,000 Registrations." *Managing Intellectual Property*. 16 July 2013. Web. 10 Nov. 2014.
<<http://www.managingip.com/Article/3231628/Managing-Internet-IP-Archive/Trademark-Clearinghouse-passes-5000-registrations.html>>.

"Trademark Clearinghouse Tops 5,000 Registrations." *WIPO*. 16 July 2013. Web. 10 Nov. 2014. <<http://www.worldipreview.com/news/trademark-clearinghouse-tops-5-000-registrations>>.

"Trademark Counsel Weigh the Costs of Being a TMCH Agent 21 Mar 13." *World Trademark Review*. 21 Mar. 2013. Web. 18 Nov. 2014.
<<http://www.worldtrademarkreview.com/Blog/detail.aspx?g=f3a09c7d-7795-4a78-bb47-23eba67e43cb>>.

Appendix: List of Discussion Questions

Section 3: Trademark Clearinghouse

- a. What were the challenges, if any, in terms of satisfying the requirements for trademark inclusion into the Clearinghouse?
- b. Were there any challenges related to marks from specific jurisdictions in relation to the Clearinghouse guidelines?
- c. Was the verification process successful in restricting non-eligible trademarks?
- d. What factors could be considered to make the trademark verification process more effective?
- e. What factors could be considered to make the process of updating Clearinghouse records more effective?
- f. Did the Clearinghouse structure successfully balance implementation of the service with data misuse concerns?
- g. Do the Clearinghouse benefits outweigh the concerns about distribution of data?
- h. Were any issues identified relating to misuse of Clearinghouse data?
- i. Was the proof of use requirement helpful in meeting the goals of a creating a standard that accommodates practices from multiple jurisdictions?
- j. What were the challenges, if any, in terms of satisfying the proof of use requirement?
- k. Was the proof of use requirement successful in restricting the Sunrise period to Sunrise-eligible rights holders?
- l. What factors could be considered to make this process more effective?
- m. Should the verification standards in the Clearinghouse Guidelines be adjusted in one or more areas?

- n. Could verification standards used by the Clearinghouse be adjusted to better serve rights holders in all global regions?
- o. To the extent that gaming is occurring, could this be prevented by modification to the verification standards?

Section 4: Sunrise Period

- a. How effective is the Sunrise period for protecting intellectual property rights?
- b. Are the Start-Date Sunrise and End-Date Sunrise alternatives useful?
- c. What were the challenges, if any, in terms of registering a domain name during the Sunrise period?
- d. What factors can be addressed to make Sunrise processes more effective?
- e. Did having a set of Sunrise minimum requirements across TLDs provide for increased efficiencies in registration processes? Were there advantages and disadvantages to the required Sunrise for rights holders? For Registry Operators?
- f. Did the use of SMD files help streamline the process? Were there any technical issues encountered, if so, what were they?
- g. Is there an appropriate balance of registry discretion to reserve names from registration and the inclusion of names in the required RPMs? Should additional considerations be applied around registry allocation practices and their interaction with the required RPMs?
- h. Were Limited Registration Periods a useful part of registry launch processes?
- i. What were the challenges, if any, in terms of registering domain names during Limited Registration Periods?
- j. Did registries find that registrants took advantage of Limited Registration periods?

- k. Was the QLP useful for registries in launching and promoting their TLDs? What were the challenges, if any, in terms of operating a QLP? What factors, if any, would make it more effective?
- l. Did the QLP succeed in maintaining safeguards against intellectual property infringement? Were any intellectual property infringement issues noted with regard to names issued as part of a QLP?
- m. Are there similar programs that could be built into TLD Startup processes that would support registry startup while maintaining safeguards against intellectual property infringement?
- n. How useful was the SDRP in resolving disputes?
- o. What were the most common types of disputes?
- p. What were the challenges, if any, in using the SDRP?
- q. What factors could be addressed to make Sunrise processes more effective?

Section 5: Trademark Claims

- a. Is the Claims notice an effective form of communication?
- b. For those with registrant/customer interactions, what has been the customer response to Claims notices?
- c. Were any technical issues identified relating to the Claims service?
- d. Is there any other piece of information that should be included in the Claims notice?
- e. How helpful is it to have the Trademark Notice in English and in the language of the registrant's registration agreement? Should additional language considerations be applied?
- f. How could the Claims service be improved?
- g. How useful are extended Claims services?
- h. What were the challenges, if any, in terms of extended Claims services?

- i. How effective is the inclusion of previously abused labels in protecting against trademark abuse and infringement?
- j. Should the standards for verification of previously abused labels be modified?
- k. How clear is the Notice of Registered Names to the trademark holder? Is there any other piece of information that should be included in the Notice of Registered Name?
- l. Is the Notice of Registered Names received in a timely manner?
- m. Did the Notice of Registered Names help trademark holders decide on next steps?

Section 6: URS

- a. How effective is this service in providing a quick and low-cost process for addressing infringement?
- b. What were the challenges, if any, in terms of using the URS?
- c. Are translation and language elements of the notification processes effective?
- d. How could communication processes be improved among URS providers, registry operators, registrars, and registrants?
- e. What factors could be addressed to make the URS more effective?