

**CONTENT OF CHATROOM – NBO Meeting –
TRADEMARK PROTECTION IN NEW gTLDs**

Date:

Monday, 8 March 2010 - 16:00 - 17:30

Room:

Tsavo A

Presentation:

Trademark Protection in New gTLDs

Meeting Leaders:

Margie Milam Senior Policy Counselor

<http://nbo.icann.org/node/8927>

[16:00] Frederick_F: no audio

[16:00] Roland_2: Terrible echo on the audio

[16:02] Nick_Ashton: Welcome to the session

[16:02] markus_trav:

[16:02] Robert_Hogg: welocme everyone

[16:04] Robert_Hogg: given the three-part format of this session PLEASE indicate the topic of your question before you type it

[16:05] nashton: To ask a question or make a comment, please use the link immediately to the right entitled 'Ask a question or make a comment' by clicking on it, and pressing the 'Browse to" button directly below

[16:06] nashton: You may also find the URL for the question/comment box on the agenda page for the session at <http://nbo.icann.org/node/8927>

[16:06] nashton: You can also see the comments and questions of others using the relevant button on the right, and from the URL in the agenda

[16:16] Frederick_F: wait, isn't it that with new TLDs that the clearing house is only in effect for secondary registrations

[16:17] James_Blade: Question: If the new registry uses the TMCH for Sunrise, does this mean they can cease using (and paying for) it once the TLD is open for general registration?

[16:17] *** Kathy_Kleiman2392 (anon@208-58-72-27.c3-0.fch-ubr2.lnh-fch.md.cable.rcn.com) has joined channel #tsavo

[16:17] jberryhill: @bladel - a registry could choose to use it as part of a claims notification service (like the .biz STOP)

[16:19] James_Blade: @John: Optionally?

[16:19] Kathy_Kleim: Peter is right -- and the goal of the STI was to prevent the Clearinghouse from doing any independent verification of trademarks.

[16:20] Kathy_Kleim: That type of verification is not a role we wanted ICANN - or an ICANN-contractor. That's not ICANN's role (nor one we want).

[16:20] jberryhill: @bladell - sure @Kathy_Kleiman - I can get any TM registered that I want in 24 hours in Tunisia or 2 weeks in Benelux - that's what happened to the .eu sunrise, it was swamped by "TM registrants"

[16:21] jberryhill: "Verification" can be "show me a specimen of use"

[16:21] Gordon_Chil: "Court Validated" marks sort of suggests why they didn't simply go to an existing database.

[16:22] jberryhill: @gordon because some people do not register or enforce until they have an infringer

[16:22] Gordon_Chil: Understood, and they wanted to be able to cover that.

[16:23] Kathy_Kleim: That's why, if the Clearinghouse is mandated to accept the Benelux (no review) marks, then under the STI recommendations, Registries should be able to choose only the substantive review marks in their pre-launches.

[16:23] jberryhill: @gordon - at least "some official body" has looked at it. However, I can run a collusive suit and get a court judgment.

[16:24] jberryhill: I file suit against you for infringing my "blah" trademark - you stipulate to an injunction - boom, I have my "court validated trademark". Easy peasy

[16:24] James_Blade: Question: If the use of TMCH is optional for rights holders, then what is the incentive to use & pay for the service? Should failure to register marks with TMCH be considered in UDRP / URS ?

[16:24] Michele_Ney: "court validated"? What's that mean in terms that a normal human can understand?

[16:25] Frederick_F: @kathy K - what constitutes substantive review? and how do you differentiate between substantive and other reviews?

