**Techlaw LLP**

**Dana Robinson**

**ICANN Issues T1, T3, N1 and N2 (Round 2)**

**February 2, 2012**

**IAG Priority N1**

**Issue: Authentication Standards**

I submitted my input on the five enumerated questions posed in this slide a couple of weeks ago. I saw excellent feedback from Keith Barritt on January 26, and again on February 2. Below, are my additional thoughts.

**1. If contact verification is employed, should this be repeated for every new trademark record submitted, or could it be only when a new contact record is initiated?**

No additional comments.

**2. What is the optimal level of authentication of the party submitting the trademark rights to the clearinghouse? How much cost are users willing to bear for additional layers or levels of authentication? For any additional authentication steps proposed, what value would be added for Clearinghouse users?**

In my original N1 response, I argued for letters being submitted, or some other authentication of the submitting party. I see excellent feedback from Keith and agree that if the owner of the mark is ultimately matched to the owner of the submission with the TMC, then we may not care about their identity or relationship to the owner.

**3. Is it desirable or necessary to provide a more in-depth authentication of the trademark rights themselves? How much cost are users willing to bear for those additional layers or levels of authentication, and what value do they add to Clearinghouse users?**

In two recent emails, Keith brought up the question about the difference between the validation and authentication processes as well as their general usage. Tom responded that these are two separate processes, however, I am still unclear as to what the authentication process serves. We are using “authentication” for the questions about owners (See N1 Q1).

In my previous comments to Priority N1 Q3, I noted that authentication should be fairly thorough. I stand by this if what we mean by authentication is a voluntary process that a mark owner undertakes in order to avail itself of some additional benefit. But, maybe I need to revise my opinion once I figure out what the authentication serves. Is this an additional layer? If so, what does the mark owner get for it?

**4. What safeguards or penalties could be established for misuse of data (e.g., a party takes publicly available data and makes submissions to the Clearinghouse in its own name)? Is this a significant concern?**

No additional comments.

**5. How can we, and do we need to, mitigate any inequity if some data can be verified online and other data cannot?**

I agree with Tom’s suggestion that costs be borne by the party who submits time-consuming authentication documents. If a streamlined process makes it cheap and easy to verify data online for most marks, then those who submit should be rewarded.

**IAG Priority N2**

**Issue: Validation Standard for Proof of Use**

**1. Is it desirable or necessary to establish more onerous standards for certain parts of the review of samples in validating for use? For instance, should validation for use include consideration as to how the sample matches the class of goods or services? Is there additional value to mark holders and to Clearinghouse users of more detailed (and thus more expensive) examination of samples?**

Let me add the following to my previous submission.

First, the use of “validation” is only for sunrise claims, correct? If so, then why not have a fairly rigid standard of examination for those who wish to avail themselves of the benefits of the sunrise process? In this regard, I think that a more onerous standard should be applied. A validated submission should not be rubber stamped. Trained personnel should apply a thorough examination if a submission will be “validated.”

On the issue of specimens, Keith’s comments on both N1 and N2 were insightful. He takes issue with my suggestion that proof of use be more than for one good or service. I see his point, and can imagine the additional burden on the owner and on the TMC for validating many specimens of use. But, I have seen many, many overbroad registrations that are likely to be used to make overbroad claims in the sunrise process. If the validation procedure is only for sunrise claims, then forcing the owners to show use of their mark on all goods that they want to claim would not be unreasonable and prevent abuse by those who overreach in their trademark registrations (which is very common, unfortunately).

Maybe it is irrelevant whether or not the validating trademark owner has made overbroad claims of goods or services. Is it sufficient that the owner have a validated claim, regardless of what it is for? If the actual goods or services are a non-issue, then I concur with Keith that the specimen need only be for one good or service identified in the trademark registration.

I agree with a comment from Keith that we need to figure out how to deal with descriptive marks, Supplemental Registrations and disclaimed terms. Do you allow validation of a mark that is a Supplemental Registration? This would entitle someone to claim otherwise descriptive domains in the sunrise process based on a registration that is admittedly descriptive. On the one hand, we do allow a Supplemental Registration to block a Principal Registration or subsequent Supplementals that are confusingly similar. However, there is an opportunity for overreaching, and even for filing of Supplemental Registrations for descriptive phrases in order to use the Supplemental Registration in the sunrise process.

Further, what do we do with design marks where the whole literal element is disclaimed? Someone has to be reading these applications with an awareness of this type of registration.

On the issue of partial disclaimers, I suppose that the owner of the mark is only able to use the whole string in a sunrise claim. Thus, it seems acceptable to validate the whole text string used in the mark, because the registration itself is for only the whole mark and not the disclaimed portions “apart from the mark as shown.”

Also, I am not clear on the language now that I look more closely. It appears that if a mark has been “protected” by a statute, court or treaty, then it can be validated without demonstration of use. But, if it has not been protected by a statute, court or treaty, then the mark owner must submit proof of use.

What does it mean to show that a mark has been protected by a statute? Is the issuance of a federal trademark registration in the U.S., a mark that is “protected” by a statute? Can the owner of a federal registration validate for sunrise without showing specimens of use? The registration is issued under federal statutes. If this is the case, then when will evidence of use ever need to be shown? Virtually all jurisdictions use statutes to enable the issuance of national registrations. U.S. individual states have statutory schemes for their state-wide trademark registration systems.

**2. How frequently should proof-of-use be re-verified? For example, could a verified proof of use be valid for a year or more?**

I have no changes to my previous comments.

**3. What should be the process for notifying the Clearinghouse if the mark holder abandons use of the mark?**

I have no changes to my previous comments.

**IAG Priority T1**

**Issue: Implementation: Data Locations**

From my perspective (moderately non-technical), the role of the TMC is to be the gatekeeper. I have seen mostly comments that reflect a concern over data mining and misuse of the TMC data, as it will be a unique repository of trademarks not otherwise collected in any other centralized manner.

However, Tom Barrett’s Feb 1, 2012 comments present arguments that the data can be mined regardless of where it is stored.

While I cannot present a conclusion, I can suggest that the technical participants do a fairly robust analysis of whether the TMC can even do the job on a 99% basis if all data is retained by the TMC. If it can, then this option still seems to make sense. If there are real threats to the TMC’s ability to do its job as both gatekeeper and provider of data, then the data will have to be entrusted to registries in some way that makes the TMC comfortable that the registries are providing the data in a way that prevents data mining and stops unwanted conduct from a technological standpoint. I appreciate and concur in Tom’s final comment:

***One final thought regarding Data Locations. This decision does not need to be "either-or". The TMCH could start out with a centralized data approach.***

***After the first round of gTLD's, this issue could be re-visited to see if data distribution is warranted.***

**IAG Priority T3**

**Issue: Implementation: Communication Protocols**

This T3 appears to be a different slide than the last T3. I am glad for the flowchart, which is very helpful. But, I cannot add anything intelligent to the open questions.

One thing that might be helpful at this point is to have a flow chart that actually shows where the “authentication” comes into play.