

ADDITIONAL PROPOSALS RECEIVED FOR WHICH CONSIDERATION WILL BE DEFERRED AS THESE DO NOT RELATE SPECIFICALLY TO THE THREE OPEN QUESTIONS UNDER CURRENT DISCUSSION¹:

Additional Proposals

Additional Work Tracks submitted by Greg Shatan:

Despite not being fully convinced that gaming of Sunrise (i.e., the registration of trademarks as a pretext to obtain a TMCH registration and thereby the ability to acquire registrations in Sunrise) is really a problem of such magnitude that we need to make any changes at all, the RPM Working Group should consider the following issues which are more appropriately dealt the work track for Sunrise Processes rather than with the TMCH itself:

- Making proof of use requirements for purposes of Sunrise eligibility more rigorous to try and further limit the possibility of “gaming.”
- Requiring that all Sunrise Dispute Resolution Policies contain a provision that subject to any Sunrise or premium fees imposed by the registry on the initial Sunrise registrant a successful complainant that challenges a Sunrise domain name registration is awarded either a cancellation and right of first refusal to register the domain name itself, or a transfer of the domain name that was challenged.

For the avoidance of doubt, “gaming” does not refer to the good faith registration in the TMCH of bona fide trademark registrations containing undisclaimed text elements, regardless of the nature of those text elements. Gaming also does not refer to the use of TMCH registrations to register domain names in Sunrise, regardless of the nature of the new gTLD in which the registration is acquired.

Proposal submitted by Jeremy Malcolm:

Open questions 7 and 8 illustrate how the protections provided to trademark holders through the TMCH have been applied too broadly by the provider, opening the door for gaming and abuse by trademark holders, and chilling of speech by affected third parties. This proposal also bears on question 16 (Does the scope of the TMCH and the protections mechanisms which flow from it reflect the appropriate balance between the rights of trademark holders and the rights of non-trademark registrants?).

¹ Staff notes that there is an ongoing discussion on the Working Group mailing list on topics such as “gaming”, the cumulative roles of having both a Sunrise and Claims mechanism, and the benefits and disadvantages of some of the suggestions that have been made. This table only captures the specific proposals that some members have submitted as such, and does not fully reflect the scope of the mailing list discussions, or other suggestions that may have been made in the course of that discussion.

It has been seen that the TMCH has facilitated trademark owners claiming exclusive rights in domain names that they don't exist in domestic trademark law, such as words incorporated into design marks. Open question 10, rather than addressing the potential for abuse, actually suggests a measure that would allow even more non-trademarked terms to be locked up by priority claimants.

As a measure to address these problems, we propose eliminating the TMCH's Sunrise Registration service altogether. Although we also have concerns about its Trademark Claims service and will likely propose its elimination separately at a later date, the Sunrise Registration service is the most urgent to eliminate, because it creates an absolute bar to third parties registering domains that a Sunrise registrant has already claimed, whereas the Trademark Claims service results in a warning to third parties but does not absolutely preclude them from registering.

We believe that the elimination of Sunrise Registrations would be the simplest way to address the problems of gaming and abuse that have been observed by working group members, not only in respect of design marks and geographical words, but also the misuse of dubious trademarks over common dictionary words such as "the", "hotel", "luxury", "smart", "one", "love", and "flower" to lock up domains unrelated to the original trademark.

If the Sunrise Registration system were widely used by trademark holders, then it might be claimed that its elimination was disproportionate—but as we have seen, this is not the case. There have been only about 130 Sunrise Registrations per new domain. Such a small number of claims could be more simply and efficiently handled simply by allowing those claimants to resort to curative mechanisms such as the UDRP in the event that a third-party registrant beats them to registering a domain over which they might have made a claim.

The benefits of the elimination of Sunrise Registrations would be:

- An overall cost saving.
- Streamlining of the public availability of domains in new registries.
- Elimination of the potential for gaming and abuse by putative trademark holders who claim rights over domain names that do not correspond to their domestic trademark rights.

The costs would be:

- Some trademark holders would be required to resort to curative proceedings if domain names over which they have a legitimate claim are registered by third parties.

Proposal submitted by Kurt Pritz:

Recommendation:

1. Sunrise periods should be voluntary for registry operators

2. Trademarks Claims should be mandatory and perpetual (with a caveat described below as to whether they are perpetual or time limited)

Background:

1. The STI recommended that registries conduct a Sunrise or a Trademark Claims period. This approach was most likely based on: past practice leading up to the gTLD round where new registries always conducted one or the other; and affording new registries some freedom in selecting how they wanted to protect marks owners.
2. In practice, it is difficult to force registries to have a Sunrise period. Registries can just price Sunrise registrations in a way that effectively obviates the offering. There were no price controls in this (2012) round or the previous (2003-04) round and for very good reasons.
3. With a wave of its imperial wand, the GAC converted the “or” (as in Sunrise or Trademark Claims) to an “and,” ignoring past practice and the market realities stated above.
4. The STI also recommended that Trademark Claims last a period shorter than the current 90-days (60 days?), a period that was intended to coincide with the then-traditional landrush periods that preceded GA. This was because it was thought that domain investors who might infringe were more likely to obtain trademarked names in the land rush period. Also, by limiting the Claims period to land rush, registrars could participate in the start of General Availability without having to absorb the costs of implementing the Claims process.
5. Again, the GAC arbitrarily increased the Claims period to 90 days, effectively forcing registrars to bear the expense of administering claims or missing the first month or more of GA.
6. As the market has evolved, land rush periods have largely been abandoned and replaced with Early Access Periods that are part of General Availability so any registrar wanting to sell domains from the start of GA has to accommodate Claims.
7. There was no real pushback to the GAC interventions even though there were valid cases to be made. By that time new gTLD proponent were too weary, had waited too long, and were too extended by delays to consider extending the public debate. The GAC recommendations were accepted with little comment.

Summary: the Sunrise period was originally designed to be voluntary and it still is, in effect, voluntary – if registries price Sunrise registrations very high. The Claims period is of arbitrary length, there is no available data pointing to a 90-day or any other period.

Rationale: Making the Sunrise period voluntary and extending the Claims period to perpetuity will:

1. Does not change the “in-fact” status of Sunrise as voluntary but does avoid the reputation impact to the program when registries prohibitively price Sunrise registrations.
2. Will not likely impact the number of registries that conduct a Sunrise period. Registries conducted Sunrise periods in the past, they remain a revenue generating opportunity today, and most registries do seek a reputation for protecting IP rights.
3. If a registry wants to operate a Sunrise period, there is no justifiable way to bar that.
4. A Claims notice in perpetuity will accustom registrants to seeing the notice and promoting an understanding of its effect. Since a notice will not accompany every registration, it will still have meaning, but will not be such a surprise that it would be likely to deter an otherwise legitimate registration.
5. There is no real rationale for a Claims notice being of value on day x and not of value on day x=1. New entrants are entering the domain name industry each day and the value of Claims notices might even increase as the market evolves.
6. Registrars that have held off to date, would be obligated to find a way to implement Claims and all registrars will be able to participate from the opening of GA.

The one caveat is that last point and it has to do with a comment Jon Nevett made to another RPM list. I don't understand the burden to registrars of implementing Claims notifications. (Remember, the IRT originally avoided this issue by limiting the length of the Claim period.) If it is demonstrated that implementing Claims is likely to put smaller registrars out of business or at a significant cost disadvantage, then I would reduce the recommended Claims period from perpetuity, back to 90 days.