[16:25] Kathy_Kleim: yes, we were using the one from the IRT Report

[16:25] jberryhill: @bladell - it's just a toolkit upon which policies can be built. @michele - "court validated" means that a court has rendered a judgment of some kind - like my default suit against you in a remote jurisdiction

[16:25] Michele_Ney: John - that's nuts

[16:26] Michele_Ney: So "court validated" means I have to sue one of you just to show that I have a TM

[16:26] jberryhill: Rather than fixating on what is "substantive review" the question is "how do we address 'paper trademarks' for dictionary words in easy jurisdictions"

[16:26] jberryhill: @michele - yes. In some jurisdictions, registration is not required to have an enforceable right

[16:26] Eric_Brunne: ++1 jberryhill

[16:27] Michele_Ney: John - I know - I've defended our rights based on common law rights and usage

[16:27] Kathy_Kleim: It was understood in STI that creating a list of countries which conduct substantive review would be straightforward to produce. We discussed this a lot.

[16:27] Michele_Ney: Kathy - great, but you're ignoring lots of people's rights based on usage + actual LAW

[16:27] Michele_Ney: as opposed to some ICANN invented rubbish

[16:28] jberryhill: Hang on Michele - the database itself doesn't determine anyone's rights under any

policy - it is but ONE tool of many

[16:28] jberryhill: The problem is trying to solve EVERY problem with each tool, instead of looking at the overall picture and deciding whether we have enough different tools

[16:29] Michele_Ney: John - so let the courts decide :)

[16:29] Kathy_Kleim: M-N, the goal is to protect and balance everyone's rights -- including the rights of others to dictionary words, fair use and generic terms

[16:30] Michele_Ney: Kathy - I see it being abused by big brand holders

[16:32] Kathy_Kleim: I do too -- that is why goods and services are listed in the TC, and the STI wanted to give Registries to use only those TMs with the goods and services relevant to their new gTLD

[16:33] Kathy_Kleim: wanted to give Registries ****the right**** to use only those TMs with the goods and services relevant to their new gTLD

[16:34] Peter: hello

[16:34] jberryhill: @kathy - but let's not confuse "what goes in a database" with "what does a policy do with it"

[16:38] gpmgroup: Would it be worth considering price limits for domain names registered during sunrise periods or perhaps even the option to register a non resolving name where the funds are paid to ICANN rather than the new gTLD registry as these measures may help minimize any new gTLDs being set up primarily to benefit from defensive registrations and speculation purposes?

[16:40] Robert_Hogg: remember you can submit a question/comment using the standard form here - <https://icann.wufoo.com/forms/icann-37-trademark-protection-in-new-gtlds/>

[16:53] Doug_Brent9: test

[16:55] Doug_Brent: Test

[16:56] gpmgroup: http://www.adr.eu/arbitration_platform/news.php

[16:57] wseltzer: whoa, the Board might make a decision??

[16:58] Michele_Ney: odd

[16:58] Eberhard: I am surprised, too, to hear that the Board might decide

[16:59] Kathy_Kleim: There is great worry in the community that the Czech Arbitration Court and WIPO expedited review changes to UDRP will bypass the ICANN community input process. We hope all changes to the UDRP will be done together!

[16:59] Jeff: We may have a couple people here in Reston that have a question. Kristina has one.

[17:04] Kathy_Kleim: It must be faster- it's a 3-day decision period (or thereabouts)

[17:05] Bruce_Tonki: Cost and time to resolve are often trade-offs. In this case I assume we are trying to make it cheaper and faster. May not always be possible to do both.

[17:06] jberryhill: it can only be fast and cheap if narrow, but everyone wants to solve every problem with it

[17:06] Bruce_Tonki: Certainly there can be cost savings in using electronic documents rather than shipping paper around.

[17:06] Bruce_Tonki: Also cost savings in allowing judgements online, rather than having to attend a court hearing

[17:07] Kathy_Kleim: It is much narrower than the UDRP - again to make decision-making faster (and to encourage Complainants to bring only appropriate filings to the URS forum).

[17:07] Jothan_Frak: it was partially rhetorical

[17:07] Jothan_Frak: thank you for consideration

[17:07] mib_jt5l7e: Nominet doesn't have an expediated process - just a cheaper process in cases where a registrant doesn't respond to a complaint.

[17:11] ms_2: Nominet has a medation phase plus a cheaper and quicker process where no response is filed

[17:15] Pat_Kane: hey suzanne

[17:16] Kathy_Kleim: Nominet has very clear criteria for safe harbors -- which are now embraced under the "defenses" section of the URS.

