

Special Trademark Issues Report

PUBLIC COMMENTS SUMMARY AND ANALYSIS

(17 December 2009–27 January 2010)

Sources: The full text of the comments may be found at <http://forum.icann.org/lists/sti-report-2009/>

GENERAL

Key Points

- The recommendations contained in the GNSO STI Report (<http://gns0.icann.org/issues/sti/sti-wt-recommendations-11dec09-en.pdf>) reflect the carefully negotiated consensus position of the STI drafting team, which included representatives from each of the GNSO's Stakeholder Groups. These negotiations occurred during over a seven week period in response to the request issued by the ICANN Board that invited the GNSO Council (<http://gns0.icann.org/mailling-lists/archives/council/pdfHmFLGTtyhn.pdf>) to suggest an alternative model (referred to as the GNSO-STI Model) for an IP clearinghouse and Uniform Rapid Suspension Process that is more effective and implementable than the proposed Staff model.
- The GNSO-STI Model received the *unanimous* approval of the GNSO Council on 18 December 2009.
- In developing proposals to address trademark protection in the New gTLD program, Staff's approach for the AGB Model is to adopt *substantially all* of the GNSO-STI Model, and to diverge from them in instances where issues were overlooked or not considered by the STI team, or where the proposed implementation creates significant issues for ICANN.
- Overall, the comments generally supported the creation of a Trademark Clearinghouse, and the Uniform Rapid Suspension Procedure, but suggested modifications that would improve the benefits to rights holders.
- Many comments suggested that the GNSO-STI Model significantly watered down the protections that were proposed in the IRT Report, and that the resulting costs to rights holders from the STI proposal were likely to be high.
- Notwithstanding the reduced benefits to rights holders of the GNSO-STI Model, it is widely recognized that the Trademark Clearinghouse (TC) and Uniform Rapid Suspension (URS) process are an improvement beyond the status quo and are "at least something" to address some of the concerns of rights holders.
- Some comments state that the GNSO STI Model does not satisfactorily address the issue of trademark protection in new gTLDs and that more work is needed to achieve a resolution of this overarching issue.
- Some oppose expanding the trademark protections beyond the GNSO STI Model because they potentially grant protections beyond that available under trademark law, especially with respect to protections for generic words or trademarks that may have been registered in countries where there is no substantive evaluation of the mark prior to registration.
- Other comments addressed issues that were extensively considered by the STI team in their deliberations, but did not become part of the STI recommendations because they lacked consensus.

Summary of Comments

General Support for STI Recommendations

Richard Tindal; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS)

The gTLD Registries Stakeholder group thanks the STI group for its hard work and dedication to discussing and putting forth proposed solutions to balance the rights of intellectual property owners, businesses, noncommercial entities, users and the domain name registry and registrar communities. However, we note that there are still several implementation details that remain unclear regarding both the Clearinghouse and URS Policy solutions. We believe that these details are material, and should be subject to an open and transparent review by the ICANN community. *IPC Constituency Statement*

While INTA is pleased to see that the STI Recommendations are an improvement beyond the current status quo, given the importance of resolving the overarching issues with an unlimited number of new gTLDs, including trademark protection, INTA believes it is critical for ICANN to adopt the Trademark Clearinghouse and URS in a manner that may actually lead to increased protections. *Claudio DiGangi, INTA*

Time Warner supports the recommendations of the Special Trademark Issues (STI) review team that all new gTLD registries must use the Trademark Clearinghouse (TC) to support their pre-launch rights protection mechanisms and that all new gTLDs must participate in the Uniform Rapid Suspension (URS) procedure. At the same time, it is essential to view the STI report in context. It addresses only two of a number of proposed and extensively debated mechanisms that are aimed at preventing abusive registrations that will harm consumers and brand owners in the new gTLDs, and at providing effective and expeditious remedies when these registrations occur. Most of the other mechanisms that have been proposed fell outside the scope of the STI's remit, and thus were not addressed in its recommendations. At a yet broader perspective, the STI recommendations do not – nor were they intended to -- represent any forward progress on the other complex issues that must be satisfactorily resolved before it would be prudent or justified to open the application window for any new gTLDs. *Sandra Aistars and Fabricio Vayra, Time Warner*

FICPI agrees that the establishment of a TC (Trade-mark Clearinghouse) and a URS (Uniform Rapid Suspension system) may effectively address certain concerns of brand owners in the new gTLD space, however there is a concern that the STI recommendations do not go far enough in protecting the interests of brand owners. *Jonathan Cohen and Peter Rindforth, FICPI (Fédération Internationale des Conseils en Propriété Industrielle); Claudio DiGangi, INTA*

Concern that STI Report watered down IRT Recommendations

Leo Longauer, UBS; Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes; Roslyn Dickerson, InterContinental Hotels Group; Diane Hamer, BBC; Birgit Schnell, Red Bull

The recommendations of the STI are based upon the IRT report which was presented as “a tapestry of solutions”. We are concerned that by focussing on the Clearinghouse and the URS, valuable as we think they will be, ICANN is diluting the package of measures to protect IPR that the IRT proposed. In particular, we regret that more work has not been done to provide a remedy for the owners of globally well-known trademarks which face infringement after infringement. *Nick Wood, Cum Laude*

Cybersquatting, phishing and fraud have increased under ICANN's watch. The Internet is a potentially dangerous place to conduct business. ICANN's Board is obligated to ensure its actions do not cause further harm. But to date it is brand owners that have born the costs of preventing this harm by costly defensive registrations and UDRP actions. These are costs that are an externality to the business model

of the registry but born by third parties. The IRT recommendations set out to mitigate this unfairness but sadly a combination of ICANN staff and the domain supplier interests seems to have weakened the proposals during the GNSO process. AIM is concerned that the ICANN Board is therefore not fulfilling its role as a guardian of the public's trust. *Philip Shepard, Association Industries de Marque, European Brands Association; John Noble, British Brands Group*

MarkMonitor believes that the STI proposals of the URS and IP Clearinghouse have been substantially watered-down or minimized to render them potentially ineffective for the purposes for which they were originally intended. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom*

The IRT Report did provide some protection for trademark owners but as the Report was a compromise between trademark interests and registry/registrar interests the protection for trademark owners was still insufficient. The protection provided in the IRT Report has been weakened in the STI Report to such an extent that there doesn't seem to be much protection left for trademark owners. *Peter Kjær, LEGO Juris A/S*

Although Telestra Corporation generally supports the adoption of a Trademark Clearinghouse and URS, the current implementation is unduly burdensome and costly for trademark holders. However, with certain improvements, it would better balance the interests of trademark holders and other participants. *Isabelle Fabian, Telstra Corporation Limited*

Regrettably, Adobe finds the STI's recommendations fall far short of effectively remedying and alleviating the potential risks and costs to trademark holders that will accompany the implementation of new gTLDs. Moreover, with the STI Report and recent 3rd Version of the Draft Applicant Guidebook, ICANN continues to move in the direction of minimizing and limiting trademark protections for brand owners. Instead of developing and expanding the rights protection mechanisms proposed in the IRT Report, the STI Report significantly scales them back. *Daniel Poliak, Adobe*

We were disappointed to learn that ICANN only selected two variations of the RPMs recommended by the IRT for review by the STI Team, i.e. the Uniform Rapid Suspension ("URS") and Trademark Clearinghouse. *Sarah Deutsch, Verizon*

We believe that the current versions of the URS and TC provide very little protection for trademark owners, thus rendering such RPMs largely ineffective for the purpose for which they were originally intended. As discussed below, the remedies will wind up costing trademark owners millions of dollars, if not more, each year in new enforcement costs should the rollout of new gTLDs proceed as planned. *Sarah Deutsch, Verizon*

With the current narrow recommendation for the TC, together with the removal of the proposed Globally Protected Marks List, there is no longer an effective deterrent to brand abuse such as cybersquatting. *Leo Longauer, UBS*

The Board of Directors should not have eliminated the IRT's Globally Protected Marks List recommendation. The GPML would have served a valuable role in rendering defensive registrations unnecessary for the qualifying marks, and was the only IRT recommendation aimed at reducing the need for defensive registrations. *Russell Pangborn, Microsoft*

The IACC supports the overall thrust of the STI-RT report. The IACC is impressed with the results and considers it a serious effort to arrive at consensus on intellectual property protection measures to be applied in the new gTLD space. There are some exceptions. *Andrew Coombs, International Anti-Counterfeiting Coalition*

If the STI recommendations are fully adopted and effectively implemented in the context of a launch of new generic Top Level Domains (gTLDs), they will mark some progress toward increasing the chance that this launch will actually benefit consumers, and reducing the likelihood that the launch will have a pervasive detrimental impact on them. However, the STI's work must be viewed in context. Its recommendations are a far cry from constituting an adequate resolution of even the range of trademark-related issues arising from ICANN's proposed new gTLD launch, much less all the other unresolved issues that must be adequately addressed before the new gTLD application window opens. *Steve Metalitz, Coalition for Online Accountability*

What the STI review team has done is to tweak the IRT proposals for the TC and the URS to arrive at a formulation that all constituencies could accept as a mandatory feature of the new gTLD rollout. This is a significant accomplishment, but its significance must be precisely understood. In effect, all STI team members agreed that these provisions were necessary to protect the rights of brand owners and the public interest in preventing consumer confusion in the new gTLDs. However, there was no consensus that these two mechanisms were sufficient to advance those goals. COA, and many others, are convinced that they are far from sufficient. *Steve Metalitz, Coalition for Online Accountability*

We strongly support both the URS and the Trademark Clearinghouse, being valuable tools to assist in the protection of IP rights. However, we are concerned by the potential unravelling of the tapestry of solutions as proposed by the IRT which in itself was a heavily discussed consensus set of recommendations. Of these IRT recommendations, only two were considered by the STI and whilst the Trademark Clearinghouse and URS are swinging back in the right direction in the STI Recommendations as opposed to the ICANN staff proposals, modifications are still necessary for brand owners to have the appropriate minimum level of protection. *David Taylor, Lovells*

Given that it was the most requested solution in previous comments to previous versions of the Draft Applicant Guidebook, it is regrettable that the GPML was left aside as it would have helped avoiding thousands of defensive registrations, unnecessary court proceedings, UDRP proceedings and URS cases. If it is not going to be taken forward then the use of the Trademark Clearinghouse post launch would seem eminently sensible. Also the post-delegation dispute resolution procedure as included in DAG3 is at variance from the IRT version and needs reviewing. *David Taylor, Lovells*

We support the concepts of the TC and URS; however, targeted adjustments must be made to better protect existing trademark rights, further minimize burdens on DNS stakeholders (registries, registrars, registrants, and trademark owners), and help ICANN meet aspirations in its Affirmation of Commitments, in particular promoting consumer trust and choice, and preserving the security and stability of the DNS. *Erik Wilbers, WIPO*

Many stakeholders remain unconvinced that the proposed mechanisms sufficiently address the vast potential for increased trademark abuse, the attendant high costs of defensive registrations, and broader brand enforcement burdens. *Erik Wilbers, WIPO*

The New gTLD Program-related processes have to date consumed substantial resources. While representative bodies with substantive expertise have provided considered and consistent input, the impression exists that a narrow group of ICANN participants appear able to influence ICANN's deliberations in a manner which runs counter to the Affirmation of Commitments. The current constellation of processes calls for stable, level-headed deliberation. Where special interests translate into unworkable compromise, this will detract from the fundamental goal of minimizing rights abuse in the DNS without excessive need for court intervention. *Erik Wilbers, WIPO*

We continue to believe that a cost-effective and user-friendly Trademark Clearinghouse, along with a workable top-level rights-protection mechanism, an effective Uniform Rapid Suspension process and a

thick Whois model are critical elements that must be in place before new TLDs are brought on line.
Roslyn Dickerson, InterContinental Hotels Group

The STI Report presents considerable progress on the overarching issue of trademark protection since ICANN issued DAG1. Nonetheless, Microsoft continues to support the recommendations contained in the IRT Final Report as providing better and more comprehensive tools for preventing and combating trademark abuse than the tools contained within the STI Report. The Board of Directors should approve the STI Report recommendations as modified below. To avoid any doubt, it is our view that adoption and implementation of the STI Report, as modified, still does not “adequately address” the issue of trademark protection as required by the Affirmation of Commitments. *Russell Pangborn, Microsoft*

