

Implementing Rights Protection Mechanisms in the Name Collision Mitigation Framework

The [Name Collision Occurrence Management Framework](#) was created to help mitigate the impact of name collisions in the domain name system (DNS), which typically occur when fully qualified domain names conflict with similar domain names used in private networks. ICANN, in support of a stable and secure Internet for users, and has launched an effort to mitigate and manage name collision occurrence. This paper describes a specific issue in relation to implementation of the Name Collision Occurrence Management Framework and its interaction with required Rights Protection Mechanisms (Section 1, Specification 7 of the [new gTLD Registry Agreement](#)).

Section I of this paper will discuss the background of the Name Collision Occurrence Management Framework. Section II reviews the current requirements of the Name Collision Occurrence Management Framework, including the [Name Collision Occurrence Assessments](#) issued to registry operators who have signed gTLD registry agreements.

Section III describes various alternatives to providing Rights Protection Mechanisms for certain domain names once they are released for allocation for the first time. Community input is being requested regarding alternatives for handling of this category of names (i.e., names included in a registry operator's Alternate Path to Delegation Report and recorded in the Trademark Clearinghouse (TMCH) which registry operator withheld from allocation during its Sunrise period or Claims period).

I. Background

On 7 October 2013, the New gTLD Program Committee of the ICANN Board of Directors adopted the [New gTLD Collision Occurrence Management Plan](#) (the "Collision Management Plan") to help manage collision occurrences between new gTLDs and existing private uses of the same strings. Reports generated as part of the Name Collision Occurrence Management Plan helped determine whether applicants for specific gTLD

strings were eligible to elect the Alternate Path to Delegation. The majority of applicants were found eligible to proceed with the Alternate Path to Delegation prior to receiving their Name Collision Occurrence Assessments.

The Alternate Path to Delegation required that new gTLD registry operators block second-level domains (SLDs) considered to raise a name collision risk to the Internet's domain name system (DNS). The specific names to be blocked from activation in the DNS (until such time as data became available to demonstrate that collision occurrences had been mitigated), were generated based on [Day in The Life datasets](#). The names included in the SLD "block list" vary from one new gTLD registry to another, and may contain names that match trademarks.

Applied-for gTLDs that were considered ineligible for the Alternate Path to Delegation were those for which the growth of the number of SLDs queried year over year significantly exceeded the average growth rate for all applied for gTLDs in at least two of the DITL years (2006-2012), and for which one of the years in which this was observed was the most recent year, 2012. The analysis of this data showed that for some strings, the variance of SLDs queried varied so significantly from year to year that the mechanism of blocking SLDs might not be an effective way of addressing the name collision issue.

The New gTLD Collision Occurrence Management Plan adopted by the Board's New gTLD Program Committee called for undertaking an additional study to develop a Name Collision Occurrence Management Framework. As a result, ICANN was tasked with analyzing the potential DNS namespace related issues and proposed the Name Collision Occurrence Management Framework to mitigate future name collisions that could occur, as well as to provide emergency response capabilities in the event that critical systems are negatively impacted.

On 30 July 2014, the Board New gTLD Program Committee passed a [resolution](#) approving the Name Collision Occurrence Management Framework. The framework consists of a set of requirements intended to manage potential collisions that could arise between new gTLDs and domain names that may be in use in private namespaces. On 4 August 2014, in accordance with the resolution, ICANN issued each new gTLD registry operator with an executed registry agreement a [Name Collision Occurrence Assessment](#)

(“Name Collision Assessment”) consistent with the approved Final Name Collision Framework. The Name Collision Assessment is the mechanism to implement the mitigation measures in the Final Name Collision Framework through the [Registry Agreement](#). The Assessment also provided requirements for how names could be released from the SLD Block List.

II. Existing Requirements

Specification 6, Section 6 of the Registry Agreement provides that, before activating any second-level domain name, the Registry Operator must either (a) implement the mitigation measures described in its Name Collision Occurrence Assessment or (ii) block those second-level domain names for which the mitigation measures have not been implemented and proceed with activating names that are not subject to specific requirements in the Assessment. Prior to the issuance of the Name Collision Occurrence Management Framework, a registry operator eligible for the Alternate Path to Delegation could proceed with offering names for registration in the TLD, so long as the names included in the TLD-specific SLD Block List were not activated in the DNS and the registrants were clearly informed of the inability to activate such names.

Additionally, registry operators are required to implement a “wait” period of no less than 120 days from the date that a registry agreement is signed before activating any names (with the exception of <NIC>) under the TLD in the DNS. The length of this period is based on the Baseline Requirement 11.14 for Certification Authorities (CAs) and is intended to mitigate risks related to the internal name certificates issue. Registry operators, if they choose and if otherwise allowed by their registry, may accept registrations during this period, but are not permitted to activate the names in the DNS. If a registry operator chooses to register names during this 120-day period, the operator must clearly inform the registrants (through the registrars) about the inability to activate names until the period ends.

