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Takeaways From ICANN 49 in Singapore

As you may know, the most recent public Internet Corporation for Assigned Names and Numbers (ICANN) meeting concluded at the end of March in Singapore. Our new gTLD (generic top-level domain) team has closely examined developments at the meeting and carefully distilled several hot topics and takeaways at a high level.

In advance of ICANN 49, we predicted major developments in several areas, including: ongoing refinements to Governmental Advisory Committee (GAC) safeguard advice; the Qualified Launch Program (QLP) for registry operators; Specification 13 to the new gTLD Registry Agreement for dot brand registries; and the Internet Assigned Numbers Authority's (IANA's) transition away from the US National Telecommunications and Information Administration (NTIA). In addition, characteristic of any ICANN meeting, an impromptu smattering of often controversial topics emerged with respect to rights protection mechanism (RPM) circumvention and intergovernmental organization (IGO) abbreviations. We fully address each one of these subjects below.

Governmental Advisory Committee Safeguard Advice

Benefitting consumers and intellectual property rights holders worldwide, the GAC has continued to apply pressure on the ICANN Board of Directors with respect to implementation of its safeguard advice on new gTLDs. In particular, the GAC continues to push for: (1) details on WHOIS verification and accuracy checks to be performed by ICANN, and (2) an affirmative obligation upon registry operators to verify and validate credentials of domain name registrants that indicate membership in certain professional or regulated sectors. The hope is that these safeguards will translate into greater consumer trust online, more accurate registration data and increased registrant accountability, particularly within sensitive strings and regulated market sectors. In addition, led by the United States and encapsulated in the GAC Singapore communiqué, the GAC also continues to push for clarity on mandatory public interest commitments (PIC) obliging registry operators to manage their TLDs in a transparent manner absent undue preference or discrimination, and the enforcement of such obligations by governments or other interested parties through the PIC Dispute Resolution Procedure.

Specification 13 Negotiations

We wish to highlight four amendments to Specification 13 designed to make the new gTLD Registry Agreement more palatable for Fortune 500 brand owners:

- A two-year cooling off period for any dot brand TLD re-delegation upon registry agreement termination;
- An exemption to Registry Operator Code of Conduct requirements prohibiting vertical integration;
- Trademark sunrise period deferral until the registry offers domain names to unaffiliated third-party registrants; and

For more information, or if you have any questions, please contact your Katten Muchin Rosenman LLP attorney or any of the following members of Katten's **Intellectual Property Practice**.

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- Slightly revised definitions regarding the terms “dot brand TLD” and “trademark licensee,” which allow flexibility in third parties, such as customers, having limited control over domain names.

Despite overwhelming support in public comments, an additional amendment addressing security concerns in prohibiting dot brand registries from using exclusive or preferred corporate registrars has been relegated to the Generic Names Supporting Organization (GNSO) Council to ensure consistency with prior policy advice.

One issue that branched off from the negotiations and has taken on a life of its own is the registrability of country names and codes at the second level. ICANN counsel directed the issue toward the existing Registry Services Evaluation Process. In response, the GAC redirected the issue in Singapore by proposing a list where individual nations within the GAC can preemptively elect to allow dot brand registries to register domain names corresponding to country names and codes.

Internet Governance and Accountability Mechanisms

In the wake of the NTIA announcement regarding the transition of IANA functions, brand owners and parties in privity of contract with ICANN all want to know whether ICANN will remain a California nonprofit corporation for jurisdictional and accountability purposes. Dialogue around the IANA transition carried forward from Singapore into US House of Representatives Energy and Commerce Committee and Judiciary Committee hearings, where ICANN and the NTIA remained committed to the Affirmation of Commitments—the agreement which mandates that ICANN will remain a California nonprofit corporation. ICANN and the NTIA also remained committed to developing an IANA transition plan through the inclusive, transparent, accountable and consensus-driven multistakeholder model of Internet governance. The only two possible outcomes that have been taken off the table are indefinitely maintaining NTIA oversight, and transition of IANA oversight to the United Nations International Telecommunications Union. Importantly, proving that the community could continue its work in Singapore amidst such engrossing debates, the GNSO Council unanimously approved five motions progressing policy work. These motions addressed, among other things: territory and region names—such as .AMAZON—as TLDs; GAC engagement in the policy development process; and Internationalized Domain Names (IDNs) and IDN variants.

Rights Protection Mechanisms

Commercial stakeholders made their dissatisfaction known to ICANN staff and leadership with respect to several burgeoning shortcomings and practices that are circumventing hard-fought RPMs. ICANN used the term “technical glitch” to excuse its delays in publication of TLD startup data cutting into the 30 days’ notice that brand owners are supposed to receive prior to each new gTLD launch. In addition, the ICANN Contractual Compliance Department expressed an inability to take any remedial action against new gTLD applicants advertising exorbitant domain name prices to vitiate sunrise protections or pre-registration programs that sidestep fulsome trademark claims notices. Such practices are best evidenced by Vox Populi Registry Inc., an applicant for the .SUCKS gTLD, which plans to charge \$25,000 for each premium sunrise registration.

In relation to the Qualified Launch Program (QLP), questions arose in Singapore about QLP name lists and their public accessibility. By way of background, the QLP exempts up to 100 domain names from sunrise registration requirements based on the operational or promotional needs of each registry operator. ICANN expressed an openness to developing some transparency mechanism for QLP name lists, and additional information recently published by ICANN makes clear the organization’s ability to “post each registry operator’s QLP names list to the registry operator’s TLD startup information page.”

Intergovernmental Organization Abbreviations

IGO abbreviations—such as OECD, UPU, WTO and WHO—are controversial within ICANN on both a procedural and substantive level. With respect to process, policy guidance from the GNSO stands in direct conflict with advice from the GAC. In weighing its options in Singapore, the ICANN Board stirred up controversy in justifying its pursuit of an immediate compromise between the GAC and the GNSO, rather than acting on any proposals outright. With respect to substance, the GAC has advised that ICANN should reserve all IGO abbreviations, while the GNSO has recommended merely placing them in the trademark clearinghouse for 90 days and exploring alternative methods to incorporate the abbreviations in current RPMs. Not all IGOs own trademark registrations covering their abbreviations, although they are protected in the aggregate pursuant to Article 6ter of the Paris Convention for the Protection of Industrial Property, necessitating the call for special accommodations from ICANN.

As always, we hope that our summary proves useful and informative to you in navigating turbulent new gTLD program waters. Truly, there is no substitute for face-to-face discussions or calls to address key details and developments resultant from each ICANN meeting. It would be our pleasure to schedule an appointment at your convenience. We look forward to hearing from you, and we remain at your disposal should you have any questions or concerns regarding our summary, or if you would like to discuss how we can support your organization's efforts in the Internet governance space.

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