With regard to the STI Report, USCIB generally supports policy to create a Trademark Clearinghouse (TC) and Uniform Rapid Suspension (URS) system. While USCIB’s comments here are generally supportive of the aims of the TC and URS, we are unable at this time to offer detailed comment on the quality of either policy initiative toward effective rights protection goals. However, we do believe that the policy to create TC and URS procedures to protect trademarks should be consistent with the intent and thrust of the Implementation Recommendation Team (IRT) recommendations from last year. USCIB generally supported the recommendations offered by the IRT in their final report and reiterates its view that ICANN should proceed generally with all of the mechanisms set forth in the IRT report. *Christopher Martin, US Council For International Business*

As an Initial matter, we must express our disappointment that many of the rights protection mechanisms suggested by the Implementation Recommendation Team (IRT) were not included in the most recent Draft Applicant Guidebook or the STI Report. These mechanisms were intended to work together to create an overall system for trademark rights protection, and Intel continues to support inclusion of each interrelated mechanism, including a Globally Protected Marks list. Intel believes that the mechanisms included in the STI report are insufficient to protect the rights of trademark owners and urges ICANN to reconsider the addition of some or all of the additional mechanisms suggested by the IRT. *Kelly Smith, Intel*

Opposition to the STI Recommendations

While the latest report of the STI is a step in the right direction, it continues to go beyond brick and mortar trademark rules, provides too little protection for domain owners and gives TM holders a unfair and substantial advantage. Although this proposal on its face only effects new gTLD’s, it seems it is the clear intention of trademark groups to push for these same rules to be expanded to existing gTLDs in the near future. We are therefore commenting so that bad rules aren’t implemented that later put at risk legitimate registrants in existing gTLDs. *Michael Berkens, Worldwide Media*

Just as there are cybersquatters, there are also a group in the IP community who would not hesitate to bring forth frivolous claims in order to harass existing registrants and reverse hijack their rightfully owned domain names in order to gain an economic advantage. Both of these “extremists” in the registrant and IP groups need to be reined in by the rules. There needs to be a balance in place keeping in mind that almost every word, 2 letter combination, 3 letter combination and every saying or phrase is trademarked somewhere in the world. *Michael Berkens, Worldwide Media*

Large concerns with money appear control the factors here and little consideration given to the smaller less funded individual to resolve an issue. Way too many other inconsistencies for fairness. Please go back to the drawing board on this one. *Ed Lehman*

The worst part is that It seems to me there is little accountability in the URS to anyone other than trademark interests. There is simply an absurd bias towards trademark interests. How is the common

person's domain(s) protected here I ask? Where are the provisions that fairly protect those persons? How do individual domain owners benefit from the overreaching, zealous interests of million dollar corporations who decide they simply want a domain and don't want to pay for it. There needs to be a system of checks and balances or all out war over domains will take place. *Kelly Pitts*

Trademark Clearinghouse

Support for a Trademark Clearinghouse

Antony Van Couvering, Minds + Machines

With respect to the STI Recommendations, INTA agrees that a Trademark Clearinghouse and the URS can be effective to address some of the concerns of trademark owners with the new gTLD program. However, as discussed in more detail below, INTA agrees with many of the comments found in the Minority Positions filed by three of the eight groups which comprised the STI -- the Business Constituency, At-Large Advisory Committee, and the Intellectual Property Constituency -- that the Recommendations do not go far enough to provide sufficient protection to brand owners and consumers. *Claudio DiGangi, INTA*

We are pleased that you have chosen to include a Trademark Clearinghouse proposal, and thank you for doing so. While the clearinghouse may be inherently imperfect as a protection mechanism, for the community of international trademark owners whose consumer-facing brands are particularly attractive to abusers, it would be of great utility. *Leigh Fulwood, Costco*

The "Trademark Clearinghouse" is at least "something" to protect trademark owners once new gTLDs are registered. However, with certain improvements, it could become noticeable advantage for trademark owners. *Katja Grabienski, Hanna Karin Held, and Kay Uwe Jonas, JONAS Rechtsanwaltsgesellschaft*

Verizon does not necessarily oppose the TC, however, as with many of the comments filed to date, we too have come to the disappointing conclusion that it can only be commended as something, which is better than nothing. *Sarah Deutsch, Verizon*

The Trademark Clearinghouse should have broader application, as described in the Special Trademark Issues report and the minority reports of the Business Constituency and At Large Advisory Council. *Andrew Coombs, International Anti-Counterfeiting Coalition*

Trademark Clearinghouse is not a Rights Protection Mechanism

Leo Longauer, UBS; Bart Lieben, Individually; Diane Hamer, BBC; Kelly Smith, Intel

The IPC encourages the Board of Directors to approve, with certain modifications, the STI recommendations relating to a Trademark Clearinghouse database, Trademark Claims rights protection mechanism, and Sunrise rights protection mechanism. In doing so, it is important for the Board to recognize that the Trademark Clearinghouse is not, in and of itself, a rights protection mechanism. It is a database. Properly implemented, the Trademark Clearinghouse should reduce significantly the administrative and resource burden on trademark owners of participating in rights protection mechanisms in each new gTLD. Equally, it should reduce the administrative and resource burden of registries and registrars of implementing and facilitating participation in rights protection mechanisms. That anticipated reduction is valuable. *IPC Constituency Statement*

The current proposal for a Trademark Clearinghouse is that it is not a rights protection mechanism but only a database. Without the link to the IRT proposal of the Globally Protected Marks List (GPML) it does not address the trade mark issues the Board intended to address. *Philip Sheppard, AIM*

Neither the URS nor the TC reduces the cost and administrative burden for brand rights holders, especially in light of the elimination of the Globally Protected Marks List mechanics. In addition, the inability of the brand owner to force a transfer of a domain name as opposed to a freeze will require that the brand owner continuously monitor the name and potentially re-file URS actions every year or other year. Given the high costs of the TC and URS, it would be safe to assume that it would be cheaper for a company to file defensive registrations as opposed to re-filing URS actions and registering annually with a TC Provider. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom*

INTA also notes that the Trademark Clearinghouse by itself is not designed to provide any proactive protection to brand owners or consumers. Instead, the Trademark Clearinghouse is merely a centralized database designed to ease the burden of providing documentation to prove trademark rights for each new gTLD, and perhaps a source of information in any notification system to potential domain name registrants of possible infringement or dilution. As proposed, the Clearinghouse is therefore not, nor was it intended to be, a rights protection mechanism, since by itself it does little to deter abusive domain name registrations. Rather, the protection would stem from how the information maintained in the Clearinghouse is utilized, not from the mere repository of the information. INTA agrees with the Business Constituency that a feasibility study should be done to help define the scope and potential utilization of the Trademark Clearinghouse. *Claudio DiGangi, INTA*

INTA notes that the IRT intended that the Trademark Clearinghouse work in conjunction with the Globally Protected Marks List (“GPML”), which in turn would be used to restrict theregistration of certain obviously infringing domain names without requiring brand owners to overburden their portfolio with more defensive registrations. INTA continues to support the adoption of a mechanism that addresses the defensive registration problem as a key component in resolving the overarching trademark concerns that ICANN has committed to resolving before introducing new gTLDs. *Claudio DiGangi, INTA*

I would suggest the STI team to adopt a different approach, and in particular define the minimum requirements for a Sunrise or IP Claims policy for the future new gTLDs: which rights will be acknowledged, exact matches only or also variants, etc. These (consensus) policies or recommendations should be a floor, but not a ceiling, as any gTLD registry should – depending on its proposed gTLD – have the liberty to decide which other rights or circumstances should be accepted as well, in addition to these mandatory (or recommended) minimum requirements. *Bart Lieben, Individually*

Opposition to Creation of Trademark Clearinghouse

There is no need for a Trademark Clearinghouse that is sanctioned by ICANN. It can clearly be funded and created entirely by the private sector, and does not need to be “sanctioned” or funded in any way by ICANN. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

Trademark laws need to be respected not expanded. The irreparable harm and damage that can be done to a company, big or small, with thousands of employees or not, without FULL due process poses such a risk to commerce that this proposal should not be adopted. Some of the very supporters of this may find their own companies in peril in the future as an unintended consequence of their own support. *Rick Schwartz, erealestate.com*

Section 2.1 Separation of Functions

While the TC is necessarily a monopoly provider, the Validation Service Provider should not be awarded as a single-source monopoly. Just as multiple registrars introduced innovation and lower costs for

registrants, so too can multiple Validation Providers provide innovation and lower costs for trademark owners. *Thomas Barrett, Encirca*

Section 2.2 Regional Expertise

We can see no benefit in the creation of regional Clearinghouses. This will lead to inconsistency in the validation of trade mark rights and forum shopping. More importantly, it could also add very significant costs to new gTLD registry operators as they are forced to interact with more than one Clearinghouse. *Andrew Mills ECTA; Nick Wood, MARQUES*

The concept of a Trademark Clearing House is lauded however our major concern is with respect to the process of collecting the data/information. Countries like Nigeria, which is yet to join the African Regional Intellectual Property Organization, would not readily benefit from this approach. We would require ICANN to provide additional assurance that the means of collecting trademark data will not be limited to obtaining information from the regional registries and that local registries will be involved. *Adebola Akinkugbe, Aluko & Oyebode, Lagos, Nigeria*

Allowing and/or requiring regional subcontractors to provide additional validation services for the TC Service Provider is a unnecessary touch point that could potentially increase the cost that brand holders would have to pay each year to register with the TC Provider. There are already existing trademark service providers with worldwide offices that may already have this capability. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom; Birgit Schnell, Red Bull*

Section 2.3 Segregation of TC Database

This is a front-end interface implementation issue and does not address the concern that users may see co-mingling of data in their queries, which could occur even if the databases were separate. I think the intent could be better captured with a re-wording. *Thomas Barrett, Encirca*

Section 3.1 ICANN Accreditation

It is unlikely that a TC provider would provide a broad indemnification for errors including false positives that may occur. Moreover, such a requirement would certainly increase the cost of registering with the TC Provider. In addition, 24/7, 365 day customer service will likely increase the cost to the TC registrant. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom; Birgit Schnell, Red Bull*

It is not clear what the STI means with a “false positive”, in particular in the absence of clear processes and standards of how the Clearinghouse should be operated and with whom it must interact. In particular, it is not clear which of the situations below would be qualified by the STI team as a “false positive”:

- a registered trademark that was recently nullified by a court, and the official database of the competent trademark office has not been updated, reflecting the nullification?
- a trademark registration that was cancelled by the trademark owner, but due to a databases or, in the absence of an on line database, is not publicly available, unless an interested party would submit a request with the trademark office, and a response will be provided by the latter for a fee?
- trademark registrations that contain a disclaimer (for instance where the trademark office states that no exclusive right can be claimed for a particular part of the trademark because it is descriptive)? Will the inclusion of the all textual elements be considered a “false positive”? Or is only the non-descriptive part to be recognised?
- whether and how the Clearinghouse should accept signs that were registered, notwithstanding the fact that these words should not have been registered considering the national laws or international

conventions, such as: the “Red Cross”, the words “United Nations”, marks of official government authorities, etc., and this on a global scale;- and so on. *Bart Lieben, Individually*

One important element that seems to be missing in the STI Report – and in the final IRT Report – is how the operator of the Clearinghouse should deal with errors made by intellectual property holders and/or their registrars. Experience in working as a validation agent for multiple ccTLDs and gTLDs learns that more than 50% of the records submitted by intellectual property owners and/or their registrars contains incorrect information ... In terms of liability, this should be an area of concern for all members of the community, in my opinion. *Bart Lieben, Individually*

Trademark Clearinghouse Should Not Exclude Marks where there is no substantive review

Steve Metalitz, Coalition for Online Accountability; David Taylor, Lovells; Claudio DiGangi, INTA; Russell Pangborn, Microsoft; Bart Lieben, Individually; Diane Hamer, BBC; Kelly Smith, Intel

