

## MARQUES and ECTA's concerns on ICANN issues – 19 May 2010

MARQUES represents trade mark owners and practitioners across Europe, who, together own more than three million domain names (a conservative estimate) and advise organisations of all sizes on rights protection in the domain name system. These domain names are relied upon by consumers across Europe as signposts of genuine goods and services.

ECTA is the European Communities Trade Mark Association. ECTA numbers approximately 1500 members, coming from the Member States of the European Union, with associate members from all over the world. It brings together all those persons practising professionally in the Member States of the European Community in the field of trade marks, designs and related IP matters such as domain names.

We have been concerned at ICANN's plan to introduce an unlimited number of new gTLD extensions since it was launched in 2008. As designed, we are concerned that the process will expose trade mark owners to risk and expense and the consumers that depend upon them to confusion. Whilst we have no wish to stifle innovation or to widen the digital divide, we believe there are many issues with the process that need to be addressed before any roll-out of the new gTLDs namely:

- The fact that the current ICANN processes has allowed cyber-piracy of all types to flourish in 21 gTLDs (see the growth in DRS cases, the abuse of the add grace period, the lack of accurate registrant data) convinces us that measures to safeguard IP as recommended by the IRT and called for by many commentators must be adopted without dilution. We are alarmed at the idea that the complex detail of the IRT's proposed measures to protect IP is being negotiated through the ICANN structure with non-IP specialists.
- ICANN promised several years ago to host a Universal Whois: is such an idea compatible with data protection legislation in Europe?
- The PDRP may lead to sanctions against registries that support cybersquatters. We would like to see sanctions applied to registrars too.
- The draft questions in the DAG do not feature a requirement on applicants to set out rights protection measures in detail and for this answer to be scored. This is an omission.
- The Globally Protected Marks List is an idea of the IRT that was discarded by ICANN unilaterally. We think it deserves reconsideration.
- There must be no discrimination between trade marks filed at official national or international trade mark offices that do and do not undertake substantive examination if the clearinghouse is to work properly.
- The URS should offer a winning complainant the right to request the transfer of a domain.
- Timing: if the process launches in Q4 2010 or Q1 2011 many organisations will be surprised. ICANN needs to announce a final deadline and to stick to it.
- ICANN operates under consensus policies, it reserves the right to re-delegate a gTLD & it contracts under Californian law: how acceptable to European companies and the European GAC members are these requirements?

- The costs: ICANN is proposing a flat application fee of \$185,000 which has the advantage of acting as a deterrent to infringers. However, it is a great deal for SMEs and some communities to find. Some flexibility should be offered.
- There is a compelling case for applications to be categorised so that the evaluators can compare “apples with apples” and some communities can benefit from processes especially tailored to them.
- Potential applicants are confused about what to apply for – the company name, a key mark or a generic term? An IDN? At \$185,000 our members would hope to be able to reserve a key term plus confusingly similar variations and at least one IDN equivalent
- Should ICANN award virtual monopolies in generic terms? How will this impact upon competition law in Europe?
- Are there some terms which should be protected in the public interest? Is there a role for the GAC in preparing such a list? Dot Health, Dot Food, Dot Meds, Dot Pharma, Dot Children, Dot Invest, Dot Loans etc.
- How will ICANN manage registry compliance when there are 250 or 500 new registry operators?
- When the DNs expands, will the budgets of our members for internet protection expand proportionately? As this is unlikely, will the EU consider any anti-cybersquatting legislation?
- Registries can be based anywhere in the world. Many US based registry providers are seeking business in Europe. What are the Data Protection implications of this? Accurate Whois is vital but must be balanced against need for confidentiality.
- There is only a 45 day window for mounting an Objection: this seems unreasonably short.
- ICANN meetings are held in increasingly inaccessible places. Would the Commission consider a call for ICANN to hold its meetings in hub cities where transportation is easier?
- ICANN is swayed by the views of its "core" constituencies. However, some other important constituencies are relatively weak in terms of influencing the policy making process – for example the Business Constituency. How can we work to improve this?
- How can we improve the impact of the IPC? How can we get the involvement of other intellectual property organisations in Europe?

Nick Wood, Chair  
MARQUES CyberSpace Team  
[info@marques.org](mailto:info@marques.org)  
[www.marques.org](http://www.marques.org)

Andrew Mills, Chair  
ECTA Internet Committee  
[ecta@ecta.org](mailto:ecta@ecta.org)  
[www.ecta.eu](http://www.ecta.eu)