

October 26, 2015

VIA EMAIL TO AKRAM.ATALLAH@ICANN.ORG

Mr. Akram Atallah
President, Global Domains Division
Internet Corporation for Assigned Names and Numbers
12024 Waterfront Drive, Suite 300
Los Angeles, CA 90004

Dear Mr. Atallah,

fTLD would like to bring to the attention of ICANN the following issue which it believes raises potential gaming concerns in connection with the Trademark Clearinghouse. During the recent ICANN meeting in Dublin Craig Schwartz met with Karen Lentz on this topic and she recommended coordinating a meeting with ICANN staff to discuss potential ways for fTLD to address this issue for its launch of the .INSURANCE gTLD. Unfortunately, this concern was only recently shared with fTLD, and therefore was not known and could not have been submitted to ICANN during the public comment period associated with the Draft Report: Rights Protection Mechanisms Review conducted earlier this year. fTLD would respectfully request that this issue be incorporated into any further Rights Protection Mechanisms reviews.

As noted, it was recently brought to the attention of fTLD by a community member that a successfully registered .BANK domain name during the Sunrise period with a valid Signed Mark Data (“SMD”) file was associated with a nationally registered trademark registration. However, the successful Sunrise registrant did not appear to be licensed to provide banking services in this jurisdiction, and the statement of use provided to the Trademark Clearinghouse appears to be based exclusively on use of the mark via the Internet in a different jurisdiction. fTLD contacted the Trademark Clearinghouse about this apparent irregularity and was informed that this was permissible. In fact and in response to ICANN’s Draft Rights Protection Mechanisms Review published for public comment earlier this year, Deloitte, ICM and CHIP specifically stated in their public comment that: “proof of use acceptance requirements are in no means linked to the country or jurisdiction in which the trademark is registered.”

fTLD is supportive of the both the Sunrise and Trademark Clearinghouse mechanisms as they provide important safeguards to trademark owners. However, fTLD is concerned about the potential for a prospective registrant to obtain a national registration in a jurisdiction that does not require proof of use, and then provide proof of use to the Trademark Clearinghouse based upon use in a different jurisdiction than the one where it holds a trademark registration. The concerns of gaming ICANN’s Rights Protection Mechanisms are further heightened when it is questionable whether the Sunrise applicant would have been able to obtain a national trademark registration in the jurisdiction where they actually use the mark.

Additionally, fTLD will, when it meets with ICANN staff, seek clarification on whether it may impose an additional requirement as part of its Name Allocation Policy for the .INSURANCE Sunrise period. Specifically, fTLD would like to require applicants provide proof of use associated with any Sunrise .INSURANCE domain name registrations to be based upon actual use of the trademark in the jurisdiction associated with the SMD file issued by the Trademark Clearinghouse.

Should you have any questions or comments please do not hesitate to contact me.

Best regards,

A handwritten signature in cursive script that reads "Heather Diaz".

Heather Diaz
Director, Compliance and Policy

cc: Craig Schwartz, Managing Director, fTLD
Cyrus Namazi, Vice President for DNS Industry Engagement, ICANN
Karen Lentz, Director, Operations & Policy Research, ICANN
Krista Papac, Director, Registry Services & Engagement, ICANN
Amy Stathos, Deputy General Counsel, ICANN
Vickey Folens, Senior Manager, IP & Internet Services and Strategy, Deloitte