[17:20] RESTON: Scribe audio is cutting out -- but our audio is fine here in Reston -- Mikey

[17:20] Joly_MacFie: It's cutting out for me too

[17:20] Frederick_F: audio poor now

[17:20] Frederick_F: cutting in and out

[17:21] Marika_Koni: We are working on it

[17:21] Philip_Corw: cutting in and out for me as well--was fine until just a few minutes ago

[17:21] RESTON: bah! Never mind -- we're coming in by phone. belway that last comment -- Mikey - too little sleep

[17:21] steve_metal: Same audio troubles here though nothing seems to be lost

[17:22] Frederick_F: dropping substantially most of the content at this point

[17:23] Marika_Koni: Please confirm whether audio has improved

[17:23] Kathy_Kleim: Alas, no

[17:23] Michele_Ney: audio is in and out

[17:23] steve_metal: audio has not been fixed and is now totally out of sync with scribing

[17:23] gpmgroup: no

[17:23] Philip_Corw: what audio?

[17:24] Michele_Ney: no audio at all now

[17:24] Philip_Corw: it is getting worse, not better

[17:24] ms_2: Give it a minute or two

[17:24] steve_metal: video just dropped

[17:24] Jothan_Frak: try using the feed instead of the adobe connect audio

[17:24] Jothan_Frak: 16k feed working great

[17:24] ms_2: it is back

[17:24] Joly_MacFie: 64k not

[17:24] steve_metal: video back but no audio

[17:25] Michele_Ney: ack it's just avc anyway

[17:25] Jothan_Frak: <http://stream.icann.org/tsavoa-16-en.m3u>

[17:25] Michele_Ney: sure what will he say? :)

[17:26] gpmgroup: <http://stream.icann.org/tsavoa-16-en.m3u> not working here either

[17:26] Michele_Ney: or here

[17:26] Marika_Koni: We are looking into it

[17:26] ICANN: it is a general issue

[17:27] Joly_MacFie: scribes are on the phone presumably?

[17:27] VeriLAN_MDR: no, scribes are in an office at ICANN HQ

[17:29] Michele_Ney: fallback audio only on both channels

[17:29] Michele_Ney: piano music

[17:29] gpmgroup: scribes must be hands free - their ability to keep up with even the fastest speakers is amazing

[17:31] Marika_Koni: We are working on it, but it might take a little bit to get the audio streams back up

[17:31] Marika_Koni: Hopefully everyone can see the scribing in Adobe Connect

[17:32] Joly_MacFie: yes thanks

[17:32] Frederick_F: can see but can't figure out how to scroll back to re-read something

[17:33] Joly_MacFie: <http://nbo.icann.org/scribe-feed>

[17:33] Kathy_Kleim: Agreed - much work to be done on this point.

[17:33] Nick_Ashton: Cannot scroll the scribing in the AC interface - we are going to make improvements for Brussels to make that possible

[17:33] Nick_Ashton: However, as Joly said, the lo-bandwidth scribe feed will let you scroll

[17:34] Eric_Brunne: nic: sound is down

[17:35] Nick_Ashton: Yeah, sorry about that, they are working on it

[17:35] Jothan_Frak: +1 Michael

[17:35] Joly_MacFie: Michele must be upset to miss Foody

[17:36] Kathy_Kleim: Who is responding to Paul?

[17:36] Jothan_Frak: Kathy that's michael silber

[17:36] Kathy_Kleim: Tx, it's all silence here...

[17:36] Jothan_Frak: the moderator

[17:37] Kathy_Kleim: Agree with the moderator!

[17:40] ms_2: thanks kathy :-)

[17:40] ms_2: Even though I was only partly correct

[17:41] Frederick_F: Jothan - what m+m study was referred to earlier?

