The Perfect Sunrise?

How pre-launch Rights Protection Mechanisms and successful registry operations go hand in hand

A short guide for new gTLD applicants by the Intellectual Property Constituency

ipc

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Contents

About the IPC & MARQUES

This booklet has been produced by the Intellectual Property Constituency (IPC) of ICANN. The IPC is one of the constituencies of the Generic Names Supporting Organization (GNSO) of ICANN charged with the responsibility of advising the ICANN Board on policy issues relating to the management of the domain name system. The IPC membership consists of hundreds of intellectual property specialists from all over the world including the major professional associations that represent them. The IPC provides ICANN through the GNSO with the views of rights owners.

MARQUES, the Association of European Trade Mark Owners, is one of the professional associations in membership of the IPC. MARQUES is pleased to sponsor this publication. MARQUES has a determination to improve measures for the protection of intellectual property on the internet both on behalf of its members, who are 750 trade mark experts, and the millions of individuals and communities who regard these trade marks as a guarantee of quality and authenticity. MARQUES conservatively estimates that its members together own upwards of 2 million domain names.

Introduction

One fine day in 2009 or maybe 2010 the first new gTLD registry to be approved by ICANN under the "New gTLD Program" which it started in back in 2006 will launch.

During this time frame, it is possible that a new ccTLD will launch and almost certain that an existing ccTLD will offer IDNs or registration under a new second-level domain.

Naturally, all registry operators will strive to minimise risk and ensure security and stability. With regulators and investors to satisfy, a smooth launch is critical.

Due to the need for global interoperability, technical and operational "Best Practice" is essential during a launch. Registrars undertake formal Operational Testing & Evaluation, communicate with registries by EPP and may be required to set up their servers for checks. They will deposit funds into credit accounts with the registry operators and ensure that the Terms & Conditions of Registration are made available to clients.

However, there is no consensus on what constitutes "Best Practice" when it comes to measures to protect intellectual property and the rights of others during the launch phase of a new gTLD. (The Uniform Dispute Resolution Policy is a universal curative measure that enables rights owners to tackle bad faith gTLD registration post-launch).

As one of ICANN's goals is to encourage diversity of both registry services and service providers, a wide variety of gTLD registry models will develop. In 2007, the Generic Names Supporting Organization's "Protecting the Rights of Others" Working Group concluded in a 114 page report for ICANN that Best Practice guidelines that would be suitable for one registry model may not be appropriate for another. It therefore declined to recommend "an approved model Rights Protection Mechanism".

Despite this, it has been the experience of members of both the Intellectual Property Constituency of ICANN and MARQUES that potential registry operators welcome impartial guidance on measures to protect the rights of others. In both the 2000 and 2004 new gTLD rounds, applicants requested meetings with the IPC to discuss this subject. Individual members of the two organisations have also been consulted by registry operators and government agencies with responsibility for TLD projects.

Therefore the IPC decided to produce this guide to assist potential gTLD applicants and possibly some ccTLD registry operators to identify and assess pre-launch Rights Protection Mechanisms (RPM).

Why RPM are important to registry operators

The World Intellectual Property Organisation explains why there are so many disputes over domain names on its website:

There is no agreement within the Internet community that would allow organisations that register domain names to pre-screen the filing of potentially problematic names. The reasons vary, ranging from allowing easy registrations to stimulate business, to the practical difficulties involved in determining who holds the rights to a name, to the principle of freedom of expression. Furthermore, the increasing business value of domain names on the Internet has led to more cybersquatting, which results in more disputes and litigation between the cybersquatters and the businesses or individuals whose names have been registered in bad faith". **(www.wipo.int/amc/en/domains/resources)**

Whatever your position on the rights of intellectual property owners, if you are involved in the application process for a new gTLD registry, you should consider the benefits of a pre-launch Rights Protection Mechanism (RPM) that suits your business model. These include:

- **The possibility of attracting registrations from numerous brand owners. Historically, RPM-related registrations have sometimes provided a significant revenue stream at a critical time.**
- **Building the reputation of your registry as a desirable domain extension for internet users from the community that you are targeting.**
- **Allocating desirable terms, both popular generic words and trade marks, fairly and appropriately between eligible claimants from across jurisdictions.**
- **The potential cost savings if you do not need to pay a large or expensive legal team to manage disputes. For example, in 2002 .info operator Afilias was forced to make over 13,000 Challenges of Last Resort through WIPO in order to block abusive .info applications that had succeeded because there was no eligibility validation requirement.**
- **The reduction of potential legal risks if you avoid the difficulties that other gTLD operators have experienced which can have a very negative impact on your Business Plans. In August 2001, less than 30 days after launching the .biz domain, NeuLevel Inc, 60 of its registrars and ICANN faced a Class Action in the Superior Court of Los Angeles for its method of allocating domain names between competing parties which was construed an illegal lottery. Other legal challenges followed. Neulevel was forced to make $1.7 million in refunds to the 25,000 applicants for some 58,000 disputed names and eventually settled the last case in January 2003 with a payment of $1.2 million.**

If it is self-evident that a smooth registry launch with adequate protections for the rights of others is in the best interests of trade mark owners, registry operators and internet users, then how do you choose the RPM that is best for your registry model? In its report entitled, "New Generic Top Level domains: Intellectual Property Considerations", WIPO sums up the criteria for an effective pre-launch Rights Protection Mechanism:

The experience gained thus far suggests that preventive IP protection mechanisms should satisfy (at least) the following requirements:

- *Protection mechanisms should be effective in order to prevent new gTLDs from turning into cybersquatting havens, which would not only damage the interests of IP owners, but also the reputation and credibility of the gTLDs in question;*
- *Protection mechanisms should be designed in a way that minimizes the potential for abuse. The more a mechanism is open to abuse, the less credibility and legitimacy it will have, and the less it can serve its purpose;*
- *Protection should be balanced and take account of rights and interests of third parties wherever this is reasonably feasible;*

The protection mechanism should be practicable and not overly complex, and should not cause undue delays in the introduction or functioning of the gTLD as a whole. **(Source: http://www.wipo.int/amc/en/domains/reports/newgtld-ip/index.html).**

What might be the ingredients of a programme to protect the rights of others?

