



European Communities Trade Mark Association

20 September 2012

ECTA POSITION PAPER

ICANN New gTLDs Proposed Public Comments

1. Introduction

The European Communities Trade Mark Association (ECTA) was formed in 1980. ECTA numbers approximately 1.400 members, coming from all the Member States of the European Union with associate members from all over the world. It brings together all those persons practising professionally in the field of trade marks, designs and related IP matters who can be considered specialist practitioners in these areas.

The extensive work carried out by the Association, combined with the high degree of professionalism and recognised technical capabilities of its members has established ECTA at the high level and has allowed the Association to achieve the status of a recognised spokesman on all the questions related to the protection and use of trade marks, designs and domain names in and throughout the European Union.

More information on ECTA can be found at www.ecta.eu

2. Purpose of the comment

The new gTLD application comment period provides the public with an opportunity to have their views considered by evaluation panels as part of the application evaluations.

The following applications are commented:

- ADULT
- CHEAP
- CLAIMS
- PORN
- SEX
- SEXY
- SUCKS
- WTF

Panel/objection grounds
Community



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3. Comment [same for each application]

ECTA believes that there is a significant risk that trade mark owners, charities, governments, public bodies and others will be forced to spend significant sums of money on preventative registrations for this gTLD in order to prevent the abuse of their brands by others.

This occurred with the recently launched .XXX gTLD, for which our community has invested a significant sum in blocking domain names to prevent abuse by others. For example, one US educational institution has publically said that it has paid over three thousand US dollars to block dozens of .XXX domains.

If ICANN's evaluation panels are minded to accept an application for this gTLD, we ask that ICANN require the successful applicant to develop a blocked list as suggested by AIM in its comments on various gTLD applications. AIM has commented:

"To avoid consumer confusion and the wasted resources of needless dispute resolution procedures, legal actions and defensive registrations (none of which benefit consumers), as well as proving to the entire community that the registries do wish to act in good faith in a clean space, we request that new registries develop "blocked" lists of brand names that should not be registered absent evidence of good faith. Such lists could take the form of "white lists" at the second level that could only be lifted if requested by and for the brand owner."

In order to minimize the known risk for trade mark owners and others having to each spend many thousands of dollars on preventative registrations for this gTLD, we suggest that ICANN takes the above suggestion into account, and that trade mark owners be allowed to register their brands on the "*blocked list*" or "*white list*" for either no fee or only a fee sufficient to cover the registry's reasonable costs in reviewing a registration request.