Trademark Clearinghouse: Strawman Solution

29 November 2012
(updated 3 December 2012 for clarification and list of meeting participants)

Summary

ICANN has recently convened a series of meetings with a group of stakeholder representatives to work to complete implementation discussions on the Trademark Clearinghouse and its associated rights protection mechanisms. Members of multiple GNSO constituencies participated in these discussions. The group collaborated on a possible "strawman solution" addressing a number of the elements in a set of recommendations by the Intellectual Property and Business Constituencies of the GNSO. The discussions on this model included significant compromise and accommodation by the participants.

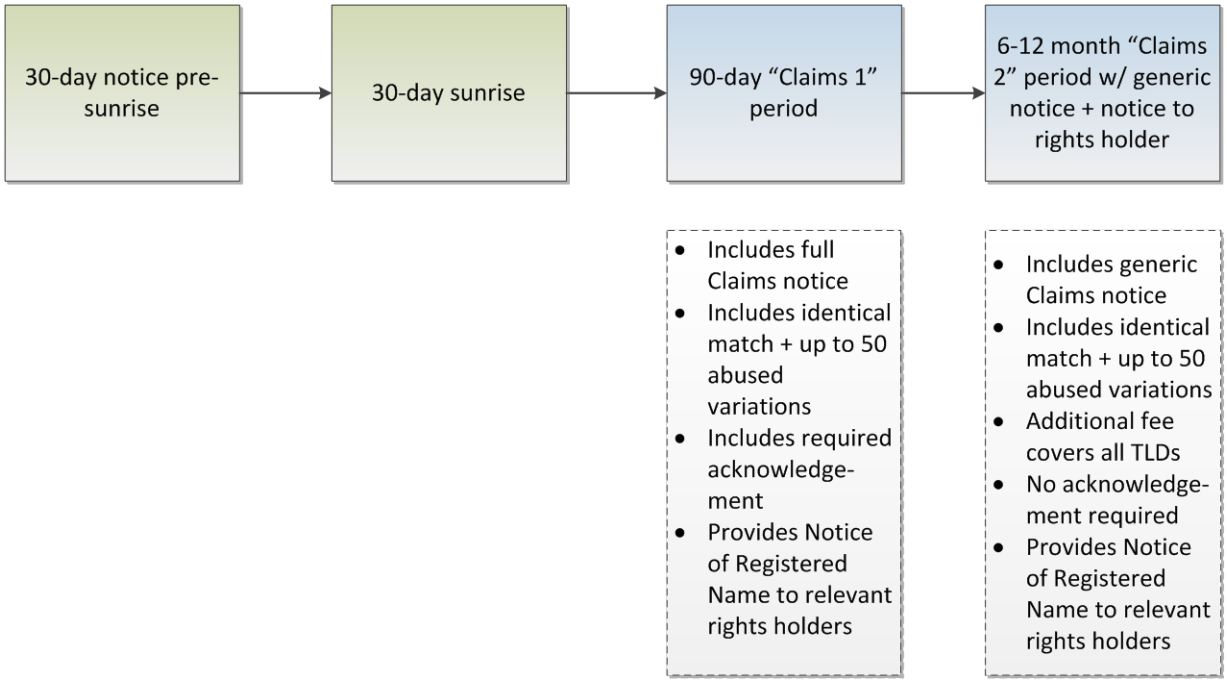
The strawman solution includes a proposed implementation of Sunrise and Trademark Claims services that balances and addresses the concerns of the various parties. These services affect a variety of stakeholders: registries, registrars, trademark holders, domain name registrants, and others. Accordingly, the interests of these parties were all considered to devise an optimal implementation. This strawman solution is now being posted for public comment.

In the strawman solution:

The Sunrise Period features a 30-day notice period in advance, to facilitate awareness and enable effective participation. The required 30-day sunrise period remains as included in the Applicant Guidebook.