We have listed below just some of the ingredients that registry operators have mixed together in previous gTLD launches to protect the rights of others. These ingredients are set out in alphabetical order, like most glossaries.

Accreditation of Registrars
ICANN mandates that gTLDs can only be sold via an ICANN Accredited Registrar. Each ICANN Accredited Registrar can decide whether or not to participate in a gTLD registry operator's RPM. Not all Accredited Registrars choose to sell all gTLDs, especially if the gTLD is Sponsored (focused on a tight community with a small pool of potential registrants).

Amendments
If the Validation Agent finds a simple error in an application that does not materially affect its validity such as a typographical error or the transposition of the numbers in a date, it may invite the applicant to make an Amendment.

Challenge Mechanisms
A process allowing third parties especially the owners of legal rights that match a domain name to challenge the registration. Examples of Challenge Processes include the .biz STOP (Start Up Trade mark Opposition Policy) or the .asia Sunrise Registration Challenge Policy.

Character String Requirements
Registry operators define the character strings that can be filed as a domain name. Generally an exact match is required between a trade mark and the domain applied for. However, this is not always possible. For example, spaces, punctuation and special characters such as ampersands (&) could be either be omitted, replaced with hyphens or spelt out in full so A+B can be used to apply for AandB.domain or AplusB.domain but not AB.domain. The allowable characters in a gTLD registration are currently the Ascii character set (0 – 9, A- Z and the dash or hyphen), usually with a minimum of two or three characters and a maximum of 63. This will vary when full IDN registration becomes available.

Charter Enforcement
The actions taken by the operators of a Community or Sponsored Registry to ensure that registrants remain members of the sponsoring community or adhere to other requirements of registration such as an obligation to enable any website under a .mobi registration so it can be accessed on a mobile device e.g. no frames. Charter compliance can be via spot checks or a requirement to resubmit an eligibility declaration on an annual basis. Third parties with an interest in a domain value the ability to mount a challenge on a registrant who is in breach of a charter through a formal Challenge Process.

Community IDs
Members of a specific community targeted by a Sponsored registry pre-register their interest in a domain for example by providing details of their membership of a professional association. In return, they receive an ID that must be supplied when they register. The ID may be checked annually. This mechanism eliminates infringement almost entirely.

Community or Sponsored gTLDs

Community or Sponsored gTLDs are extensions that serve a special interest group that is defined by the registry operator. If the special interest group is defined widely – such as anyone in Asia for .asia – the risk of an abuse of the rights of others is greater than when the special interest group is narrowly defined such as with .museum where the International Council of Museums produced a tight definition of eligibility.

DRS (Dispute Resolution Schemes): the UDRP and the CEDRP

DRS schemes assist rights owners to settle disputes between registrants and third party owners of trade mark rights. The best known is the UDRP (Uniform Dispute Resolution Policy), which is mandatory for gTLD operators. The UDRP is a curative measure for tackling bad faith registration. A CEDRP (Charter Eligibility Dispute Resolution Procedure) operated by seven sponsored gTLDs provides a mechanism for challenging a domain name registration on the grounds that the registrant does not meet the eligibility requirements of the TLD charter.

Eligibility Cut Off Dates

Registry operators select a date such as the day before the Eligibility Rules of the Registry are published – for example 20 May 2006. This date then becomes the Eligibility Date for Sunrise applicants who can apply with a trade mark that was registered up to 19 May 2006. To ensure that organisations with a pending trade mark application are included, some registries prefer a Cut Off date just before the launch of the Sunrise. Other registry operators prefer an early date to stop exploiters obtaining expedited trade marks for generic terms.

IP Claims Service

IP Claims Service permits a registrant to submit an Intellectual Property Claim ("IP Claim"), based on asserted Legal Rights.

Landrush

When the registry opens to the public for the first time. There is often a stampede in the Landrush to register popular generic terms.

Name Allocation systems

Sunrise schemes may feature a First Come First Served system in which the first person to apply for a term gets it while others may treat all applications during the Sunrise as having arrived at the same time, in which case competing applicants for the same term face an auction or another random selection process. However, it should be noted that when NeuLevel tried an innovative randomised selection process for .biz, it faced court challenges in the USA for running an illegal lottery.

Name String Notification / Watch Schemes

A Name-String Notification is a paid subscription service where the owner of a Legal Right is notified by a registry of an application to register a new domain name which includes the monitored name-string. It is similar to trade mark watching services.

Open Registration

When the registry is open to all eligible applicants after any Sunrise or Landrush schemes have closed.

Open or Unsponsored gTLDs

Open gTLDs are available for anyone anywhere in the world to register. It is not necessary to be a member of a community and there are no requirements on how the name is used.

Pre-Validation
A service supplied by a Validation Agent to trade mark owners who wish to apply under a Sunrise scheme or to registrars managing Sunrise applications whereby the Validation Agent scrutinises a draft application and then informs the applicant or registrar what needs to be done to ensure that the application is eligible. First tried under .asia, it is credited with improving the success rate amongst eligible Sunrise applicants.

Premium Name Schemes
Premium Names are generic words and phrases which are held back from the Sunrise to be allocated via an auction or an RFP process during which the applicant has to outline how the name will be used for the benefit of the community the registry serves.

Reconsiderations
If the Validation Agent rejects an application, the applicant may apply for a Reconsideration, usually with the provision of further information. Reconsiderations do not work in a First Come First Served selection system when there has been more than one application for a term because the second in line naturally expects to be validated if the first in line is rejected.

Sunrise Schemes
A process in which owners of legal rights have the opportunity to register domain names before the Landrush process opens to the public. Limited Industry Sunrise schemes are for current members of a defined group who can demonstrate this membership for example through a membership number or certificate.

Usage Requirements
A requirement to provide Demonstrable Usage of a registered trade mark that is the basis of an application is one way of filtering out registrants who file trade marks for common or generic terms specifically to enable them to apply for the corresponding domain name in the Sunrise.

