UNLIMITED NEW GTLDS and TRADE-MARK PROTECTION

Jonathan C. Cohen - FICPI Munich

Why did 18 trade-mark professionals experienced in trademark protection on the internet come together to form the Implementation Recommendation Team (IRT)? What was it that motivated usto volunteer and spend more than eight (8) working weeks wading through over 900 pages of comment, meeting with a dozen expert witnesses, preparing draft after draft?

A sizeable number of the team would have preferred the status quo with no new gTLDs until better Rights Protection Mechanisms are in place for the existing gTLDs. Others favored the measured introduction of Sponsored or Community based gTLDs. Some support the current expansion, seeing the advantages for commerce and the consumer alike in open competition and innovation.

At the mid-point of 2009, there were something like 190 million domain names registered. Today, internationally and nationally, that number is well over 192 million. Diverse interests all depend on domain names to keep them connected.

However, the day to day experience of most internet users is not as it should be. Lurking in the darkest corners of cyberspace are the unscrupulous, the dishonest and the dangerous who prey on the unwary. Malicious behaviors like spamming or phishing abound; lucky is the internet user whose in-box is not full with offers that are too good to be true.
For most of us, it is a reasonable assumption that the owner of a trademark in the real world that you rely on to provide authentic goods or services is also the owner of a website that you find under the corresponding domain name. The complexities of gTLD and ccTLD hierarchies are of no more interest to “average” internet users than the difference between a registrar and a registry.
Unfortunately, something often “goes wrong” with domain names. Last year the World Intellectual Property Organization reported a 7% rise in the number of UDRP cases it processes.
Domain name abuse, as it has frequently been observed, is a business with low overheads, no barriers to entry and few risks. Serial cybersquatters continue to prosper:
when challenged through a UDRP or other DRP action, they often ignore the correspondence but continue to maintain websites with PPC adverts for as long as they
can, hiding behind inaccurate Whois details or Proxy Registration services.

As Francis Gurry, Director General of WIPO warned in a press release of 16 March, 2009,

“The sale and broad expansion of new top level domains in the open market, if not properly managed, will provide abundant opportunities for cybersquatters to seize old ground in new domains.”

It emerged that each one of the five brand owner representatives on the IRT expects to face *at least one new domain name infringement somewhere in the world every day of the year*.

We strived in our work to provide what we have termed "a tapestry of globally-effective solutions" which we believe, if taken together and not significantly unpinned, will help reduce the incidence and severity of trademark abuse in the new gTLDs.

The team participated in numerous teleconferences, two two-day face-to-face meetings, and one full-day face-to-face consultations with remote participation via teleconference with various interest groups resulting in draft recommendations for several proposed solutions. The IRT was constrained to prioritize the list of proposals and consequently identified five proposals which are hoped may make available solutions to address some of the immediate concerns of the stakeholders, and were thus identified as having a high priority. These included and were named:

1. IP Clearinghouse, Globally Protected Marks List and associated Rights Protection Mechanisms ("RPMs"), and standardized pre-launch rights protection mechanisms;

2. Uniform Rapid Suspension System ("URS");

3. Post-delegation dispute resolution mechanisms ("PDDRP");

4. Whois requirements for new TLDs; and

5. Use of algorithm in string confusion review during initial evaluation.

THE IP CLEARINGHOUSE

The IRT recommends the creation of an IP Clearinghouse to support new gTLD registries, in general, and in operating cost-effective RPMs that do not place a heavy financial or administrative burden on trademark owners, in particular.

The services to be provided by the IP Clearinghouse are:

 The ***validation of trademark rights on an annual basis*** which can be pushed to new gTLD registry operators or pulled by them to support pre-launch RPMs such as Sunrise schemes;

 A ***Globally Protected Marks List*** of trademarks satisfying the strict requirements recommended herein that has the effect of limiting third-party applications for (a) top-level domains that match or are confusingly similar to trademarks on the list; and (b) second-level domains that match trademarks on the list; and

 A ***Pre-Launch IP Claims Service*** that will notify new gTLD applicants and trademark owners that a current validated right exists for the identical term being applied for at the second level.

