Trademark Protection in New gTLDs

Moderator:  Mike Silber
Panelists:  Alan Greenberg, Robin Gross
Mary Wong, Zahid Jamil and Jeff Neuman
Introduction to Trademark Protection Issues

- The proposed models are the culmination of the significant work by the ICANN community to identify implementable solutions to address trademark protection concerns.

- Upon the conclusion of the Public Comment Forum, (1 April 2010), the Models will be finalized for inclusion in the Draft Applicant Guidebook version 4.
Panelists & Agenda

Panelists:
Mary Wong, Alan Greenberg, Robin Gross, Zahid Jamil, and Jeff Neuman

Agenda

- Introduction and background (5 minutes)
- Trademark Clearinghouse - *Zahid Jamil* (30 minutes, including Q&A)
- Uniform Rapid Suspension Procedure – *Mary Wong* (30 minutes, including Q&A)
- Post Delegation Dispute Resolution Mechanism – *Jeff Neuman* (20 minutes, including Q&A)
- Closing remarks (5 minutes)
## Timeline - Trademark & Community Protection

<table>
<thead>
<tr>
<th>Date</th>
<th>Event Description</th>
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<tbody>
<tr>
<td>Feb 09</td>
<td>ICANN Mexico City - IP Community requests enhanced trademark solutions</td>
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<tr>
<td>May 09</td>
<td>Implementation Recommendation Team (IRT) Report proposes new trademark solutions</td>
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<tr>
<td>Summer 09</td>
<td>Global Consultation (Sydney, New York, Hong Kong, and Abu Dhabi). General support for certain IRT recommendations, with modifications</td>
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<tr>
<td>Nov 09</td>
<td>Board seeks GNSO input on an expedited basis on several trademark solutions</td>
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<td>Dec 09</td>
<td>GNSO Special Trademark Issues (STI) drafting team reaches consensus on revised trademark solutions</td>
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<tr>
<td>Dec 09</td>
<td>GNSO unanimously approves STI Recommendations</td>
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<tr>
<td>Feb 10</td>
<td>Revised Models &amp; Explanatory Memoranda Posted</td>
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Proposed Model

Trademark Clearinghouse

Uniform Rapid Suspension Procedure

Trademark Solutions

Post Delegation Dispute Resolution Mechanism

Thick WHOIS
Trademark Clearinghouse- Key Features

- **Centralized Database:**
  - Storage of trademark registration data
  - Data authenticated by a third party provider
  - Does not create any new rights or limit any rights

- **Types of Trademark Data:**
  - Trademark registrations of national effect
  - Court validated common law trademarks

- **Required use by New gTLD Registries:**
  - Sunrise Services or
  - Trademark Claims Services

- **Costs to be borne by parties benefitting from TC**
Trademark Clearinghouse – Key Features

- Model adopts substantially all of the GNSO- STI recommendations, with some exceptions

- Trademarks from non-substantive review jurisdictions
  - Registries required to provide either sunrise or TM Claim Services for these marks
  - Registry may request additional validation of use

- Ancillary services allowed for additional solutions
  - Trademark holders may opt out of ancillary services
Uniform Rapid Suspension Procedure (URS)

- Model adopts substantially all of GNSO-STI recommendations
- Expedited take-down procedure for clear-cut cases of trademark infringement
- Protections for Registrants:
  - May file a response to restore the domain name, even after default
  - No costs to registrants except in cases of late answers
- Remedies
  - Suspension for remainder of registration term, with option to extend 1 year
  - Transfer of domain name after decision is not a remedy
URS – Key Features

- Defenses for Registrants- Model incorporates fair uses of domain names
- Penalties for abusive trademark holders
- Procedures to encourage fair examiners
- URS is an additional remedy-
  - UDRP continues to be available
  - Other legal remedies available to both parties
- Reduced costs to trademark holders versus UDRP
Post Delegation Dispute Resolution Procedure

- Used against registries for affirmative conduct - systematic trademark infringement or use of TLD for an improper purpose
- Parties: trademark holder and registry
- Fees: filing fees shared by TM holders and registries. Loser pays prevailing party’s filing fees
- Remedies: Panel to suggest graduated enforcement tools to ICANN
- Absent extraordinary circumstances, ICANN will review, approve and enforce the recommended remedies, or as amended by ICANN
- Contractual compliance, URS and UDRP are also available
Trademark and Community Protection Solutions

For more information:

Trademark Clearinghouse:  

Uniform Rapid Suspension Procedure:  

Post Dispute Delegation Resolution Procedure:  
Trademark Protection in New gTLDs

Thank You!