

Mr. Akram Atallah
President, Global Domains Division
September 24, 2018

RE: Public Interest Letter Urging Rejection of Donuts DPML Modification

Dear Mr. Atallah, GDD Staff and All Reviewing this Request,

We commend you for putting this Donuts DPML modification out for public comment – and ensuring that it reached the ICANN Community. Many of us do not follow the “technical modifications” of the RSEP process, but we do closely follow the trademark and overreach issues discussed in the policy development processes throughout the GNSO.

This seemingly mild RSEP technical request to change the Donuts’ registry agreement (across its 300+ domain names) is actually a shocking request. It is also a proposal to allow trademark owners to massively overreach the scope and limits of their trademarks. We note that you have found no competitive implications in your review prior to public comment – but this is probably a review of the competitive implications among registries (which is within your scope and expertise).

We are law professors and practitioners collectively with many years of experience teaching national and international trademark law and practicing trademark and domain name law. **We submit that the competitive implications of Donuts’ proposal are enormous – with dramatic and negative implications for those seeking to register domain names – registrants.** We urge you to reject this proposed amendment as completely unwarranted by trademark law and outside the bounds of any trademark protection.

What Donuts requests for its 300+ gTLDs is unprecedented, anti-competitive and even illegal in some circumstances. Donuts is proposing to allow one trademark owner – e.g., Princeton University – to block all other “Princetons” from registering domain names in the Donuts gTLDs.

However, Princeton is both a University and a city. Therefore, it is completely appropriate for The Trustees of Princeton University to register trademarks, e.g., Princeton University Press, but also for other non-affiliated entities to register trademark with “Princeton” as a location identifier or even just because they like the letters -- e.g., Princeton Venture Hub, Princeton Hulu Farm and The Princeton Review, all trademarks registered with the US Trademark Office and unaffiliated with Princeton University. We note further that the Princeton Plasma Physics Laboratory is registered to the US Department of Energy.

The basic principles of trademark law bar a single person or company from “owning” a word or term. A trademark is a limited grant to use a word, term, logo for a certain category of goods and services and in a certain jurisdiction. This means, as we all know, that McDonalds Corporation coexists with pages and pages of white pages entries for families with the last name of McDonalds and Orange Telecom cannot monopolize the word orange nor bar anyone from using it as a color, to name the fruit, or even for unrelated commercial purpose (e.g, “orange” as a US registered trademark for software of Sunlight Financial).

The concept of a “protected marks list,” also known as a “block list,” was roundly and loudly rejected by Stakeholder Groups of the GNSO and Advisory Committees when presented as an idea of the Intellectual Property Constituency in 2009. The “rights protection mechanisms” for New gTLDs adopted by the GNSO and later ICANN Board expressly did not include any form of a “block” or “protected marks list.” During the chaotic period of New gTLD applications, Donuts slipped the protected marks list into its individual commitments – which were not reviewed by the public or ICANN’s Legal Staff. They were adopted without any discussion of the free expression implications, the due process restrictions, and the violation of the fairness and balance of trademark laws across the world.

Specifically, Donuts seeks to change one very significant line of its Registry Agreement. The current registry agreement includes:

“Blocked labels do not prevent other trademark rights holders from unblocking the label and registering the domain name.”

The current Donuts policy allows different “Sam’s” to legitimately register in different gTLDs run by Donuts, e.g., Sam (US trademark for software and hardware) can register SAM.COMPUTER, Sam (US trademark for an ATM network) could register SAM.FINANCIAL and an individual could register his new music group in Sam.Band. The current rules are not only consistent with the balances of existing trademark law, but with the goals of the New gTLD program – to break the artificial scarcity of top level domains and open a wide range of New gTLDs to serve many communities, groups, industries and activities.

But Donuts seeks a change – ICANN’s permission to sell priority on the protected marks/block list to whichever trademark owner pays them the most, thus keeping out all other legitimate trademark owners and domain name registrants:

“In some instances, approval from the applicable DPML holder may be required for a third party with the same trademark to register the blocked name.” [The newly requested text to replace “Blocked labels do not prevent other trademark rights holders from unblocking the label and registering the domain name.”]

ICANN’s answer should be NO. Such a change would allow Donuts to give a trademark owner the unwarranted monopoly on their trademark --- completely control of a basic word, term or name in domain names across 300+ gTLDs.

As discussed above, such monopolization of basic words, terms and names is completely inconsistent with trademark law. No one owns the names “Sam,” “Jerry” or “Wendy” and no one can stop others from using their words in trademarked and noncommercial ways – unless ICANN grants this unwarranted, untechnical and highly anti-competitive request.

This is not a just a change to a Registry Agreement, it is an unwarranted change to balances and limits of trademark law. Donuts’ request violates the bounds of basic free expression protections as well as due process; it sets aside that in order to stop me from using a basic word or term, a trademark owner has to *prove* that my use is infringing. In the real world, a trademark owner never holds this type of power, and in the Domain Name System, they must not either.

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Mr. Atallah, we strongly urge you to deny this request as outside ICANN's narrow scope and mission, beyond the bounds of trademark law, and outside any reasonable control that registries should be exercising over second level domain names.

We have no financial interest in this process, however, we do seek trademark laws and policies that operate within legal and rationale bounds.

We strongly urge your rejection of this Donuts proposal.

Sincerely, the undersigned:

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