



**IPC Comments on
Trademark Clearinghouse Rights Protection Mechanism Requirements (Aug. 6, 2013)
and Revisions to Rights Protection Mechanism (RPM) Requirements
August 27, 2013**

The Intellectual Property Constituency (IPC) of the Generic Names Supporting Organization (GNSO) welcomes the opportunity to comment on the *Trademark Clearinghouse (TMCH) Rights Protection Mechanism* Requirements (Revised 6 Aug 2013) (the “*TMCH Requirements*”) and the proposed *Revisions to Rights Protection Mechanism (RPM) Requirements*.

Comments on *TMCH Requirements*

Section 2.1.1

This section should contain an explicit requirement that the Registry Operator (RO) make the TLD Start-Up Information public and not just communicate the Information to the Trademark Clearinghouse and Sunrise Operator (TMCH Operator) and ICANN. The word “notice” should be changed to “prominent public notice” to accommodate these concerns.

In any event, the 30-day notice period should begin running on the date the TLD Start-up Information is *made public* by ICANN and/or the TMCH Operator, whichever is earlier, and not the date it is communicated by the Registry Operator to the TMCH Operator and ICANN.

Section 2.1.1.2

This section is unclear. It seems to ask the RO to inform the TMCH Operator that the TMCH Operator had accepted the TLD Start-Up Information prior to this submission. This seems redundant. Please clarify the intent and purpose of this section. The IPC urges ICANN to consider separating the TMCH Operator confirmation step to another section for clarity.

Section 2.2.4

This section should be revised slightly for clarity. The term “allocation” should be further clarified to avoid gaming or misinterpretation. Therefore, the IPC proposes that the following sentence be added to the end of Section 2.2.4:

“Allocation” includes any form of Reserved Names program, Founders program, Pioneer program or other program allowing third parties to seek or be offered registration of a domain name through any mechanism whatsoever.

Section 2.3.1.4

While this provision states the objective of preventing “gaming of Registry Operator’s Sunrise Period” under the modified text, more trademarks are eligible for Sunrise Registration (allowing for greater gaming of the RO’s Sunrise Period) than under the established rules in the Applicant Guidebook.¹ This would seem to allow for more “gaming” rather than less.

To ensure the integrity of the process for all stakeholders, we recommend maintaining the safeguard that protections for trademarks do not extend to marks that are (i) subject to an opposition action or (ii) that remain within any opposition period.

In addition, the IPC notes that the *TMCH Requirements* document should clarify the one (1) year restriction. It is unclear what date the restriction will be measured from: Whether it is one year before the date the Registry Agreement was signed, the date of delegation of that specific TLD, the date that Sunrise registration commences for that particular TLD, or some other milestone - the Section must make this clear.

Section 2.4.3

Sections 3.2 and 3.3 of Specification 5 of the Registry Agreement both contemplate that a RO may “reserve” names prior to the Sunrise Period (by allocating them to the RO under Section 3.2 or by allocating them to the RO or withholding them from registration under Section 3.3). Both Sections contemplate that these names can later be released to any party or entity for registration. The IPC is very concerned that these release provisions could be used to game the system and circumvent Sunrise Periods, by holding names back until after Sunrise and then doling them out without regard to trademark rights. We are certain that was not the intention. Section 2.4.3 recognizes that these “released names” need to be subject to RPM Requirements; however, it does not go far enough and it contains ambiguous language that could create loopholes. We urge ICANN to adopt the following amended version of Section 2.4.3:

If Registry Operator reserves domain names from registration prior to or during the Sunrise Period in accordance with Section 2.6 of the Agreement and Specification 5 of the Agreement (including without limitation Sections 3.2 and 3.3 thereof) then, if any such domain name is later made available at any time following the conclusion of the Sunrise Period, such domain name MUST be subject to (i) a special Sunrise Period of the same duration as the Sunrise Period conducted by the Registry Operator and subject to the same notice provisions as such Sunrise Period and (ii) the

¹ See Module 5, Trademark Clearinghouse, Sunrise Service Section 6.2.4 which sets forth that Sunrise Period Registrations can be challenged if the trademark registration on which the domain name registrant based its Sunrise eligibility “did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received,” and Module 5, Trademark Clearinghouse Section 3.2.5 which states that “protections afforded to trademark registrations do not extend to applications for registration, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellations or rectification proceedings.”

Claims Services specified in Section 3 hereof, each so long as the Trademark Clearinghouse (or any ICANN-designated successor thereto) remains in operation.

