

## **Memorandum on the Trademark Clearinghouse “Strawman Solution” 20 March 2013**

The Trademark Clearinghouse [Strawman Solution](#) was developed by community stakeholders in November 2012, and published for comment in December 2012. The discussion leading to the Strawman proposal was convened to address feedback and comments from several stakeholders in relation to the rights protection mechanisms in the New gTLD Program.

The intention in holding these discussions was to facilitate participation from each of the GNSO stakeholder groups while enabling a focused discussion, so that a proposal could be provided for community review. The “Strawman solution” was [posted for public comment](#) on 30 November 2012. The GNSO was [requested to provide guidance](#) on the proposals; this [was provided](#) on 28 February 2013.

There was significant interest in these proposals, and ICANN reviewed all feedback received to determine which elements of the Strawman, if any, should be implemented. An additional thread in the input received was whether each element should be considered a policy or an implementation matter. These views were also considered carefully, in light of the Strawman’s accordance with current policy guidance that existing legal rights should be protected, and the GNSO’s guidance on each of the elements.

Each element of the Strawman proposal was reviewed and considered in detail to balance the feedback received and determine the appropriate next steps, as described below.

### **30-Day Notice Requirement for Sunrise**

The first element of the Strawman model was a proposed requirement that all new gTLD operators publish the dates and requirements of their sunrise periods at least 30 days in advance.

Feedback indicated that this is generally viewed as an implementation detail, and was supported as beneficial to rights holders to anticipate and prepare for upcoming TLD launches. Based on this analysis, ICANN intends to proceed with implementing this aspect of the proposal.

### **90-Day Trademark Claims Period**

The second element of the Strawman model was an extension of the current Trademark Claims period, as described in the Applicant Guidebook, from 60 to 90 days.

During the Trademark Claims period, anyone attempting to register a domain name matching a Clearinghouse record will be displayed a Claims notice showing the relevant mark information, which must be acknowledged before the registration can proceed. If the domain name is registered, the rights holder then receives a notice of the registration.

In practice, providing for 30 additional days of an existing service seems to be a reasonable implementation matter, and the feedback generally viewed this as an implementation detail. Guidance provided from the GNSO Council noted that there would not be an objection to making this extension to the Claims period as an implementation decision.

The balancing of considerations inherent in the Claims service as agreed upon in the community discussions is unchanged, and the expected benefits of the Claims service as designed will still exist. The extension is a continuation of a service that is already required, and an extended period appears to be a reasonable response to the large number of TLDs expected to be entering the market.

Based on this analysis, ICANN intends to proceed with implementing this aspect of the proposal.

### **Additional “Claims 2” Period**

The third element of the Strawman model was a proposal that rights holders have the option to pay an additional fee for inclusion of a Clearinghouse record in a “Claims 2” service for an additional 6-12 months. Anyone attempting to register a domain name matching the record would be shown a general Claims notice including a description of the rights and responsibilities of the registrant, to help propagate information on the role of trademarks and develop more informed consumers in the registration process.

The GNSO advised that this should be a policy discussion rather than an implementation decision. The feedback received via public comment generally indicated a lack of support for the Claims 2 period, either due to concerns about effectiveness or concerns about adopting the proposal without a policy discussion.

Based on this analysis, ICANN does not intend to proceed with implementing this aspect of the proposal at this time.

### **Trademark Claims Protection for Previously Abused Names**

The fourth element of the Strawman model was a proposal that where there are domain labels that have been found to be the subject of abusive registrations (for example, as a result of a UDRP or court proceeding), a limited number (up to 50) of these could be added to a Clearinghouse record. These names would be mapped to an existing record where the trademark has already been verified by the Clearinghouse.

This element of the proposal was referred to the GNSO specifically, as the scope of protection derived from inclusion in the Trademark Clearinghouse was discussed previously. The GNSO advised that this should be a policy discussion rather than an implementation change. The GNSO Council communication also made reference to the stated principle that the Trademark

Clearinghouse is intended to be a repository for existing legal rights, and not an adjudicator of such rights or a creator of new rights.

Having reviewed and balanced all feedback, this proposal appears to be a reasonable add-on to an existing service, rather than a proposed new service. Given that domain names would only be accepted for association with an existing Clearinghouse record, and only on the basis of a determination made under the UDRP or national laws, the proposal would not require any adjudication by the Clearinghouse. Additionally, the provision of notifications concerning associated domain names would not provide sunrise or other priority registrations, nor have a blocking effect on registration of these names by any party.

It is difficult to justify omission of a readily available mechanism which would strengthen the trademark protection available through the Clearinghouse. Given that the proposal relies on determinations that have already been made independently through established processes, and that the scope of protection is bounded by this, concerns about undue expansion of rights do not seem necessary.

Based on this analysis, ICANN intends to proceed with implementing this aspect of the proposal.

### **Limited Preventive Registration**

An additional proposal, the [Limited Preventive Registration \(LPR\) mechanism](#), was not part of the Strawman model but was also [posted for comment](#).

The GNSO Council was requested to provide input on the LPR proposal as it is relevant to a resolution from the New gTLD Program Committee requesting the GNSO to consider whether additional work on defensive registrations at the second level should be undertaken. Guidance received from the GNSO Council noted that the LPR represented a change in policy and therefore should be a matter of Council-managed policy work if it is to be considered.

Given that the LPR proposal does introduce requirements for a new process and is not building on existing mechanisms, it is agreed that introduction of an LPR mechanism would be a substantial change that should arise from broader policy discussions.

Based on this analysis, ICANN does not intend to proceed with implementing the LPR proposal at this time. However, ICANN will continue to encourage the GNSO to proceed with work in this area.

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The full summary and analysis of public comment is available at <http://www.icann.org/en/news/public-comment/tmch-strawman-30nov12-en.htm>.