The IPC vigorously objects to the STI Recommendation that registries should have the discretion to exclude from their Sunrise or Trademark Claims processes trademark registration issued by countries in which the national authority does not conduct substantive examination. Trademark registration authorities in numerous countries -- including most European countries -- do not conduct substantive review as to some issues. Indeed, it is for the national Trademark Registry in each country to decide how to accept registrations and not something that a registry operator or ICANN should interfere with. *IPC Constituency Statement*

In regards to the concerns raised, INTA agrees with the IPC statement that “in order to address a few problematic registrations, the proper solution for such concerns is to deal with questions of scope and validity through filing deadlines, notice, disclosure, and challenge procedures.” For example, a domain name registrant could challenge a trademark as being merely generic in a sunrise challenge or in its answer to a URS complaint, which might be used to support a claim of the filing of an abusive complaint by the purported trademark owner. *Claudio DiGangi, INTA*

Time Warner agrees with the Intellectual Property Constituency that all trademark registrations of national or multinational effect must be eligible for the Trademark Clearinghouse, subject to notice, disclosure and challenge procedures to combat abuse. Drawing a distinction between registered marks that have received “substantive review” of trademark applications, and those that have not, is untenable; and leaving it up to new gTLD registries to draw this line and to decide which timely registered word marks qualify for their pre-launch rights protection mechanisms is not a viable compromise (see STI Recommendations, TC, at 5.2.i). *Sandra Aistars and Fabricio Vayra, Time Warner*

ICANN policy development should respect international and national legal and policy instruments. The STI Report prima facie permits registries and the URS to discriminate against jurisdictions that do not conduct “substantive review” of trademark applications. Presumably this is meant to exclude trademarks registered with national IP offices that do not conduct examination on relative grounds. It may be noted that these offices routinely provide for opposition procedures achieving similar effect. The STI recommendation goes against the observation made by the WIPO Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications in connection with the “Relation Between Opposition and Examination Procedures,” that neither approach (examination on relative grounds or opposition procedures) constitutes a preferred model. *Erik Wilbers, WIPO*

The current proposals give new gTLDs registries the option to exclude from a Sunrise or IP Claims Process trade marks from countries where there is no substantive review. Despite the fact that there is no definition of “substantive review”, we cannot see any justification for this. The effect of this measure if adopted would be to significantly disadvantage many trade mark owners and therefore the consumers

that depend upon their trade marks. In Europe alone, this proposal would specifically exclude any trade mark registered at the official Patent & Trade Mark offices in Austria, France, Germany, Italy, Spain and Switzerland. Marks held at the Benelux office and within OHIM, the European Community Trade Mark Office, would also be excluded. This is a non-exhaustive list. *Nick Wood, Cum Laude, MARQUES, European Communities Trademark Association*

The current proposal (5.2.i) requiring the possibility of “a substantive review” to prove eligibility for the clearinghouse ignores the absence of such possibilities in jurisdictions such as the entire European Union. This is a significant oversight and the proposal must be removed. *Philip Sheppard, AIM*

The restriction on including trade-mark registrations only from countries where “substantive review” of trade-mark applications is conducted is highly prejudicial to brand owners in a large number of jurisdictions, including many European countries and all Community Trademarks (CTMs), therefore FICPI does not support this recommendation. Instead, registrations issued by countries with no application review, for generic terms that typically could not be protected in most countries, should be scrutinized as part of the review process to ensure the trade-marks are not generic for the associated wares/services. Other suggestions which FICPI supports would include allowing domain name registrants to launch sunrise challenges or challenge “abusive” complaints by trade-mark owners based on the generic nature of a trade-mark. *Jonathan Cohen and Peter Rindforth, FICPI*

Trademark Clearinghouse Should Exclude Marks where there is no substantive review

To the extent the TC database is limited to trademarks, then such trademarks should be limited to trademarks in jurisdictions with substantive review. It should be mandatory for registries to use only trademarks registered in jurisdictions with substantive review given that allowing trademarks to be registered in the TC database in jurisdictions that do not have a rigorous review system, subjects the process to potential gaming by speculators. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom*

Our strongest support is for recommendation 5.2, which allows registries to discriminate between legitimate and non-legitimate domain name application based on class of trademarks, and to disallow trademarks from jurisdictions where there is no substantive review (in other words, where they are sold to whomever wants them). *Antony Van Couvering, Minds + Machines*

Section 4.1 National or Multinational Registered Marks

Design Marks Should Not Be Excluded

Diane Hamer, BBC; Áva SZIGETI, Dr., DANUBIA Patent & Law Office; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS); Leonora Hoicka, IBM; Bart Lieben, Individually,

The proposed exclusion of design marks from the Trademark Clearinghouse (4.1) will adversely, and disproportionately, impact small to medium enterprises and non-profit organizations that do not have financial resources necessary for registering numerous iterations of their marks. We recognize that including design marks will add complexity, but note that the launches of .eu, .asia, .mobi and .tel demonstrate that these complexities are clearly not insurmountable. *IPC Constituency Statement*

Under the .eu Sunrise, figurative marks were allowed provided that the sign exclusively contained a name, or the word element was predominant and could be clearly separated or distinguished from the device element. Subsequently, figurative marks were allowed under the .mobi, .asia, .tel, .me and .nl Sunrises which all adopted a consistent rule. In considering this rule, which has been proven to work in practice, it is worth noting that complaints under the UDRP can be filed on the basis of a figurative mark and that many small organisations have but one trade mark and that is often a figurative mark. *Nick Wood, Cum Laude*

Further consideration may be given to the implications of excluding protection of certain types of marks such as design marks (e.g., where the textual elements attain acquired distinctiveness, where textual elements are not disclaimed, or where design elements consist of non-local scripts). *Erik Wilbers, WIPO*

Many trademarks are protected worldwide solely by registrations that include the word mark with a design element, as registration for both the design mark and the text mark would be prohibitively expensive, and registrations for the composite of the design and words may extend protection to the word elements as well. Since expert review of marks going into the Trademark Clearinghouse is unavoidable, INTA believes that the most equitable process is for the Clearinghouse to include the textual elements found in design marks, provided that the mark sought to be included (i) is not a generic term and (ii) is presented in a prominent manner and can be clearly identified and isolated from the design element. This proposal is similar to the policy implemented by .ASIA. *Claudio DiGangi, INTA*

While we recognise the complexity that would be associated with including figurative marks in the Trademark Clearinghouse, we believe that it is a necessary effort to make since many entities throughout the world will not have registered multiple variations of the mark they trade under but rather the one mark they use to carry out their business activities which will often be a logo featuring a figurative element. As an example, we advised numerous clients on the launch of .EU in 2005 in order to ensure that they met the Sunrise period requirements. Figurative or design marks were permitted, as per section 19 of the .EU Sunrise Rules, provided that the sign exclusively contained a name, or the word element was predominant and could be clearly separated or distinguished from the device element. *David Taylor, Lovells*

The restriction on including text marks only is problematic due to the lack of an accepted international definition of what is a “text mark”. For example, in some countries, a mark consisting only of words in stylized lettering would still be considered design marks and thus ineligible for inclusion in the TC. Similarly, the inclusion of text elements from trade-marks containing both word and design elements would be prevented. FICPI supports the recommendation that the textual, non-generic, elements of design marks also be included in the TC. *Jonathan Cohen and Peter Rindforth, FICPI*

Design Marks Should Be Excluded

We strongly support recommendation 4.1, which restricts trademark rights to text-based trademarks and rejects the inclusion of design marks. As the report rightly notes, inclusion of design marks would expand trademark rights well beyond their current scope. *Antony Van Couvering, Minds + Machines*

The consideration of “design marks” by the STI, section 4.1, is an example of something which is neither feasible nor desirable. It suggests that the STI authors are unaware of the limitation on text labels in the DNS, of which domain names are one application. Regardless of what theories of right are advanced concerning sequences of labels, labels in isolation, or characters within labels, the definition of labels is not within the scope of ICANN, or anybody lobbying ICANN to advance its particular interests. The rationale offered for the non-inclusion of “design marks” should not make reference to some irrelevant policy framework, whether the rights associated with trademark holders is to be expanded, contracted, or left unchanged, but because of technical impossibility, absent a revision of the technical standard for text labels in the DNS. *Eric Brunner-Williams, Individually*

Trademark Clearinghouse must recognize Special Statutory Trademark Protections

Special trademark legislation from across the globe grants enhanced statutory protection for the Olympic marks, and numerous courts have recognized such protections. It is incumbent on ICANN Staff to recognize and account for the global enhanced protection of the Olympic trademarks. The TC must include a reserved names list for Olympic trademarks and/or recognize this special statutory protection as a basis for inclusion in the TC. *Urs Lacotte, International Olympic Committee*

Section 4.2 Common Law Rights

We support recommendation 4.2, which would allow (but not require) registries to include common-law trademarks, because it will eliminate a layer of confusion for some new registries. Geographical gTLDs in non-common-law jurisdictions, for example, would be hampered by a requirement to include common-law trademarks, while others may at their discretion allow them. *Antony Van Couvering, Minds + Machines*

Trademark Clearinghouse should include Common Law Rights and Other Protected Rights

Katja Grabienski Hanna Karin Hel, and Kay Uwe Jonas; Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom; Sarah Deutch, Verizon; David Taylor, Lovells; Jonathan Cohen and Peter Rindforth, FICPI; Roslyn Dickerson, InterContinental Hotels Group; Claudio DiGangi, INTA; Diane Hamer, BBC; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS); Birgit Schnell, Red Bull

The STI's recommendation that only court-validated common-law marks should be permitted in the Trademark Clearinghouse (4.2) is overly narrow and will adversely impact trademark

owners, often small or not-for-profit enterprises, in jurisdictions that recognize such rights. At a minimum, registry operators should be permitted to include such marks in their rights protection mechanism, and, in order to do so, will need the data about those rights in the Trademark Clearinghouse. To avoid any uncertainty, the IPC is not taking the position that all common-law marks must be included in the Trademark Clearinghouse; instead, the IPC position is that the registry operators should be permitted to respect such marks in their pre-launch rights protection mechanisms, and thus call for the inclusion of those marks in the Trademark Clearinghouse. *IPC Constituency Statement*

INTA welcomes the inclusion of common-law trademarks in the Trademark Clearinghouse, although it believes the Clearinghouse should not be restricted to court validated common-law marks only. More specifically, once a common-law trademark owner has gone through the more burdensome process of demonstrating the existence of a common law mark and validating that mark through the Trademark Clearinghouse process, it should be included in the Trademark Clearinghouse for future gTLD launches. However, the requirements for "use" capable of supporting a common law application for inclusion in the Clearinghouse should be clarified to be consistent with trademark principles. *Claudio DiGangi, INTA*

Under the .eu Sunrise Phase Two, 164,912 applications were made for 114,246 unique terms (see www.eurid.eu/files/2006_annual_report.pdf) including unregistered trade marks, trade names, business identifiers, personal names and the distinctive titles of protected literary and artistic works "insofar and to the extent they were protected by the national laws in which they were held. We recommend this model to ICANN. Many future registry operators may want to include common law rights and the Clearinghouse should support them. *Nick Wood, Cum Laude*

Trademark Clearinghouse should match to include at least the protection offered by the Dot Asia Sunrise Period and the Dot EU Sunrise Period. *Katja Grabienski Hanna Karin Held and Kay Uwe Jonas; Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes; Jonathan Cohen and Peter Rindforth, FICPI*

Wherever possible, we should not be overly prescriptive in limiting the function of TC and should instead let the marketplace (i.e. registry operators) decide the functions performed by the TC. This includes allowing the TC to include common law trademarks and other Rights requested by registries. *Thomas Barrett, Encirca*

Looking at the apparent interest in managing geographical community-based gTLDs, it is unclear why other local rights, apart from registered trademarks, should not be recognised by the Clearinghouse. In

many countries, small enterprises or individual entrepreneurs do not have the financial means to apply for trademark protection. Although most of the past Sunrise processes were based on registered trademarks, some also included other types of rights, such as – in the case of .EU (and to a certain extent also .ASIA and .NL). *Bart Lieben, Individually*

