

## Questions for the GAC – PROTECTION OF RIGHTS

Below please find each of the specific suggestions made by the Governmental Advisory Committee (GAC) with respect to the Trademark Clearinghouse, the Uniform Rapid Suspension System (URS) and the Trademark Post-Delegation Dispute Resolution Procedure (PDDRP). Following each GAC suggestion are clarifying questions identified by Board members, or a notation that no clarification is needed on a given suggestion at this time. While more questions may arise, this provides some initial requests from the Board for clarification.

### 1. Trademark Clearinghouse:

- The TC should be permitted to accept all types of intellectual property rights that are recognized under the national law of the country or countries under which the registry is organized or has its principal place of business. The only mandatory requirement for new registry operators will be to recognize national and supranational trademark registrations issued before June 26, 2008 and court-validated common law trademarks.

What does the GAC mean by “all types of intellectual property rights?”

- Sunrise services and IP claims should both be mandatory for registry operators because they serve different functions with IP claims serving a useful notice function beyond the introductory phase.
  1. What is the GAC’s rationale for mandating both sunrise and claims services?
  2. What does the GAC mean by “they serve different functions with IP claims serving a useful notice function beyond the mandatory phase.”
- IP claims services and sunrise services should go beyond exact matches to include exact match plus key terms associated with goods or services identified by the mark ) e.g. “Kodakonlineshop”) and typographical variations identified by the rights holder.

No questions at this time.

- All trademark registrations of national and supranational effect, regardless of whether examined on substantive or relative grounds, must be eligible to participate in the pre-launch sunrise mechanisms.

No questions at this time.

- Protections afforded to trademark registrations do not extend to applications for registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings.

No questions at this time.

- The IP claims service should notify the potential domain name registrant of the rights holder's claim and also notify the rights holder of the registrant's application for the domain name.

If the potential registrant and the trademark holder are notified at the same time, what does the GAC intend to happen after notification to the trademark holder?

- The TC should continue after the initial launch of each gTLD.

Does the GAC mean that the registries must continue to access the Clearinghouse after launch and provide notifications for every registration made that involves a name in the Clearinghouse?

- Rights holders, registries and registrars should all contribute to the cost of the TC because they all benefit from it.

Why has the GAC included registrars as an entity that would pay for the Clearinghouse?

## 2. URS:

- The complaint should be simplified by replacing the 5,000 word free text limit + unlimited attachments [para 1.2] with a simple pro forma standardised wording with the opportunity for not more than 500 words of freeform text and limit the attachments to copies of the offending website.

No questions at this time.

- Decisions should be taken by a suitably qualified 'Examiner' and not require panel appointments.

What does the GAC see as a difference? (Current plan in to have just one Examiner).

- Where the complaint is based upon a valid registration, the requirement that the jurisdiction of registration incorporate substantive examination (paras 1.2f (i) and 8.1a) should be removed.

No questions at this time.

- If, as is expected in the majority of cases, there is no response from the registrant,

the default should be in favour of the complainant and the website locked. The examination of possible defences in default cases according to para 8.4(2) would otherwise give an unjustified privilege to the non-cooperating defendant.

Is the GAC advising that, when no response is filed, there be no Examination of a complaint? Or it is just advising that the reference to possible defenses be omitted?

- The standard of proof (para 8.2) should be lowered from “clear and convincing evidence” to a “preponderance of evidence”.

No questions at this time.

- The “bad faith” requirement in paras 1.2f), 1.2g) and 8.1c) is not acceptable. Complainants will in only rare cases prevail in URS proceedings if the standards to be fulfilled by registrants are lax. Correspondingly, the factors listed in paras 5.7a) (“bona fide”) and b) “been commonly known by the domain name”) can hardly allow a domain name owner to prevail over the holders of colliding trademarks.
  1. Is the GAC advising that the requirement of bad faith by the registrant be omitted?
  2. Is the GAC advising that sections 5.7(a) and 5.7(b) of the Clearinghouse proposal in the Proposed Final Applicant Guidebook be omitted in their entirety?
- A ‘loser pays’ mechanism should be added. In addition, registrants who have lost five or more URS proceedings should be deemed to have waived the opportunity to respond to future URS complaints (this amendment corresponds to the “two strikes” provision which applies to rights holders).

No questions at this time.

- However, there should be a clear rationale for appeal by the complainant. The time for filing an appeal in default cases must be reduced from 2 years to not more than 6 months. In addition, the examination of possible defences in default cases according to para 8.4(2) means an unjustified privilege of the non-cooperating defendant.
  1. What does the GAC mean by a clear rationale?
  2. Did the GAC intend to only reference the Complainant?
  3. Is the GAC advising that the time to seek relief from default should be reduced from two (2) years to six (6) months?
- The URS filing fee should be US\$200-US\$300 and minor administrative deficiencies should not result in dismissal of the URS complaint.

How does this stated fee differ from the Guidebook, which suggests \$300.00?

- A successful complainant should have the right of first refusal for transfer of the disputed domain name after the suspension period so that the complainant is not forced to pursue a UDRP proceeding to secure a transfer.

No questions at this time.

- The URS should go beyond ‘exact’ matches and should at least include exact + goods/other generic words e.g. “Kodakonlineshop”.

No questions at this time.

- There are no questions at this time with respect to the timescales identified in the GAC’s chart.

### 3. **PDDRP:**

- The standard of proof be changed from “clear and convincing evidence” to a “preponderance of evidence”.

No questions at this time.

- The second level registrations that form the underlying basis of a successful PDDRP complaint should be deleted.

No questions at this time.

- The requirement of “substantive examination” in para 9.2.1(i) should be deleted.

No questions at this time.

- A new para 6.1 a) be added: “being identical to the complainant’s mark in relation to goods and services which are identical to those for which the complainant’s mark is registered. This would not apply if the registrant has a better right to the mark. In particular the registrant will in normal circumstances have a better right if the mark has been registered prior to the registration of the complainant’s mark.”

No questions at this time.

- Regarding the second level (para 6.2), the registrant operator should be liable if

he/she acts in bad faith or is grossly [sic] negligent in relation to the circumstances listed in para 6.a)-d).

Is the GAC advising that “bad faith or gross misconduct” replace “affirmative conduct” in the following portion of 6.2: “Complainants are required to prove, by clear and convincing evidence that, through the registry operator’s affirmative conduct . . .”?

- The requirement in para 7.2.3 lit.d) that the complainant has to notify the registry operator at least 30 days prior to filing a complaint is burdensome and should be reduced to 10 days if not deleted entirely.

No questions at this time.

- Para 19.5 should be amended as follows: “In cases where the Expert Determination decides that a registry operator is liable under the standards of the Trademark PDDRP, ICANN will impose appropriate remedies that are in line with the Determination.

No questions at this time.