

Specification 13 to the Registry Agreement FAQs

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Q1: What is the process to apply for a Specification 13 if I already signed the Registry Agreement?

A1: An application may be submitted to the Customer Service Center at newgtld@icann.org. The application must be submitted by the Registry Operator primary contact. Only submissions made by the Registry Operator primary contact will be considered. The application should include:

1. Completed application for Specification 13 (Attachment 3 of the [.Brand TLD Application Process document](#))
2. Complete TLD registration policy
3. Accurate and complete copy of the applicable trademark registration that forms the basis of the request for .Brand TLD qualification

Q2: What is the process to apply for a Specification 13 if I already responded to the Contracting Information Request (“CIR”)?

A2: An application may be submitted to the Customer Service Center at newgtld@icann.org or <https://myicann.secure.force.com/>. The application must be submitted by either the Primary Contact for the application or the Contracting Point of Contact. Only submissions from the Primary Contact for the application or the Contracting Point of Contact will be considered. The application should include:

1. Completed application for Specification 13 (Attachment 3 of the [.Brand TLD Application Process document](#))
2. Complete TLD registration policy
3. Accurate and complete copy of the applicable trademark registration that forms the basis of the request for .Brand TLD qualification

Applications to qualify for Specification 13 will be processed in parallel to the processing of the CIR and Registry Agreement. Applicants have the option of executing the Registry Agreement first while the Specification 13 application is under review, or waiting to sign both the Registry Agreement and Specification 13 at the same time (if the applicant is approved for .Brand TLD).

Q3: What is the process to apply for a Specification 13 if I have not responded to the CIR?

A3: The applicant should submit a response to the CIR, and separately submit an application to the Customer Service Center via the CSC Portal at <https://myicann.secure.force.com/>. A new case should be created to submit the application. The application must be submitted by the Primary Contact of the application or the Contracting Point of Contact. Only submissions by the Primary Contact for the application or the Contracting Point of Contact will be considered. The application should include:

1. Completed application for Specification 13 (Attachment 3 of the [.Brand TLD Application Process document](#))
2. Complete TLD registration policy
3. Accurate and complete copy of the applicable trademark registration that forms the basis of the request for .Brand TLD qualification

Applications to qualify for Specification 13 will be processed in parallel to the processing of the CIR and Registry Agreement. Applicants have the option of executing the Registry Agreement first while the Specification 13 application is under review, or waiting to sign both the Registry Agreement and Specification 13 at the same time (if the applicant is approved for .Brand TLD).

Q4: Who can apply for a Specification 13 to the Registry Agreement?

A4: Entities that meet the definition of a .Brand TLD may apply for a Specification 13 to the Registry Agreement. Specification 13 defines a .Brand TLD as:

1. the TLD string is identical to the textual elements protectable under applicable law, of a registered trademark valid under applicable law, which registered trademark:
 - a. is recorded with, and issued a signed mark data file by, the Trademark Clearinghouse or any successor or alternative trademark validation authority appointed by ICANN, if such trademark meets the eligibility requirements of such validation authority (provided that Registry Operator is not required to maintain such recordation for more than one year);
 - b. is owned and used by the Registry Operator or its Affiliate in the ordinary course of Registry Operator's or its Affiliates' business in connection with the offering of any of the goods and/or services claimed in the trademark registration;
 - c. was issued to Registry Operator or its Affiliate prior to the filing of its TLD registry application with ICANN;
 - d. is used throughout the Term [of the Registry Agreement] continuously in the ordinary course of business of Registry Operator or its Affiliate in connection with the offering of any of the goods and/or services identified in the trademark registration;
 - e. does not begin with a period or a dot; and
 - f. is used by Registry Operator or its Affiliate in the conduct of one or more of its businesses that are unrelated to the provision of TLD Registry Services; and
2. only Registry Operator, its Affiliates or Trademark Licensees are registrants of domain names in the TLD and control the DNS records associated with domain names at any level in the TLD;
3. the TLD is not a Generic String TLD (as defined in Specification 11); and
4. Registry Operator has provided ICANN with an accurate and complete copy of such trademark registration.

Q5: What is the definition of Trademark Licensees?