Protection should be expanded beyond “Identical Match”

Andrew Coombs, IACC; Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes; Jonathan Cohen and Peter Rindforth, FICPI; Yvette Wojciechowski, CADNA; Bart Lieben, Individually; Āva SZIGETI; Diane Hamer, BBC; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS); James B. Lake, Thomas, LoCicero & Bralow, on behalf of Publix Supermarkets; Birgit Schnell, Red Bull; Leonora Hoicka, IBM

INTA urges ICANN to adopt an approach for determining matches that would allow brand owners to submit for inclusion in the Trademark Clearinghouse both their trademarks and a descriptive term either (i) contained in the identification of goods or services covered by its trademark registration, or (ii) from the Nice classification for the registration. In addition, brand owners should be permitted to submit a verified list of generic or descriptive terms for which the brand owner can demonstrate they have trademark rights and have successfully prosecuted a UDRP or similar legal or administrative proceeding in the past. At a minimum, a match should include plurals of and domain names containing the exact trademark. *Claudio DiGangi, INTA*

The IPC believes that the date contained in the Trademark Clearinghouse should have broader application, as described in the STI report and the minority reports of the Business Constituency and At Large Advisory Council. Limiting this remedy to an exact match on the trademark seriously undermines the effectiveness of the proposed rights protection mechanisms utilizing the Trademark Clearinghouse. Because typosquatting and use of a trademark in tandem with generic dictionary words will not be captured by the rights protection mechanisms as outlined in both the IRT final report and the STI recommendations, the IPC believes that the effectiveness of the proposed rights protection mechanisms will be greatly diminished. The experience of trademark owners with abuse in the existing DNS indicates that the failure to allow the proposed rights protection mechanisms to include variants of the trademarks listed in the Clearinghouse is a key omission which will undermine the effectiveness of the proposed rights protection mechanisms. *IPC Constituency Statement*

As currently proposed, the Trademark Clearinghouse will consider only “identical matches” to trademarks and is to be employed only during pre-launch periods, providing insufficient protections for brand owners. *Daniel Poliak, Adobe*

Any use of the TC database should not focus alone on the exact trademark as listed but also consider confusingly similar variations since the vast majority of infringements may involve the trademark combined with other words or with misspellings (typosquatting) of the trademark. *Sarah Deutsch, Verizon*

Typosquatting and use of a trademark in tandem with generic dictionary words would not be captured by the Trademark Clearinghouse as outlined in the STI-RT. Trademark owners’ experience with abuse of the domain name space in existing gTLDs and use of these abusive domain names to market counterfeit merchandise indicate that these are key omissions which will undermine the proposed Trademark Clearinghouse. *Andrew Coombs, IACC*

TC should consider confusing similarity and foreign equivalents. *Urs Lacotte, International Olympic Committee*

At a minimum, FICPI supports the suggestion that “identical match” should include transliterations of a trade-mark in other alphabets or character sets designated by the brand owner. Presently, the STI recommendations do not explicitly state whether the TC would apply to IDNs, as recommended by the Final Report of the IRT. *Jonathan Cohen and Peter Rindforth, FICPI; Claudio DiGangi, INTA*

We feel that it is very important to go beyond “identical match” and trademark holders should be able to make use of the Trademark Clearinghouse to do this. For instance, any name that has been the subject of a UDRP or Court decision should be able to be included in the Trademark Clearinghouse - as it has already been the subject of an abusive registration. *David Taylor, Lovells*

TM Claims limited to identical matches at pre-launch provide limited benefit (i.e., exactly one domain name per TLD), requiring brand owners to additionally engage curative mechanisms (e.g., the UDRP, URS, or various court options). This is reflected in the BC and ALAC Positions calling to extend TM Claims beyond identical matches (a “match-plus”) e.g., to domain names that include textual or word elements of a TC-validated mark, and also post-launch. Extending TM Claims in this manner seeks to facilitate informed real-time registrations and minimize increased brand enforcement burdens. It also reflects the naming realities in many of today’s infringing registrations. The operation of this mechanism may be balanced through the introduction in the TC Claims Notice of non-exclusive examples of both non-infringing and abusive uses. *Erik Wilbers, WIPO*

Matches against marks listed in the Clearinghouse should be broadened to include more than just the identical hits recommended in the STI Report. Other gTLD launches, such as DOT Asia, included broader matching possibilities. There is no reason to limit the match to identical hits when the technology exists to address broader matches that are still clear infringements, such as the use of a brand name with a related generic term. *Paula Guibault, The Coca-Cola Company*

This should be re-worded as a minimum requirement. The TC should be able to be responsive to requests by registries to provide more than just identical matches. Registrants would benefit from awareness about possible conflicts. *Thomas Barrett, Encirca*

Section 5.1 Mandatory Pre-Launch use of Trademark Clearinghouse

Objection to first sentence in 5.2(ii) that: “Registries shall have discretion to decide whether to grant protections to trademarks in the TC” as overly broad. Second sentence of this sentence is sufficiently precise to identify the intended scope of the exception. *Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS)*

Registries should not have unilateral right to decide to grant protections to names in the Trademark Clearinghouse. *Leonora Hoicka, IBM*

Section 6.1 Use of the Trademark Clearinghouse for Ancillary Services

The TM Clearinghouse data should be in the public domain (i.e. there should be bulk access for the public to download it for free, just as they can for the .com zone file), and be available for free to successor TM clearinghouse operators (i.e. no perpetual monopolies). *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

We support recommendation 6.1, which allows trademark clearing house provider(s) to offer innovative services. *Antony Van Covering, Minds + Machines*

Opposition to Use of Trademark Clearinghouse for Ancillary Services

The IPC urges the Board to reject the STI's recommendation that the Trademark Clearinghouse or third-party service providers may use, impliedly without trademark owner consent, the data deposited by trademark owners into the Trademark Clearinghouse for ancillary services. The collection of trademark data anticipated to be housed by the Trademark Clearinghouse will be commercially valuable and, as a result, vulnerable to abuse and misuse. For this reason, the IRT recommended that trademark owners grant a license -- limited to the sole purpose of supplying data to registries and registrars for implementation of rights protection mechanisms. ICANN must not permit the use of this data for ancillary services by any entity without the trademark owner's specific consent as to each type of use. *IPC Constituency Statement; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS); Birgit Schnell, Red Bull*

Even though trademark information is publicly available, Telestra opposes allowing use of the data for ancillary services and suggests limiting the license for the sole purpose of assisting in the implementation of gTLDs. *Isabelle Fabian, Telstra Corporation Limited*

The top priority of the TPMs should be to educate the registrant such that, even before they begin the registration process, they have a clear understanding of whether their proposed domain name might infringe the rights of a third party. In order to accomplish this education, the Trademark Clearinghouse (TC) must be freely accessible and searchable to the public, just as the publicly-available Whois databases are. The search results must explain the purpose of trademarks and what rights they do and do not convey to the rights holder. *Thomas Barrett, Encirca*

The information that trademark owners submit to the Trademark Clearinghouse should only be shared with registries and registrars for the purpose of supporting RPM procedures, unless the trademark owner explicitly authorizes sharing of the information for another purpose. Intel objects to the licensing of its trademark information for unspecified and unlimited "ancillary services." *Kelly Smith, Intel*

The Board should reject the STI's recommendation that trademark owner data deposited with the Trademark Clearinghouse may be used by the Clearinghouse or third-party service providers without trademark owner consent. The data collected by the Trademark Clearinghouse will be vulnerable to abuse and misuse due to its commercial value. ICANN should adopt the IRT recommendation that trademark owners grant a license -- limited to the sole purpose of supplying data to registries and registrars for implementation of rights protection mechanisms. *Russell Pangborn, Microsoft*

Section 7.1 No Mandatory Post Launch Use of the Trademark Clearinghouse

George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Venture; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pit; Warren Royal; Jean-Sébastien Lascary

The Trademark Clearinghouse should be required to operate only pre-launch and not post-launch to avoid a chilling effect on registrations. The RSG further suggests that a registry should be able to voluntarily choose to employ the Trademark Clearinghouse post-launch, but this decision should be made at the discretion of the registry and not mandated. *The Registrar Stakeholder Group Statement*

We support STI Clearinghouse recommendation 7.1 (No Required Post-Launch TM Claims), and oppose the BC minority statement. Registries should have a choice to offer either a Sunrise or a trademark claims process, but should not be required to offer both. And if a registry offers a Sunrise, it should not be required to use the Clearinghouse to provide notifications to registrants, registrars, or trademark holders. *The Registry Stakeholder Group Statement*

The BC states that “A so-called ‘TM Claims’ service should be mandatory throughout the life of new gTLD registries, unless there is strong reason for an exception granted by ICANN.” This envisions a system that would inappropriately shift legal and cost burdens from trademark holders and registrants to registries. Registrants have always been responsible for determining if their registrations infringe upon the rights of others, and are bound to appropriate language in their registration agreements, as per ICANN requirements. Trademark holders are also responsible for protecting their marks. These fundamental concepts should remain in place, and registries should not be forced to assume the liabilities and costs of shielding trademark holders and registrants. *The Registry Stakeholder Group Statement*

Despite the comments by those in the Business community and others who have no experience in the administration or operation of domain name registries, the implementation of an Intellectual Property Claim service post launch in any real-time or near-real-time capacity would not only impose an undue hardship on domain name registries, but would significantly impact the ability of new registries to compete with the existing TLDs. This would be completely contrary to the purpose of introducing new TLDs in the first place – the promotion of competition and choice. Thus, the requirement to have any form of post launch Trademark Claims process is not only impractical, but should be considered a non-starter. *The Registry Stakeholder Group Statement*

Require Mandatory Post Launch TM Claims Service

Philip Sheppard, AIM; Isobelle Fabian, Telstra Corporation; Sandra Aistars and Fabricio Vayra, Time Warner; Clare Speed; Leigh Fulwood, Costco; Birgit Schnell, Red Bull; Sarah Deutch, Verizon; Leo Longauer, UBS; Steve Metalitz, Coalition for Online Accountability; David Taylor, Lovell;, Erik Wilbers, WIPO; Jill Luckett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes; Jonathan Cohen and Peter Rindforth, FICPI; Roslyn Dickerson, InterContinental Hotels Group; Yvette Wojciechowski, CADN; Claudio DiGangi, INTA; Diane Hamer, BBC; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS)

The first weakness of the clearinghouse is its limited purpose. The STI suggests the clearinghouse might be employed only for “sunrise” screening (5.1). Such limited use will render the clearinghouse largely ineffectual, because no doubt many infringers will seek to register infringing domains after the sunrise period. Screening will benefit not only trademark owners, but also registries, registrars, and unwitting registrants by providing them a way to avoid unnecessary disputes. Therefore, the clearinghouse’s services ought not be limited to sunrise use. *James B. Lake, Thomas, LoCicero & Bralow, on behalf of Publix Supermarkets*

Both Sunrise Periods and IP Claims services should be mandated for new TLDs. IP Claims should continue throughout the life of a TLD, since registrant confusion about possible trademark conflicts can exist not just during land rush, but whenever they attempt to register a domain name. *Thomas Barrett, Encirca*

It is not just brand owners who stand to benefit from a strong “TM Claims” service; cyber-squatting has a negative impact on our customers and the general public as well. A robust TMC is important to protect the rights of those who use the internet to purchase goods and services as well as those who market those goods and services. *Roslyn Dickerson, InterContinental Hotels Group*

The use of the TC database should not be limited to only sunrise periods for new gTLDs. A brand owner should be notified under a TC Claim if any registrant attempts to register its trademark post launch. To the extent marks are expanded beyond identical matches, this would be of far greater value to a brand owner. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom*

A so-called “TM Claims” service should be mandatory throughout the life of new gTLDs registries unless there is strong reason for an exception granted by ICANN. *Katja Grabienski Hanna Karin Held and Kay Uwe Jonas*

