

The IRT Proposals of a Globally Protected Marks List (GPML): Dangers/Problems And Innovative Solutions

Paper shared on August 7, 2009

Introduction

We spent a long time trying to understand what the IRT wants in the GPML. So, let's start with how the IRT envisions the GPML – “the IRT recommends the creation of a Globally Protected Marks List to provide protection to Globally Protected Marks at the top and second levels”. [IRT report, p.16)

What the IRT specifically proposes:

Trademark owners that wish to have a mark included on the GPML must provide to the Clearinghouse documented evidence that is capable of being verified of the criteria listed below. After the initial gTLD application round, these criteria should be evaluated and, if appropriate, revised.

The IRT no longer provides the ICANN community with any specific recommended criteria about registration numbers in the various regions, and appears to be at odds within the Committee as to the answers.

Further, all trademark registrations must have issued on or before the date that GPML applications are first accepted and must be based on trademark registration applications filed on or before 1 November, 2008, and the second level domain name for the GPM's principal online presence must be identical to the GPM. [IRT Recommendation, pp. 16-7]

Dangers/Problems with the GPML Proposal:

1. *Globally Protected Marks* (“GPM”): The IRT report seeks to create an alternative, new category of trademarks that do not fall within the famous/well-known category.

2. GPMs will not necessarily involve famous marks, and may not even include famous brands – however, the IRT’s GPMs could include very esoteric scientific and technical terms that are currently used worldwide.

3. **Thus**, these new GPML marks will be even broader in their numbers and have protection far beyond that of today’s well-known brand names.

4. The new GPML marks will have a ‘supernova’ status, and for the discussion below, we call them ‘supernova trademarks.’

5. The protection of these supernova marks will be excessive within ICANN.

6. The scope of protection of these supernova marks outside of ICANN is unknown, and potentially quite dangerous.

Note: as an academic specializing in the UDRP and studying its untended consequences outside of ICANN, Dr. Komaitis shares his expert opinion:

“Unfortunately, we cannot tell you much about the scope of protection for ‘supernova’ trademarks, how courts view them, how academics understand them – **they don’t exist**. Even in the case of famous/well-known marks, which welcome an additional layer of protection compared to ones not classed as famous, the fame of the mark does not grant its owner immunity against any other use. The GPML will grant this sort of immunity – it will allow owners of marks to exclude words and monopolize the domain name vocabulary.

“The IRT has touched upon (and is asking ICANN to canonize) an issue, which is more controversial than the completely baffling, unchartered and confusing path of famous marks. In the US, as in most parts of the world, one cannot tell it is a famous mark unless the court says so. At an international level there is no single list, no consensus and no agreement on that very issue.”

In brief:

- The GPML will exorcise certain words from the DNS as it promotes protection of strings of characters, rather than

protection of the mark and its association with goods or services;

- The GPML will create an alternative, new category of trademarks that do not fall within the famous/well-known category;
- The GPML will include very esoteric scientific and technical terms that are currently used worldwide
- The GPML will create 'supernova' marks.
- The GPML will create scope of protection of the supernova marks beyond that of even what globally famous brands should enjoy within ICANN;
- The GPML overrides the fundamental legal principle that only courts can determine whether a mark qualifies as "famous";
- The GPML will help a trademark owners elevate the status of their trademarks to the protection of "text strings," not trademarks -- truly unprecedented levels;
- The GPML will not further consumer protection;
- And the GPML will violate a fundamental norm of Free Speech and Freedom of Expression -- the prohibition on its 'prior restraint'

Additional Dangers/ Problems for ICANN of Overseeing a GPML

- Harassment - trademark owners will lobby ICANN incessantly for the GPML bars to be set to a point where their company's trademark qualify
- Liability - trademark owners not listed in the GPML may sue ICANN for inclusion for and seek damages for the costs of not being included with the special privileges (envisioned and unforeseen) that the GPML will deliver
- Defend ICANN from potential lawsuits from trademark owners losing their domain name due to GPML hijacking (abuse of a granted GPML listing)
- Defend ICANN from potential lawsuits from free speech advocates
- Process appeals related to the GPML;
- Administravia – e.g. processing addition/deletion from the GPML at regular intervals, including performing assessments for GPML listing candidates.

Conclusion

The issue of globally famous marks is one which has wracked the brains of those who created ICANN, those who worked within ICANN since its inception, and today. When faced with the question of famous marks, the White Paper turned to WIPO.

When faced with the question of famous marks protection in the gTLDs, Working Group B of the DNSO also turned to WIPO -- requesting a list from which to base its findings.

All have turned outside of ICANN -- for its not within the technical scope and mission to create such a list. ICANN must wait until the global community has created standards, and a list, of globally famous marks.

We join NCUC, ALAC, eNom, and many others, even within the IRT, who say that the GPML is clearly a proposal of the IRT that cannot go forward and cannot be fixed.

We hope to make you see that implementation of such a proposal could backfire and fragment the registration of domain names. The degree of protection that trademark owners seek through the GPML does not exist in the offline world.

