



April 29, 2015

Via Electronic Mail

comments-rpm-review-02feb15@icann.org

Re: Rights Protection Mechanism (RPM) Review Draft Report

Google appreciates the opportunity to provide input on the [Rights Protection Mechanism \(RPM\) Review Draft Report](#). Our comments below are aligned with Google's historic positions with respect to the RPMs. See, e.g., [Public Comments of Google Inc. on the Rights Protection Mechanisms](#) (Aug. 27, 2013).

As a preliminary matter, we note that the Draft Report is based on insufficient data, as it largely focuses on metrics from only certain months within the 2013-2014 time period. ICANN should continue to collect and disseminate data from which to draw conclusions about the RPMs, and the review of these RPMs should be based on metrics on an ongoing basis using an iterative process as additional information becomes available. ICANN should also incorporate into its review a broader range of community input based on staff observations, qualitative reports of abuse or gaming, public comments submitted to ICANN, contractual compliance complaints, and transcripts from public ICANN meetings.

With that stated, Google believes that the Trademark Clearinghouse (TMCH) and the Trademark Claims Service have generally been working well to protect participating intellectual property owners from trademark infringement and similar abuses within the new gTLD program. However, the RPMs would be more effective if they were not underutilized from a global perspective. This concern is illustrated by the mere 34,400 marks recorded in the TMCH to date (based on data provided in the Draft Report); contrast this figure with the number of trademarks registered in the United States alone, which number in the millions. In addition, 7,800 complaints were submitted to the TMCH, indicating a proportionately high degree of user difficulty with the submission and verification system.

Thus, we believe that further metrics on user awareness and usability of the TMCH would be a useful starting point to determine the extent of these issues. Following the publication of this data, outreach to rights owners in underserved areas or areas underutilizing the RPMs may be warranted to ensure greater global participation, along with additional considerations surrounding user friendliness vis-a-vis participation, and commensurate improvements to each RPM in scope and efficacy.

Transparent compliance processes are also essential to ensure proper registry implementation of RPMs; indeed, ICANN should go further to enhance oversight over abusive registry practices aimed at taking advantage of the system at the expense of rights owners in violation of the spirit of the RPMs. Specifically, we urge ICANN to take steps to prevent registry operators from engaging in “predatory pricing” against trademarks by charging exorbitant Sunrise fees as high as 10 to 50 times standard pricing, and including famous distinctive trademarks as “premium domains” during general registration. Such practices not only harm rights owners themselves, but the ICANN community and the consuming public by extension. ICANN should engage with the community to address these practices, in furtherance of its mandate to act in the public interest and in order to ensure that the RPMs continue to have a meaningful impact on mitigating abuse.

In addition to these overarching comments, Google provides its specific responses to the questions posed in the Draft Report below.

1. Trademark Clearinghouse

ICANN Question	Google Input
<p>What were the challenges, if any, in terms of satisfying the requirements for trademark inclusion into the Clearinghouse?</p>	<p>Lack of clear communication from the TMCH regarding its processes and requests.</p> <p>For example, when the TMCH requested the “registration date” it was really asking for the date of issuance of the registration certificate (which may or may not be the “registration date” depending on the respective country that issued the registration certificate). As another example, there are times when a TMCH validator will mark a record as “incorrect”; however, there is no corresponding explanation or only a vague explanation of what is required to correct the deficiency.</p>
<p>Were there any challenges related to marks from specific jurisdictions in relation to the Clearinghouse guidelines?</p>	<p>Google’s agent experienced difficulty inputting specifications of services in a foreign language (in particular Arabic and other languages that are written right-to-left). In general, entering any non-English text into the form provided by the TMCH was a challenge, as the text</p>