Validation or Verification
The act of checking the eligibility of the Legal Right that is the basis of an application usually through an examination of a registered trade mark right. Since EURid, the operator of the .eu ccTLD retained an outsource provider to undertake a validation of all Sunrise applications, all other gTLD launches have used an outsource provider. The Validation Agent will check details of claimed rights (e.g. trade mark registration details at national trade mark office online databases) and may require applicants to submit documentation in support of a claimed right such as a Certified Copy of a trade mark registration certificate.

Whois
Although the provision of a Whois service POST-LAUNCH is mandatory upon gTLD registries, there are several PRE-LAUNCH options including:

- A Sunrise Whois that features every applicant for a term ranked in priority order of application
- The provision of a Whois service only after the Sunrise is completed
- An Auction Whois which is open only to the competing applicants for a single term
- A Whois service that only allows you to view your own records to ensure that there are no administrative typographical errors in the submission of your application.

An overview of the Rights Protection Mechanisms used in five gTLDS

The summaries of the RPM employed by five gTLD operators set out below are designed to illustrate how a rights protection programme is built up, measure by measure. We have covered the following five registries which offered a broad variety of measures:

.aero
A sponsored gTLD for the aviation industry which apparently managed to eliminate infringement through strict charter requirements and enforcement.

.asia
The most recently launched sponsored gTLD. The Sponsored Community was broad enough to permit participation by any trade mark owner that identified a local contact within the .asia region. DotAsia Organisation devised several innovative mechanisms including the Pre-Validation of applications, as well as an Amendment and Reconsideration process. Most notably .asia turned away from First Come First Served in favour of auctions between competing eligible applicants.

.biz
An unsponsored gTLD with an innovative but complex pre-launch RPM that led to legal challenges and delays.

.mobi
The first gTLD to outsource the validation of applications and to introduce the concept of selling Premium Names.

.museum
A sponsored gTLD with a complex application process and originally some controls over naming conventions.

.AERO

TLD	.AERO
Operator	SITA (Societe Internationale de Telecommunications Aeronautique), a co-operative owned and managed by the Air Transport community. It manages .aero "for the benefit of the aviation community on a not-for-profit basis".
Type of TLD	Sponsored. It is reserved exclusively for the aviation community.
Dates	Start Up Phase 18 March – 2 September 2002.
Community	It is reserved exclusively for 19 groups of "people, entities and government agencies which: (1) provide for and support the efficient, safe, and secure transport of people and cargo by air; and (2) facilitate or perform the necessary transactions to transport people and cargo by air." .Aero is managed through the Dot Aero Council (DAC) which features representatives of specific aviation groupings including airports, air navigation service providers, air freight companies, airlines, civil aviation authorities, business aircraft operators and aviation industry associations.
Rights Protection Mechanism & Eligibility	No Sunrise but all registrants must have either a right to the commercial name applied for, or they must be registered with a recognized government or industry authority. This meant trade mark owners and common law rights owners were eligible. During Land Rush phase, SITA required applicants to specify one of six types of domain they were applying for: ● Industry Code (domains intended to be used exclusively in a structured format, as in xx.aero, where "xx" is the IATA 2-character airline designator). ● Registered Entity (domains intended to be used for brand visibility and allocated in a form consistent with an entity's name, e.g. company.aero). ● Trade mark (domains allocated to trade mark holders in a format consistent with the registered trade mark, as in trade mark.aero). ● Allocated Sub Domain (reserved to specific Registrant Groups at second level, as in charleslindbergh.pilot.aero). ● Special Industry Name (allocated by SITA on receipt of a proposal). ● Unregulated Name (without restrictions other than "anything.aero," to begin after start-up).
Length of Sunrise	N/A but Start up phase lasted 24 weeks.
Term of registration	Two years initially.
Charter requirements	An Aviation Community Membership ("ACM") ID required to show membership of the defined aviation community.

Submission Process

First come, first served for owners of ACM IDs.

A name can be revoked by SITA if registrant changes name.

When .aero first launched, a two step process applied. First, the applicant was required to obtain an ACM ID. Once issued, the applicant could then apply for registration of .aero domain names through an Accredited Registrar. SITA have now consolidated the process so an applicant can apply simultaneously for both the ACM ID and the desired .aero domain name.

Applications could be made either via a .aero partner association which would validate eligibility or direct to .aero registry via an Accredited Registrar.

Applications direct to the registry must feature:
- Details of the applicant
- The Registrant Group to which the applicant belongs
- A warranty that the applicant meets the eligibility requirements
- Relevant supporting credentials that depend on the Registrant Group category chosen such as an air operating certificate for an airline, a license for an air navigation
- Services provider, a website for aviation media, or an explanatory letter for a recreational user.

Policies

Trade marks and common law rights allowed if applicant is eligible.

IDNs: Not possible.

Device Marks: Domain name must be identical to the word component of the trade mark if application based on a trade mark.

Special Industry Names, such as generics like "hotels" or "news" reserved and only allocated if the registrant convinces the DAC that its use of the name will benefit the aviation community.

Transfers of names prohibited for two years following registration.

Character strings

.Aero registrations must:
- Be at least 3 characters and no more than 63 characters long (except Airline codes) e.g. XXX.AERO or MYNAME.AERO
- Be at least 2 characters and no more than 63 characters long
- Not contain a hyphen on the 3rd and 4th position e.g. XX--AA.AERO
- Contain only letters (a-z), numbers (0-9) and hyphens, or a combination of these
- Start and end with an alphanumeric character, not a hyphen.

Certain types of term are reserved including:
- Airport codes: all location identifier codes reserved for airport operators only.
- Airline codes: all 2-character airline designators are reserved for airlines only.
- Flight numbers: Only available for registration by airlines and airports.
- Route Codes: Only available for registration by airports.

Authentication

SITA screens every application for an Aviation Community Membership ("ACM") ID. Spot checks are undertaken by SITA to ensure continuing eligibility.