Kathryn Kleiman, Esq.
Trademark Law Attorney, UDRP Drafter

Dr. Konstantinos Komaitis,
Law Professor,
The Law School,
University of Strathclyde, Galsgow, UK

Appendix:

Further analysis of famous marks and the GPML by Dr. Komaitis:

Here is a brief outline of much larger problems ICANN will overlook, should this part of the recommendation proceed to implementation.

Famous/well-known Requirements - Federal Trademark Dilution Act, §43, 15 U.S.C. §1125 (c)(1):

The owner of a famous mark shall be entitled, subject to the principles of equity and *upon such terms as the court deems reasonable* [emphasis added], to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to -

1. The degree of inherent or acquired distinctiveness of the mark;
2. The duration and extent of use of the mark in connection with goods or services with which the mark is used;
3. The duration and extent of advertising and publicity of the mark;
4. The geographical extent of the trading in which the mark is used;
5. The channels of trade for the goods or services with which the mark is used;
6. The degree of recognition of the mark in the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought;
7. The nature and extent of use of the same or similar marks by third parties; and,
8. Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Comparing these two lists, it is evident that the requirements for well-known/famous marks are stricter compared to the GPML. What we have to understand is that under trademark law the marks that will be listed in the GPML are classed as well-known/famous. Why not make the requirements even stricter or allow WIPO - in its

capacity as a UN body – to proceed to the creation of such list? Why create a separate list altogether and not use the established criteria for famous/well-known marks?

The truth is that only courts can determine whether a mark qualifies as “famous”. If, indeed, the understanding of WIPO is correct and contractual criteria will determine entry in the list, then this should be clearly stated. If that is the case, our argument is that this list will be subjected to extreme levels of abuse, elevating the status of and over-expanding the protection mechanisms for trademarks, which, under normal circumstances, would not even be worthy of protection against dilution.

What we would like to submit to your attention is a certain pattern promoted by trademark owners that also follows the GPML recommendation. Professor McCarthy, trademark law czar, talking about the way trademark owners use the Federal Dilution Act to simplify the test and receive extra-protection, stated: “Some attorneys for owners of famous marks began to think it was preferable, *because it was easier*, (emphasis added) to use this new anti-dilution law in order to prevail in garden variety cases of infringement by a competitor”.

The GPML has the same effect. Trademark owners are using the addition of the new gTLDs as an excuse to elevate the status of their trademarks to unprecedented levels. This is, in a nutshell, what the GPML seeks to achieve.

Effects of GPML Implementation

The GPML derives its scope from the theory of dilution; creating a list of super-famous marks, calling for special protection and seeking to exclude an international audience, indicates the same wish that has prompted the passage of various anti-dilution statutes around the world. Moreover, seeking to block identical marks – in the top and second level domain names – assumes that users will be automatically confused. This is a mistaken assumption.

Is this type of protection even needed? The world’s foremost Trademark Authority would say NO!

According to professor McCarthy, first of all, all assumptions need to

be proven in order to justify extra-protection. He suggests that consumers are not so easily confused and he presents the very interesting example of Amazon to show that, the fact that Amazon can be considered a famous mark does not mean that it is worthy of extra-protection against all other uses. Amazon can mean different things (the great river basin of South America and Greek women warriors), which makes it not an arbitrary mark. If someone were to acquire Amazon food, Amazon drinks, Amazon Gyms, for example, this does not automatically mean that Amazon should be able to block its use on the basis of fame. As Professor McCarthy graphically says: “My thought is that, to a majority of consumers, these uses would not immediately call to mind that particular use of the word “Amazon” as a famous mark for an online seller”.

The GPML will create even more problems for generic terms, such as TIME, PEOPLE, FORD, SHELL, and many others. “I do not think that it can be assumed or presumed that the ordinary consumer, when confronted with an identical mark on nonconfusing, far removed goods or services, will inevitably and necessarily think of the famous mark”. (prof. T. McCarthy).

The IRT has suggested that its recommendations are part of a bigger picture concerning – amongst other things – consumers. The GPML does not aim at consumer protection; on the contrary, it attempts to over-protect trademark interests.

Finally, we would like to draw your attention to how the implementation of the GPML fails to adhere to a fundamental norm regarding speech – the prohibition on its ‘prior restraint’. Graham Chynoweth – general Counsel for Dynamic Network Services, Inc. has stated on this issue: “It isn’t ‘fair’ or ‘right’ for ICANN to stop people from creating TLDs or registering domain names before it is known whether the use of a word in the TLD or domain name, in fact, infringe upon the rights of a trademark owner. [...] In the GPML case, we see a proposed prior restraint on the publishing of a TLD or a domain name into the DNS until the publisher can prove that they have a ‘legitimate’ interest in the word or words at use.” In simple words: “don’t punish the grower that wants to register “apple.food” just because some miscreant wants to sell knock off computers on “apple.deals”.¹

¹ Graham Chynoweth, “Mahmoud Ahmadinejad and the Globally Protected Marks List (GPML), http://www.circleid.com/posts/20090621_mahmoud_ahmadinejad_globally_protected_marks_li

Should the GPML be implemented, we anticipate a substantial degree of disruption in competitive practices, in the market of language and in issues of freedom of speech.