	<p>needed to be in a format that can be copied and pasted into the appropriate field. Additional challenges experienced were the direct result of challenges with specific jurisdictions and were not necessarily issues caused by the TMCH (e.g. obtaining a copy of the certificate of registration, obtaining a translation of services, etc.).</p>
<p>Was the verification process successful in restricting non-eligible trademarks?</p>	<p>The verification process seems to have been generally successful in restricting non-eligible marks.</p>
<p>What factors could be considered to make the trademark verification process more effective?</p>	<p>Overall, the verification process appears generally effective so far, although communication and learning tools could be improved to assist brand owners and TMCH staff in using this new system with its inherent learning curve on both sides.</p> <p>A number of the TMCH responses Google’s agent received to service requests contained the phrase “our verification agents missed/overlooked ...” Regular training or even direct oversight by an experienced trademark practitioner might reduce such verification errors.</p> <p>One useful training resource might include sample verification forms from all of the jurisdictions the TMCH supports. One option could be to provide in the form, or as a component, of a guidebook, providing clarification as to the relevant information from the respective jurisdictions that the TMCH will need.</p>
<p>What factors could be considered to make the process of updating Clearinghouse records more effective?</p>	<p>In general, Google’s agent found this process reasonably effective.</p>
<p>Did the Clearinghouse structure successfully balance implementation of the services with data misuse concerns?</p>	<p>The TMCH structure has successfully balanced implementation of the services with data misuse concerns. Google believes the TMCH should not implement any search and query functions or</p>

	entertain requests for TMCH data, in consideration of the potential risks of misuse of such data (e.g. gaps in brand protection, social engineering, and phishing).
Do the Clearinghouse benefits outweigh the concerns about distribution of data?	The benefits of the TMCH outweigh data distribution concerns.
Were any issues identified relating to misuse of Clearinghouse data?	Google has not encountered any issues relating to misuse of TMCH data.
Was the proof of use requirement helpful in meeting the goals of a creating a standard that accommodates practices from multiple jurisdictions?	Google agrees that proof of use is an important element in creating an appropriate standard for access to Sunrise services. Such a requirement promotes Sunrise registration by brand owners actively using their marks, and prioritizes such use over registration but non-use by a potentially-competing rights holder. In addition, this safeguard prevents gaming (e.g. where a party obtains a spurious trademark registration in a jurisdiction that does not require trademark use and could thereby obtain a domain name in Sunrise over a legitimate brand owner or use the registration to acquire an otherwise-generic domain during Sunrise). The parameters of the proof of use requirement were sufficiently broad and not burdensome.
What were the challenges, if any, in terms of satisfying the proof of use requirement?	Google's agent experienced very few challenges in satisfying proof-of-use requirements, although detailed explanations from the TMCH could be improved in instances where specimens of use were initially rejected.
Was the proof of use requirement successful in restricting the Sunrise period to Sunrise-eligible rights holders?	The proof of use requirement seems to have sufficiently restricted access to the Sunrise period to eligible rights holders. Any gaming appears to have been minimized. Additional metrics and data on potential gaming of Sunrise services through spurious trademark registrations with "token use" would be useful.

<p>What factors could be considered to make this process more effective?</p>	<p>The TMCH document upload system was not particularly user-friendly. For instance, there was no ability to delete a file prior to submission (if the wrong file was uploaded inadvertently, the process would have to be reinitiated from the beginning). Another possible consideration to streamline the submission and verification process might be the addition of an electronic signature option for the declaration of use.</p>
<p>Should the verification standards in the Clearinghouse Guidelines be adjusted in one or more areas?</p>	<p>Google is generally satisfied with the current verification standards. In particular, Google believes any mark containing word elements, including marks that may also contain or incorporate design or figurative elements, should remain eligible for entry in the TMCH so long as they can reasonably be distilled into just the word mark itself. In addition, Google believes the TMCH should continue to prohibit marks that include a TLD or consist of a TLD (e.g. .ICANN). Additional input regarding matching rules, in particular, is provided below.</p> <p>As applied to registered trademarks, Section 5.3.1 of the TMCH Guidelines should more clearly designate that “Registration Date” means the date the Certificate of Registration was issued, as opposed to the start of the registration term (which in some jurisdictions relates back to the application filing date).</p> <p>The TMCH may also want to reconsider the requirements for verification of a licensee and/or assignee under Sections 5.3.5; 5.4.7; 5.5.8 of the TMCH Guidelines. In most cases, there is already an executed agreement documenting a particular license or assignment, and that document should be sufficient for submission and verification. The requirement to execute a separate</p>