Amendments & Reconsiderations	Not possible.
Supporting information	Not required but submitting registrars were required to check.
Challenge Mechanism	Eligibility Reconsideration Policy ("ERP") prospective registrants denied Aviation Community Membership ("ACM") ID or deemed ineligible to register a particular domain name; A third party with concerns about the eligibility of a registrant, may file a complaint under the Charter Eligibility Dispute Resolution Policy ("CEDRP") managed by WIPO.
Sunrise Whois	N/A
Disputes	All registrants agree to be bound by the UDRP. The UDRP applies to challenges to registered domain names based on the grounds that: (i) a domain name is identical or confusingly similar to a trade mark in which the complainant has rights; and (ii) the registrant has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and used in bad faith
Novel Features	Requiring all applicants to obtain an Aviation Community Membership ("ACM") ID before applying together with strict Charter Compliance deters infringers.
Official fees	$30 per name per year.
Some statistics	Start Up volume: 2,561 domain name registrations. Only one dispute during the Start up phase; no UDRP cases.
URLs	*.aero policy:* www.nic.aero/policy/aerodmp.htm *ERP Rules:* www.information.aero/registration/policies/erp_rules *CEDRP Rules:* www.information.aero/registration/policies/cedrp_rules

.ASIA

TLD	.ASIA
Operator	DotAsia Organisation Ltd.
Type of TLD	Sponsored gTLD.
Community	"Legal entities within the Pan Asia and Asia-Pacific region defined by ICANN" meaning 73 countries from Turkey to New Zealand.
Rights Protection Mechanism & Eligibility	Sunrise with three phases, with sub-divisions: ● Phase SR1 for governments in the .asia region. ● Phase SR2a for owners of current registered trade marks applied for on or before 16 March 2004 in any jurisdiction. ● Phase SR2b for owners of current registered trade marks applied on or before 6 December 2006 in any jurisdiction. ● Phase SR2c for Extended Protection featuring the name of the trade mark and a term from the trade mark class. ● Phase SR3 for registered company names in Asia region incorporated on or before 6 December 2006.
Dates	SR1 & SR2a: 9 October 2007 to 30 October 2007. SR2b, 2c & 3: 13 November 2007 to 15 January 2008 (extended). Landrush: 20 February – 12 March 2008 (extended). Go Live: 26 March 2008.
Length of Sunrise	Phase 2a: 3 weeks; Phases SR2b, SR2c and SR3 8 -10 weeks concurrently.
Term of Registration:	Sunrise: Two years minimum. Open registration: One year minimum, ten year maximum.
Charter requirements	Each applicant supplied a Charter Eligibility Declaration Contact (CED) required to be a "legal entity" in the defined .asia region. The CED featured on the record of registration as either the Registrant, the Administrative or the Technical Contact.
Submission Process	Via .asia Accredited Registrars. All applications under each Sunrise phase deemed to have arrived at the same time (not First Past the Post). Electronic auctions held between eligible competing applicants for the same term. English auction format selected with highest bidder winning. Pool.com selected to run auctions on outsource basis.

Policies	Key term: Exact match required between trade mark and domain applied for in all phases other than SR2c Extended Protection phase whereby application must incorporate both the key trade mark (in entirety) and "significant words from the titles, subtitles and descriptions of their respective classes in the Nice Classification System".
	Licensees & Transferees: Allowed with submission of Declaration made on template form.
	Usage: The applicant must have Demonstrable Usage of the Registered Mark in the class for which the mark is registered under Phase SR2a.
	IDNs: Not allowed.
	Device Marks: The domain name applied for must match the entire text or word in the device. A partial match was not allowed. The text or word must be clearly separated from the device element.
	There are special restrictions on using the term ASIA in a domain.
Character strings	Spaces, punctuation and special characters (such as "&" or "+") not allowed in the domain name system may be omitted or replaced by hyphens;
	Punctuation and special characters may be spelled out in full using LDH (LetterDigitHyphen) characters so A+B can be used to apply for AandB.asia and AplusB.asia;
	Accented characters may be replaced by "Base characters" without the accent – so "ä" becomes "a" – it cannot become "ae";
	Identifiers such as LTD, PTE, Inc, SA or ® can be omitted; Only Ascii characters will be allowed (0-9 and a-z plus the hyphen).
Authentication	All applications validated by third party Verification Agent, namely Deloitte.
Amendments & Reconsiderations	Verification Agent could request an Amendment Clarification from applicant to correct a typographical mistake. No additional fee charged.
	Applicant could apply for a Reconsideration within seven days of a rejection on the basis of the original application or with the provision of further information.
Supporting information	Proof of eligibility such as Certified Copy of trade mark certificate could be requested by Verification Agent. Certified translations of such documents into English could also be requested.
Challenge Mechanism	Sunrise Registration Challenge Policy administered by Hong Kong International Arbitration Service mandatory on Sunrise applicants in breach of Eligibility Requirements outlined above. Cost US$500.
	During .asia auctions, an invited bidder who disputed the entitlement of a competing bidder must notify the Registry and initiate a dispute prior to the commencement of the auction "in a competent tribunal".
	WIPO administer Challenge Process for Pioneer Names.

Sunrise Whois

Not provided though applicants could check the details of their own applications through a web interface accessible to their registrars.

During Sunrise auctions, all bidders could review the details of other bidders. This was not possible during Landrush auctions.

Disputes

Charter Eligibility Dispute Resolution Policy (CEDRP) for disputes over an applicant's right to register a .asia domain based on a nexus with the .asia region. Names could be cancelled All registrants agree to be bound by the UDRP. The UDRP applies to challenges to registered domain names based on the grounds that:

    (i)   a domain name is identical or confusingly similar to a trade mark in which the complainant has rights; and

    (ii) the registrant has no rights or legitimate interests in respect of the domain name; and

    (iii) the domain name has been registered and used in bad faith.

Dispute provider: Hong Kong International Arbitration Centre.

Novel Features

Selecting auctions between competing applicants rather than First Come First Served.

Pre-Validation offered by Validation agent to registrars and applicants whereby draft applications were scrutinized to ensure eligibility prior to submission. Pre-validated applications were assigned a code which permitted instant approval following submission to the registry.

