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
1401 Constitution Ave., N.W.
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
P.O. Box 1450
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.

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

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.²

- 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;³

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

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

³ 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,

William G. Barber
President
American Intellectual Property Law Association

Josh Bourne
President
Coalition Against Domain Name Abuse

Herbert C. Wamsley
Executive Director
Intellectual Property Owners Association

Alan C. Drewsen
Executive Director
International Trademark Association