The Name Collision Assessment addresses Section 6.2 of Specification 6 of the Registry Agreement, whereby the appropriate Name Collision Occurrence Assessment

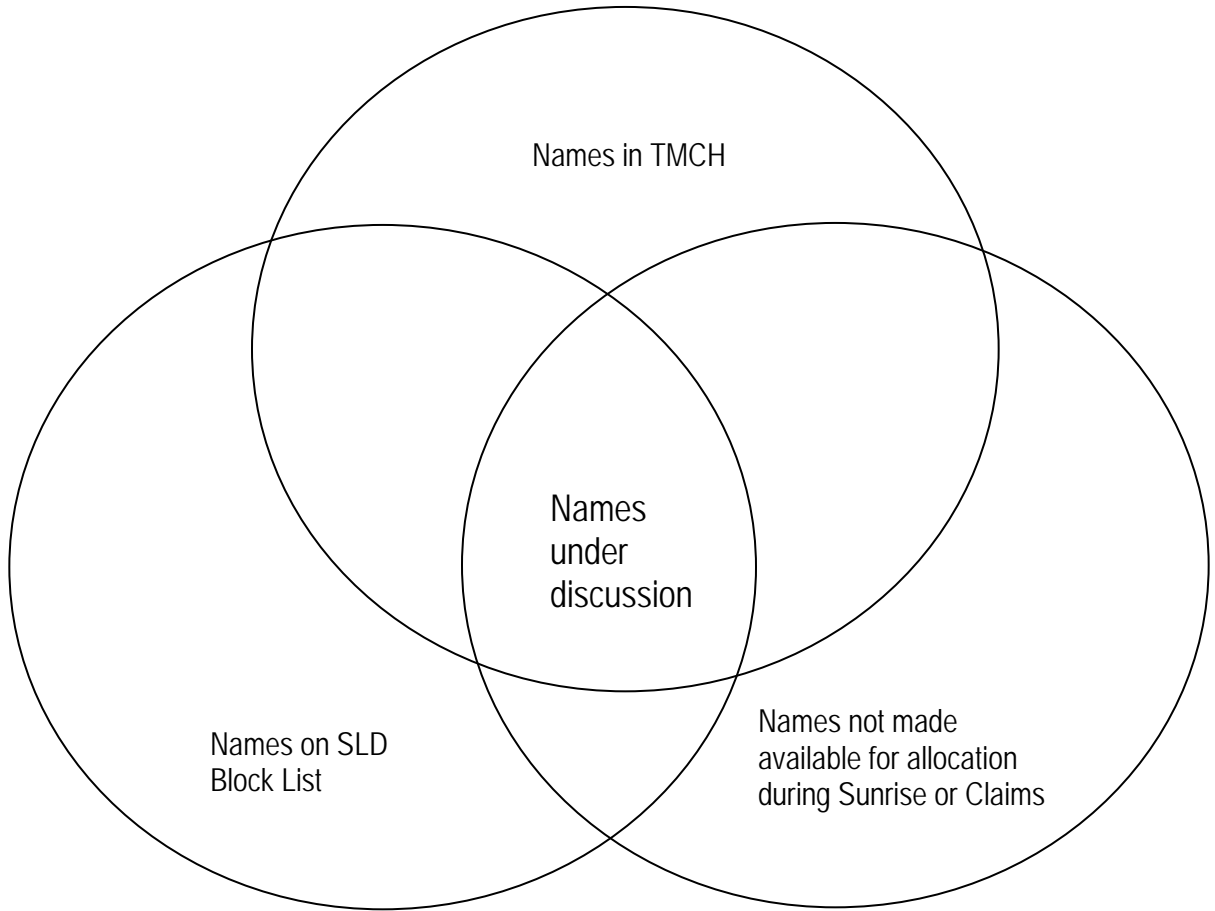
measures must be implemented for the top-level domain. The Name Collision Occurrence Assessment identifies requirements for three different cases:

- For TLDs delegated on or after 18 August 2014, the Registry Operator must not activate any second-level domain names until the required 90-day wildcard controlled interruption period has been completed.
- For TLDs delegated prior to 18 August 2014 who have activated names, the new gTLD registry must ensure that second-level domain names desired to be activated from its SLD Block List, after the 90-day controlled interruption period for these names, have been subject to applicable Rights Protection Mechanisms as required under Section 1, Specification 7 of the Registry Agreement. These requirements are discussed in more detail below.
- For TLDs delegated prior to 18 August 2014 that have not activated names, implementation of the controlled interruption measures outlined in the Name Collision Occurrence Assessment may occur through a controlled interruption as a wildcard for the entire TLD, or a controlled interruption on the SLD Block List associated with the TLD.