Pioneer Programme allocated desirable names to applicants who competed via the provision of Business Plans stating why they deserved a term. Applications accompanied by deposit of, e.g. $10,000 returned to winning applicants when they showed receipts for marketing to the value of $10,000. Applications categorized into: Celebrity Pioneers, Social Pioneers, Community Pioneers, Global Brand Pioneers and Partner Pioneers.

Official fees

Sunrise application fee: $70.

Annual registration fee: $20.

Pre-Validation: $50.

Some statistics

- Sunrise applications (all phases): 32,205 applications with 90% success rate, in part due to Amendment and Reconsideration process
- Landrush opened with 263,663 applications on first day, 35% from Asia, 40% from USA and 24% from Europe.
- Landrush closed with 473,633 applications.
- 45,000 auctions for names applied for more than once during the Landrush

URLs

Organisers: www.dotasia.org
Sunrise Challenge Policy: www.hkiac.org/odr/DotAsia/policy.html
CEDRP: www.icann.org/udrp/cedrp-policy.html
Pioneers: pioneer.domains.asia
Links to all policies: www.dotasia.org/policies.html

.BIZ

TLD	.BIZ
Operator	NeuLevel Inc.
Type of TLD	Unsponsored.
Dates	.biz Start Up: 25 June – 21 September 2001.
	IP Claims: 21 May – 6 August 2001.
	Landrush: 25 May – 25 September 2001.
	STOP complaints: Round One from 24 November - 14 December 2001; Round Two from 8 April - 28 April 2002.
Community	Designed for "bona fide business use".
Rights Protection Mechanism & Eligibility	IP Claim Service & STOP.

IP Claim Service, as described by WIPO:
"Any trade mark owner could register an IP Claim to assert trade mark rights for an alphanumeric string that was identical to a trade mark. Multiple IP Claims could be filed for the same alphanumeric string.

If, during the start-up phase, an application was filed for a domain name that was subject to an IP Claim, NeuLevel contacted the applicant, provided details of all IP Claims filed for this domain name (including contact details of the IP Claimants, as well as the trade mark data provided) and requested the applicant to confirm its intention to register the domain name.

If the applicant proceeded to register the domain name in spite of the IP Claims, NeuLevel notified the concerned IP Claimants of the contact details of the domain name registrant. If more than one IP Claim had been filed with regard to the disputed domain name, NeuLevel established a priority order among these claims, on a randomised basis.

The priority Claimant was then given the opportunity to initiate a STOP proceeding. If the priority Claimant did not file its complaint within a period of 20 days, NeuLevel notified the next Claimant in the priority order of its right to file a STOP complaint.

Domain names that were subject to IP Claims could not be used for 30 days after the live date of .biz start-up domain names. Following the 30-day period, the domain name resolved but could not be transferred until all pending IP Claims had been dealt with.

In essence, the IP Claim service therefore provided what might be called an automated "watch service" for trade mark owners who, in order to qualify for obtaining the corresponding domain name, still had to submit a domain name application against a separate fee".

STOP – Start Up Trade Mark Opposition Policy as described by WIPO:
"Very similar to the UDRP, STOP carried a lower burden of proof. Unlike the UDRP where a Claimant must demonstrate that a domain name registrant **both** registered a domain name in bad faith **and** used the domain name in bad faith, STOP allows a Claimant to prevail where he or she demonstrates that a domain name was **either** registered in bad faith **or** used in bad faith".

Applications were welcomed from registered rights owners, common law rights owners and those who had applied for but not yet been granted a registration.

Length of Sunrise 12 week Start Up Phase but STOP Complaints still being processed 10 months after launch.

Term of registration Initially two years; thereafter one year.

Charter requirements .biz was unsponsored so no charter.

Submission Process Via .biz Accredited Registrars.

Not First Come First Served: Domains allocated on a randomised basis. Due to challenges in Superior Court of Los Angeles and elsewhere to the .biz domain name allocation method during start-up, which was alleged to be an illegal lottery, NeuLevel postponed the Go Live date for domain names for which more than one domain name application had been filed and which had therefore been allocated on a randomised basis. The case settled in January 2003.
When submitting an IP claim, applicant required to show:
- The name applied for was identical to a trade mark
- A description of the goods and services for which the trade mark was being used
- The date of first use of the mark in commerce
- For all registered marks, the country and registration number

Policies STOP – Start UP Trade Mark Opposition Policy.

STOP was for pre-registration disputes. Only trade mark owners who filed an IP Claim could file under STOP which ran for the 12 weeks of the official Start-up period. STOP challenges featured:
- Claims based on trade marks identical to a domain name registered during the Start-up period
- Onus on challenger to prove registration or use of the domain name in bad faith
- Single member panels only
- Only remedy: transfer
- No preclusion of subsequent claims under UDRP and RDRP against the same domain name

Licensees & Transferees: Trade mark owners and beneficiaries could apply under STOP.

Usage: Date of first use in commerce required but no further proof.

IDNs: Not allowed.

Device Marks: Not allowed.

Character strings	Minimum length 3 characters; maximum length 63 characters.
	Only Ascii characters allowed (0-9 and a-z plus the hyphen).
	Spaces, punctuation and special characters (such as "&" or "+") not allowed.
Authentication	"The .biz registry will not verify whether a trade mark claimed on an IP Claim Form corresponds with an actual, legal or valid trade mark".
Amendments & Reconsiderations	Not possible.
Supporting information	Not required.
Challenge Mechanism	All registrants bound by Restrictions Dispute Resolution Policy (RDRP). "This policy may be invoked by a third party in order to resolve a dispute with a Registrant over the registration or use of the Registrant's domain name in violation of the .BIZ domain name registration restrictions. Such a violation would include complaints that the domain name is not being, or will not be, used primarily for a bona fide business or commercial purpose"
Sunrise Whois	Not required because of the IP Claims Service.
Disputes	All registrants agree to be bound by the UDRP. The UDRP applies to challenges to registered domain names based on the grounds that:

    (i)   a domain name is identical or confusingly similar to a trade mark in which the complainant has rights; and

    (ii) the registrant has no rights or legitimate interests in respect of the domain name; and

    (iii) the domain name has been registered and used in bad faith

Novel Features	IP Claims & STOP, both novel features, were evaluated by WIPO as follows: "NeuLevel developed the IP Claim service and STOP in an effort to protect trade mark owners against the abusive registration of their trade marks during the introduction of the .biz TLD. The system thus established was relatively complex and required IT-based interaction between dispute resolution providers, registry operator and IP Claimants at various stages of the process. In addition, the system was relatively costly for trade mark owners, who not only had to pay the fees for filing a STOP complaint, but had to incur the additional expenses of participating in the IP Claim service. By purchasing an IP Claim trade mark owners did not necessarily acquire the right to initiate a STOP complaint, because in cases of multiple IP Claims the challenge priority was determined on a randomized basis; nor was success guaranteed in a STOP proceeding because of the difficulties of proving bad faith in a start-up setting."
	.biz encouraged applications from those with common law rights and newer companies that had filed but not received a trade mark registration.

