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October 1, 2018  
Mr. Akram Atallah  
President, Global Domains Division  
Via E-Mail To: [comments-dpml-modification-15aug18@icann.org](mailto:comments-dpml-modification-15aug18@icann.org)

**RE: Proposed Change to Donuts' Domain Protected Marks List**

Dear Mr. Atallah and ICANN Staff,

The Electronic Frontier Foundation (EFF) joins others in the public interest community in opposing Donuts' proposed change to its registry agreement, concerning its "Domain Protected Marks List."<sup>1</sup> This change, presented as a mere technical modification, is in fact a dangerous and unwarranted expansion of large commercial interests' control over domain name registration by the general public.

EFF is a nonprofit, donor-supported public interest organization that defends the rights of technology users. Founded in 1990, EFF has over 37,000 dues-paying members.

As discussed in the Public Interest Letter,<sup>2</sup> Donuts' proposed change would allow trademark holders to block the registration of domains that contain particular words or phrases in the Trademark Clearinghouse (TMCH) database, even when others have the right to use that word or phrase. Even close variations on a word or phrase can be included. This policy, a modification to Donuts' "Domain Protected Marks List," applies across all of Donuts' approximately 238 generic top-level domains. Thus, this change would grant a group of trademark holders unprecedented power over domain registrations.

Basic principles of trademark law forbid a single person or company from "owning" a word or phrase. A trademark is a limited grant of protection for the use of a word, phrase, logo, or other mark in commerce, in connection with the sale of specific goods and services in the places where they are sold. A trademark does not bar others from referring to a product by its name, nor from criticizing it, nor from using a similar name on different goods and services. These limits on the rights of trademark holders are critical safeguards for free speech and for competition.

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<sup>1</sup> <https://www.icann.org/en/system/files/files/rsep-2018058-donuts-request-13jun18-en.pdf>

<sup>2</sup> <https://mm.icann.org/pipermail/comments-dpml-modification-15aug18/2018q3/000002.html>

Mr. Akram Atallah  
October 1, 2018  
Page 2 of 2

The ICANN Community long ago rejected the concept of a block list. Nonetheless, Donuts, which is the registry for a vast portfolio of New gTLDs, has chosen to implement one itself, without the imprimatur of the ICANN policymaking community. With the proposed change, trademark holders in the Clearinghouse will gain a level of control that the ICANN community and trademark law have both rejected.

ICANN has created powerful processes and procedures to address cybersquatting, *i.e.*, making bad-faith claims on domain names that impose on the legal rights of others. Donuts' proposal would allow trademark holders to prevent domain names from being used in countless lawful ways, invading other people's rights to use a business's name in order to criticize it, or even to conduct a different kind of business, serving different products in a different geographical area. By invading others' legal rights to use the domain name system, this proposal itself enables a broad form of cybersquatting.

The limitations in trademark law, and in the processes and procedures established by ICANN consensus policy, are not mere omissions for companies such as Donuts to fill unilaterally. They are key safeguards of public rights. ICANN should defend those rights by rejecting Donuts' proposal.

Very truly yours,

Mitch Stoltz  
Senior Staff Attorney  
Electronic Frontier Foundation