

New gTLD Program: Rights Protection Update

14 March 2012



Agenda

- Background on new rights protection mechanisms
 - Trademark Clearinghouse
 - URS
 - PDDRP



Background

- New gTLD Program founded in GNSO policy recommendations
- GNSO Recommendation 3: Strings must not infringe the existing legal rights of others that are recognized or enforceable under generally accepted and internationally recognized principles of law.



Development of new RPMs

Implementation Recommendations
Team (IRT) Report (*May 2009*)

Community discussion and comment

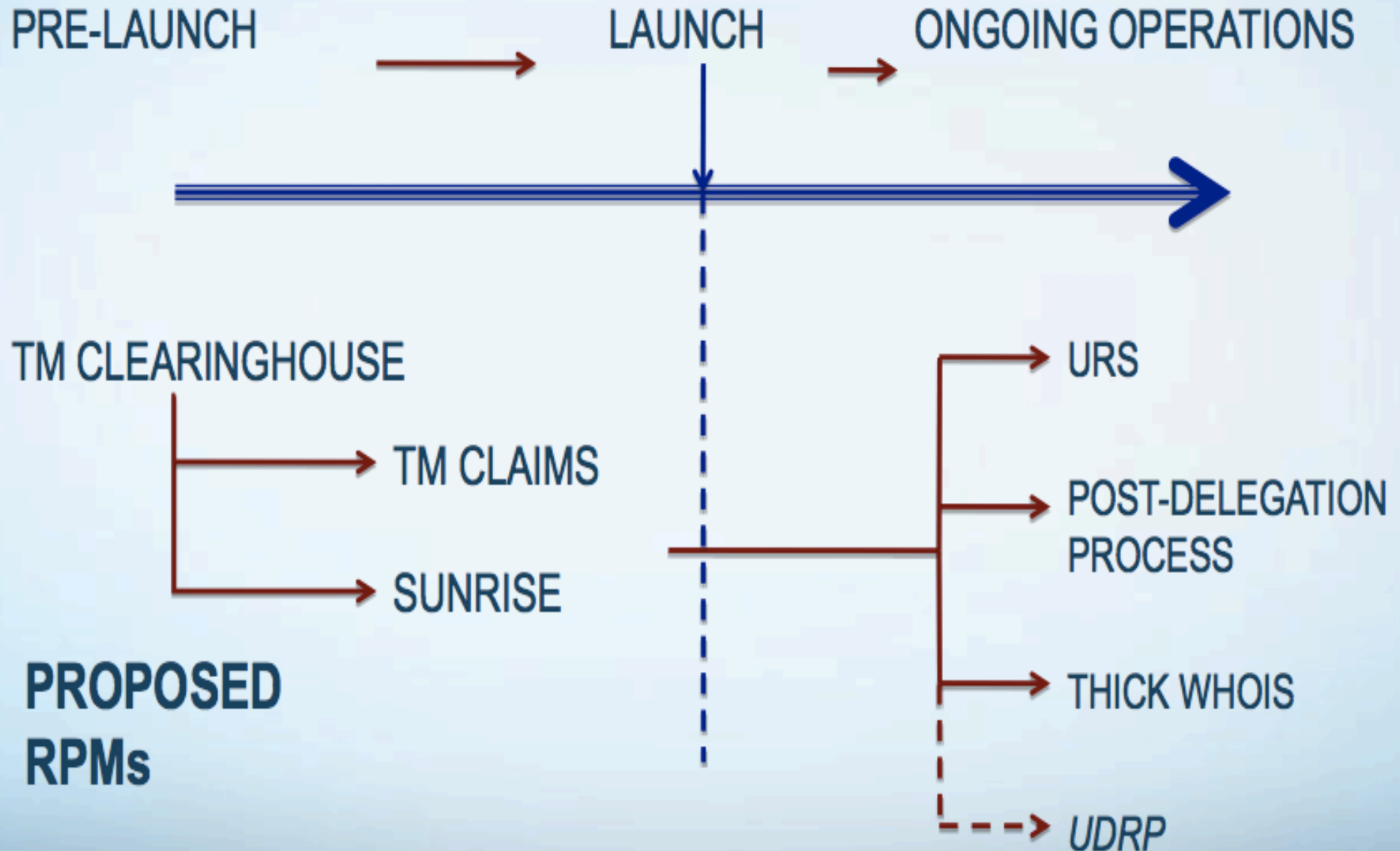
Special Trademark Issues Review Team
(STI) Recommendations (*Dec 2009*)

Community discussion and comment

New requirements reflected in gTLD
registry agreement



Rights Protection Mechanisms



New Requirements

- At start-up:
 - Sunrise period
 - Trademark Claims service
 - Both supported by Trademark Clearinghouse data
- Ongoing:
 - Implement URS
 - Implement PDDRP



