

September 24, 2018

To: comments-dpml-modification-15aug18@icann.org

I am writing on behalf of VeriSign, Inc. in regard to the proposed “Modification of Domains Protected Marks List Service” that was published for public comment on August 15th at <https://www.icann.org/public-comments/dpml-modification-2018-08-15-en>.

We would like to thank ICANN for recognizing that “this modification to the DPML service may have a significant impact on third parties, such as trademark rights holders and potential registrants”, and was therefore deserving of public comment. Registry operators should have considerable latitude in their ability to offer services although, in this instance, it was wise to obtain public comment.

The currently proposed amendment contemplates only a single change to the DPML service. Nonetheless, this change raises serious process and policy issues.

First, it is concerning that Donuts has been offering the very service on which public comment is now being sought for the first time for at least the past two years, and doing so in apparent violation of its current registry agreements. Section 4.1 of Exhibit A (Approved Services) of Donuts’ registry agreements currently state that “Blocked labels do not prevent other trademark rights holders from unblocking the label and registering the domain name.” Yet, the 2-year old service now subject to public comment is doing exactly that, “prevent[ing] other trademark rights holders from unblocking the label.”

Second, we believe that this registration blocking aspect of the new DPML Plus service appears to go beyond the bounds of recognized trademark law and therefore should be subject to further study before it is approved. Trademarks offer important protections, restricted to the nation in which the trademark was registered and for a particular category[ies] of goods and services, and generally do not permit one owner of a mark to block legitimate activities of another entity with rights in that same mark.

As an example, Delta Airlines ordinarily would not be permitted to prevent Delta Faucet from registering and using domain names containing the word “delta.” The ICANN community should think carefully before allowing a private registry operator the right to refuse access to registration services for domain names to Delta Faucet just because Delta Airlines bought the new DPML Plus service first. Allowing one trademark owner to deny the use of another trademark owner’s rights in this manner goes beyond the protections of trademark law, and is at odds with the general rationale of the new gTLD program, which is to enhance consumer choice and competition through increased availability of gTLDs available for domain registrations.

Thank you for this opportunity to comment.

Sincerely,

Philip S. Corwin

Policy Counsel

Verisign