In order to help impede the abusive registration of domain names that are confusingly similar to the trademarks of others, NCTA and its members therefore strongly urge ICANN to require new gTLD registries to provide a Trademark Watch Service that makes use of the Trademark Clearinghouse both before and after the gTLD launch. *Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes*

To best utilize the efficiencies allowed by the Trademark Clearinghouse, Intel suggests that it be used not only by new gTLDs in pre-launch RPMs, but also in post-launch procedures (including the Uniform Rapid Suspension process and perhaps even UDRP proceedings) by all gTLDs (both new and existing). *Kelly Smith, Intel*

Section 8.1 TM Claims Notice

We support recommendation 8.1, which is essentially educative. Given the poor understanding of ICANN’s current trademark protection mechanisms by non-experts, provisions to provide registrants with an explanation of how the system works can only be helpful, and ultimately to the advantage of trademark holders. *Antony Van Couvering, Minds + Machines*

Section 10 Costs of Operating the Trademark Clearinghouse

The better form of the STI set of proposals is that where the applicant proposing a new registry has no policy mechanism to cure a problem which is reasonably certain to exist, that the registry operator eat the cost of accessing externally available mechanisms and policies, such as those proposed by the Working Group. Where the applicant has a policy and practice which is reasonably certain to make externally available mechanisms and policies of no actual value to the intended beneficiary, that the cost be borne by some party other than the applicant, or the requirement waived as being without necessity for the specific applicant. *Eric Brunner-Williams, Individually*

Costs should be borne by Rights Holders

It must be recognized that these mechanisms are primarily for the benefit of the rights owners, and the rights owners should bear the costs of their implementation. There must be a detailed examination of the potential impact on costs and liabilities to registries. Registries should not bear new liabilities as a result of implementing and administering the Clearinghouse and URS. To the extent that costs are imposed on registries for implementing and administering these mechanisms, such costs should be recovered in full and such cost recovery mechanisms should be guaranteed. *The Registry Stakeholder Group Statement*

The implementation of the Clearinghouse and URS may impose significant costs on registries. For example:

- The Clearinghouse is designed to increase efficiency by serving as a central database to provide information on trademarks. If registries must build and maintain systems to interface with the Clearinghouse, or to use it in Sunrise processes, there will be costs for technical, legal and administrative resources and expertise.
- It is unclear as to whether or how registries will be involved in the execution of URS decisions (described in more detail below). Many of the current proposals could potentially impose significant costs and liabilities on registries. *The Registry Stakeholder Group Statement*

Trademark Clearinghouse too costly for Rights Holders

Leo Longbauer, UBS; Roslyn Dickerson, Intercontinental Hotels Group; Yvette Wojciechowski, CADNA; Cody Zumwalt, Greg Philips and Thomas Lee, on behalf of Ford, Volvo, Audi, Honda Volkswagen and Hertz; James B. Lake, Thomas, LoCicero & Bralow

The TC operations will be funded from annual registration and validation fees that will come primarily from brand owners. Red Bull believes however, that the TC should be a service that is provided gratis to the Internet community by ICANN. At very least, the TC should be funded by a combination of fees from ICANN and brand owners and/or other parties. This will keep the TC registration fees at a reasonable level. *Birgit Schnell, Red Bull*

The proposal for the Trademark Clearinghouse does not lessen the burden on trademark owners – on the contrary. *Peter Kjær, LEGO Juris A/S*

Neither the URS nor the TC reduces the cost and administrative burden for brand rights holders, especially in light of the elimination of the Globally Protected Marks List mechanics. In addition, the inability of the brand owner to force a transfer of a domain name as opposed to a freeze will require that the brand owner continuously monitor the name and potentially re-file URS actions every year or other year. Given the high costs of the TC and URS, it would be safe to assume that it would be cheaper for a company to file defensive registrations as opposed to re-filing URS actions and registering annually with a TC Provider. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom*

The TC operations will be funded from annual registration and validation fees that will come primarily from brand owners. MarkMonitor believes however, that the TC should be a service that is provided gratis to the Internet community by ICANN. At the very least, the TC should be funded by a combination of fees from ICANN and brand owners and/or other parties. This will keep the TC registration fees at a reasonable level. *Fred Felman, MarkMonitor; Jennifer Martin Nordstrom; Leonora Hoicka, IBM*

Support the Business Constituency Minority Position that the costs of the TC should be borne by ICANN and the registries. *Isabelle Fabian, Telstra Corporation; Sandra Aistars and Fabricio Vayra, Time Warner; Steve Metalitz, Coalition for Online Accountability; David Taylor, Lovells; Erik Wilbers, WIPO; Diane Hamer, BBC*

Costs associated with the Clearinghouse, in the form of annual and validation fees, are to fall disproportionately on trademark owners with no amount to be borne by ICANN or the applicants for new gTLDs. *Daniel Poliak, Adobe*

We think that ICANN, Registries, Registrars and Trade mark owners (e.g. users) should equally bear the costs of operating the Trademark Clearinghouse, as all of these parties will benefit from it. *Nick Wood, Cum Laude*

We align ourselves with the minority position of the Business Users Constituency to the effect that since the protection afforded by the clearing house is minimal (i.e. covers only registration of exact match of the registered trademark), the fee to be paid by users should be minimal. *Adebola Akinkugbe, Aluko & Oyebode, Lagos, Nigeria*

We believe that the current versions of the URS and TC provide very little protection for trademark owners, thus rendering such RPMs largely ineffective for the purpose for which they were originally intended. As discussed below, the remedies will wind up costing trademark owners millions of dollars, if not more, each year in new enforcement costs should the rollout of new gTLDs proceed as planned. *Sarah Deutsch, Verizon*

We believe that the TC should be run on a not-for-profit basis and costs associated with using the TC should be shared by all parties, including ICANN, who benefit from its services. These protections will help keep the TC registration fees reasonable for all stakeholders. *Sarah Deutsch, Verizon*

The TC should be funded entirely by registries, registrars and registrants, and trademark holders should not fund the TC. *Urs Lacotte, International Olympic Committee*

NCTA and its members believe that it would be equitable for the registries and/or ICANN to share in the costs associated with a Trademark Clearinghouse. The original proposal providing that trademark owners would pay a reasonable fee to the Clearinghouse to have a mark verified and entered into the database and the registry operators would pay a reasonable fee to have the Clearinghouse conduct Sunrise or Trademark Watch services is far more equitable than placing all of the costs on the trademark community. *Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS)*

Any fees paid by a trademark owner to submit its trademarks to the Trademark Clearinghouse (whether for inclusion to support sunrise registrations or as part of a TM Claims service) should be limited to a minimal registration fee. In our view, most of the operating costs of the clearinghouse should be borne by the new gTLD registries as a cost of ensuring IP protection in the rollout of new gTLDs. *Kelly Smith, Intel*

The Trademark Clearinghouse should not be funded by brand owners alone. The Clearinghouse will also benefit registrars and ICANN by providing administrative and data checking functions, and will benefit the public by preventing adoption of at least some fraudulent domain names in the new gTLDs. Payment of the fees for use of the Clearinghouse therefore should reflect that it benefits all constituencies. Payment of the fees for use of the Clearinghouse should also reflect the significant costs brand owners already bear under the current domain name system, which will only increase with new gTLDs. *Paula Guibault, The Coca-Cola Company*

Database Structure

Trademark Clearinghouse to be set up at the outset with suitable procedures and infrastructure so that its use may be expanded in the future. *Leigh Fulwood, Costco*

Generic Words

Stop allowing companies and individuals to steal generic words and phrases from domain owners. There have been many instances where domain owners lost ownership of domains they owned BEFORE any trademarks were registered for that word or phrase. Also when reverse high jacking has been determined by the panel or individual arbitrator there has been NO severe penalties to the individual(s)/groups that initiated the complaint to deter these frivolous complaints. *S Barclay*

“Validation” at the clearinghouse would be gamed by those holding the weakest marks (e.g. trademark trolls), often for the sole purpose of asserting claims on generic descriptive domain names that they would otherwise not be entitled to. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

Ability to Challenge contents of an IPR Record in the IP Clearinghouse

In my view, it makes more sense from an operational and legal point of view to provide for a procedure whereby a third party has the right and the ability to challenge the existence and/or contents of an IPR record in the IP Clearinghouse. *Bart Lieben, Individually*

Analysis of Public Comments on Trademark Clearinghouse

The proposed AGB Model for a Trademark Clearinghouse diverges from the GNSO-STI Model in the following respects:

Treatment of trademarks registered in countries that do not conduct substantive review.

The GNSO'S proposal to allow registries to exclude registrations from particular countries was the subject of extensive comment. The GNSO-STI Model requires registries to provide equal protection to all trademarks in the TC database except in certain circumstances. One exception (Section 5.2(i)) gives registries the discretion to exclude protection for trademarks from countries that do not conduct substantive review. This GNSO-STI recommendation received significant opposition from a broad cross-section of commentators. Specifically, several comments noted that trademarks from many countries in Europe would not qualify for protection under the STI proposal. Others highlighted the difficulties that ICANN could face in implementing this recommendation and identifying the countries that do qualify for protection.

Those opposed to expanding the protection these countries point to the ease by which generic words can be registered in such countries. Requiring protection for such marks potentially excludes a large list of premium, desirable names from being available to the general public.

Adopting this GNSO-STI recommendation does not satisfy ICANN's goal of identifying a global solution to the issue of trademark protection in new gTLDs. The ICANN community should explore whether a compromise position may be possible to afford protection for *all* countries. The following alternative approach suggested by, or in response to, comments could accomplish the goals of the GNSO and satisfy concerns raised:

- Registries must recognize in sunrise or trademark claims services one of the following: (1) all registered trademarks in the Trademark Clearinghouse database, or (2) all registered AND validated trademarks in the Trademark Clearinghouse database. (Such validation could be satisfied either at time of trademark registration as in some countries or by subsequent validation by the trademark clearinghouse or its agents to determine whether the rights holder has used the registered trademarks in connection with the goods and services applicable to the registration.)
- A challenge procedure could be adopted allowing challenges to any trademark in the Trademark Clearinghouse that has not been validated for use in these countries. The rights holder would submit to the additional validation requirements established by the Trademark Clearinghouse validator in order to receive the same protection applicable to the other trademarks in the registry, either at the initial submission of its information to the Trademark Clearinghouse, or at the time of challenge.

Staff recommends inclusion of the first alternative, but has included both suggestions in the AGB Model for discussion purposes. Other alternatives were suggested in the public comments, such as developing a generic words list that could be excluded from sunrise protection. These proposed alternatives are not exhaustive, but are suggested as a means of soliciting discussion and commentary from the Community to identify a practical resolution of this important issue.

Comments resulting in no change to AGB due to prior consideration by the GNSO-STI drafting team

Several comments raised issues that were extensively evaluated by the GNSO-STI drafting team. Since the GNSO STI Model reflects compromises reached by the participants after ample consideration of these concerns, the AGB Model proposes adoption of the GNSO-STI approach without change. The comments in this category include the following:

- Concerns that the use of regional expertise would increase the costs to rights holders. Design marks should not be excluded from the TC database.
- The TC database should include common law marks in addition to registered trademarks
- Registries should be required to extend protection beyond “identical matches, to include (i) marks plus generic words, (ii) typographical misspellings, or (iii) foreign transliterations of the mark.
- Registries should be required to offer a post launch trademarks claims service.
- Concerns that the costs of participating in the TC are too burdensome for rights holders.
- Suggestions to shift the entire costs of operating the TC to ICANN, or to the registries.

Comments resulting in clarifications the GNSO-STI Model

Scope of License of TC database for ancillary services

Several comments indicated that trademark holders should consent to use its trademark information for ancillary services, and that the license from the trademark holder to the TC database should be limited to only allow uses related to implementation of rights protection mechanisms. The AGB Model includes appropriate license terms to restrict the use of this information, and requires consent of the trademark holder to have its information used for ancillary services.

Other comments emphasized that the information in the TC database should be freely searchable and accessible to the public, to serve as an educational service for registrants to research whether their proposed use of the domain name infringes upon the rights of others. Since the GNSO-STI Model did not suggest broad use of the TC database, and limited use of the TC database to specific research by a registrant for TM Claim’s notices received, the AGB Model follows the GNSO-STI Model in this regard.