Sections 2.4.4 and 3.2.4

Section 3.2.4 reads, in part, “[t]he Sunrise Period and a Limited Registration Period MAY overlap.” This change may cause conflict with Section 2.2.4, which says that no domain name can be allocated to a non-Sunrise Eligible Right Holder before conclusion of the Sunrise Period. This change creates a potential conflict between Sunrise Period applications and Limited Registration Period applications for the same string. New Section 2.4.4, which says that the RO must allocate and register all Sunrise applications before allocating and registering any Limited Registration applications, recognizes this issue, but it is not clear that Section 2.4.4 solves the problem, because it does not discuss what will happen if there is a conflict between such identical strings. ICANN must clarify that any overlapping Sunrise and Limited Registration Periods are subject to both Section 2.2.4 and Section 2.4.4, and that any conflict between a Sunrise Period application and a Limited Registration Period application is resolved in favor of the Sunrise Period application.

Miscellaneous Comments

The IPC notes that all payment, “changes” and audit provisions are deleted from the August 6, 2013 draft. Please clarify whether these provisions are contained in a different agreement.

Comments on Revisions to Rights Protection Mechanism (RPM) Requirements

Proposal on notice of Sunrise Period

The IPC does not oppose the option of longer Sunrise Periods. However, the IPC opposes the change for notice of Sunrise Period from 30 days’ notice in advance of Sunrise to 60 days’ notice from the end of Sunrise Period. Because ROs may provide a Sunrise Period that lasts longer than 30 days, this change could eliminate an important opportunity for trademark owners to register for the TMCH before the beginning of a Sunrise, in order to receive the full protection of claims notifications and to be eligible to participate from the beginning of a Sunrise.

The IPC also notes with concern that this proposal allows for allocation at 30 days post-notice, regardless of the length of the individual Sunrise Period. It is unclear how this will be implemented in a “first come, first served” Sunrise. Will applications be allocated in “first come, first served” order, or will identical applications be placed in “contention sets”? If the latter, how will contention sets be resolved? These issues are moot if no Sunrise registrations are allocated until the end of that TLD’s Sunrise Period, so that all Sunrise- and Registry-Eligible participants have an equal opportunity to submit potentially-competing claims. We maintain that such a system is preferable to a “first come, first served” Sunrise in any event.

Proposal for allocation of 100 names

The IPC objects to the proposed language which would allow ROs to allocate names to third parties before or during the Sunrise Period. This proposal clearly contradicts Section 3.2 of Specification 5, which allows ROs to activate names for their own use that are “*necessary* for the operation or promotion of the TLD.” (emphasis added) The proposal involves neither “necessity” nor RO use. As such, this is really a proposal to amend the Registry Agreement. For this reason alone, the proposal should be rejected.

The proposal is also troubling on its merits. Pursuant to Section 2.2.1 of the RPM Requirements document, Sunrise must be offered *before* any Limited Registration Period. This is clearly a Limited Registration Period in substance and must be subject to the same limitations as any other Limited Registration Period. The priority of Sunrise Registration over all other forms of third party registration must be respected and maintained.

The IPC can support pre-Sunrise allocation to the RO of names necessary for promotional information related to the TLD launch (e.g.: Sunrise.TLD) for the RO’s use, but these domains should NEVER be allocated, registered or controlled by third-parties, partners and/or affiliates at any time in the future.

The IPC can also support post-Sunrise allocation of names to third parties prior to General Registration – i.e., Limited Registration Periods. We are confident that these Limited Registration Periods can be used by ROs to support their business objectives without diminishing the rights of trademark owners.

Proposal for exemption procedure

In regard to TLD-specific startup plans, the IPC does not support granting exemptions for any proposal which would circumvent Sunrise Periods (as discussed above). As noted above, the IPC would support additional registration periods that come after Sunrise Periods. However, because these are already contemplated in the RPM Requirements (as Limited Registration Periods), there is no need for any exemption process. The IPC also opposed implementation of any TLD-specific clearinghouse. If a new clearinghouse has the same registration requirements as the TMCH, it is unnecessary; if a new clearinghouse has different registration requirements than the TMCH, it will create confusion and undermine trademark rights. Furthermore, it is not practicable at this point to develop and approve new clearinghouses, along with necessary corresponding dispute resolution policies and mechanisms. Although the IPC could consider supporting alternative clearinghouses to offer claims services after the claims period, we think that it is inappropriate to charge additional registration fees while the TMCH is operational, to avoid “double-billing” trademark owners. Therefore, if such limited clearinghouses are offered, all registrations in the TMCH should be included in such clearinghouses at no charge.

Of course, none of these comments should be read as opposition to voluntary adoption by registries of policies giving some degree of precedence (i.e., during Limited Registration Periods) to other non-trademark forms of IP (e.g., company names, book titles) or to non-IP criteria; nor does IPC object to the use of single-TLD or multi-TLD mechanisms to create and use databases of claims of entitlement to such precedence. We do not consider such databases to be “clearinghouses” within the meaning of this document.

Respectfully submitted,
Intellectual Property Constituency (IPC)