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Co-Chairs
GNSO PDP Working Group
'Review of all Rights Protection Mechanisms (RPMs) in all gTLDs'
<http://gns0.icann.org/en/group-activities/active/rpm>

ICANN Rights Protection Mechanisms versus Trademark Law

Dear Co-Chairs,

We are a group of law professors and practitioners with expertise in trademark law. We write to you in your capacities as Co-Chairs of the ICANN GNSO PDP Working Group on 'Review of all Rights Protection Mechanisms (RPMs) in all gTLDs' to express our shared concern about how rights protection mechanisms at ICANN are developing.

We observe a troubling tendency for rights protection mechanisms at ICANN to disregard the delicate balance that domestic trademark law strikes between the business interests of trademark owners and the free expression rights of their competitors and the general public. We are concerned that the expansive protections recently demanded by trademark owners are inconsistent with basic propositions of trademark law.

A case in point is the Trademark Clearinghouse, a mechanism established for the new gTLDs that gives trademark owners special rights to prevent the registration of domain names that contain their trademarks. Those registered in the Trademark Clearinghouse have access to a sunrise period that gives them priority access to domain names in a new gTLD, and to a trademark claims process that gives them early warning when domains the contain their trademarks are registered.

The problem with these mechanisms is that they go beyond the rights that domestic trademark law recognizes. Under U.S. and most other countries' trademark laws, ordinarily a trademark right only exists within a distinct class of goods or services—for example, the APPLE technology company's trademark coexists with APPLE trademarks held by a bank, an insurance company, and a travel company. Moreover, trademarks are territorially based so that in addition to the four US APPLE trademarks above, there may be other APPLE trademarks protected in different jurisdictions. The Trademark Clearinghouse does not recognize these important limitations on the scope of trademark rights.

Additionally, trademark law recognizes other limitations on trademark owners' rights. For example, in the United States, the defense of fair use allows other parties to use a trademark for its descriptive meaning or to refer to the trademark holder or its goods or services, where there is no attempt to confuse consumers. Courts have specifically applied this limitation to domain names. It exists in similar form in other countries. Yet it is absent from the rights protection mechanisms established by ICANN.

The importance of maintaining these limits is that in their absence, these new rights protection mechanisms risk interfering with:

- the free expression rights of those wishing to use generic words and proper names in domains, without fraudulent intent;
- the free expression rights of those wishing to use trademarks for the purposes of commentary, parody, or criticism of the trademark or its owner; and
- the ability of other legitimate trademark owners to use identical or similar trademarks in a second-level domain name.

In particular, two features of the Trademark Clearinghouse disrupt the appropriate balance between the rights of trademark holders and the rights of non-trademark registrants. The first is the inclusion of design marks in the Trademark Clearinghouse. Many design marks include words that would not be protectable absent the design. The inclusion of these words in the Trademark Clearinghouse effectively extends the trademark protection of these words beyond what trademark law would permit. For example, a registered design mark for microprocessors may include the word “smartseries,” only if that word is disclaimed. Having been disclaimed, it should not then be protected just as a registered word mark is protected in the Trademark Clearinghouse.

Our second concern is with the secrecy of the Trademark Clearinghouse database. Given that the Trademark Clearinghouse is exercising a quasi-public function, we believe the public should be able to search its database just as the public is able to search the USPTO database for trademarks. Trademark registries have always been open to public searches, limited only by physical access. In the digital age, the concealment of these records is a momentous and unjustifiable retreat from transparency.

The availability of rights protection mechanisms that exceed the rights of trademark owners under trademark law has troubling broader implications. Notably, it has emboldened intergovernmental organizations (IGOs) to [ask for similar protections](#) for their own names and acronyms, even though such protection has no legal basis. It has also prompted the creation of new registry programs that go even further than ICANN RPMs in the privileges they afford trademark owners—such as Donuts’ [DPML Plus](#) which allows trademark owners to “block” a trademark (including a misspelling) across all of their 200 new gTLDs.

Given these developments, we urge ICANN to reevaluate the premises of many of its existing rights protection mechanisms to ensure that they do not exceed the purposeful boundaries of trademark rights. Such a review is appropriately within the scope of the Review of all Rights Protection Mechanisms PDP Working Group. We respectfully request that this review be undertaken. Until such a review is undertaken, any further expansion of the rights provided by the Trademark Clearinghouse to domains that it does not already cover, including legacy domains, would be premature.

The objective of the new Trademark Clearinghouse was to protect the legitimate interests of trademark owners as established by trademark law. We believe this objective can be achieved without harming the competing interests of other users of the domain name system.

We place ourselves at your disposal to address any questions you may have.

Yours sincerely,

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