A5: “Trademark Licensee” means any corporation, partnership, limited liability company or similar legal entity (and not a person) that has a written trademark license agreement with Registry Operator or its Affiliate, for use of the registered trademark owned by Registry Operator or its Affiliate, the textual elements of which correspond exactly to the .Brand TLD string operated by Registry Operator, where:

1. such license is valid under applicable law;
2. such license is for the use of such trademark in the regular course of that entity’s business outside of the provision of TLD Registry Services, and is not primarily for the purpose of enabling registration or use of domain names in the TLD;
3. such trademark is used continuously in that entity’s business throughout the Term; and
4. the domain names in the TLD registered to the Trademark Licensee are required to be used for the promotion, support, distribution, sales or other services reasonably related to any of the goods and/or services identified in the trademark registration.

Q6: What is the definition of Affiliate?

A6: The definition of Affiliate is provided in Section 2.9(c) of the Registry Agreement:
“Affiliate means a person or entity that, directly or indirectly, through one or more intermediaries, or in combination with one or more other persons or entities, controls, is controlled by, or is under common control with, the person or entity specified.”

Q7: What does “control” in the Affiliate definition mean?

A7: The definition of control is also provided in Section 2.9(c) of the Registry Agreement:

“Control” (including the terms “controlled by” and “under common control with”) means the possession, directly or indirectly, of the power to direct or cause the direction of the management or policies of a person or entity, whether through the ownership of securities, as trustee or executor, by serving as an employee or a member of a board of directors or equivalent governing body, by contract, by credit management or otherwise.

Q8: Will an entity under control by contract be considered an Affiliate?

A8: Generally, a third party that is under contract with respect to a specific matter (for example, a customary photocopier lease agreement) is not “controlled” by the other contracting party for purposes of determining “Affiliate” status. Whether a contract provides one party with “control” over the other party requires analysis of the particular facts and circumstances, and cannot be determined absent full knowledge of such facts and circumstances. Generally speaking, the contract must provide Party A with the power to direct the operations and policies of Party B in order to make Party B an “Affiliate” of Party A, and the degree and significance of such power is also a facts and circumstances analysis.

Q9: Can a Registry Operator that intends to operate the TLD in a non-exclusive manner qualify for a Specification 13?

A9: One of the requirements to qualify as a .Brand TLD is that “only Registry Operator, its Affiliates or Trademark Licensees are registrants of domain names in the TLD and control the DNS records associated with domain names at any level in the TLD.” Thus a non-exclusive TLD would not meet these requirements and would therefore not be qualified for a Specification 13.

Q10: If I operate my TLD in a non-exclusive manner, and then later decide to operate it in an exclusive manner, could I apply for Specification 13 at that time?

A10: It would be unrealistic to change from non-exclusive operation of a TLD to exclusive operation of a TLD. Pursuant to Section 2.10(a) of the Registry Agreement, a Registry Operator must offer registrars the option to obtain initial domain name registrations for periods of one (1) to ten (10) years at the discretion of the registrar, and pursuant to Section 2.10(b) of the Registry Agreement, a Registry Operator must offer registrars the option to obtain domain name registration renewals at the current price (i.e., the price in place prior to any noticed price increase) for periods of one (1) to ten (10) years at the discretion of the registrar. Thus, once domain names have been registered to parties other than Registry Operator, its Affiliates and Trademark Licensees, and registrars have the right to maintain those registrations in force for an initial term of one (1) to ten (10) years and to renew those registrations for an additional period of one (1) to ten (10) years, it is hard to see how a Registry Operator could easily revert back to only having domain names registered to Registry Operator, its Affiliates and Trademark Licensees. If a Registry Operator that does not initially qualify as a .Brand TLD believes that it has successfully transitioned to qualifying as a .Brand TLD without breaching the terms of the Registry Agreement and without breach by its registrars of their contractual obligations to registrants, ICANN would consider a later application for Specification 13 in light of all the facts and circumstances.

Q11: Can a Registry Operator of a “Generic String” qualify for a Specification 13?

A11: No, a “Generic String” TLD cannot qualify for Specification 13 because one of the requirements to qualify as a .Brand TLD is: “the TLD is not a Generic String TLD (as defined in Section 3(d) of Specification 11 of the Registry Agreement).”

Q12: What is a “Generic String”?

A12: A “Generic String” is defined in the Registry Agreement as a string consisting of a word or term that denominates or describes a general class of goods, services, groups, organizations or things, as opposed to distinguishing a specific brand of goods, services, groups, organizations or things from those of others (see Section 3(d) of Specification 11 of the Registry Agreement).