 The generation of data for and participation in ***URS*** pre-registration, and validation of URS complaint claims regarding trademark rights.

The IRT believes that an ***IP Watch Notice*** service would be a highly useful tool for trademark owners. Because similar services already exist in the market, the IRT does not believe that the IP Clearinghouse should be required to or exclusively provide such a service. Nonetheless, the IP Clearinghouse should not be prohibited or prevented from offering such a service, provided that it should not use the data submitted to it by trademark owners in relation to either the Globally Protected Marks List or the Pre-Launch IP Claims Service for such purpose.

THE GLOBALLY PROTECTED MARKS LIST (GPML)

The IRT recommends the creation of a Globally Protected Marks List (GPML) to provide protection to Globally Protected Marks (GPMs) at the top and second levels. We recommend the GPML in recognition of the numerous comments by and on behalf of trademark owners that called for the establishment of a Reserved Names List or White List for trademarks.

UNIFORM RAPID SUSPENSION SYSTEM (URS)

The Implementation Recommendation Team ("IRT") recommends that all new gTLD registries be required, pursuant to their contracts with ICANN, to take part in a Uniform Rapid Suspension System ("URS"). The purpose of the URS is to provide a cost effective and more timely mechanism for brand owners to protect their trademarks and to promote consumer protection on the Internet.

The URS is ***not*** meant to address questionable cases of alleged infringement (e.g., use of terms in their generic sense) or for anti-competitive purposes or denial of free speech, but rather for those cases in which there is "no genuine contestable issue as to the infringement and abuse" that is taking place.

The UDRP has unquestionably been an important and successful mediation tool for trademark owners and domain name registrants alike. However, times and circumstances have changed since the UDRP was implemented and brand owners and Internet users find themselves facing unprecedented levels of abuse and infringement, which undermines trust in, and thereby negatively impacts the stability and security of the Internet. The URS is intended to supplement and *not* replace the UDRP. They are separate proceedings with distinct remedies.

The URS is designed to provide a faster, cheaper means to stop the operation of an abusive site where there is clearly no defense.

The UDRP is designed to result in the transfer of the abusive domain name. Brand holders seeking to thwart infringement could utilize either or both proceedings.

Therefore, the IRT recommends that ICANN implement the URS, which would be mandatory for all new generic Top Level Domain (gTLDs), implemented through the

new gTLD registry agreements, which would in turn bind registrars supplying new gTLDs to the marketplace. The URS would address cases of abusive use of trademarks where there is no genuine contestable issue as to the infringing or abusive use of a mark in a domain name and in connection with a site that represents abusive use (i.e., not a fair use or commentary situation nor a situation involving questions of whether the registrant is or is not authorized or selling, for example, legitimate, non-counterfeit goods).

The purpose of the URS is to address a cybersquatting problem for brand owners that is already insidious and enormous in scale, and which could continue to spiral out of control with the introduction of an unlimited number of new gTLDs, unless addressed.
The intent in proposing the URS is to solve the most clear-cut cases of trademark abuses, while balancing against the potential for an abuse of the process. It does not replace other current options available, such as the UDRP or other litigation options. Rather, it is intended to address the hole not filled by current available remedies.

POST-DELEGATION DISPUTE MECHANISM

As part of the IRT process, the IRT considered the numerous public comments calling for ICANN to create a mechanism for a post-delegation challenge to certain activities of new gTLD registries. the IRT remains convinced that a Post-Delegation Dispute Mechanism is a necessary rights protection mechanism as enforcement has not been effective.

The Post-Delegation Dispute Mechanism is designed to combat (i) Registry Operators that operate a TLD in a manner that is inconsistent with the representations and warranties contained within its Registry Agreement, or (ii) Registry Operators that have a bad faith intent to profit from the systemic registration of infringing domain names (or systemic cybersquatting) in the Registry Operator's TLD. Whilst it is not possible to define a specific threshold as to what amounts to systemic cybersquatting, the IRT wishes to specifically state that this mechanism is not intended to be used against Registry Operators that may have infringing domain names within their TLDs where such Registry Operators do not have a bad faith intent to profit from those infringing names.