Comments not fully explored by the GNSO-STI Drafting Team meriting further consideration

- **Concerns on the broad indemnification required for false positives.** Some comments expressed concern over the broad indemnification requested of service providers (Section 3.2 of the GNSO-STI Model) for false positives, and noted the difficulties that ICANN could face in defining false positives. The AGB Model addresses this concern by clarifying that such indemnification should be sought “to the extent practicable.”
- **Protection of Special Statutory Trademark Protection.** One comment (Urs Lacotte, International Olympic Committee) stated that certain marks are entitled for enhanced statutory trademark protection, and should be eligible for inclusion in the TC, and for protection along with registered trademarks, or be included in a reserved names list. Upon further research and evaluation of this issue, it may difficult to identify a definitive list of such special trademarks that exist all over the world. For example, in the United States alone, approximately 70 statutes have been enacted providing various degrees of additional statutory protection to different marks. However, as noted in Mr. Lacotte’s comments, these protections have been upheld by the courts for the Olympic marks. As a result, such marks would be eligible for inclusion in the Trademark Clearinghouse through the procedure for court validated common law marks.

Special Trademark Issues Report – Uniform Rapid Suspension System (URS)

PUBLIC COMMENTS SUMMARY AND ANALYSIS

(17 December 2009–27 January 2010)

Sources: The full text of the comments may be found at <http://forum.icann.org/lists/sti-report-2009/>

Summary of Public Comment on the URS

Support for the URS

Daniel, Schindler; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS)

The IPC believes that the URS, if properly implemented, will be an important remedy for brand owners to effectively and efficiently address clear cut cases of abusive domain name registrations. However, the IPC believes that the STI Recommendations on the URS make it far too easy for serial cybersquatters to manipulate the systems. ICANN must address these vulnerabilities in order for the URS to have the intended deterrent effect on abusive registrations. *IPC Constituency Statement*

INTA believes that the URS can be an important remedy for brand owners to effectively and efficiently address abusive domain name registrations. The Recommendations, however, would not prevent the URS from being easily manipulated by cybersquatters, thereby limiting its value. *Claudio DiGangi, INTA*

The URS has the potential to be an important remedy for abusive domain name registrations. Sadly, the current recommendations, make it a weak remedy. *Philip Sheppard, AIM*

The Globally Protected Marks List is not part of the STI Report which is very disappointing as it might have been the rights protection mechanism that could have provided some relief for trademark owners of such marks. *Peter Kjær, LEGO Juris A/S*

Support of the Minority Position from the Business Constituency that the costs for the URS will not be significantly lower than the fees associated with the UDRP. *Isabelle Fabian, Telstra Corporation Limited; Roslyn Dickerson, InterContinental Hotels Group, Diane Hamer, BBC*

In our opinion, ICANN has not yet solved the overarching trademark issue and the STI report is not the right path to take in order to solve this issue. We urge ICANN to solve the trademark issue before any new gTLDs are released. *Peter Kjær, LEGO Juris A/S, INTA*

We wish to reiterate the fact that significant concerns remain with respect to the four overarching issues raised by ICANN with regard to the introduction of new gTLDs and additional work remains to be conducted before ICANN can move forward. *Sarah Deutsch, Verizon*

The availability of an effective URS continues to be one of the most important trademark protection mechanisms for trademark owners, including Verizon. Its purpose should be to provide the quickest and cheapest solution possible, as opposed to the relatively lengthy and costly Uniform Dispute Resolution Policy (“UDRP”) proceeding. We believe that this remedy, as currently proposed, will not provide a complete remedy for trademark owners. Instead, the URS will require trademark owners who will inevitably be targets of cybersquatting across potentially thousands of new gTLDs to engage in continual monitoring and will raise costs for businesses and their customers. *Sarah Deutsch, Verizon*

In short, new gTLDs will result in more UDRPs, more lawsuits, more monitoring and more enforcement costs for trademark owners. As we stated in the past, the Coalition against Domain Name Abuse (CADNA) conservatively estimates that brand owners worldwide could suffer from over \$1 billion in losses as a result of diverted traffic and the loss of consumer trust and goodwill. *Sarah Deutsch, Verizon*

We are concerned that the URS proposal will not provide a cheaper or faster solution than filing a UDRP. Not only does the URS require a “much higher burden of proof” but a successful URS will not result in the transfer of the domain name to a successful complainant even though the complainant has to bear the costs of filing a URS. *Leo Longbauer, UBS; Cody Zumwalt, Greg Philips and Thomas Lee, on behalf of Ford, Volvo, Audi, Honda Volkswagen and Hertz*

COA continues to strongly support an expedited takedown mechanism for clearly abusive domain name registrations. At least so long as the required pre-launch mechanisms are limited to exact matches between registered marks and domain name registrations, such an enhanced post-launch remedial system is indispensable. *Steve Metalitz, Coalition for Online Accountability*

We support mandating the availability of a properly-designed rapid suspension mechanism as an expedited and cost effective complement to the UDRP. Although aspiring to this goal, in its current form the URS produces few net gains over the existing UDRP. *Erik Wilbers, WIPO*

Intel agrees that the URS can be a beneficial implementation tool for RPMs and should be required in the new gTLD program. But for the URS to have any benefit to Intel, it should afford a less expensive and quicker resolution than that afforded by the UDRP process. As currently described in the STI Report, it does not. *Kelly Smith, Intel*

MARQUES and ECTA support the URS as a low-cost and rapid means of tackling abusive domain name registrations where is no genuine contestable issue as to the infringement and abuse that is taking place. This is a long overdue, and very welcome, proposal. *Andrew Mills ECTA; Nick Wood, MARQUES*

Opposition to the URS

While we support the concept of a URS, we feel that the proposed URS falls short in protecting the rights of registrants. The proposed URS looks too much like a fast-track UDRP. The URS should not have the same elements as the UDRP and should not rely on any precedents provided by UDRP decisions. There are too many poor UDRP precedents that should be disregarded. *Thomas Barrett, Encirca*

We oppose the URS in principle, as it will be abused and used to harass legitimate registrants. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

Concern that the URS watered down the IRT’s URS Proposal

The Uniform Rapid Suspension (URS) proposed in the STI Report is also much weaker than the URS proposed in the IRT Report. It doesn’t seem to be more rapid or cheaper than the ordinary UDRP and the domain name is only blocked for a short period of time with the possibility of perpetuating the cyber-squatting. Again, the trademark owners’ burden is not lessened. *Peter Kjær, LEGO Juris A/S*

Section 2.1

Safe Harbors

The Safe Harbor language in section 3.1.b of Annex 6 should be clarified to make clear that websites associated with disputed domain names are not considered abuse under the policy only if the site “operated solely in tribute to or in criticism of a person or business” is found to be “fair use.” As written,

the language suggests that all such sites are always automatically deemed fair use and not considered abuse under the policy. *Russell Pangborn, Microsoft*

The “Safe Harbors” in the URS should include the words “without limitation”, to ensure that they can grow over time. The policy is flawed because URS providers have a financial incentive to expand the definition of “abuse” over time, but registrants should have that same power to check that growth through their own examples of good faith usage. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal, Jean-Sébastien Lascary*

Section 2.4

Standard of Review is too high

Cody Zumwalt, Greg Philips and Thomas Lee, on behalf of Ford, Volvo, Audi, Honda Volkswagen and Hertz

INTA is concerned that it may be very difficult for a trademark owner to prove by “clear and convincing” evidence that the registrant lacks a “legitimate interest” in the domain name. This involves proving a negative, which can rarely be done in more than a presumptive manner. Indeed, a more logical system is for the registrant to bear the burden of proving that it has a legitimate interest once the complainant has established by clear and convincing evidence the other elements of a URS complaint, namely that the registered domain name (i) is identical or confusingly similar to a trademark in which the complainant has rights and (ii) was registered and is being used in bad faith. Accordingly, consideration should be given to treating “legitimate interest” in the domain name as an affirmative defense of the registrant for which it should bear the burden of proof. *Claudio DiGangi, INTA*

The current URS requires the trade mark owner to prove a negative. It requires “clear and convincing” evidence that the registrant lacks a “legitimate interest” in the domain name. This must be changed to make the registrant prove that it has a legitimate interest to a name that is identical or confusingly similar to the complainant’s trademark. *John Noble, British Brands Group; Philip Sheppard, AIM*

It is not clear how the “clear and convincing standard” can be met if the complaint is to be designed to be as simplistic and formulaic as possible. By reducing the evidence allowed, additional guidance is needed to explain how a trademark holder can meet this standard. *Isabelle Fabian, Telstra Corporation Limited*

There is a concern that the standard of proof required by the URS is too onerous in that proving the registrant’s lack of legitimate interest in a domain name is often impossible. A suggested alternative is to place the burden of proof on this ground on the registrant once the complainant has established the other elements of the complaint (identical or confusingly similar trade-mark in which the complainant has rights, and registration and use of domain name in bad faith). *Jonathan Cohen and Peter Rindforth, FICPI*

The proposed URS requires the trade mark owner to prove “clear and convincing” evidence that the registrant lacks a “legitimate interest” in the domain name. This must be changed to make the registrant prove that it has a legitimate interest to a name that is identical or confusingly similar to the complainant’s trademark. *Andrew Coombs, IACC*

We believe that if the complainant has to demonstrate rights in a term then a respondent to a URS should also be required to prove that it has a legitimate interest in a term that is identical or confusingly similar to the complainant’s trade mark. *Andrew Mills ECTA; Nick Wood, MARQUES*

Section 3

Notice to Registrant

The STI-proposed URS (unlike the UDRP) provides registrants an opportunity to file an answer at any time during the life of the registration as part of a standard “grace-period” within the URS examination. Moreover, as this grace-period is not subject to any re-examination fee up to 30 days after a decision is rendered, this may be subject to abuse, and disincentivizes the filing of timely answers. This may impact panel availability and in effect requires re-examination of the case without remuneration.

There should be notice made to attorneys of the domain registrants, whose legal contact data would appear in the public Whois on an opt-in basis. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Venture; Alan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

20 days is insufficient notice, especially for domains that have been registered for long periods. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Alan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

CADNA also disagrees with the dispute resolution timeframe set out by this model of the URS. According to this model, filing a complaint puts the domain name on a “freeze,” which means that the domain cannot be transferred but will continue to resolve to the same content during a 20-day response period granted to the registrant. This response time is not nearly rapid enough in the case of truly harmful content. CADNA proposes that the 20-day window be shortened to a 5-day window in order to expedite the process of resolving the complaint and to create a truly “rapid” response. *Yvette Wojciechowski, CADNA*

Intel believes that to expedite the process, the respondent should have less than 20 days to answer the Complaint. The UDRP response time is 20 days; for the URS to be truly “rapid” it should allow less time for response. *Kelly Smith, Intel*

The STI Report does not identify the time period within which the initial examination that triggers the “freeze” of the domain name must occur. A time period should be set -- preferably 24 hours. The 20-day answer period should be shortened to 14 days, as recommended by the IRT. A 20-day answer period, combined with an undefined initial freeze deadline, runs the risk of slowing the “rapid” in Uniform Rapid Suspension procedure, and the “rapid” aspect is highly desirable to trademark owners. Adopting the IRT timelines will not prejudice registrants, who will still have ample time to respond and can utilize the Default Answer procedure in the highly unlikely event that they have no email access for 16 days. *Russell Pangborn, Microsoft*

Section 4

Answer

The STI-proposed URS (unlike the UDRP) provides registrants an opportunity to file an answer at any time during the life of the registration as part of a standard “grace-period” within the URS examination. Moreover, as this grace-period is not subject to any re-examination fee up to 30 days after a decision is rendered, this may be subject to abuse, and disincentivizes the filing of timely answers. This may impact panel availability and in effect requires re-examination of the case without remuneration. *Erik Wilbers, WIPO*