Official fees	IP Claim: $90 plus $2 administration fee.
	STOP: $100.
	During Start Up phase: $25 per year.
	Annual registration fee: $15 per year.
Some statistics	2,401,609 applications for 280,000 terms received in the Landrush. 1,278,498 matched IP Claims.
	80,000 IP Claims filed. This led to 198,000 attempts by third parties to apply for trade mark terms being abandoned.
	Of 338 STOP complaints, 107 (31.66%) decided in favor of the Complainant, 159 (47.04%) denied and 71 (21.00%) terminated. One case suspended (0.30%) pending the outcome of a court action relating to the disputed domain name.
URLs	*Organisers:* www.neulevel.biz
	IP Claims: www.neulevel.biz/ardp/docs/ipclaims_service.pdf:
	STOP: www.neulevel.biz/stop_overview/index.html
	FAQ: www.neulevel.biz/faqs/drp_qa.html#1

.MOBI

TLD	.MOBI
Operator	MTLD Top Level Domain Ltd.
Type of TLD	Sponsored gTLD.
Dates	Limited Industry Sunrise: 22 – 29 May 2006.
	Trade Mark Sunrise: 12 June - 21 August 2006.
	Landrush: 28 August - 14 September 2006.
	Open Registration: 15 September 2006.
Community	Mobile content providers and users community.
	.MOBI is owned by a consortium featuring Ericsson, Google, GSM Association, Hutchison, Microsoft, Nokia, Orascom Telecom, Samsung Electronics, Syniverse, T-Mobile, Telefónica Móviles, TIM and Vodafone.
Rights Protection Mechanism & Eligibility	Sunrise with two phases.
	Limited Industry Sunrise for fully paid members in good standing of organisations such as the Cellular Telecommunications & Internet Association (CTIA), The Canadian Wireless Telecommunications Association (CWTA), GSM Association (GSMA), Mobile Entertainment Forum (MEF) and Mobile Marketing Association (MMA).
	General Trade mark Sunrise for owners of trade marks of national effect, applied for prior to 11 July 2005 and granted before the date of the domain name application. Applicants had to pre-register intention to apply with .mobi prior to 11 May 2006.
	Registry reserved right to cancel registration for non-compliance with Charter.
	Landrush after Sunrise "when desirable .mobi names can be registered at premium prices".
Length of Sunrise	Limited Industry Sunrise for one week.
	General Trade mark sunrise for 10 weeks.
	Landrush for two weeks.
	Names registered under the .mobi Sunrise locked and could not be modified, transferred or deleted until the Sunrise Challenge Period ended on 15 December 2006
Term of registration	Initially two years; thereafter one year.

Charter requirements	All registrants must ensure that any web site under a .mobi is accessible to users of mobile devices (e.g. via XHTMLMP, without frames). Instructions and polices set out in "dotMobi Switch On Guide for Web Development". Non-compliance could result in cancellation of the domain after three warnings. Random checking undertaken by registry.
Submission Process	Via .mobi Accredited Registrars. First Come First Served. Registrars required to submit: • Trade mark name • Applicant name • Trade mark registration number • Date of trade mark application • Date of granting of trade mark • Country of trade mark registration
Policies	Key term: Exact match required between trade mark and "the complete term applied for". Licensees & Transferees: Not allowed. Usage: Not required. IDNs: Not allowed. Device Marks: "A .mobi domain name must be identical to the textual or word elements of the mark".
Character strings	Minimum length 3 characters; maximum length 63 characters. Only Ascii characters allowed (0-9 and a-z plus the hyphen). Spaces, punctuation and special characters (such as "&" or "+") not allowed in the domain name system may be omitted or "transcribed in a conventionally accepted way". Domains cannot begin or end with hyphens.
Authentication	Most applications validated by third party Verification Agent, namely PWC after random selection.
Amendments & Reconsiderations	Not possible.
Supporting information	Proof of eligibility such as Certified Copy of trade mark certificate could be requested by Verification Agent.

Challenge Mechanism   Sunrise Challenge Process designed and administered by WIPO open from
28 August - 15 December 2006. Challenges accepted if:

- At the time of the Respondent's registration of the Domain Name, no current (non-expired) trade mark or service mark registration was registered in the Respondent's name:
- The Domain Name was not identical to the textual or word elements of the trade mark or service mark registration on which the registration of the Respondent's Domain Name was based;
- The trade mark or service mark registration on which the registration of the Respondent's Domain Name was based was not of national effect;
- The trade mark or service mark on which the registration of the Respondent's Domain Name was based was not registered or applied for prior to July 11, 2005, with the trade mark authority with which the mark is registered.

The three possible outcomes of a Sunrise challenge were:

- Original registrant proves his/her right to the domain. In this case the registrant kept the domain and it was unlocked for his/her use.
- Original registrant was not eligible or did not respond and the challenger proved his/her right to the domain. In this case WIPO awarded the domain to the complainant.
- Neither the original registrant nor the complainant proved rights to the domain. In this case WIPO ordered that the domain is cancelled. The registry deleted the domain and it became available at a later date.

The cost of filing a Sunrise Challenge was $750.

