

ICANN criticized for approach to rights protection

The Internet Corporation for Assigned Names and Numbers (ICANN) has come under fire from brand owners over its handling of the trademark protection policy for the expanded generic top-level domain (gTLD) space developed by the Implementation Recommendation Team (IRT).

The third Draft Applicant Guidebook, published at the beginning of October, was expected to outline how ICANN would protect trademarks. Instead, it reframed the IRT's suggestions to create an IP Clearinghouse and a Uniform Rapid Suspension

process, republished them for public comment and sent them for further consideration to the Generic Names Supporting Organization, the gTLD policy-making group. The document failed to include the IRT's scheme to create a globally protected marks list.

The move sparked criticism from members of the IRT team. "My personal impression is that the IRT was formed just to shut trademark owners up and that ICANN never had any intention of listening to the IRT and/or trademark owners," said Mette Andersen, senior in-house

counsel at Lego Group.

"Our recommendations were not a starting point for negotiations. If this had been the objective we may have taken a more robust position," added David Taylor, a partner at Lovells and team member.

However, Doug Brent, chief operating officer of ICANN, told *WTR* the organization had not "misled" trademark owners. He responded: "I do think all [stakeholders] understood that recommendations would be reviewed by the board and not necessarily adopted wholesale."

However, he added: "The process isn't over. Getting to unanimity is clearly impossible. Still, ICANN needs to be able to articulate how the IP concerns have been considered and

handled for the process to move ahead."

Speaking at ICANN's annual meeting in Seoul, the organization's chair Peter Dengate Thrush speculated that, while "reasonably confident" that workable protection measures will be implemented in time, it is possible that ICANN initially rolls out the gTLD expansion for less problematic registrations only, such as those pertaining to a community. "There aren't obvious trademark problems arising from the names of key capital cities of the world," he said. "So it could be that, if we come to a problem where we're still struggling to solve all the aspects of IP right protection, we may go to some [types of application] that don't have those problems."