Although STI Recommendation 5.2 makes no mention of any fees payable by a domain name registrant when filing an answer to a URS complaint, the IPC believes that the fee mechanism set out in Section 5

of the IRT final report that required a registrant to pay a fee to file a response when more than 26 domain names are at issue is the best model to assist in thwarting manipulation of the URS by serial bad actors. *IPC Constituency Statement; Claudio DiGangi, INTA*

Contrary to STI Recommendations 4.3 and 5.3, if an answer is filed after a default decision, the domain name should not automatically be redirected to the registrant's name servers. Rather, the filing of an answer after a default decision should be treated the same as an appeal with respect to maintaining the status quo of the domain name prior to the filing of the appeal or late answer. *Claudio DiGangi, INTA,*

MarkMonitor does not believe that TC registrants should be allowed a de novo review at any time (during the life of the registration) after a respondent fails to file an answer. Under this scenario, in the event of a five (5) year registration, if a URS case is filed in the first year then the case would effectively stay live for four years. MarkMonitor would instead suggest a grace period for a de novo review of a default judgment. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom; Birgit Schnell, Red Bull*

Section 4.1

Domain locking/freezing should be done by the *registrar*, NOT the registry operator. This would allow the registrar to also contact their client, to improve the odds of actual notice. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Michael Berkens, Worldwide Media; Allan Wilson, Max Menius, Menius Enterprises*

Section 6.2

Pre-Registration for URS

Any fees that will be charged in order to enable URS procedures will ultimately be passed on to brand owners. These additional fees will make it likely that brand owners will not take advantage of these potential benefits of the TC. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom*

We do not support linkage between the TC and the URS (in 6.2), unless the domain registrant is in the same country/jurisdiction as that of the TM. *Michael Berkens, Worldwide Media*

Section 6.5

Fairness of Examiners

The STI Report recommends that examiners "have a legal background and should be trained and certified in URS proceedings." Requiring expensive and/or time-consuming training and establishing a complicated certification regime could significantly limit the number of persons interested and qualified to be Examiners, particularly since Examiners will receive low examination fees. The abuse guidelines for Examiners, depending on their content, could have a similar unanticipated adverse consequence. *Russell Pangborn, Microsoft*

In order to ensure that there is no forum shopping, the URS provider should be selected by the *registrant* (or alternatively the registrar), not by the complainant. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

Section 7

URS Remedies

The IPC believes that the better approach would be to allow the successful Complainant to pay a reduced fee in order to keep the domain suspended for one additional term equal to the initial

registration term and, at the end of this additional period of suspended registration, allow the successful complainant the opportunity to purchase the domain name before it is returned to the pool of available domain names. *IPC Constituency Statement*

The RSG supports permitting the Whois record to be updated after a successful URS proceeding so that the original registrant's contact information is removed and the registrant Whois record reflects "SUSPENDED" status. *The Registrar Stakeholder Group Statement*

A remedy that allows the domain name to be put on hold indefinitely along with the inclusion of a transfer option will also help eliminate this loophole. Without the transfer or indefinite hold options, the costs and gaming associated with the URS will simply drive trademark owners back to using UDRP proceedings or filing lawsuits, where it is possible to do so. *Sarah Deutsch, Verizon*

An alternative to a transfer remedy would be that subsequent registrants should receive notice of prior suspensions, and should bear the burden of overcoming a presumption of bad faith in order to register. *Urs Lacotte, International Olympic Committee*

A reserved names list (see, e.g., the auDA Policy) may more effectively bolster the URS concept, in which case, to avoid unfair prejudice, there is scope for a bona fide third-party registration mechanism. *Erik Wilbers, WIPO*

Trademark Holders should be given the right to point traffic from a domain name to their website if successful in a URS proceeding, if no transfer is available. *Cody Zumwalt, Greg Philips and Thomas Lee, on behalf of Ford, Volvo, Audi, Honda Volkswagen and Hertz*

Possible solutions could include indefinite suspension of domains, suspension for whatever period of time the successful complainant maintains its verified trade-mark information in the TC, or, at a minimum, notification of brand owners of the impending deletion of a domain. *Jonathan Cohen and Peter Rindforth, FICPI; Claudio DiGangi, INTA*

The remedies in 7.1 and 7.2 may not be appropriate for non public TLDs such as a .brand TLD. In those instances, cancellation of the domain name may be the appropriate remedy. *Leonora Hoicka, IBM*

URS Remedies should include a Transfer of the Domain Name

Dan Poliak, Adobe; Urs Lacotte, International Olympic Committee; David Taylor, Lovells; Jonathan Cohen and Peter Rindforth, FICPI; Roslyn Dickerson, InterContinental Hotels Group; Yvette Wojciechowski, CADNA; Claudio DiGangi, INTA; Diane Hamer, BBC; Cody Zumwalt, Greg Philips and Thomas Lee, on behalf of Ford, Volvo, Audi, Honda Volkswagen and Hertz; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS); Kelly Smith, Intel

There is no advantage in using the URS as long as no transfer of the domain name is a remedy. Unless transfer of the domain name is remedy in the URS proceedings, it will be necessary to additionally file for an UDRP proceeding (including all fees and preparation costs). *Katja Grabienski, Hanna Karin Held, and Kay Uwe Jonas, JONAS Rechtsanwalts-gesellschaft; Claudio DiGangi, INTA*

We believe that the proposed remedy of suspending a domain name is insufficient. We would like a successful complainant to be given the option of requesting a transfer of the domain name either on winning the complaint or when the current registration period expires (as is allowed at DENIC under its "Dispute Entry" programme). The current proposal of allowing disputed domains to be returned to the pool of available domains will encourage drop-catching and could put a trade mark owner to significant extra trouble. *Nick Wood, Cum Laude; Andrew Mills, ECTA; Nick Wood, MARQUES*

Suspension for the balance of a domain name registration period provides a limited remedy of typically a few months, and may result in a “revolving-door” of URS filings. Even if brand owners may try the URS given its lower filing cost, sophisticated registrants may seek previously suspended domain names. *Erik Wilbers, WIPO*

The terms of the URS currently require a “freezing” of a domain name for the duration of a registration (with the addition of an extra year) in the event of a successful URS dispute by complainant. As we stated in the past, this would require that the brand owner continue to monitor the name to ensure that a cybersquatter does not register the name after the expiration of the freeze period. Again, this policy will be inconvenient and costly to the brand owner and potentially require that the brand owner file continuous URS actions on the same domain name. MarkMonitor therefore believes that in the event of a successful URS action, the domain name should be transferred back to the complainant, at the discretion of the brand owner. *Fred Felman, MarkMonitor; Jennifer Martin, Nordstrom; Birgit Schnell, Red Bull,*

By now it should be obvious to ICANN that “freezing” a domain name for the life of its registration does not adequately address the enforcement needs of trademark owners. We again stress that one of our most significant concerns is that the URS does not permit a domain name to be transferred back to the trademark owner. It is important that domain names should be permitted to be transferred back to the trademark owner to avoid consumer confusion and permanently place such domain names with their rightful owner. Without the transfer option, the trademark owner is left having to incur costs to file lawsuits or UDRP proceedings. *Sarah Deutsch, Verizon*

Since a domain name can only be temporarily “frozen,” trademark owners will be placed in a perpetual monitoring situation after having spent the time, effort and money to go through the URS process. An entire industry may spring up to game the system by watching which domain names are in a “frozen state” and will be dropped by the registry after the domain name registration in the URS process expires. *Sarah Deutsch, Verizon*

If at the end of the appeal period, the registrant has taken no action to obtain a ruling that it should be entitled to register and use the domain name (or has been unsuccessful in its efforts to do so), the registration would then be transferred to the trademark owner. In light of the showing that the trademark owner had to make to prevail on the URS complaint and the resulting inaction by the registrant, this resolution would be fair and equitable. *Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes*

No Transfer Remedy Should be Available

George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Venture; Allan Wilson; Max Menius, Menius Enterprise; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary

Complainants utilizing the Uniform Rapid Suspension System (“URS”) should not have the option to receive a transfer of the domain name like successful complainants can obtain under the Uniform Domain Name Dispute Resolution Policy. The URS is intended to be a quick and cost effective way for a successful complainant to takedown an infringing domain name. The URS is not designed to acquire a transfer of the domain name. By contrast, an action under the UDRP is the appropriate mechanism for acquiring a transfer of an infringing domain name. If transfer of a domain name was an available remedy under the URS then there would be no reason to have both the URS and UDRP. *Registrar Constituency Statement; The Registrar Stakeholder Group Statement*

Section 7.2

One Year Extension of Registration

The RSG supports the option of adding one year to the domain name registration at the request of a successful URS complainant if the complainant pays commercial rates. This option should be a one-time extension to prohibit complainants from keeping the domain name suspended indefinitely. *The Registrar Stakeholder Group Statement*

The current URS remedy is to block a domain and later release it. This is absurd as it will perpetuate a cycle of cyber-squatting. *Philip Sheppard, AIM*

Even a one-year extension is of limited benefit, and in any event, should not be on standard commercial terms, but should be made available on a cost-recovery basis. *Erik Wilbers, WIPO*

Another compromise solution would eliminate any limitation on the length of time during which the trademark owner can pay to keep the domain registered and suspended. If, however, the trademark owner wants the additional remedy of having the domain name registration transferred to it so that it can exercise control over the domain name, it can then file a proceeding under the UDRP. At that point, the registrant will have a second opportunity to contest the allegations of abuse and, if it chooses not to do or is unsuccessful, there can be no complaint regarding the result. *Jill Lockett, National Cable & Telecommunications Association; Mitch Stabbe, Dow Lohnes*

Make it a Loser Pays Model

Steve Metalitz, Coalition for Online Accountability; Jonathan Cohen and Peter Rindforth, FICPI; Claudio DiGangi, INTA; Bart Lieben, Individually

A system where the loser pays is an effective deterrent. The proposal currently and very oddly provides penalties for abuse by trademark holders or examiners but not by registrants. This ignores the 10-year experience of the UDRP. *John Noble, British Brands Group; Philip Sheppard, AIM*

The IACC repeats its position stated in prior submissions on the DAG that a loser pay approach be adopted. The proliferation of UDRP complaints demonstrates that bad faith registrants have no motivation to avoid such proceedings or to transfer in response to informal demands. A system where the loser pays should be a useful deterrent. *Andrew Coombs, IACC*

Section 8

Appeals

The IPC is concerned that including an appeals process within the URS as envisioned in STI Recommendation 8.1 defeats the purpose of the system. Allowing the owners of abusive registrations to drag out the process through an appeal will greatly diminish the URS. The IPC believes that an aggrieved party (whether registrant or complainant) should have the right to proceeding de novo in a court of competent jurisdiction. *IPC Constituency Statement*

Because the URS is designed for quick action for particularly egregious cases of abuse, the appeals process in STI Recommendation 8.1 would defeat the purpose of the system. Allowing registrants to drag out the process through an appeal would diminish the benefit the URS is supposed to provide. As with the UDRP, the aggrieved party should have the right to proceeding de novo in a court of competent jurisdiction. *Claudio DiGangi, INTA*

There should be a limited grace period for a de novo review of a default judgment of no more than 3 months or the expiration of the registration period, whichever occurs first. If the current proposal

allowing de novo review at any time remains in effect, then the domain name should not reserve back to the original IP address, unless the answer is filed within a limited grace period. *Diane Hamer, BBC*

ICANN should clarify the difference between an “appeal” and the filing of a “late answer” after a default judgment – which seems to be essentially an appeal of the default judgment. *Claudio DiGangi, INTA*

With full respect for the need for due process and appropriate safeguards, given the intended efficiencies of the proposed URS, as presently designed the URS appeals process would add significant complexity to what is intended to be a straightforward procedure. Specifically, we question the utility of an appeals process in cases of re-examination (i.e., under this scheme, a defaulting respondent effectively gets three chances to have their “clear cut” case heard), and in cases where a complaint is denied (as complainants would already have recourse to the UDRP or court of competent jurisdiction). In any event, to provide a degree of certainty for all parties, any appeals process should be time-limited. *Erik Wilbers, WIPO*