IRT RECOMMENDATION OF THICK WHOIS MODEL (FOR ALL NEW TLDS TO PROVIDE WHOIS INFORMATION UNDER THE THICK WHOIS OR REGISTRY LEVEL WHOIS MODEL)

As part of its charge, the IRT considered the public comments filed during the public comment period on the first Draft Guidebook for New gTLD Applicants ("DAG"). In doing so, the IRT identified numerous public comments calling for ICANN to amend the draft Registry Agreement set forth in the DAG to include a provision requiring all registry operators of new gTLDs to provide WHOIS information under the Thick WHOIS model as is done in the .info and .biz registries.

For clarity, the IRT defines the “Thick WHOIS” model as the central, registry-level provision of WHOIS information for all domain names registered within the registry. This model is in contrast to the “Thin WHOIS” model whereby the registry-level information is very limited and Internet users must rely on the registrar-level for the submission of robust WHOIS data.

The IRT believes that the provision of WHOIS information at the registry level under the Thick WHOIS model is essential to the cost-effective protection of consumers and intellectual property owners. For this reason, the IRT recommends that ICANN amend the proposed Registry Agreement to include an obligation that all registry operators for new gTLDs must provide registry-level WHOIS under the Thick WHOIS model currently in place in the .info and .biz registries.

In addition, the IRT recommends that ICANN immediately begin to explore the establishment of a central, universal WHOIS database to be maintained by ICANN.

IRT REPORT AND RECOMMENDATION ON USE OF THE ICANN DEVELOPED ALGORITHM IN THE STRING CONFUSION REVIEW DURING THE INITIAL EVALUTION

The IRT reviewed numerous public comments that called for a revision to the string confusion review that will be used during the Initial Evaluation of new gTLD applications.
This procedure may be found in Section 2.1.1.1 of the DAG. Specifically, many comments stated that reliance on visual similarity alone was insufficient.
In fact, it is the position of the IRT that expanding the analysis to also include consideration of the aural and commercial impression (meaning) created by the string would assist in passing more applications through the system. Accordingly, the IRT recommends that the algorithm only be used to identify those strings that require the application of further analysis.

DAG-4 – Draft Applicant Guidebook – Version 4

Currently the gTLD namespace consists of 21 gTLDs and 255 ccTLDs operating on various models. Each of the gTLDs has a designated “registry operator” according to a Registry Agreement between the operator (or sponsor) and ICANN. The registry operator is responsible for the technical operation of the TLD, including all of the names registered in that TLD. The gTLDs are served by over 900 registrars, who interact with registrants to perform domain name registration and other related services. The new gTLD program will create a means for prospective registry operators to apply for new gTLDs, and create new options for consumers in the market. When the program launches its first application round, ICANN expects a diverse set of applications for new gTLDs, including IDNs, creating significant potential for new uses and benefit to Internet users across the globe. There could be anywhere from another several hundred to several thousand new registries and gTLDs – operated by entities who are brand owners, non-commercial and commercial communities, non-profit organizations etc.

The program has its origins in carefully deliberated policy development work by the ICANN community. In October 2007, the Generic Names Supporting Organization (GNSO)—one of the groups that coordinate global Internet policy at ICANN—formally completed its policy development work on new gTLDs and approved a set of 19 policy recommendations. Representatives from a wide variety of stakeholder groups—governments, individuals, civil society, business and intellectual property constituencies, and the technology community—were engaged in discussions for more than 18 months on such questions as the demand, benefits and risks of new gTLDs, the selection criteria that should be applied, how gTLDs should be allocated, and the contractual conditions that should be required for new gTLD registries going forward. The culmination of this policy development process was a decision by the ICANN Board of Directors to adopt the community-developed policy in June 2008. A thorough brief to the policy process and outcomes can be found at http://gnso.icann.org/issues/new-gtlds.
ICANN's work is now focused on implementation: creating an application and evaluation process for new gTLDs that is aligned with the policy recommendations and provides a clear roadmap for applicants to reach delegation, including Board approval. This implementation work is reflected in the drafts of the applicant guidebook that have been released for public comment, and in the explanatory papers giving insight into rationale behind some of the conclusions reached on specific topics. Meaningful community input has led to revisions of the draft applicant guidebook.

