

IPC Minority Statement re STI Report, Clearinghouse Section 5.2

The IPC opposes Section 5.2(i) and the first sentence of 5.2(ii) of the Trademark Clearinghouse part of the STI Report. These sections of the STI report on the Clearinghouse recommend that new gTLD registries should provide equal protection to all trademarks in the Clearinghouse, except for trademarks from countries that do not have substantive review of trademark applications, and further suggest that registries should have unspecified discretion to decide "whether to grant protections to trademarks in the Clearinghouse."

The exceptions stated above are contrary to the recommendations of the IRT and would make the Clearinghouse inadequate. While IPC is prepared to accept compromises on a number of its long-held positions in the context of the STI report, the IPC is strongly opposed to limiting the use of the Clearinghouse in that manner. The trademark registration systems of a large number of developing and developed countries, including most of Europe, do not engage in substantive review. It is a serious problem and unwise for ICANN or its registries to treat such systems in the Clearinghouse as being inferior or to disenfranchise registrants from these countries from the protections in the Clearinghouse. This would particularly prejudice small businesses and not-for-profits who may only budget for a limited number of trademark registrations in their country of origin, rather than a global registration program.

Instead, the protections provided by new gTLD registries, at a minimum, should include all registrations of national or multinational effect, as recommended by the IRT. We understand the concerns voiced by some that this might allow trademark holders in the Benelux and elsewhere to obtain domain name registration for generic terms. Rather than denying trademark registrants from those countries all benefits of the Clearinghouse, in order to address a few problematic registrations, the proper solution for such concerns is to deal with questions of scope and validity through filing deadlines, notice, disclosure, and challenge procedures. These techniques have worked well to address this problem in previous gTLD launches.

The statement appearing in the first sentence of 5.2(ii) is misleading and should not be adopted. IPC does not object to the specific example given in the second sentence.