Trademark Clearinghouse



Trademark Clearinghouse

- A repository for trademark data supporting rights-protection mechanisms offered by new gTLD registries
- To be operated by third party, via agreement with ICANN
- Replaces need for trademark holders to register in many databases as TLDs are launched



Trademark Clearinghouse

- Performs authentication/validation and maintains database of trademark data
- Data supports Sunrise and Trademark Claims services offered by new gTLDs



Sunrise period

- Pre-launch phase: provides mark holders the opportunity to register domain names in a TLD before registration is generally available to the public
- Eligibility: rights must be validated for proof of use to be eligible for sunrise registrations
- Mandatory in all new gTLDs: at least 30 days
- Notice of Sunrise registration provided rightsholders with matching records in Trademark Clearinghouse

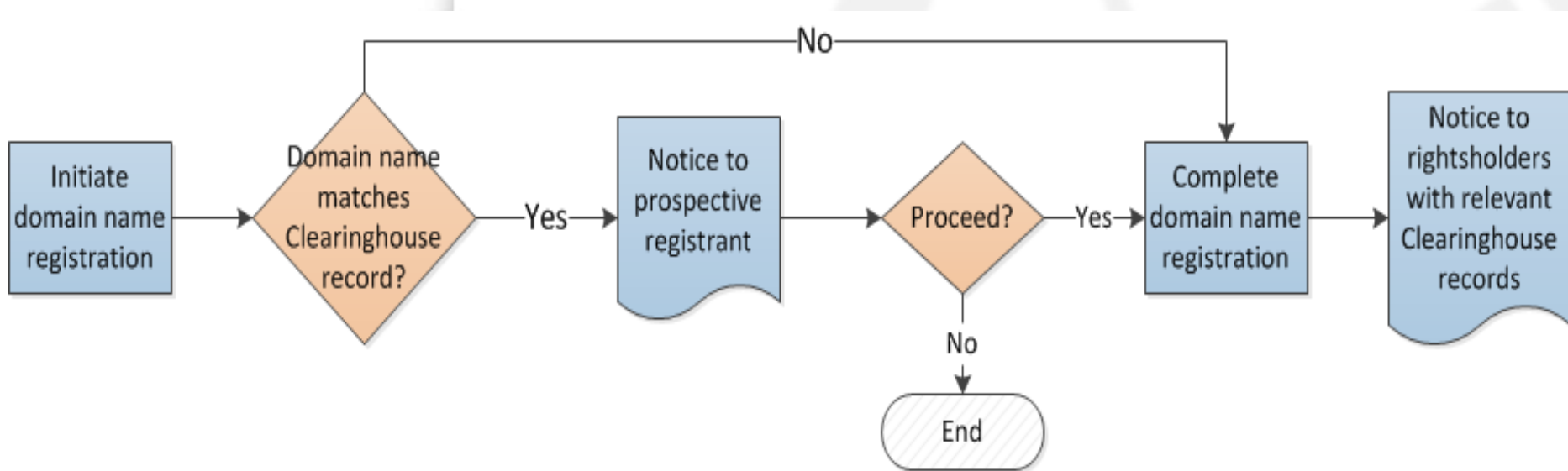


Trademark Claims service

- Generates real-time notice to a party attempting to register a domain name if it matches a trademark in the Clearinghouse.
- Also notifies trademark holders when domain names are registered that match marks in the Clearinghouse.
- Eligibility: All trademarks recorded in Trademark Clearinghouse are eligible
- Mandatory in all new gTLDs: at least first 60 days of general registration



Trademark Claims



Implementing the Clearinghouse

- 1) selection of one or more providers for clearinghouse services, and
- 2) development of supporting processes (e.g., Trademark Claims and Sunrise processes) for the Clearinghouse



Trademark Clearinghouse

Provider selection

- Request for Information (October 2011)
- Review of submissions, candidate discussions
- Completing selection process currently



Trademark Clearinghouse

Process development

- Implementation Assistance Group (IAG) formed November 2011
- Purpose of the group: provide advice on key Clearinghouse processes and high-level technical implementation issues (not to design solutions)
- Goal: ICANN to deliver a set of business requirements to the service provider(s) selected out of the RFI Process



Implementation Assistance Group (IAG)

- Tracks for process and technical issues
 - 13 rotated conference calls
 - Written submissions
- Now completing compilation and analysis to create model
- Completion of requirements expected March 2012

<https://community.icann.org/display/cctrdmrkclrnghsiag/Home>



Topics discussed

Topic	Issue
Sunrise – P1	Domain Registration
Sunrise – P4	Audit/Logging/Compliance
TM Claims – P2	Registrant Claims Notice
TM Claims – P3	Trademark Holder Notice
TM Claims – P5	TM Claims Check
Tech Implementation – T1	Data Locations
Tech Implementation – T2	Data Access
Tech Implementation – T3	Communications Protocols
Data Maintenance – P6	Information Accuracy & Update
Authentication/Validation	Rights Verification
Authentication/Validation	Proof-of-Use
Dispute Resolution	SDRP Administration
IDNs	String Comparison and Matching

Criteria for inclusion in Clearinghouse

- Nationally or regionally registered word marks from all jurisdictions.
- Any word mark that has been validated through a court of law or other judicial proceeding.
- Any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion.
- Other marks that constitute intellectual property.