	declaration is potentially unduly burdensome.
Could verification standards used by the Clearinghouse be adjusted to better serve rights holders in all global regions?	The standards themselves are adequate, but greater outreach to global rights holders, particularly in underserved regions or regions shown to have underutilized the Clearinghouse, would be beneficial.
To the extent that gaming is occurring, could this be prevented by modification to the verification standards?	It is unclear whether modifications to the verification standards would prevent gaming without sacrificing proper access to the Clearinghouse.
Should ICANN reconsider the “identical match” definition, specifically, expansion of the matching rules to include plurals, “marks contained” or mark+keyword, and common typos of a mark?	<p>Strictly for purposes of taking advantage of the trademark Claims Service, ICANN should reconsider the “identical match” definition. We would support expansion of the matching rules to include plurals, “marks contained” and mark+keyword, as well as common typographical errors. In addition, Google would support the relaxation of standards in respect of marks containing accents and other similar special characters and would support a definition that considered marks with the special characters and their non-special-character counterparts as equivalents (e.g. èé mark would be treated as identical to ee mark, but ee mark would not be treated as identical to èé mark).</p> <p>Note that such expansion would not replace the registration + proof of use requirement for Sunrise registration.</p>

2. Sunrise Period

ICANN Question	Google Input
How effective is the Sunrise period for protecting intellectual property rights?	The Sunrise period has generally been effective for protecting intellectual property rights, particularly for exact matches of rights owner trademarks. However, as

	<p>noted in the introduction, some registry operators are taking advantage of rights owners during Sunrise by charging exorbitant and extortionate Sunrise registration fees. Although such pricing policies are not strictly within the ICANN compliance mandate, they contravene the spirit of the RPMs, damage ICANN's reputation, harm consumers in contravention of ICANN's mandate to promote the public interest, and create disincentives for rights owners to take advantage of the Sunrise period.</p>
<p>Are the Start-Date Sunrise and End-Date Sunrise alternatives useful?</p>	<p>As the Draft Report indicates, the vast majority of TLDs have offered End-Date Sunrise (293 out of 355, or about 83%). Although Google favors flexibility in Sunrise implementation, it may be more equitable to rights holders for all registries to implement a single uniform 60-day End-Date Sunrise system across all open new gTLDs. In the alternative, any Start-Date Sunrises should also incorporate some form of de-contention mechanism rather than apply a first-come-first-serve process.</p>
<p>What were the challenges, if any, in terms of registering a domain name during the Sunrise period?</p>	<p>Inconsistent methods across registrars for the acceptance of SMD files posed a significant challenge; some registrars allowed brand owners to upload the SMD file (the preferred method of Google's agent), while others required brand owners to copy and paste the contents from the file (this method risked corrupting the file).</p>
<p>What factors can be addressed to make Sunrise processes more effective?</p>	<p>Use of more resilient SMD files that would facilitate uniform upload methodologies, including acceptance of files as an attachment.</p>
<p>Did having a set of Sunrise minimum requirements across TLDs provide for increased efficiencies in registration</p>	<p>Sunrise minimum requirements across all TLDs provided for increased efficiencies in registration processes to a certain extent,</p>

<p>processes? Were there advantages and disadvantages to the required Sunrise for rights holders? For Registry Operators?</p>	<p>although disparate treatment by individual registrars disrupted the uniformity and efficiency of the processes.</p>
<p>Did the use of SMD files help streamline the process? Were there any technical issues encountered, and if so, what were they?</p>	<p>See our above comments regarding SMD file issues.</p> <p>ICANN could consider exploring alternative means of conveying proof of use and other signed mark data, such as some sort of authorization code or other alternative.</p>
<p>Is there an appropriate balance of registry discretion to reserve names from registration and the inclusion of names in the required RPMs? Should additional considerations be applied around registry allocation practices and their interaction with the required RPMs?</p>	<p>Some registry operators are taking unfair advantage of reserved name and premium name carve-outs from RPM requirements to purposefully withhold well known and distinctive trademark names from Sunrise. ICANN should closely review registry allocation practices to ensure such gaming is addressed. So long as sufficient safeguards are in place to prevent abuse of intellectual property through reservation of names, there should be no specific limitations on registry operators' ability to reserve names, and no time constraints on activating previously reserved names.</p>
<p>Were Limited Registration Periods a useful part of registry launch processes?</p>	<p>Google supports the use of reasonable Limited Registration Periods as part of registry launch processes, subject to the RPM Requirements.</p>
<p>What were the challenges, if any, in terms of registering domain names during Limited Registration Periods?</p>	<p>Google did not typically register names during any Limited Registration Period.</p>
<p>Did registries find that registrants took advantage of Limited Registration periods?</p>	<p>Yes. "Anchor-tenant" promotions and QLPs are particularly useful in developing unique content for new gTLD registries and should remain a viable element of the program.</p>
<p>Was the QLP useful for registries in launching and promoting their TLDs? What were the challenges, if any, in terms of operating a QLP? What factors, if any, would make it more effective?</p>	<p>Google supports the QLP and believes that it should remain sufficiently flexible to enable appropriate pre-Sunrise allocations in the public interest.</p>