The Trademark Claims period as described in the Applicant Guidebook is extended to 90 days (i.e., the first 90 days of general registration in the TLD). There is an additional period during which rights holders may elect to participate in a "Claims 2" service for an additional fee. The "Claims 2" process is a lighter-weight version of Trademark Claims, which includes a generic notice and does not require an acknowledgement of the notice from a domain name registrant. For purposes of both Claims services, rights holders are able to submit documentation for domain name strings previously determined to have been abusively registered or used, which can be associated to a verified trademark record in the Clearinghouse. These names would also be subject to Trademark Claims.

These stages are depicted below:



Under this model, trademark holders have an expanded set of tools from which to choose.

The Strawman Model

The model includes the following elements:

1. All new gTLD operators will publish the dates and requirements of their sunrise periods at least 30 days in advance. When combined with the existing (30-day) sunrise period, this supports the goal of enabling rights holders to anticipate and prepare for upcoming launches.

2. A Trademark Claims period, as described in the Applicant Guidebook, will take place for 90 days. During this "Claims 1" period, anyone attempting to register a domain name matching a Clearinghouse record will be displayed a Claims notice (as included in the Applicant Guidebook) showing the relevant mark information, and must acknowledge the notice to proceed. If the domain name is registered, the relevant rights holders in the Clearinghouse will receive notice of the registration.

   Example: The trademark "EXAMPLE" is submitted to the Clearinghouse and the record is verified. An individual attempts to register the domain name "EXAMPLE.TLD" and is shown a Claims Notice (as included in the Applicant Guidebook) including the mark information. The prospective domain name registrant must acknowledge the Claims Notice before proceeding with the registration. If the registrant chooses to proceed, the rights holder will receive a notice that "EXAMPLE.TLD" has been registered.

3. Rights holders will have the option to pay an additional fee for inclusion of a Clearinghouse record in a "Claims 2" service where, for an additional 6-12 months, anyone attempting to register a

domain name matching the Clearinghouse record would be shown a Claims notice indicating that the name matches a record in the Clearinghouse (but not necessarily displaying the actual Claims data). This notice will also provide a description of the rights and responsibilities of the registrant and will incorporate a form of educational add-on to help propagate information on the role of trademarks and develop more informed consumers in the registration process.

Example: The trademark "EXAMPLE" is submitted to the Clearinghouse and the record is verified. An individual attempts to register the domain name "EXAMPLE.TLD" and receives a Claims notice with information about the rights and responsibilities of the registrant with regard to trademarks and domain names. If the name is registered, the rights holder will receive a notice that "EXAMPLE.TLD" has been registered.

4. Where there are domain labels that have previously determined to have been abusively registered or used (e.g., as a result of a UDRP or court proceeding), a limited number (up to 50) of these may be added to a Clearinghouse record (i.e., these names may be mapped to an existing record for which the trademark has already been verified by the Clearinghouse). Attempts to register these as domain names will generate the Claims notices as well as the notices to the relevant rights holders (for both Claims 1 and 2).

   Example: The trademark "EXAMPLE" is submitted to the Clearinghouse and the record is verified. The rights holder also submits evidence of a UDRP case where registration of the string "EXAAMPLE" in a domain name was found to meet the three-part test for a successful UDRP complaint based on the trademark "EXAMPLE." This domain string "EXAAMPLE" is now associated with the Clearinghouse record for the "EXAMPLE" trademark for purposes of Trademark Claims. During the Trademark Claims period, anyone attempting to register "EXAMPLE.TLD," as well as anyone attempting to register "EXAAMPLE.TLD," will receive a Claims Notice requiring acknowledgement. If the rights holder chooses, he may pay an additional fee for an extended "Claims 2" service, which will provide a notice but not require acknowledgement. In both cases, if "EXAAMPLE.TLD" is registered, the rights holder will receive a notice that "EXAAMPLE.TLD" has been registered.

Proposal for Limited Preventative Registration Mechanism

During the stakeholder meetings on Clearinghouse implementation, there was discussion of a possible preventative mechanism that would be available for rights holders in new gTLDs. This mechanism was not included in the strawman, but remains a high priority item for the IPC/BC. There was not support among non-IPC/BC participants for solutions to the issue of second level defensive registrations. After hearing concerns on this issue, members of the IPC/BC have provided a description of a preventative mechanism, the "Limited Preventative Registration," which is being published for public comment.