In parallel, ICANN is establishing the resources needed to successfully launch and operate the program.

The current draft of the Applicant Guidebook is the fourth draft made available for public comment as the work advances through implementation. It was released on May 31, 2010.

The Draft Applicant Guidebook, version 4 (DAG-4) was released on May 31, 2010 and provides detailed information about the rules, requirements and processes of applying for a new generic top-level domain (gTLD). Included among these are the obligations registry applicants will have to meet in relation to IP protection – specifically the various RPMs recommended by the IRT.

From a trade-mark owners perspective, DAG-4 is of significant concern because unfortunately, as in the first three iterations of the Guidebook, certain of the proposals have been either rejected entirely (such as the GPML) or modified to such a degree that their value as "rights protection mechanisms" (RPMs) is seriously compromised. This has been a great disappointment not only to IRT members, but to brand owners and the IP community in general who continue their efforts to ensure that IP protection is what it should be when the new gTLDs are ultimately rolled out.

In particular, the IRT recommendations represented a carefully thought out consensus position on a number of workable solutions for IP protection – as well as significant compromises on the part of IP holders – that were not intended to serve merely as a starting point for "negotiation".

Among the concerns about the DAG-4 are the following:

Trademark Clearinghouse

The IRT had proposed that the Trade-mark Clearinghouse should include all trade-marks registered at any national or multi-national trade-mark office. In the DAG-4, this proposal has been modified so as to include trade-marks registered only in those jurisdictions that conduct a substantive review or that have been "Court or Trademark Clearinghouse validated". This change was prompted by concerns about "gaming" by speculators who might resort to registering trade-marks in certain countries which lacked substantive review for the sole purpose of being able to participate in this RPM. "Substantive review" is not defined in DAG-4 and "validation by the Trademark Clearinghouse" will result, according to WIPO, in the Clearinghouse becoming "the arbiter of the validity of trade-marks legitimately obtained".

URS

The IRT proposed this mechanism to provide a quick and efficient mechanism for trade-mark owners in the clearest-cut cases of cybersquatting. The "diluted" version of the URS in DAG-4 is arguably almost useless in this regard. Rather than being an immediate, inexpensive and efficient remedy, it has been turned into a process that could actually be slower and not any less expensive than the current eUDRP procedure, having a higher burden of proof for Complainants and potential very lengthy delays where the disputed domain remains locked, or where there is an appeal by a respondent. Moreover, there is no loser-pays mechanism and the process has been restricted to situations where there is no open question of fact.

PDDRP

The PDDRP was intended to deal with registry operators that have a bad faith intent to profit from systemic cybersquatting. Although the PDDRP is now open to trade-mark owners claiming that one or more of their trade-marks have been infringed, the ability to recover monetary damages has been eliminated. Moreover, despite the concerns of the IP community, there is no provision for ICANN's involvement in the PDDRP.

There are many other provisions in the DAG-4 and other issues related to the introduction of new gTLDs which can and will impact trade-mark owners once new gTLDs are approved and come online. As always, IP counsel are strongly encouraged to keep informed about the developments in this area, by visiting the ICANN website at www.icann.org and by participating in the Intellectual Property Constituency (IPC) of ICANN. Both IP professionals and IP owners are also encouraged to make their voices heard by participating in ICANN's public comment periods for the various issues of interest to IP owners, either directly or through the IPC.

UNLIMITED NEW GTLDS and TRADE-MARK PROTECTION

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2010

➢ In March 2009, 18 expert TM professionals experienced in TM protection on the internet came together to form the Implementation Recommendation Team (IRT)

➢ Spent more than 8 working weeks wading through over 900 pages of comment, meeting with a dozen expert witnesses

➢ Prepared draft after draft of recommendations to ICANN for protecting TM owners + the public when an unlimited # of new TLDs are introduced

A sizeable number of the team would have preferred the status quo (approx. 20 gTLDs) with no new gTLDs until better Rights Protection Mechanisms (RPMs) for TMs are in place for the existing gTLDs.