There is a concern that the inclusion of an appeals process for registrants would serve to negate the advantages offered by the URS for quick resolution of clearly egregious abusive registration. *Jonathan Cohen and Peter Rindforth, FICPI*

The URS is intended to be a Uniform Rapid Suspension System. Including an appeals mechanism runs contrary to that. Like the UDRP an aggrieved party should have the right to go to court. *John Noble, British Brands Group; Philip Sheppard, AIM*

In addition, the fee for the appeal will of necessity be considerably higher given the extra consideration necessary, as in theory the fact that an appeal has been brought is an indication that the facts are potentially more complex and the issues not “clear cut”. Thus in our view, any appeal would need to have a fee at least on the level of that for a UDRP decision. This would also then allay to an extent concerns regarding gaming the system by appeal as it should thwart manipulation of the URS by bad actors. *IPC Constituency Statement*

We support the idea of an appeal process as a valuable safeguard provided the process is fast and the cost of mounting an appeal is sufficient to deter gaming of the process: for example, the appeal fee might be \$5,000 with half of the fee going to the costs of administering the appeal and half the fee going to the complainant if the appeal is unsuccessful. *Nick Wood, Cum Laude*

An appeal by the registrant in real court to overturn the URS should immediately restore the nameservers to those specified by the complainant. Real court must trump URS. That appeal should be permitted at any time, including during the time before a URS response is required. The registry and registrar need to obey the court in restoring the nameservers, otherwise innocent registrants would have income-generating websites disrupted by bad decisions from URS providers. *Michael Berkens, Worldwide Media*

In regard to a potential appeal process, the fee for the appeal will of necessity be considerably higher given the extra consideration necessary, as in theory the fact that an appeal has been brought is an indication that the facts are potentially more complex and the issues not “clear cut”. Thus in our view, any appeal would need to have a fee at least on the level of that for a UDRP decision. This would also then allay to an extent concerns regarding gaming the system by appeal as it should thwart manipulation of the URS by bad actors. *David Taylor, Lovells*

Section 9

Abuse of Process

At a minimum, the IPC urges ICANN to specify that a complainant is not deemed to have filed an abusive complaint solely because a complaint is denied or because a complainant seeks to enforce its rights regularly and vigorously through the URS. The IPC recommends that ICANN look to the definition of Reverse Domain Name Hijacking (“RDNH”), which is defined in the UDRP Rule 1 as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.” *IPC Constituency Statement*

The IPC also believes that any penalty mechanism designed to thwart abuse must be reciprocal. In short, the IPC urges ICANN to design penalties for domain name registrants who regularly abuse the system. *IPC Constituency Statement*

INTA disagrees with STI Recommendation 9.1 regarding the threshold at which a trademark owner should be barred from filing a complaint under the URS. Instead, INTA believes that a fair balance is barring complainants from the URS for a one-year period following three URS abuse judgments within any five-year period. *Claudio DiGangi, INTA*

INTA agrees with STI Recommendation 9.1 that ICANN staff should clarify what constitutes “abuse” by trademark owners. INTA believes that any such definition should clarify that abusive complaints are those in which a registrant provides compelling evidence that a complainant has abused the system by filing a complaint based on a false claim of rights or by asserting fraudulent claims against domain names that clearly involve legitimate use. Likewise, any such definition should specify that a complainant is not deemed to have filed an abusive complaint solely because a complaint is denied, or because a complainant seeks to enforce its rights regularly and vigorously through the URS. *Claudio DiGangi, INTA*

Limiting accreditation to serious URS providers of proven professional integrity should go a long way to eliminating the need for impracticable modalities such as panel randomization (amongst multiple providers). ICANN can make a contribution by addressing instances where extrinsic motives induce provider disregard for the fundamental precepts of domain name dispute resolution. *Erik Wilbers, WIPO*

Time Warner notes that the STI Recommendations provide no corresponding penalties for abusive registrants. We strongly recommend that ICANN require registries and registrars to implement penalties for registrants who have been found to repeatedly register domain names infringing upon trademarks, thereby profiting from consumer confusion. Such penalties may include financial penalties, cancellation of current registrations or blocks from future registrations. *Sandra Aistars and Fabricio Vayra, Time Warner*

The Board should adopt the “three strikes” standard for abusive complaints by trademark owners that the IRT proposed. This standard is more appropriate than the STI’s “two strikes” standard -- especially in light of the fact that there are no equivalent penalties for serial cybersquatters. The “one strike, one year; two strikes, you’re out” standard for findings of “deliberate material falsehood” is of concern because the STI Report contains no definitions, explanations, or illustrations that permit analytical assessment of this “standard.” The guidelines for what constitutes abuse that ICANN staff are to implement should be clear, specific, and appropriate in scope. The references to “previous cases” of “TM abuse and general principles of fairness” are vague, overly general, and have the potential to be so broad as to be effectively useless. Once drafted by the appropriate experts, these “abuse” guidelines should be published for public comment. *Russell Pangborn, Microsoft; Ayala Deutsch, Coalition to Advance the Protection of Sports Logos (CAPS)*

FICPI agrees with the suggestion that the deterrent effect of the URS will be diluted in the absence of any penalties for abuse by registrants, such as in the case of repeat cybersquatters. *Jonathan Cohen and Peter Rindforth, FICPI*

We strongly recommend that ICANN consider measures against domain name registrants who have been found to consistently engage in abuse, whether it be barring them from registering more domain names, establishing a presumption of abuse in future URS or UDRP proceedings against them, or establishing/increasing any fees due for filing an answer to a URS or UDRP complaint. INTA recognizes the difficulty of establishing that any one registrant is the same as or affiliated with another, though where such a relationship can be established INTA believes that there should be consequences for registrants who repeatedly engage in abusive practices to harm consumers and legitimate business interests. *Claudio DiGangi, INTA*

The sentence “Multiple complaints must be against the same entity and should not include affiliates.” should be revised to “For purposes of counting abusive complaints and findings of “deliberate material falsehood” against a trademark owner, only complaints and findings against the entity identified as the Complainant - and not its affiliates or related companies - should be tallied.” *Russell Pangborn, Microsoft*

With regard to the URS, we are confused and concerned by one part of recommendation 9.1, which concerns abuse of the URS system by trademark holders. In this recommendation, the recommendation states “Multiple complaints must be against the same entity and should not include affiliates.” It is unclear if this is referring to complaints by trademark holders against trademark abusers, or complaints by registrants against abusive trademark holders. *Antony Van Couvering, Minds + Machines*

It is improper to have a “strike penalty” when the aim of the URS to remedy hundreds of thousands of unauthorized and infringing domain registrations. *Urs Lacotte, International Olympic Committee*

The penalties for abuse by TM holders are trivial. They need to be made substantially stronger. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

In Canada, there are financial penalties under the CDRP (.ca version of UDRP) which provides for a bad faith complainant paying up to \$5000 (as ordered by a panel): <http://www.cira.ca/assets/Documents/CDRPolicy.pdf>; (section 4.6) *Michael Berkens, Worldwide Media*

We are confused and concerned by one part of recommendation 9.1, which concerns abuse of the URS system by trademark holders. In this recommendation, the recommendation states “Multiple complaints must be against the same entity and should not include affiliates.” It is unclear if this is referring to complaints by trademark holders against trademark abusers, or complaints by registrants against abusive trademark holders. In either case, it is trivially easy to construct affiliates to do dirty work, and many ICANN processes have been subverted by the creation of multiple corporate entities under the same effective ownership. ICANN should not allow abusers to run a shell game to escape censure. *Antony Van Couvering, Minds + Machines*

There are huge conflicts of interests in allowing panelists to also represent complainants/respondents. Panelists should be precluded to ever represent others (i.e. in other domain disputes). *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

Appendix 6

Evaluation of the URS Case

The STI proposal also introduces, in addition to the UDRP circumstances demonstrating registrant rights or legitimate interests, six registrant “safe-harbors” that would demonstrate the absence of bad faith. Issues of selection and phrasing aside, it should be considered how the inclusion of such rather practical guidance interacts with existing UDRP criteria and jurisprudence. *Erik Wilbers, WIPO*

In Appendix 6, the points in 1.2 (page 44) are described as “non-exhaustive”. This is flawed, just as in the UDRP, and encourages URS providers and panelists to have an ever-expanding definition of “bad faith” in order to promote themselves and or their provider amongst complainants. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

The proposed Safe Harbors send the wrong message. The safe harbors improperly detract from the original intent of the URS. These safe harbors unnecessarily add obstacles to a system which was intended to be straight-forward and simple. *Urs Lacotte, International Olympic Committee*

Miscellaneous

One option offering a meaningful complement to the UDRP would be a default-based filtering mechanism (including important and appropriate safeguards) as described in the WIPO Center’s proposal for an Expedited (Domain Name) Suspension Mechanism. *Erik Wilbers, WIPO*

Finally, we would like ICANN to require providers of URS services to collect and publish a uniform set of data on cases and decisions that is freely searchable. UDRP data is currently spread across providers with WIPO, ADR.EU, NAF etc. maintaining their own statistics. *Nick Wood, Cum Laude; Andrew Mills, ECTA; Nick Wood, MARQUES*

All URS decisions need to be made public, just as in the UDRP, in order to ensure that the public can scrutinize whether panelists and URS providers are following the rules. *George Kirikos, Leap of Faith Financial; Hakan Ozcan; Bryan Gray; Chad Wright, Webquest; Chris Beach; Jon Schultz, Blue String Ventures; Allan Wilson; Max Menius, Menius Enterprises; Kelly Pitt; Warren Royal; Jean-Sébastien Lascary*

Registrants should be able to white-list themselves to opt-out of the URS (and UDRP) through mechanisms such as Whois verification, or posting of security bonds with their registrars. The “good guys” want to stand out from the bad guys, however ICANN and the TM groups want to treat all registrants as though all large domain holders as cybersquatters. *Michael Berkens, Worldwide Media*

Analysis of Public Comments on the URS

Comments resulting in no change to the AGB Model due to prior consideration by the GNSO-STI drafting team

Several comments raised issues regarding the URS that were extensively evaluated by the GNSO-STI drafting team. Since the GNSO-STI Model reflects compromises reached by the participants after ample consideration of these concerns, the AGB Model proposes adoption of the GNSO-STI approach without change. The comments in this category include the following:

- Standard of review is too high.
- Length of notice to registrant is too long or too short.

- Filing an answer after a default judgment should not trigger an immediate redirection of name servers.
- Registrant should select the examiners.
- Transfer or other remedies should be available to successful complainants.
- Make it a loser pays model.
- Appeals process is unnecessary and will negate the advantage of the URS to rights holders.
- Substantial fees should apply to any appeals process.
- Penalties should apply to abusive registrants.
- Penalties against abusive complainants are too severe.
- Safe Harbors add obstacles and complicate the URS.

Comments resulting in clarifications to the GNSO-STI Model

Scope of Safe Harbors

One comment expressed concern that the safe harbor for websites “operated solely in tribute to or in criticism of a person or business” would automatically deem all of such websites to be fair use, when in some circumstances they might be infringing (Russell Pangborn, Microsoft). To clarify this concern, the AGB Model slightly modifies the language as follows: “(d)omain Name sites operated solely in tribute to or in criticism of a person or business that is found to be fair use.”

Comments not fully explored by the GNSO-STI Drafting Team meriting further consideration

Right to De Novo Review at Any Time During Life of the Registration

Several comments questioned the need to grant a *de novo* review at any time during the life of the registration, as it may be subject to abuse (Erick Wilbers, WIPO, Fred Felman, MarkMonitor), and it is possible that such right could extend for five years after the default decision. To address this concern, the AGB Model proposes a *maximum* period that such right would be available-- two years after the date of the determination. This would provide trademark holders with certainty regarding closure of the URS case, while affording registrants a reasonable time to overturn a default decision.

Searchability of URS Decisions

Several comments suggested that URS Decisions should be freely searchable and accessible to the public (Nick Wood, Cum Laude, Andrew Mills, ECTA). Such information would be important in enabling the community to evaluate the efficacy of the URS and identify areas where the URS could be improved in the future. To address this concern, the AGB Model requires the URS service provider to offer such a feature.