



Trademark Protection in New gTLDs



Moderator: Mike Silber

Panelists: Alan Greenberg, Robin Gross

Mary Wong, Zahid Jamil and Jeff Neuman

Introduction to Trademark Protection Issues

- The proposed models are the culmination of the significant work by the ICANN community to identify implementable solutions to address trademark protection concerns
- Upon the conclusion of the Public Comment Forum, (1 April 2010), the Models will be finalized for inclusion in the Draft Applicant Guidebook version 4

Panelists & Agenda

Panelists:

Mary Wong, Alan Greenberg, Robin Gross, Zahid Jamil, and Jeff Neuman

Agenda

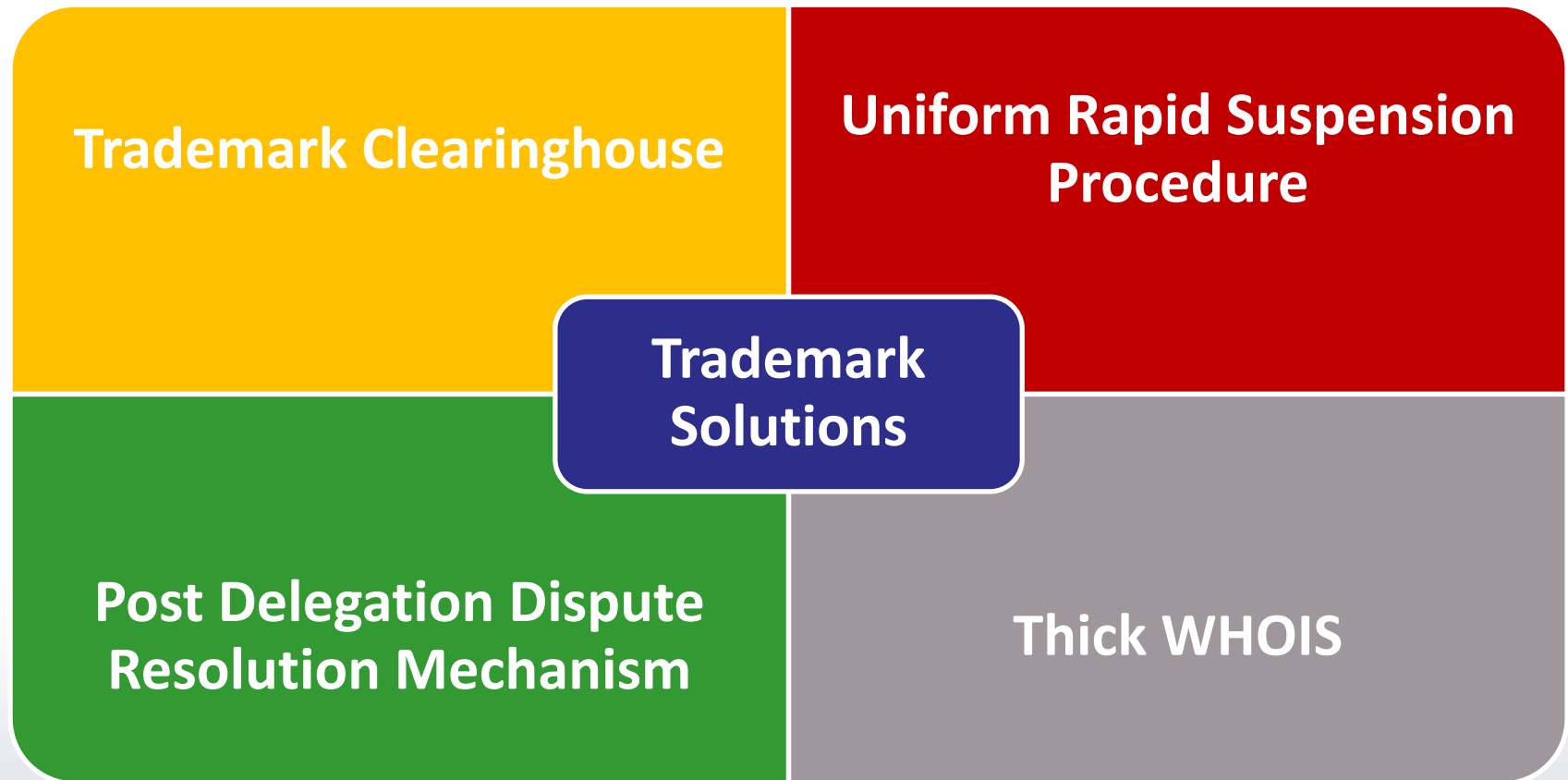
- Introduction and background (5 minutes)
- Trademark Clearinghouse -
Zahid Jamil (30 minutes, including Q&A)
- Uniform Rapid Suspension Procedure –
Mary Wong (30 minutes, including Q&A)
- Post Delegation Dispute Resolution Mechanism –
Jeff Neuman (20 minutes, including Q&A)
- Closing remarks (5 minutes)