Others favored the measured introduction of Sponsored or Community based gTLDs.

Some support the current expansion, seeing the advantages for commerce and the consumer alike in open competition and innovation.

At the mid-point of 2009, there were 190+ million DNs registered. Today, internationally and nationally, that number is almost 200 million.

Diverse interests all over the planet all depend on DNs to keep them connected.

However, the day to day experience of most internet users is not as it should be.

Lurking in the darkest corners of cyberspace are the unscrupulous, the dishonest and the dangerous who prey on the unwary.

Malicious behaviors like *spamming, phishing* or *fast flux* aboundl

Lucky is the internet user whose in-box is not full with offers that are too good to be true.

It is a reasonable assumption that the owner of a TM in the real world that you rely on to provide authentic goods or services is also the owner of a website that you find under the corresponding DN.

Unfortunately, this is not always the case. Last year WIPO reported a 7% rise in the number of UDRP cases it processes, as more & more people unfairly adopt DNs which are the TMs of other people.

DN abuse is a business with low overheads, no barriers to entry, and, few risks.

Serial cybersquatters continue to prosper

When challenged through a UDRP or other DRP action, they often ignore the correspondence but continue to maintain websites with PPC adverts for as long as they can, hiding behind inaccurate WHOIS details or Proxy Registration services.

Francis Gurry, Director General of WIPO warned in a press release of 16 March, 2009,

"*The sale and broad expansion of new top level domains in the open market, if not properly managed, will provide abundant opportunities for cybersquatters to seize old ground in new domains.*"

Each one of the five brand owner representatives on the IRT expects to face *at least one new domain name infringement somewhere in the world every day of the year*.

The IRT strived to provide "**a tapestry of globally-effective solutions**" which it believes, if taken together and not significantly unpinned, will help significantly reduce the incidence and severity of trademark abuse in the new gTLDs.

The IRT identified **5 proposals** which are hoped address the immediate concerns of the stakeholders. These are:

1. **TM Clearinghouse (TC), Globally Protected Marks List (GPML) and associated Rights Protection Mechanisms (RPMs), and standardized pre-launch RPMs;**
2. **Uniform Rapid Suspension System ("URS");**
3. **Post-delegation dispute resolution mechanisms ("PDDRP");**
4. **Thick Whois requirements for new TLDs; and**
5. **Use of algorithm in string confusion review during initial evaluation.**

THE TM CLEARINGHOUSE (TC)

The IRT recommends the creation of aTC to support new gTLD registries, in general, and in operating cost-effective RPMs that do not place a heavy financial or administrative burden on TM owners, in particular.

The services to be provided by the TC are:

- The ***validation of trademark rights on an annual basis***
- A ***Globally Protected Marks List***
- A ***Pre-Launch IP Claims Service***
- The generation of data for and participation in ***URS***

THE GLOBALLY PROTECTED MARKS LIST (GPML)

The IRT recommends the creation of a GPML to provide protection to Globally Protected Marks (GPMs) at the top and second levels.

~~We recommend the GPML in recognition of the numerous comments by and on behalf of trademark owners that called for the establishment of a Reserved Names List or White List for trademarks.~~ NOT APPROVED

UNIFORM RAPID SUSPENSION SYSTEM (URS)

The purpose of the URS is to provide a cost effective and much quicker mechanism for brand owners to protect their TMs and to promote consumer protection on the Internet more efficiently than the UDRP in absolutely clear cases.

The URS is ***not*** meant to address questionable cases of alleged infringement (e.g., use of terms in their generic sense) or,

for anti-competitive purposes or,

denial of free speech,

But rather for those cases in which there is “no genuine contestable issue as to the infringement and abuse” that is taking place.