When a word or term is used as the common dictionary name for the goods or services it describes, the word is generic. If the word “sushi” is used to identify the Japanese food sushi (i.e., vinegared rice with raw fish), the term is used generically. However, if a business uses the term SUSHI as a brand to identify goods or services unrelated to the food sushi, that would not be a generic use of the term. So a SUSHI brand line of clothing, or a SUSHI brand automobile, or a SUSHI brand photocopying service, would not be a generic use of the term sushi.

If an applicant applies for the TLD string “sushi” and it is in the business of operating restaurants that serve sushi, that would be a Generic String that describes the general

class of goods or things comprising sushi. However, if an applicant applies for the TLD string “sushi,” and the applicant’s business is marketing and selling SUSHI brand clothing or a SUSHI brand automobile or a SUSHI brand photocopying service, that would not be a Generic String. In those cases, SUSHI would not be used to denominate the class of food known as sushi, but would instead be used to distinguish SUSHI brand clothing or SUSHI brand automobiles or SUSHI brand photocopying services from other brands of clothing or automobiles or photocopying services.

Q13: Will ICANN Provide .Brand TLD Applicants Extensions to Sign the Registry Agreement?

A13: As per the Applicant Guidebook, to qualify for an extension, the applicant must demonstrate that it is working diligently and in good faith toward successfully completing the steps necessary for entry into the registry agreement. The applicant would be deemed to meet this requirement if:

- a. The applicant submits a complete CIR form (modified as described above) to ICANN on or before September 1, 2014.
- b. The applicant submits a Specification 13 application to qualify as a .BRAND TLD on or before September 1, 2014.
- c. The TLD string is identical to the textual elements protectable under applicable law, of a registered trademark valid under applicable law, which registered trademark:
 - i. is recorded with, and issued a signed data mark file by, the Trademark Clearinghouse;
 - ii. was issued to applicant or its Affiliate prior to the filing of its TLD registry application with ICANN; and
 - iii. does not begin with a period or a dot.
- d. The applicant provides ICANN with its Specification 13 application an accurate and complete copy of such trademark registration.

If these requirements are met, the applicant will be granted an extension of nine months, from October 29, 2014 to July 29, 2015, to execute the registry agreement.

These requirements are intended in part to establish baseline minimum criteria demonstrating that an applicant has a good faith basis for asserting that it is entitled to qualify as a .BRAND TLD, and to prevent applicants from submitting an application for qualification under as a .BRAND TLD simply to seek an extension of time for executing the registry agreement, where it is clear that the applicant does not have a good faith basis for asserting that it qualifies as a .BRAND TLD.

The requirements specified above relate only to whether the applicant will be deemed to have demonstrated to ICANN’s reasonable satisfaction that it is working diligently and in good faith toward successfully completing the steps necessary for entry into the registry agreement and do not in any way limit or modify the criteria for qualification as a .BRAND TLD as set forth in Specification 13.

Q14: If I Do Not Meet the Requirements in FAQ 13, Can I Still Qualify for an Extension?

A14: If an applicant does not meet the requirements in FAQ 13, it may still demonstrate to ICANN's reasonable satisfaction that it is working diligently and in good faith toward successfully completing the steps necessary for entry into the registry agreement. ICANN may take into account the applicant's failure to meet the requirements in FAQ 13 in considering whether the applicant is working diligently and in good faith.

Q15: If I Want to Further Negotiate Certain Provision in the Registry Agreement Upon ICANN Approval or Denial of the Specification 13 Application, When Must I Submit My Requested Changes?

A15: An applicant that is granted an extension of nine months from October 29, 2014 must provide its requested changes to the Base Registry Agreement to ICANN in .doc, .docx, or .pdf format (or alternatively (a) indicate that it would like ICANN to consider a previously executed registry agreement for another string as the baseline for the terms and conditions of the registry agreement or (b) withdraw its request to negotiate the terms of the Base Registry Agreement) not later than ninety (90) days after the approval or rejection of that applicant's Specification 13 application or February 1, 2015, whichever is later. Failure to do so may result, at ICANN's discretion, in loss of potential eligibility to execute a registry agreement with negotiated changes, but will not impact potential eligibility to execute the Base Registry Agreement for the TLD (with Specification 13 if approved, without Specification 13 if not approved).