Timeline - Trademark & Community Protection

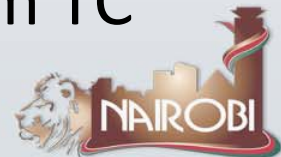
- Feb 09** ICANN Mexico City - IP Community requests enhanced trademark solutions
- May 09** Implementation Recommendation Team (IRT) Report proposes new trademark solutions
- Summer 09** Global Consultation (Sydney, New York, Hong Kong, and Abu Dhabi). General support for certain IRT recommendations, with modifications
- Nov 09** Board seeks GNSO input on an expedited basis on several trademark solutions
- Dec 09** GNSO Special Trademark Issues (STI) drafting team reaches consensus on revised trademark solutions
- Dec 09** GNSO unanimously approves STI Recommendations
- Feb 10** Revised Models & Explanatory Memoranda Posted

Proposed Model



Trademark Clearinghouse- Key Features

- Centralized Database :
 - Storage of trademark registration data
 - Data authenticated by a third party provider
 - Does not create any new rights or limit any rights
- Types of Trademark Data:
 - Trademark registrations of national effect
 - Court validated common law trademarks
- Required use by New gTLD Registries:
 - Sunrise Services or
 - Trademark Claims Services
- Costs to be borne by parties benefitting from TC

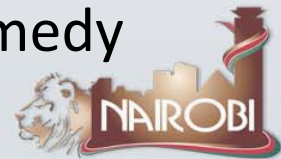


Trademark Clearinghouse – Key Features

- Model adopts substantially all of the GNSO- STI recommendations, with some exceptions
- Trademarks from non-substantive review jurisdictions
 - Registries required to provide either sunrise or TM Claim Services for these marks
 - Registry may request additional validation of use
- Ancillary services allowed for additional solutions
 - Trademark holders may opt out of ancillary services

Uniform Rapid Suspension Procedure (URS)

- Model adopts substantially all of GNSO-STI recommendations
- Expedited take-down procedure for clear-cut cases of trademark infringement
- Protections for Registrants:
 - May file a response to restore the domain name, even after default
 - No costs to registrants except in cases of late answers
- Remedies
 - Suspension for remainder of registration term, with option to extend 1 year
 - Transfer of domain name after decision is not a remedy



URS – Key Features

- Defenses for Registrants- Model incorporates fair uses of domain names
- Penalties for abusive trademark holders
- Procedures to encourage fair examiners
- URS is an additional remedy-
 - UDRP continues to be available
 - Other legal remedies available to both parties
- Reduced costs to trademark holders versus UDRP

Post Delegation Dispute Resolution Procedure

- Used against registries for affirmative conduct- systematic trademark infringement or use of TLD for an improper purpose
- Parties: trademark holder and registry
- Fees: filing fees shared by TM holders and registries. Loser pays prevailing party's filing fees
- Remedies: Panel to suggest graduated enforcement tools to ICANN
- Absent extraordinary circumstances, ICANN will review, approve and enforce the recommended remedies, or as amended by ICANN
- Contractual compliance, URS and UDRP are also available

Trademark and Community Protection Solutions

For more information:

Trademark Clearinghouse:

<http://www.icann.org/en/topics/new-gtlds/trademark-clearinghouse-proposal-clean-15feb10-en.pdf>

Uniform Rapid Suspension Procedure:

<http://www.icann.org/en/topics/new-gtlds/draft-urs-clean-15feb10-en.pdf>

Post Dispute Delegation Resolution Procedure:

<http://www.icann.org/en/topics/new-gtlds/draft-trademark-pddrp-clean-15feb10-en.pdf>

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Thank You!