With the adoption of the Name Collision Occurrence Management Framework, the Alternate Path to Delegation has been eliminated as an option for registries going forward.

Per measure II, section C in the Name Collision Occurrence Assessment, for names included on the SLD Block List of the registry's Alternate Path to Delegation Report and recorded in the Trademark Clearinghouse that the registry withheld from allocation during its Sunrise Period or Claims Period, the registry must continue to withhold the names from allocation while ICANN consults with the community regarding appropriate rights protection mechanisms for this category of names. As appropriate, the new gTLD registry will be provided with an updated Name Collision Occurrence Assessment with details about how to activate these names after the period of community consultation.

Below is a diagram illustrating the category of names under discussion in this paper:



III. Alternatives for Release of SLD Block List Names

The [Rights Protection Mechanism Requirements](#) were put in place for the New gTLD Program to enable trademark holders to protect their rights during the Domain Name System expansion. Based on feedback and discussion to date in the community regarding appropriate Rights Protection Mechanisms for names in the SLD Block list, several possible approaches are described in for the handling of these names. ICANN is requesting feedback on these alternatives, or proposals for additional measures.

1) The “Status Quo”: Names must go through Trademark Claims (“Claims Only”)

The Claims Only option is the existing approach for names that are released from the SLD Block List. Names that were not previously made available for allocation are subject to the Trademark Claims service on release. The Trademark Claims service presents potential domain name registrants with a notification if the name in question matches a record in the [Trademark Clearinghouse](#). If the name is registered, the Trademark Clearinghouse will send a notice to those trademark holders with relevant records in the Trademark Clearinghouse, informing them when someone has registered the matching domain name. The Claims service is mandated for all new gTLDs during at least the first 90 days of the general availability in the TLD.

Per Section 2.6 of the Registry Agreement, a Registry Operator may at any time establish or modify policies concerning Registry Operator’s ability to reserve (i.e., withhold from registration or allocate to Registry Operator, but not register to third parties, delegate, use, activate in the DNS or otherwise make available) or block additional character strings within the TLD at its discretion. Per section 2.4.3 of the RPM Requirements, if Registry Operator reserves and thereafter releases a domain name following the start date of the Claims Period, such domain name must be subject to the Claims Services for a period of ninety (90) calendar days from release.

Under the Registry Agreement, new gTLD Registry Operators eligible for the Alternate Path to Delegation had discretion to allocate names on the SLD Block List

during the Sunrise and Claims periods, so long as the names were not activated in the DNS zone, as well as to withhold the names from registration altogether. Requiring that any names being released from the SLD Block List for allocation be subject to the Claims service for 90 days is consistent with what is required for the release of reserved names and ensures a minimum level of protection across registries. That is, for every name that becomes available for registration for the first time, that name will, at a minimum, go through the Claims service. Rights holders who have recorded marks in the Trademark Clearinghouse will receive notifications if matching domain names are registered. For this approach, no additional requirements or procedures would need to be developed. Treating names released from the SLD Block List in the same manner as reserved names does not entail the need to develop a new procedure.

Previous feedback from some stakeholders indicates that providing the Claims service for SLD Block list names would not compensate for the absence of a Sunrise period whenever blocked SLDs are released for registration. Feedback also indicates that this mechanism may generate additional complexities for registry operations; as compared to the voluntary reserved names list, the SLD Block List may be more extensive and new gTLD registry operators may not have the procedures in place to operate additional Claims periods for these names.

2) Possible Alternative Approaches

This section outlines feedback received by ICANN to date on recommendations for how names released from the SLD Block List should be treated.

The Sunrise period is intended to give priority to trademark holders who wish to register domain names in new gTLDs. Registration of domain names during the Sunrise Period is restricted to Sunrise Eligible Rights Holders whose marks are registered in the Trademark Clearinghouse. All registrations of domain names during the Sunrise Period that were validated using a Signed Mark Data (“SMD”) file generated by the Trademark Clearinghouse are deemed “Sunrise Registrations.”

Given that the names on the SLD Block List may include SLDs that match trademarks, there is concern that upon release, if these names are not subject to the

Sunrise requirements, this could cause harm to the protection of intellectual property rights. ICANN has received feedback from some members of the community favoring a requirement to put previously-blocked SLDs through a primary Sunrise or some variation of a Sunrise period (i.e., a “secondary sunrise” whereby names are offered to rights holders on a priority basis using a process to be developed).

