

**UNITED STATES BRAND OWNER JUNE 2012 SUMMIT  
NEW gTLD RECOMMENDATIONS TO STRENGTHEN SECOND-LEVEL RIGHTS  
PROTECTION MECHANISMS**

August 29, 2012

**VIA CERTIFIED MAIL AND EMAIL**

The Honorable Lawrence E. Strickling  
Assistant Secretary for Communications & Information  
National Telecommunications & Information Administration  
United States Department of Commerce  
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Washington, DC 20230  
lstrickling@ntia.doc.gov

The Honorable David J. Kappos  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
United States Patent and Trademark Office  
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Alexandria, VA 22313-1450  
david.kappos@uspto.gov

Re: June 2012 United States Brand Owner Summit

Dear Assistant Secretary Strickling and Under Secretary Kappos:

The undersigned United States industry groups write to you to request your consideration of and support for additional trademark protections at the second level of all new gTLDs. ICANN's receipt of over 1900 applications for over 1400 unique gTLD strings, and the associated expected scope of defensive second-level registrations in these gTLDs, warrant these additional protections.

On June 11, 2012 we held a summit meeting in New York devoted to developing a list of top recommendations for strengthening second-level rights protection mechanisms in ICANN's new generic top-level domain program.

The summit included remote and in-person participation from U.S. brand owners: Adobe Systems, Inc.; Alcon Laboratories, Inc.; Amazon.com, Inc.; American Express Company; AOL, Inc.; Avon Products, Inc.; Citigroup Inc.; Coach, Inc.; The Coca-Cola Company; eBay Inc.; Facebook Inc.; Fidelity Investments; Hitachi America Ltd.; Johnson & Johnson; JPMorgan Chase & Co.; Marriott International, Inc.; Microsoft Corporation; National Football League; NBA Properties, Inc.; News Corporation; Nike, Inc.; Nintendo of America, Inc.; Revlon Consumer Products Corporation; Time Warner Inc.; Verizon Communications, Inc.; Weight

Watchers International, Inc.; and Yahoo! Inc.. In addition, representatives from industry groups AIPLA, ANA, CADNA, CRIDO, and INTA participated in person.<sup>1</sup>

The items put forth by and receiving significant support from the participants of the summit are what form the recommendations. These recommendations were subsequently further discussed and honed both in light of the massive scope of applied-for gTLD strings disclosed on “Reveal Day” and before, during and after the recent ICANN meeting in Prague, Czech Republic. We are pleased to propose for your consideration and support the following recommendations:

### **Trademark Clearinghouse**

- The Trademark Claims Service must:
  - Be broader than merely identical match to include at least, domain names that (a) contain (not merely consist of) a mark in the Trademark Clearinghouse; and (b) consist of the mark and a generic term from the description of goods and services in the registration deposited with the Trademark Clearinghouse; and
  - Last longer than sixty days.<sup>2</sup>
- Sunrise periods should include the option for brand owners to “block” in perpetuity second-level names that match their trademarks, for as long as the owner, or a successor-in-interest, retains rights in the trademark, similar to the ICM Registry launch of the .XXX sTLD.

### **Uniform Rapid Suspension System (“URS”)**

- Procedure:
  - The Trademark Clearinghouse should automatically tie into the URS with an easy-to-use interface so that brand owners need only validate their marks once, thus making URS complaints simpler and less costly and the URS process faster; and
  - Default judgments must not warrant panel appointments.
- Fees:
  - The loser of a contested URS proceeding must bear the URS filing and adjudication fees;<sup>3</sup>

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<sup>1</sup> ANA and CRIDO participated on June 11, 2012, but were unable to reach agreement on a letter supporting the conclusions reached at the summit.

<sup>2</sup> A specific time frame for the Trademark Claims Service was not established during the summit and requires further consideration and development.

<sup>3</sup> Additional information from ICANN staff and potential URS service providers during the Prague meeting demonstrated that the provider infrastructure needed to support a loser-pays URS model is one factor that may drive implementation costs of the URS upward. Accordingly, this recommendation may require further consideration and development.

- If the Respondent (registrant) does not respond, the brand owner should pay only an administrative fee and not the fee required in a contested proceeding where a panel is appointed; and
  - The URS must operate on a low- or no-cost basis, which ICANN should subsidize if necessary.
- Recidivist bad actors should be tracked via a list of common Respondents and that list should be published and publicly available.

The undersigned United States industry groups jointly signing this letter recognize and acknowledge the many other industry group members and private practitioners who collectively contributed to and endorse these recommendations.

We sincerely appreciate your attention to these recommendations to ensure and improve brand owner protections in connection with ICANN's new generic top-level domain program. From a concerted U.S. brand owner perspective, although these recommendations are a minimum and many brand owners believe that more work needs to be done, we believe they are the most important and implementable additions to rights protection mechanisms at the second level. We welcome the opportunity to discuss with you any questions or concerns you may have about these proposals.

Respectfully submitted,



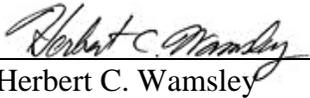
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President  
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Josh Bourne  
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Executive Director  
Intellectual Property Owners Association



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Alan C. Drewsen  
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