

July 17, 2014

Cherine Chalaby  
Chair, New gTLD Program Committee  
Internet Corporation for Assigned Names and Numbers  
12025 Waterfront Drive, Suite 300  
Los Angeles, California 90094

**Re: Application of Rights Protection Mechanism to Name Collision Blocklists**

Dear Cherine and other members of the NGPC:

We write today with a joint proposal of the Registry Stakeholder Group (RySG), the Business Constituency (BC), and the Intellectual Property Constituency (IPC) on the matter of the application of rights protection mechanisms to the release of names from name collision blacklist. After considerable discussion in the community, including at the ICANN meeting in London and subsequent consideration by each of our constituencies, we believe that the proposal below better address both the needs of trademark holders and operational considerations of registry operators than to attempt to apply the existing RPM Requirements onto the unique scenario created by the alternative path to delegation. Although this proposal has not been subject to a formal vote, it has been reviewed by, and is supported by, each of the IPC, RySG and BC.

**Background:** ICANN requires that registries prevent certain SLDs within each registry from being activated as part of the Alternative Path to Delegation (APD) that was developed in response to the issue of name collision. The new name collision framework developed by JAS Advisors and that staff intends to present to the NGPC at the end of the month will allow registries to activate those names once the registry has run them through a 90 day period of "controlled interruption".

One issue raised during the public comment period on the original JAS report and not addressed specifically in the proposed framework, however, is how registries should apply RPMs to names once they are released from the name collision list. This is an important issue because the RPM Requirements incorporated in the registry agreements were developed prior to the implementation of the APD and do not anticipate a situation in which names are reserved or otherwise excluded from the standard Sunrise or Claims periods because of an ICANN mandate as opposed to the usual case in which the registry voluntarily elects to place names on reserved lists.

**ICANN Staff Position:** Based on conversations at the London meeting, ICANN staff have suggested:

1) That the APD requires only that registries not activate names, but they are free to allocate names during existing registration periods, including Sunrise and Claims. Therefore registry operators should be making names available for registration during existing Sunrise and Claims periods.

2) Given that ICANN is not requiring that names be withheld from registration during Sunrise and Claims periods, if registries do not make them available, this is simply equivalent to the registry operator reserving the names through the mechanisms in Specification 5 of the Registry Agreement.

3) Generally, existing RPMs adequately cover the situation. Specifically, if registries have withheld names from registration during Sunrise and/or Claims, if the names are later released for registration, they would be subject to a 90-day Claims period, but not Sunrise, pursuant to section 2.4.3 of the RPM Requirements.

**Problems With The Staff Position:** Each of the elements of the staff position is problematic for the community, as noted below:

1) Staff's contention that registries could offer names through existing RPMs simply does not match the reality of the situation.

1a) Although ICANN staff is correct in noting the distinction between activation and allocation, it is not feasible for registry operators to make blocked names available through the existing RPMs. Many (but not all) registry operators have allowed blocked names to be registered in Sunrise on the theory that trademark holders are sophisticated registrants and will be willing to secure the name without being certain of when they will be able to make use of it. However, this same approach does not work for the Claims period where names will be generally available to the public. It would be difficult to explain to consumers that they are registering names that they will not be able to use for some period of time, and both registry and registrar systems would need to be substantially retooled in order to be sure adequate notices were being provided to registrants. ***To the best of our knowledge, not a single registry operator has made blocked names available during their Claims period.***

1b) The notion of allowing non-resolving registrations during Sunrise and Claims has always been presented as an option rather than a requirement for registries. As a result, many registries have elected not to make names available during their initial Sunrise and Claims periods on the assumption that they would release the names after they had been removed from block lists.

2) There are important distinctions between registries reserving names at their own discretion and withholding ICANN-mandated blocklists. These blocklists are often many times larger than discretionary reserved lists, so procedures that may work for releasing a small number of reserved names (for example, that include a significant element of manual handling) may not be feasible for the much larger set of names on blocklists. Moreover, some registry operators may not have had any plans to release names from their reserved lists, so will have no procedure to operate an additional Claims period for these names.

3) The current RPM Requirements did not anticipate, and therefore do not provide for the scenario posed by the APD in which large numbers of names have been withheld from registration during one or more of the periods required in the RPM Requirements doc directly in reaction to a requirement imposed by ICANN.

3a) The reasons why offering these names via existing Claims period is problematic is highlighted in #1(a) above and the operational challenges with allowing for an additional Claims period as anticipated by the existing RPM Requirements are discussed in #2 above.

3b) Even if a registry that did not initially make blocklist names available in Sunrise were to elect to voluntarily allow SMD holders an exclusive period in which to register affected SLDs, the current RPM Requirements provide no guidance or mechanism to do so. Each registry operator would be left to implement this process entirely on its own, with no common notification to trademark holders or coordination through ICANN or the TMCH.

In short, ICANN staff's current position provides inadequate rights protection while simultaneously posing significant operational challenges to registry operators.

**Proposed Alternative Approach:** We believe that a simple compromise in the implementation of the Name Collision Occurrence Mitigation Framework would serve the needs of the community significantly better than attempting to retrofit the existing RPM Requirements onto the novel set of circumstances created by the APD. *This solution is unique to the circumstances of the APD, and is not intended to alter the RPM Requirements or to serve as any sort of precedent for future discussion around RPMs.* Further, this proposal applies only to TLDs subject to the alternative path to delegation; TLDs delegated under the new name collision framework would not use blocklists and hence all SLDs would be subject to the existing RPM Requirements. In particular, we propose:

1) The APD blocklists represent a unique set of events that were not anticipated by the RPM Requirements when they were drafted. Therefore, the release of these names from the blocklist would be subject to a unique set of rules intended to apply only to names affected by APD blocklists and without generally altering the RPM Requirements or expectations therein.

2) Any name on the name collision blocklist not reserved by the registry<sup>1</sup> would have to be subject to some period of 30 days or more in which registrations were available exclusively to SMD holders.<sup>2</sup> Many registries have already satisfied this requirement by offering the names for registration during their initial Sunrise period; those that did not could develop the mechanism and the timing of their choice, possibly overlapping with the 90 day controlled interruption period. ICANN and/or the TMCH would develop procedures by which appropriate notification of these registration periods could be made to trademark holders. We expect that ICANN would work with the community to develop appropriate notification requirements and mechanisms.

3) SLDs released from the name collision blocklist would NOT be treated as reserved names and would NOT be subject to the requirement of an additional 90-day Claims period.

**Conclusion:** We believe that this proposal better serves the needs of both trademark holders and registry operators than ICANN staff's attempt to align the APD with the the existing RPM Requirements. It is supported by a broad cross-section of the community and, due to the limited, one-time nature of the problem, can be implemented in a lightweight manner by registries, registrars and ICANN while still providing important protections for trademark holders. We urge the NGPC to incorporate this proposal into the finalized name collision framework.

Sincerely,

Elisa Cooper  
Chair, Business Constituency

Keith Drazek  
Chair, Registry Stakeholder Group

Kristina Rosette  
President, Intellectual Property Constituency

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<sup>1</sup> SLDs reserved by the registry at its own discretion are subject to section 2.4.3 of the RPM Requirements.

<sup>2</sup> We do not use the term "Sunrise" here because registries and registrars may find it simpler to accept registrations via manual handling rather than through EPP. Registry operators could not, however, impose additional restrictions on registrants in this period above and beyond those in place in the TLD's Sunrise.