The Internet Committee of the International Trademark Association (INTA) [has expressed concern](#) regarding the release of SLD names and has recommended a secondary Sunrise period, stating:

For the foregoing reasons, INTA recommends that ICANN require that all trademarked names that registry operators are forced to block under their alternative path to delegation plans be available for allocation during the original Sunrise period or be subject, upon release, to a secondary Sunrise period. The sole exception would be for dotBrand registries qualifying for Spec 13, which are not obliged to run a Sunrise period unless they later decide to open the registry to third-party registrations.

INTA also recommends that ICANN immediately issues clarification, which is both published on the website and sent direct to relevant registry operators, notifying them that all names on their name collision block lists should be made available for allocation during the initial Sunrise to qualifying trademark holders, notwithstanding that those names cannot be activated at present. This will prevent the situation being further exacerbated and limit the number of registries who are obliged to offer a secondary Sunrise.

ICANN has also received feedback from various stakeholder groups suggesting an alternative approach to address the needs of both trademark holders and registry operators. The Registry Stakeholder Group (RySG), the Business Constituency (BC), and the Intellectual Property Constituency (IPC) [proposed an alternative approach](#) to the matter of the application of rights protection mechanisms to the release of names from the SLD Block List:

1) The APD blocklists represent a unique set of events that were not anticipated by the RPM Requirements when they were drafted. Therefore, the release of these names from the blocklist would be subject to a unique set of rules intended to apply only to names affected by APD blocklists and without generally altering the RPM Requirements or expectations therein.

2) Any name on the name collision blocklist not reserved by the registry would have to be subject to some period of 30 days or more in which registrations were available exclusively to SMD holders. Many registries have already satisfied this requirement by offering the names for registration during their initial Sunrise period; those that did not could develop the mechanism and the timing of their choice, possibly overlapping with the 90 day controlled interruption period. ICANN and/or the TMCH would develop procedures by which appropriate notification of these registration periods could be made to trademark holders. We expect that ICANN would work with the community to develop appropriate notification requirements and mechanisms.

3) SLDs released from the name collision blocklist would NOT be treated as reserved names and would NOT be subject to the requirement of an additional 90-day Claims period.

To develop a procedure to support a secondary Sunrise mechanism there are several factors ICANN must consider, including:

- a. What is the appropriate notification to be sent to the trademark holders for registrations during a secondary sunrise? As per the current Sunrise requirements, the new gTLD registry notifies the TMCH of registration of the domain names during the Sunrise Period, so that matching rights holders in the TMCH also receive notification. Should this mechanism be present during a secondary Sunrise?

- b. Should there be a minimum/maximum duration of the secondary Sunrise period? What time period requirements would be appropriate?
- c. What type of notice should registries be required to provide in advance of a secondary Sunrise? Should there be a requirement for date and registration requirements to be published in a similar manner as the original Sunrise period?
- d. Should the registry be required to report its secondary Sunrise to ICANN? How does ICANN confirm that registries are complying with the requirements?
- e. What type of dispute resolution processes should be in place for a secondary Sunrise?

An option requiring a secondary Sunrise, without the Claims service, requires rights holders to proactively monitor the secondary Sunrise periods. That is, it requires awareness from rights holders of when secondary sunrises are occurring for various TLDs, running the risk of missing the opportunity to register a name if proper attention is not paid to this period. In addition, without the Claims protection, rights holders would not receive notification when matching names were registered after the secondary Sunrise.

A combination of both the Sunrise and Claims services would also be possible and would provide a maximum level of protection for trademark rights in relation to names on the SLD Block List. (For clarification, it should be noted that once a name has been registered during the Sunrise period, it will no longer be necessary to put the name through Claims.) With this option, in the event that attention is not paid to the Sunrise period, the rights holder has the added benefit of the Claims service and will receive a notification when any matching names are registered. This option would also require a new procedure to support a secondary Sunrise as discussed above, as well as presenting increased complexity to registry operations.

In addition to the alternatives discussed in this paper, new solutions may exist that provide an appropriate balance between protection for trademark rights and flexibility for registry processes. Interested parties are welcome to propose other possible alternatives for

additional measures in the comment forum.

IV. Conclusion

ICANN's mission and core values call for preserving and enhancing the operational stability, reliability, security and global interoperability of the Internet. ICANN is fully committed to developing the appropriate procedures to release second-level domains from the SLD Block List, including measures to protect rights holders. ICANN appreciates the community's involvement in the process and looks forward to the community's input or additional suggestions relating to the questions discussed in this paper.

Subsequently, as part of the 90-day consultation period starting from the posting of the resolution on 30 July 2014, ICANN will review and analyze the comments received, and will develop and publish the final approach and requirements on the appropriate Rights Protection Mechanisms for releasing names from the SLD Block List.