UNIFORM RAPID SUSPENSION SYSTEM (URS)

The IRT recommends that ICANN implement a mandatory URS for all new gTLDs, implemented through the new gTLD registry agreements, which would in turn bind registrars supplying new gTLDs to the marketplace., as described in the IRT Report to the ICANN Board at:

http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf

POST-DELEGATION DISPUTE RESOLUTION MECHANISM (PDDRP)

The IRT considered the numerous public comments calling for ICANN to create a mechanism for a post-delegation challenge to certain activities of new gTLD registries.

The IRT remains convinced that a PDDRP is a necessary RPM.

The PDDRP is designed to combat:

(i) Registry Operators operating a TLD in a manner that is inconsistent with the representations and warranties contained within its Registry Agreement, or

(ii) Registry Operators that have a bad faith intent to profit from the systemic registration of infringing domain names (or systemic cybersquatting) in the Registry Operator's TLD.

IRT RECOMMENDATION OF THICK WHOIS MODEL

Many public comments filed on DAG-1 for new gTLD Applicants called for ICANN to amend the draft Registry Agreement in the DAG to require all new gTLD registry operators to provide WHOIS information under the Thick WHOIS model as in .info and .biz.

"Thick WHOIS": central, registry-level database of WHOIS information for all DNs in the registry.

"Thin WHOIS": registry-level information is very limited and Internet users must rely on the registrar-level for robust WHOIS data.

APPROVED

IRT RECOMMENDATION OF THICK WHOIS MODEL

The IRT believes the Thick WHOIS model is essential to the cost-effective protection of consumers and IP owners. The IRT recommends that ICANN require all new gTLD registry operators to provide registry-level WHOIS under the Thick WHOIS model.

The IRT also recommends that ICANN immediately begin to explore the establishment of a central, universal WHOIS database to be maintained by ICANN – though this raises privacy concerns

IRT REPORT AND RECOMMENDATION ON USE OF THE ICANN DEVELOPED ALGORITHM IN THE STRING CONFUSION REVIEW DURING THE INITIAL EVALUTION

The IRT reviewed numerous public comments calling for a revision to the string confusion review that will be used during the Initial Evaluation of new gTLD applications. This procedure may be found in Section 2.1.1.1 of the DAG.

Many comments stated that reliance on visual similarity alone was insufficient.

The IRT believes that also considering aural and commercial impression (meaning) created by the string would assist in passing more applications through the system. The IRT recommends that the algorithm only be used to identify those strings that require the application of further analysis.

APPROVED

DAG-4 – Draft Applicant Guidebook – Version 4

Currently: 21 gTLDs and 255 ccTLDs.

Each gTLD has a “registry operator” with a Registry Agreement between the operator (or sponsor) and ICANN

Registry operator responsible for the technical operation of the TLD & all names registered in that TLD.

Currently: over 900 ICANN-accredited registrars worldwide - interact with registrants to register DN’s & provide related services.

The new gTLD program will allow applicants to apply to run new gTLD registries, creating new options for consumers in the market.

In the 1st application round, ICANN expects a diverse set of applications for new gTLDs, including IDNs, creating significant potential for new uses and benefit to Internet users across the globe.

There could be anywhere from another several 100 to several 1000 new registries and gTLDs

DAG-4 – Draft Applicant Guidebook – Version 4

The Generic Names Supporting Organization (GNSO) formally completed its policy development work on new gTLDs and approved a set of 19 policy recommendations.

Representatives from stakeholder groups—gov'ts, individuals, civil society, business and IP constituencies, and the tech community discussed questions including:

1) the demand, benefits and risks of new gTLDs,
2) the selection criteria that should be applied,
3) how gTLDs should be allocated, and
4) the contractual conditions that should be required for new gTLD registries going forward.

DAG-4 – Draft Applicant Guidebook – Version 4

The culmination of this policy development process was a decision by the ICANN Board of Directors to adopt the community-developed policy in June 2008.

A thorough brief of the policy process and outcomes can be found at http://gnso.icann.org/issues/new-gtlds.

ICANN's work is now focused on implementation:

-creating an application and evaluation process for new gTLDs that is aligned with the policy recommendations and provides a clear roadmap for applicants to reach delegation, including Board approval.