Sunrise Whois   Sunrise whois provided information on:
- Applicant
- Domain name
- Trade mark name
- Trade mark country
- Trade mark number
- Date trade mark applied For
- Date trade mark registered

Disputes   All registrants agree to be bound by the UDRP. The UDRP applies to challenges to registered domain names based on the grounds that:

(i)   a domain name is identical or confusingly similar to a trade mark in which the complainant has rights; and

(ii) the registrant has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and used in bad faith.

Novel Features   Mtld Ltd reserved 5,500 "premium names" for distribution using "non-traditional allocation models". Premium Names were commonly used or generic words and phrases allocated via publicised auctions and Request for Proposals (RFP) processes where applicants made a case for a name based on the benefits to mobile users.

WIPO administered a Premium Name Application Process for Trade Mark Holders from 15 September - 13 October 2006 as some Premium Names were also trade marks.

The first auction of 100 names administered by Sedo raised $850,000 on 26 September 2007.

Official fees

Sunrise application: $100 per year, two year minimum.

Landrush: $30 with two year minimum.

Open registration: $15 per year (though discounted since).

Some statistics

Volumes of registration during Sunrise:
Limited Industry: 1,706
General Sunrise: 13,081
Total – 14,787

Sunrise Challenges: 18 in total of which 9 were successful; 2 were cancelled; 7 were terminated.

URLs

Organisers: **mtld.mobi/**

Sunrise Challenge Policy & Process:
pc.mtld.mobi/documents/dotmobi-Sunrise-Challenge-Rules.pdf

SwitchOn Guide: **pc.mtld.mobi/documents/dotmobi-Switch-On!-Web-Browsing-Guide.html**

Premium names: **mtld.mobi/domain/premium/auction**

.MUSEUM

TLD	.MUSEUM
Operator	Museum Domain Management Association (MuseDoma).
Type of TLD	Sponsored.
Dates	Phase 0: Naming Convention Development and Demonstration Period : 30 June 2001 - 1 April 2002. Phase 1: Formal start-up period 1 April 2002 – 31 December 31 2002.
Community	The international museum community: "Registrations shall be granted only to entities that are museums, professional associations of museums, or individuals who are professional museum workers."
Rights Protection Mechanism & Eligibility	Every registrant is required to obtain a Community ID before registering a .museum domain name. The basis for eligibility to register in .museum is judged by the International Council of Museums (ICOM) definition of museum and is restricted to genuine museums, museum associations and individual members of the museum profession. Applicants for a .museum domain name must apply first to its Eligibility and Name Selection (ENS) Service for a Community ID before seeking to register a domain. The Community ID signifies that the registrant qualifies as a "museum" under the .museum Charter. To receive an ID, applicants that are members of a professional museum association provide their membership number. Applicants that are not members are asked to provide detailed information about the nature and scope of their museum activities.
Length of Sunrise	No sunrise.
Term of registration	Two years initially.
Charter requirements	The original definition of a "museum," from the Statutes of the International Council of Museums (ICOM), provides that "a museum is a non-profit making, permanent institution in the service of society and of its development, and open to the public, which acquires, conserves, researches, communicates and exhibits, for purposes of study, education and enjoyment, material evidence of people and their environment." However, MuseDoma has since interpreted the definition of "museum" flexibly to permit "virtual museums" to qualify for registration.
Submission Process	First come first served if you have a Community ID. Applicants must first apply to the Eligibility and Name Selection (ENS) Service for a "Community ID" before seeking to register a .museum name. To obtain a Community ID, applicants can submit a membership number of ICOM (International Council of Museums) or another professional museum organisation or detailed info regarding the nature/scope of museum activities. Applicant has one year to satisfy MuseDoma that it qualifies. At the end of one year, MuseDoma

will ask applicant to address outstanding issues or will refer the matter to ICOM or an independent expert panel.

Policies

The .museum TLD does not offer protective registrations for trade mark holders. However, only bona fide members of the Museum community can obtain .museum domains and Musedoma forbids the commercial exploitation of .museum domains: " Registering a domain name solely for the purposes of selling, trading or leasing the domain name for compensation; or the unsolicited offering to sell, trade or lease the domain name for compensation; or permitting the domain name to be used on any terms whatsoever by any organization, institution or individual other than the one to which it is registered, shall not constitute genuine museum use of that domain name even if one or more parties in any of these cases is a genuine museum".

The eligibility requirements state that:
- "No entity will be permitted to register the name of any other entity at its own initiative."
- "Every name registered in .museum must be clearly and recognisably derived from the name by which the entity to which it is assigned is otherwise widely known."
- Individual members of the museum profession can only register personal domains "in a suitably labeled second-level domain," such as "firstname.secondname.conservator.museum" or "name.curator.museum."
- A ".museum name must specifically designate the entity to which it is assigned. A name containing only two labels may not contain a generic term or a location designation as the second-level label". As a result, each registration must correspond to the name of the registering entity. This eliminates third party registration on behalf of a museum.
- Initially, generic terms and geographic identifiers, could not be registered without additional descriptive terms. They were reserved for shared use. This has now been relaxed to allow registration at the second level in some circumstances.

Character strings

See policies above: Eligible applicants may only register a name that is "clearly and recognisably derived from the name by which the entity to which it is assigned is otherwise widely known" and that "specifically designates the entity to which it is assigned".

IDN registration now possible in 24 scripts. Further scripts to be added.

Minimum 3 characters; maximum 63.

Generic terms originally available for shared use at the third level. Names in the form city.museum are reserved for inclusion in three-label names in the form yourname.city.museum.

Individual members of the museum profession may register personal domains in a suitably labeled second-level domain. This would allow for a construct resembling somefirstname.somelastname.professional.museum. Second-level designations such as conservator.museum and curator.museum are also acceptable.

Authentication

If MuseDoma cannot confirm eligibility of an applicant, it will refer the case to either ICOM or an independent expert panel for review. At ICOM, the question is referred to the Secretary General, who is on a subcommittee designated by the Executive Council for addressing such issues.

MuseDoma monitors the continuing eligibility of registrants through random checking to determine whether a museum is using its .museum name in accordance with the initial determination of eligibility.

Amendments & Reconsiderations Not possible.

Supporting information Applicants can send in supporting information to support a request for an ENS Community ID.