[17:42] Joly_MacFie: almost getting audio on the 64k

[17:42] Michele_Ney: Frederick - there are two on the M + M site

[17:42] Joly_MacFie: but no cigar

[17:43] paulfarkas: no audio again

[17:43] Frederick_F: but there was one referred to in this session, which was referred to?

[17:43] Jothan_Frak: it is up on the mm website under the blog or email me jothan at mindsandmachines.com and I'll send it to you

[17:43] Jothan_Frak: @ff

[17:44] Kathy_Kleim: But there is another remedy in the new gTLDs for post-launch disputes - in addition to the URS -- and that's the UDRP. As Mary mentioned, the UDRP still exists and is not displaced by the URS. They complement each other .

[17:44] Jeff: Although the line between fast track UDRP and URS is being blurred by dispute providers

[17:44] Jeff: And we need to examine that

[17:45] Joly_MacFie: audio there but a lot of clicking

[17:45] Joly_MacFie: <http://stream.icann.org/tsavoa-64-en.m3u>

[17:45] Kathy_Kleim: We do, but I don't see any adoption of that yet. It should some though ICANN.

[17:47] Kathy_Kleim: meant -- it should go through ICANN.

[17:47] Joly_MacFie: ah! clean audio!

[17:47] Joly_MacFie: oh no. gone!

[17:47] Joly_MacFie: back. good.

[17:47] Nick_Ashton: There is a problem upstream in Europe apparently

[17:47] Philip_Corw: ICANN BOard has to tell CAC that they can't just go ahead and implement their own fast track UDRP process absent ICANN approval in a blatant attempt to attraract complainants

[17:48] Joly_MacFie: audio good now

[17:48] Joly_MacFie: on audiocast

[17:49] Phil_Buckin: I am in UK - no audio for ages

[17:49] Philip_Corw: still the sounds of silence at my computer in Alexandria VA

[17:49] Joly_MacFie: <http://stream.icann.org/tsavoa-64-en.m3u>

[17:49] wseltzer: nearly wrapping up here

[17:49] Gordon_Chil: I think I'll leave it for now. See you all tomorrow.

[17:50] gpmgroup: @Philip more here http://www.adr.eu/arbitration_platform/news.php

[17:50] ms_2: you back philip?

[17:51] Joly_MacFie: still no audio in adobe connect - but audiocast is good

[17:52] Paul_Farkas: thanks

[17:52] Paul_Farkas: finally

[17:52] Joly_MacFie: now back in adobe

[17:52] Philip_Corw: audio back here as well

[17:53] Paul_Farkas: ok lets start over

[17:53] Jothan_Frak: I congratulate the team on their work and the improvements that they've mede since Sydney

[17:53] Jeff: lol

[17:53] Phil_Buckin: Audio back finally

[17:53] Mouhamet_Di: YEAH GREAT

[17:54] nashton: Sorry for the period with no audio, there was a problem upstream from Nairobi, at the first uplink from Nairobi there was a period of serious packet loss

[17:54] dotSCOT: Joy, an echo on the audio feed now!

[17:54] Joly_MacFie: sounds good here

[17:54] nashton: Getting no echo from the AC audio feed...

[17:54] ms_2: do you have audio feed and adobe running at the same time

[17:55] Mouhamet_Di: yes for now

[17:55] dotSCOT: Let me check, but I don`t think so...

[17:56] Kathy_Kleim: Great panel, All, thank you!!

[17:56] wseltzer: and we're out

[17:56] ICANN: Thanks so much, everyone remotely

[17:57] Joly_MacFie: very good

[17:57] Mouhamet_Di: Thanks you all for allowing us to follow remotely.

[17:57] Mouhamet_Di: Good job

[17:57] Nick_Ashton: Thank you for joining!

[17:58] J: thank you all

[17:58] Michele_Ney: audio disaster

[17:58] Eric_Brunne: thanks all

[17:58] Nick_Ashton: Seeing so many people using these services makes it all worthwhile

[17:58] Ryan_Kaatz: Thank you for setting this up.

[17:58] Joly_MacFie: presumably the connection problems won't affect the archive