Authentication and validation

- Goals:
 - Clearly specified, available prior to submission
 - Yield consistent, predictable results
 - Efficient process available to all regions

Authentication: Establishing that trademark information is genuine and trademark belongs to the mark holder

Validation: Establishing proof of use or rights based on statute/treaty or court proceeding



Authentication

- Name of submitter
- Contact information
 - Email address verification as a minimum
- Declaration
 - Information submitted is true & current
 - Has not been supplied for an improper purpose.
- Registration number
 - Confirmation that numbers match
 - May be via online database or other process



Validation for proof of use

- Single standard
- Declaration:
 - The trademarks in the submission are currently in use in the manner in the accompanying specimen
 - Submitter will notify if mark is abandoned
- Specimen of use:
 - e.g., labels, tags, containers, marketing materials, advertising, brochures, screen shots



Trademark claims notice

- Message / display during registration process
- Roles of registry, registrar in performing query, providing notice
- Verification that notice was sent
- Verification of acknowledgement by registrant



Matching rules: “Identical Match”

Domain name consists of the complete and identical textual elements of the mark.

- a. spaces can be replaced by hyphens (and vice versa) or omitted;
- b. only certain special characters in a trademark are spelled out with appropriate words describing it (@ and &);
- c. punctuation or special characters in a mark that are unable to be used in a domain name may be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches; and
- d. no plurals and no “marks contained” qualify.



Dispute resolution

Relevant action	Basis of dispute	Initiated by	Mechanism
Recording data in Clearinghouse	Record was accepted in error, due to faulty authentication or validation	Third party	Clearinghouse review/appeal process
Recording data in Clearinghouse	Record was denied in error	Rightsholder	Clearinghouse review/appeal process
Sunrise	Sunrise registration was permitted in error	Third party or other rightsholder	Sunrise Dispute Resolution process
Sunrise	Sunrise registration was denied in error	Rightsholder	Registry process
Sunrise	Dispute over allocation between more than 1 qualified sunrise registrant for same name	Rightsholder	Registry process
Sunrise	Notice of sunrise registration not sent to rightsholder	Rightsholder	Dependent on party with responsibility for sending notice
TM Claims	Notice sent to domain name applicant in error	Rightsholder or domain name applicant	Dependent on party with responsibility for sending notice
TM Claims	Notice not sent to domain name applicant	Rightsholder or domain name applicant	Dependent on party with responsibility for sending notice
TM Claims	Notice of registration not sent to rightsholder	Rightsholder	Dependent on party with responsibility for sending notice

Principles

- “Closeness”: each party should generally communicate with those parties with whom it has an existing relationship
- Each party should have access only to limited data as required to perform its designated function
- Submission and renewal of Clearinghouse records should not be burdensome
- Implementation work for registries and registrars should not be excessive: existing protocols/processes should be used whenever possible



Clearinghouse costs

Costs to be borne by the parties using the services:

- Trademark holders will pay to record data in the Clearinghouse
- Registries will pay for Trademark Claims and Sunrise services
- Registrars and others who avail themselves of Clearinghouse services will pay the Clearinghouse directly

Pricing model to be worked out with service provider and will be published as available



Uniform Rapid Suspension (URS)



Uniform Rapid Suspension System

- Provides trademark holders with a rapid and efficient mechanism to "take down" clearly infringing domain names.
- A complement to UDRP
- Successful case results in suspension of domain name
- Compliance with results mandatory for all new gTLD operators.



Implementing the URS

- Costs: URS Provider will charge fees to the Complainant. Fees targeted at \$300-500 per proceeding, but will ultimately be set by the Provider.
- Timing: 24 days for complete process
- RFP for URS providers to be published
- Will engage community in developing processes



Post-Delegation Dispute Resolution Procedure (PDDRP)



Trademark Post-Delegation Dispute Resolution Procedure (PDDRP)

- Provides trademark holders opportunity to seek redress from new gTLD registry operators exhibiting a bad faith intent to profit from the systemic registration of infringing domain names
- Complaints filed with a dispute resolution provider
- Remedies vary and may include termination.



Thank You



Questions

One World

One Internet