<p>Did the QLP succeed in maintaining safeguards against intellectual property infringement? Were any intellectual property infringement issues noted with regard to names issued as part of a QLP?</p>	<p>Google lacks firsthand knowledge of IP infringement issues in connection with names allocated as part of a QLP. So long as current safeguards are maintained, we believe the QLP remains a useful and appropriate mechanism for registries to launch and promote their TLDs.</p>
<p>Are there similar programs that could be built into TLD Startup processes that would support registry startup while maintaining safeguards against intellectual property infringement?</p>	<p>Certain specific pre-Sunrise earmarking/allocation of trademarked names matching names reserved in prior TLD launches (e.g. grandfathering programs), so long as they are designed specifically to promote trademark protection, should be permitted in connection with registry startup, so long as approved by ICANN and the IP community through a transparent Approved Launch Program process. More specifically, ICANN should be more transparent with Launch Program applications, ALPs, QLPs, and its acceptance or rejection of these applications. To date, only a few applications have been published for public comment, without any transparency regarding final disposition. The Draft Report reveals, however, that 41 such applications have been submitted, yet it remains unclear how many have actually been approved. ICANN should publish all Launch Program applications and ICANN's final disposition on the application. As a minor additional note, it would be helpful if TLDs were designated as open or restricted-access on the ICANN TLD Startup Information page.</p>
<p>How useful was the SDRP in resolving disputes?</p>	<p>Google has not used the SDRP and therefore lacks sufficient data to respond. The Draft Report fails to provide any data on the number of SDRP complaints received in aggregate, which would be helpful in holistically evaluating and commenting on the SDRP, apart from direct experience.</p>

What were the most common types of disputes?	See our response regarding the SDRP above.
What were the challenges, if any, in using the SDRP?	See our response regarding the SDRP above.

3. Trademark Claims Service

ICANN Question	Google Input
Is the Claims notice an effective form of communication?	<p>Based on the data presented in the Draft Report, only 96,000 domain names have been registered after a Clams notice, while over 25 million Claims notices have been issued. Based on this data, the Claims notice appears to be working effectively to deter trademark infringement. Google is unaware of any evidence that Claims notices otherwise chill free speech; however, more data around situations in which Claims notices are generated (including the form and substance of the actual notices provided, how many repeat notices were for the same domain name, what percent of claims were for identical marks vs. previously abused strings, etc.) would be helpful in making such a determination.</p> <p>With respect to the notices sent to brand owners in the event an exact match domain is ultimately registered, these notices effectively communicate the fact of the registration to the brand owner, allowing the brand owner to conduct additional investigation and follow-up as necessary.</p>
Is there any other piece of information that should be included in the Claims notice?	As referenced above, it may be useful to gather and review more data around situations in which Claims notices are generated, including the effect of receiving the existing notice, before determining whether any changes are warranted.

