

2012-11-01 NCSG Stmt on Proposals for Additional Trademark Rights Privileges for New Domain Names

1 November 2012

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Statement of ICANN's Non-Commercial Stakeholders Group (NCSG) on the IPC-BC's Proposal for Additional RPMs*

Executive Summary

- NCSG is concerned by proposals from the IPC and BC to change consensus policy and re-open previously settled policy matters on Rights Protection Mechanisms for new tlds.
- The proposal under discussion does not reflect the hard-won balance found in the current consensus policy, nor the traditional limitations that exist in trademark law.
- The proposal removes matters from the negotiated RAA and registry agreements into a vague 'backdoor process', and binds ICANN to unlimited compliance obligations.
- Both the substance of the proposals and the manner of presenting it directly to ICANN without a proper policy process undermine our shared desire to create a truly multi-equal stakeholder process that honours ICANN's commitment to transparency and accountability.

The Non-Commercial Stakeholders Group (NCSG) writes in response to the latest set of proposals to re-open well-settled matters related to trademark Rights Protection Mechanisms (RPMs) for new top-level domain names, specifically the 8-point letter sent by the Intellectual Property Constituency (IPC) and the Business Constituency (BC) on 17 October 2012 to ICANN. [1]

NCSG is deeply troubled that ICANN is considering ignoring its own policy development process by re-opening community negotiated compromises at this late date. We wish to underscore the need for equal participation from all impacted parties, including the NCSG, in any discussions to re-open policy or consider new proposals.

NCSG wishes to register concern with the process by which these proposals were presented directly to ICANN Board and senior staff in Toronto, bypassing the impacted communities and entirely circumventing the multi-stakeholder policy development process. The NCSG Policy Committee, which considers and develops policy positions for the NCSG, has yet to be approached by any of the proponents of these proposals to discuss them or any of the concerns behind them. [2]

NCSG supports the positions taken by NTAG in its 24 October 2012 letter to ICANN and notes its succinct observation that "these last-minute policy recommendations amount to just another bite of the same apple that has already been bitten down to its core." [3]

NCSG also supports the statement of the Registrars Stakeholder Group (RrSG) in response to the IPC-BC proposals for increased RPMs, and we agree with RrSG's analysis that "the additional RPMs circulated in Toronto represent a change to the policy and not the implementation of the TMCH." [4]

Indeed many of the proposals in the 17 October IPC-BC letter are proposals the community has already heard and rejected a number of times in the years of previous discussions on this subject.

The IPC-BC's letter raises from the dead rejected proposals such as the creation of a list of words that would be considered per se off limits for registration, thus creating a prior restraint on speech. [5] This proposal is broadly over-reaching in what it prohibits and would prevent many lawful uses such as corporate whistle-blowing websites, criticism of trademarked goods, services and companies, and other lawful uses of words by those other than a trademark owner.

The IPC-BC proposals contain none of the balance nor limitations found in the current consensus policy, nor in trademark law such as:

- geographical limitations to a trademark owner's rights,
- the restrictions of trademark rights to particular classes of goods and services, and
- the regulation of commercial speech only, and
- legal rulings that rightfully apply to only specific persons and specific facts.

Furthermore, just because there has been one instance of abuse with a trademark, does not mean that all subsequent uses of a trademarked word are abusive or prohibited by law. But that is the policy that IPC-BC proposes ICANN adopt.

The IPC-BC letter proposes to expand the rights afforded trademark holders beyond the bounds of law and reason and beyond the consensus reached by the entire community in the STI [6] and related discussions.

The IPC-BC letter proposes to remove matters that are properly and currently under negotiation with registrars in the Registrar Accreditation Agreement (RAA). [7] And it proposes to unilaterally, via this "back-door process", impose contractual terms and conditions on registrars and registries, [8] and to bind ICANN to vague unreasonable compliance commitments, [9] driving-up costs for end-users and stifling innovation in the market. By changing a finite period for action to an indefinite one, the IPC-BC proposal would create a chilling effect by giving trademark holders the right to intimidate registrants in perpetuity despite the community consensus that the TMCH pertain to a limited time period. [10]

In short, in addition to the objection based on principle against re-opening community-approved consensus policy, the NCSG contends that the substance of the IPC-BC's proposals would massively expand rights afforded to trademark holders under law, without any of the balancing or

public interest limitations placed upon those rights. These last-minute proposals must be rejected as an inappropriate circumvention of the bottom-up multi-equal stakeholder policy development process that ICANN champions. It is far too late to make such significant changes from what is stated in the final Applicant Guidebook.

NCSG appreciates the invitation to meet with ICANN's CEO and senior staff in the equal manner afforded to the proponents of the IPC-BC proposals, although we regret that we must again debate long-settled policy issues. We stand ready to further elaborate on the specific IPC-BC proposals in detail, including the history and context from which they derive, and their relationship to existing law and consensus policy as stated in the Guidebook. Thank you.

* This NCSG statement was approved by the NCSG Policy Committee on 1 November 2012.

[1] IPC-BC 8-point letter to ICANN dated 17 October 2012, posted online at: <http://www.icann.org/en/news/correspondence/metalitz-to-pritz-17oct12-en>

[2] The NCSG Policy Committee includes representatives from both constituencies in NCSG (NPOC and NCUC), all 6 NCSG GNSO Council Representatives and NCSG's Chair.

[3] NTAG letter to ICANN of 24 October 2012 posted online at: <http://www.icann.org/en/news/correspondence/ntag-to-icann-24oct12-en>

[4] Registrar Stakeholder Group Post-Toronto Communication to ICANN CEO posted online at: http://icannregistrars.org/calendar/announcements.php?utm_source=&utm_medium=&utm_campaign

[5] Specifically Points 4 and 8 of IPC-BC letter to ICANN of 17 October 2012.

[6] ICANN Special Trademark Issues (STI) Recommendations unanimously approved by the GNSO Council (including the IPC and BC) in December 2009 as a consensus policy for RPMs for new TLDs in which all parties compromised, but not all parties were subsequently willing to honor their commitments. STI Recommendations available at: <http://gns0.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

[7] Specifically Point 6 of IPC-BC letter to ICANN of 17 October 2012.

[8] Specifically Point 5 of IPC-BC letter to ICANN of 17 October 2012.

[9] Specifically Point 7 of IPC-BC letter to ICANN of 17 October 2012.

[10] Specifically Point 2 of IPC-BC letter to ICANN of 17 October 2012.