

Limited Preventative Registrations (original #4, priority #1)

Initial BC/IPC Consensus Position (original #4, priority #1): Implement a mechanism for trademark owners to prevent second-level registration of their marks (exact matches, plus character strings previously determined to have been abusively registered or used) across all registries, upon payment of a reasonable fee, with appropriate safeguards for registrants with a legitimate right or interest.

Implementation proposal: Limited Preventative Registrations (LPRs) will provide a streamlined form in new gTLDs of domain name registration with limited rights to strings that are exact matches to trademarks that are both eligible for inclusion in the Trademark Clearinghouse and eligible for Sunrise registration in the relevant new gTLD. Under the LPR system, a trademark holder can obtain a 5-year inactive registration, which would not resolve to any active page, but merely to a registry-controlled landing page with a simple legend such as “Domain Registered Pursuant to Limited Preventative Registration.”¹ Legitimate right holders with the same trademark are not pre-emptively excluded from registering any string. The LPR will not go into effect until after the now-mandated Sunrise period.

The LPR mechanism enhances consumer protection by providing a cost-efficient and streamlined method to register second-level domain names that are exact matches to (not variations on) Trademark Clearinghouse-included, Sunrise-eligible trademarks across multiple new gTLD registries. It does not broaden brand owner rights because no brand owner will be able to participate in the LPR system unless it could have registered the domain name in question during Sunrise anyway. This system, facilitated by the Trademark Clearinghouse, will provide a purely defensive alternative to standard Sunrise domain name registrations for trademark owners that do not affirmatively want active/resolving domain names.²

By way of example, suppose there is a trademark “BRANDX.” In order to be eligible for LPR, BRANDX would have to also be eligible for inclusion in the Trademark Clearinghouse and for a Sunrise registration. Only the exact second-level domain string of BRANDX (e.g., BRANDX.new) could be protected by LPR. Even likely typos such as BRANDZ could not be registered via LPR. Furthermore, if another entity also owned rights in the trademark BRANDX (such as in another country or for a different good or service), LPR could not be used to prevent a third-party trademark owner with rights in BRANDX from securing a Sunrise registration as long as that third-party trademark owner was eligible to participate in Sunrise with its BRANDX registration. Finally, LPR cannot be used retroactively to take away a domain name regardless of whether that domain name was registered during Sunrise or open registration.

¹ The LPR is analogous to the Sunrise B offered by ICM Registry for .xxx.

² While this suggestion envisions LPR occurring after or as a “second” Sunrise, another alternative could be to allow eligible trademark owners to designate whether they are applying for a regular Sunrise registration or an LPR.

Eligibility

1. Entry in TMCH.
2. Meets Sunrise requirements (e.g. use and any registry-specific requirements)

Scope

1. Second-level domain name must exactly match eligible trademark.

Mechanics

1. Trademark owner pays a fee to the Trademark Clearinghouse for a number of LPRs.³
2. When delegation of a new gTLD is announced (and any time after), the trademark owner can designate through the Trademark Clearinghouse that it will use in that new gTLD one of the LPRs for which it has already pre-paid. Sunrise eligibility criteria for domain names in that new gTLD apply.
3. After the initial Sunrise period ends, if the exactly matching string is still available, the registry assigns that LPR to the trademark owner that applied for it. To clarify, as between an applicant for a regular (e.g., as set out in the current Guidebook) Sunrise registration and an applicant for an LPR, the applicant for the regular Sunrise registration will become the registrant.
4. The Trademark Clearinghouse⁴ pays the registry operator, which pays the registrar. The LPR functions as a standard domain name registered to the registry's name servers.
5. The trademark owner cannot use the LPR domain name for any purpose (e.g., has no control over resolution.)
6. The LPR lasts for 5 years and must be renewed, subject to the same eligibility criteria that would have applied at initial registration.

Registrant Safeguards

1. Reverse Domain Name Hijacking exclusion: Second-level strings found to have been the subject of a finding of reverse domain name hijacking cannot be the subject of an LPR by the trademark owner against which the reverse domain name hijacking finding was made. Entities found to have engaged in repeated reverse domain name hijacking will be excluded from using LPR for any second-level string.
2. LPRs are prospective, not retroactive. If a trademark owner designates a new gTLD for an LPR after the initial Sunrise and a third party has already registered the string in question, the third party keeps the domain name and the trademark owner can use the UDRP, URS, or

³ We suggest this fee distribution mechanism for discussion. The more important aspect is that the Trademark Clearinghouse be utilized for LPR designation to gain the necessary efficiencies.

⁴ See note 3.

court action if it has a basis to do so. In other words, if the string is already registered to a third party, a trademark owner's subsequent designation of that string as an LPR does not take the domain name away from the current registrant.

Fees

1. A tiered pricing model would be preferred, whereby trademark holders pay for LPRs a reasonable fee that represents cost recovery plus a reasonable rate of return for the relevant registries in which the trademark owner sought the LPR(s).