The Limited Preventative Registration would be 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 gTLD registries, upon payment of a reasonable fee, with appropriate safeguards for registrants with a legitimate right or interest.

Process Note

Discussions during the stakeholder meetings focused strictly on finding common ground on implementation solutions; they were not policy-making meetings. The participants focused primarily on finding the right solutions, allowing for later steps to address how the solutions should be considered, adopted, or implemented.

ICANN has reviewed each of the elements of the strawman solution to identify a way forward, paying special attention to determining whether each properly belongs in a policy or implementation process. We did not find that any element of the strawman was inconsistent with the policy advice from 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.* However, the analysis of the various elements yielded different recommended steps for consideration, as described below.

Sunrise Notice Requirement. Our analysis is that the addition of the required 30-day notice period for Sunrise falls clearly into the realm of implementation. The policy advice did not recommend specific time periods, and this is a reasonable means to help address the communications concerns of rights holders, especially in light of the high volume of gTLD applications.

Trademark Claims. The extension of Trademark Claims from 60 to 90 days can also be considered implementation, as it is a matter of continuing a service that is already required. The addition of a "Claims 2" process could also fall into the category of implementation given that it is an optional, fee-based service for rights holders, and is more lightweight than what registries and registrars will have implemented in the Trademark Claims 1 period. This service is envisioned to benefit both consumers and trademark holders, and is consistent with the objectives of the Trademark Claims service developed by the community. To the extent that there are additional costs incurred by registries and registrars, it is anticipated that these fees can be offset when the process is implemented.

Scope of Trademark Claims. The inclusion of strings previously found to be abusively registered in the Clearinghouse for purposes of Trademark Claims can be considered a policy matter. This proposal provides a path for associating a limited number of additional domain names with a trademark record, on the basis of a decision rendered under the UDRP or a court proceeding. Given the previous intensive discussions on the scope of protections associated with a Clearinghouse record, involving the IRT/STI, we believe this needs guidance from the GNSO Council.[1]

[1] The originally posted document stated that: "The inclusion of strings previously found to be abusively registered in the Clearinghouse for purposes of Trademark Claims can be considered implementation, as it provides a path for associating a limited number of additional domain names with a trademark record. This is consistent with the policy advice that trademark rights should be protected, and, given that the inclusion of such names would be only on the basis of a decision rendered under the UDRP or a court proceeding, the process would merely take into account names for which the issues have already been balanced and considered. However, given the previous intensive discussions on the scope of protections associated with a Clearinghouse record, involving the IRT/STI, we believe this needs guidance from the GNSO Council." This language appeared to create ambiguity as to the nature of the analysis, and has been updated as above.

The strawman model and proposal for Limited Preventative Registrations are being provided to the GNSO Council so that it may provide guidance on these items.

Comments are requested on the feasibility and benefits of the model, as well as suggestions for modification to help achieve the objectives of an effective set of rights protection mechanisms in the New gTLD Program.

As noted above, the strawman model was discussed by participants selected by the respective stakeholder groups. Those individuals designated by the groups were:

(ALAC): Alan Greenberg, Evan Leibovitch

(BC): Marilyn Cade, Bryce Coughlin, Steve Del Bianco, Gerald DePardo

(IPC): J. Scott Evans, Kathryn Park, Kristina Rosette, Fabricio Vayra

(ISPCP): Sarah Deutsch, Tony Harris, Tony Holmes, Mike O'Connor

(NCSG): Robin Gross, Kathy Kleiman, Konstantinos Komaitis, Wendy Seltzer

(Registrar SG): Ben Anderson, James Bladel, Jeff Eckhaus, Matt Serlin

(RySG): Bret Fausett (NTAG), Jeff Neuman, Jon Nevett (NTAG), Antony Van Couvering (NTAG)

Also in attendance were: Martin Sutton (brand TLDs/single registrant TLDs), Vicky Folens and John Hudson (Deloitte), Wim Fabri and Joris Goiris (IBM), and ICANN staff (Francisco Arias, Akram Atallah, Fadi Chehadé, John Jeffrey, Karen Lentz, Gustavo Lozano, Margie Milam, David Olive, Christine Willett).