<p>How helpful is it to have the Trademark Notice in English and in the language of the registrant's registration agreement? Should additional language considerations be applied?</p>	<p>Presenting the notice in English and the language of the registration agreement should be sufficient. However, if the data shows that a disproportionate number of enforcement actions are against registrants from a particular jurisdiction, we may want to consider providing all notices in English and the language of such jurisdiction, regardless of registration agreement language.</p>
<p>How could the Claims service be improved?</p>	<p>See our comments above.</p>
<p>How useful are extended Claims services?</p>	<p>Extended Claims services would be extremely useful for brand owners. That said, Google does not favor mandatory extended (or perpetual) Claims notices, absent subsidy from ICANN, given the inherent costs and technical burdens imposed on registry operators.</p>
<p>What were the challenges, if any, in terms of extended Claims services?</p>	<p>Additional costs and technical burdens to registry operators are the main challenges with respect to extended Claims services. That said, Google is offering extended Claims service in connection with its new open gTLDs (e.g. our .SOY new gTLD Claims period runs from 15 Oct. 2014 to 22 Jan. 2024).</p>
<p>How effective is the inclusion of previously abused labels in protecting against trademark abuse and infringement?</p>	<p>Although the previously-abused label add-on service is very valuable for brand owners, the data reflect under-utilization of the service to date (only 324 strings recorded). Initial fears within certain segments of the community have gone largely unfounded in that the ability to add 50 previously abused strings might balloon exponentially. The validation price points for this service, namely \$200 for a court case and \$75 for a UDRP, likely have a direct impact on underutilization. ICANN and rights holders should continue to monitor use and effects of the service.</p>

Should the standards for verification of previously abused labels be modified?	This issue should be further explored. The process for adding abused labels to TMCH records is unnecessarily expensive, restrictive and rigid, particularly for brand owners with a large portfolio of previously-abused labels.
How clear is the Notice of Registered Names to the trademark holder? Is there any other piece of information that should be included in the Notice of Registered Name?	The Notice of Registered Names has proven to be a useful tool in monitoring and responding, as necessary, to third party registrations exactly matching TMCH-recorded marks.
Is the Notice of Registered Names received in a timely manner?	Generally, most Notices are received within 24 hours or so of the registration.
Did the Notice of Registered Names help trademark holders decide on next steps?	The Notice is a critical first step in ensuring that trademark holders are aware of potentially-infringing domain name registrations; the Notice, along with some additional preliminary investigation, allows trademark holders to determine next steps in connection with any particular registration.

4. Uniform Rapid Suspension (URS)

ICANN Question	Google Input
How effective is this service in providing a quick and low-cost process for addressing infringement?	The benefits of the URS are its quickness and relatively low-cost. It may be useful for addressing domain name registrations that require immediate take-down as a result of infringing content. However, suspension of a domain is not the optimal remedy in the vast majority of domain name infringement cases. It is unsurprising, therefore, that the URS has been minimally used to date, and trademark owners continue to rely extensively on the UDRP because of its more effective remedy, namely transfer of the domain name to the trademark owner. We believe the URS can have a transfer remedy after expiration, subject to interim appeals processes, and remain a

	complement to the UDRP. The two RPMs would still be distinguished by price, time to resolution, evidence required, and standard of proof. Adding this remedy would cause the URS to be a more effective RPM in stemming cybersquatting and infringement.
What were the challenges, if any, in terms of using the URS?	Google has not used the URS to date for the reasons stated above regarding remedies.
What factors could be addressed to make the URS more effective?	As noted above, incorporating transfer as a possible remedy would make the URS more effective in protecting trademark rights. In addition, the ability for defaulting respondents in URS cases to reply for up to one year after notice of default, even after a determination is issued, and receive de novo review of the complaint (see URS Procedure 6.4) is problematic, as it could lead to the unnecessary drawing-out of an otherwise efficient process. This important peculiarity of the URS is not accounted for in chart contained in the Draft Report.

5. Post-Delegation Dispute Resolution Procedure (PDDRP)

We believe that ICANN and the community should continue to monitor and collect data on the PDDRP and include a review of the PDDRP in an iterative RPM Review process when sufficient data becomes available for meaningful review. Given the nature of the PDDRP, it is unlikely to be used by trademark owners; however, the existence of the procedure may still possess some value as a deterrent to would-be bad actors.

Conclusion

Google appreciates the opportunity to provide its input on the RPM Review Draft Report. Google remains a supporter of the new gTLD program, and we look forward to engaging further with ICANN and other stakeholders as we prepare for and ultimately conduct the RPM Review to ensure it is as comprehensive and accurate as possible for the benefit of rights owners and the broader Internet community.

Sincerely,

A handwritten signature in black ink, appearing to read 'Andy Abrams', written in a cursive style.

Andy Abrams
Senior Trademark Counsel, Google Inc.