Challenge Mechanism All registrants agree to be bound by the Charter Eligibility Dispute Resolution Policy ("CEDRP"). The CEDRP applies to challenges filed by a third party to registered .museum domain names on the grounds that the registrant does not meet the .museum eligibility requirements.

Sunrise Whois Not applicable as no Sunrise.

Disputes All registrants agree to be bound by the UDRP. The UDRP applies to challenges to registered domain names based on the grounds that:
  - (i) a domain name is identical or confusingly similar to a trade mark in which the complainant has rights; and
  - (ii) the registrant has no rights or legitimate interests in respect of the domain name; and
  - (iii) the domain name has been registered and used in bad faith

Novel Features The .museum "index" of nearly 700 registrants at the second level which acts as a directory for finding categories of museums in a particular location under which a local museum can register at the third level. The requirement to register at the third level was removed when IDNs were introduced.

Official fees $30 per registration per year, two year minimum initially.

ENS originally $100 but can be waived if based on ICOM membership as no verification would be required.

Some statistics Less than 40 cases referred to ICOM for review.

No UDRP proceedings.

URLs *Registry website:* **musedoma.museum**
General information: **about.museum**
Index facility: **about.museum**
Registration forms: **ens.museum**
TLD Sponsorship Agreement: **www.icann.org/tlds/agreements/museum/**

What they think: some reflections on pre-launch RPM from 10 rights owners

Although ICANN's efforts to achieve consensus on what might be termed "Best Practice" in the protection of the rights of others in gTLD launches have failed, there is plenty of opinion on what works well and what has been problematic. Here are the reflections of 10 rights owners who have participated in gTLD pre-launch RPM:

"My ideal Sunrise features:
- First Come First Served for owners and licensees of current registered trade marks
- The validation of all rights
- A Sunrise whois open to everyone so I can see who is registering what
- An amendment process in case of a minor error during application
- A mechanism so we can challenge Sunrise registrations that are fraudulent cheaply and quickly:
  we are good at policing our own marks.
  That's not too much to ask for, is it?"

> *Dieuwerke van der Schalk*, *Global Brand Protection Department, Sara Lee*

"What I don't like is the rush and panic that accompanies Sunrise launches. It is really helpful when the registry operator publishes the Rules and Policies well in advance – I mean at least two months to give me time to consult with all parts of the business, explain the benefits of registration, the eligibility criteria and to get the budget together to apply for the names we want".

> *Helen Asker*, *Trade Mark Attorney, Global Intellectual Property, AstraZeneca*

"Whois availability is vital. The importance of good information on other applicants in a Sunrise is sometimes forgotten but is essential for us. I don't see why any bona fide trade mark owner should worry about having their information published".

> *Guido Baumgartner,* *Director Global Brand Protection, Coty Prestige Lancaster Group GMBH*

"I don't want any more experimentation or complication. Give me a straight up Sunrise, registered trade marks only with expert verification. I don't like attempts to sell me IP Claims or Watch notices. Ideas like that don't add anything but expense in my view. All I need is a priority registration period".

> *Mark Hodgin,* *Senior Intellectual Property Counsel, Cadbury plc*

"My ideal Sunrise does not have First Come First Served. I don't like the pressure to be first in a queue or the need to rush around to several registrars. I prefer it when all applications in a Sunrise are deemed to have arrived at the same time. I am happy to compete with other rights owners in an auction provided I get the chance to verify their eligibility".

> *Jane Collins,* *General Trademark Counsel for Syngenta, Chairman of Marques*

"I don't mind competing against others under a First Come First Served system or in an auction. As long as its fair with the validation of rights and a fast Challenge mechanism. What I'd really like to see though is some better pricing, especially discounts for registering more than 10 domains in a Sunrise".

> *J. Scott Evans,* *Senior Legal Director, Global Brand & Trademark, Yahoo! Inc.*

"I love the registries that strictly enforce both their Charters and their Terms and Conditions of registration. A fast, reasonably priced mechanism for challenging charter abuse is a great comfort".

Simon Bicket, *Director of Finance, Cheapflights Ltd*

"The validation of rights is vital. We can supply documentation in support of an application if we need to though it is not too difficult for a registry to check online at an official trade mark registry. We also think more registries should reserve the right to ask for proof of usage if they have doubts about the validity of an application, especially for a term with a generic meaning".

Frances Harding, *Trade Mark Attorney, EMI Group*

"I am not a fan of the introduction of hundreds of new gTLDs. However, if we must have them, it is vital that the Rights Protection Mechanisms they operate are affordable and well-managed. Applications must be validated with the full details of registrants published. A fast-track challenge process administered by a neutral expert agency for Sunrise or charter infringement is also a good idea".

James Elliott, *Assistant General Counsel, PartyGaming PLC*

"I don't want any new alternatives to .com. If there must be new gTLDs let them be sponsored for a community of interest and let's have an obligation on the registry to throw out anyone who is not part of the sponsoring community. Then we can register if the community is appropriate for us or relax if it is not. It is all about trust. It is important to us that internet users trust a registry to hold authentic information".

Roula Konzotis, *Director of Communications, Royal Institute of British Architects*

Next Steps

The IPC and MARQUES have members who are happy to talk with prospective new gTLD applicants about RPM and any of the information in this booklet. Contact the secretariats of the IPC or MARQUES via:

www.ipconstituency.org *or email* info@ipconstituency.org

www.marques.org *or email* info@marques.org

Key Links

ICANN Evaluation of New gTLDs: Policy & Legal Issues, July 2004:
www.icann.org/tlds/new-gtld-eval-31aug04.pdf"

GNSO Working Group on Protecting the Rights of Others, June 2007:
gnso.icann.org/drafts/GNSO-PRO-WG-final-01Jun07.pdf

World Intellectual Property (WIPO) gTLD resource:
www.wipo.int/amc/en/domains/gtld/index.html

Credits

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Disclaimer

Nick Wood who produced the first draft of this information and acted as editor takes responsibility for errors and omissions and acknowledges all those who worked on earlier reports on this matter. Contact nick.wood@ comlaude.com with comments or questions.

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