- This implementation work is reflected in the DAG versions that have been released for public comment

DAG-4 – Draft Applicant Guidebook – Version 4

The Draft Applicant Guidebook, version 4 (DAG-4) was released on May 31, 2010 and provides detailed information about the rules, requirements and processes of applying for a new generic top-level domain (gTLD).

Included among these are the obligations registry applicants will have to meet in relation to IP protection – specifically the various RPMs recommended by the IRT, as adopted, rejected or modified.

DAG-4 – Draft Applicant Guidebook – Version 4

From a TM owner's perspective, DAG-4 is of significant concern because the IRT proposals have been either rejected entirely (such as the GPML) or modified to such a degree that their value as "rights protection mechanisms" (RPMs) is seriously compromised.

The IRT recommendations represented a carefully thought out consensus position on a number of workable solutions for IP protection – as well as significant compromises on the part of IP holders – that were not intended to serve merely as a starting point for "negotiation".

Among the concerns about the DAG-4 are the following:

1. ***Trademark Clearinghouse***
2. ***URS***
3. ***PDDRP***

Among the concerns about the DAG-4 are the following:

1. ***Trademark Clearinghouse (TC)***

   The IRT had proposed that the TC should include all trade-marks registered at any national or multi-national trade-mark office.

   In DAG-4, TC has been modified so as to include TMs registered **only** in those jurisdictions that conduct a substantive review or that have been "Court or TC validated".

   This was prompted by concerns about "gaming" by speculators who might resort to registering TMs in certain countries which lacked substantive review for the sole purpose of being able to participate in this RPM.

   "Substantive review" not defined in DAG-4 and "validation by the TC" will result, according to WIPO, in the Clearinghouse becoming "the arbiter of the validity of trade-marks legitimately obtained".

   This could exclude marks reg'd in non-examination countries (Europe).

Among the concerns about the DAG-4 are the following:

2. URS

The IRT proposed this mechanism to provide a quick and efficient mechanism for TM owners in the clearest-cut cases of cybersquatting.

The “diluted” version of the URS in DAG-4 is arguably almost useless in this regard.

Instead of an immediate, inexpensive and efficient remedy, it’s now a process that could actually be slower and not any less expensive than the current eUDRP, with higher burden of proof for Complainants and potential lengthy delays where the disputed DN remains locked, or where respondent appeals

Moreover, there is no loser-pays mechanism and the process has been restricted to situations where there is no open question of fact.

Among the concerns about the DAG-4 are the following:

2. PDDRP

- Intended to deal with registry operators with a bad faith intent to profit from systemic cybersquatting. Although now open to TM owners claiming that one or more of their TMs have been infringed, recovery of $ damages has been eliminated.

- Moreover, despite the concerns of the IP community, there is no provision for ICANN's involvement in the PDDRP

- Many other provisions in the DAG-4 and other issues related to the introduction of new gTLDs can and will impact TM owners once new gTLDs are approved and come online.

- IP counsel strongly encouraged to keep informed about the developments in this area, by visiting the ICANN website at www.icann.org and by participating in the Intellectual Property Constituency (IPC) of ICANN.

- IP professionals and IP owners are also encouraged to make their voices heard by participating in ICANN's public comment periods for the various issues of interest to IP owners, either directly or through the IPC.

IRT Members

- Caroline Chicoine, Fredrikson & Byron, P.A., USA (Chair)
- Mette Andersen, LEGO Juris A/S, Denmark
- Jonathan Cohen, Shapiro Cohen, Canada
- J Scott Evans, Yahoo! Inc., USA
- Zahid Jamil, Jamil & Jamil, Pakistan
- Stacey King, Richemont, UK
- Hector Manoff, Vitale, Manoff & Feilbogen, Argentina
- Russell Pangborn, Microsoft Corp., USA
- Mark Partridge, Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, USA
- Kristina Rosette, Covington & Burling LLP, USA
- Ellen Shankman, Ellen B. Shankman & Associates, Israel
- David Taylor, Lovells LLP, France
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THANK YOU!!