

## New gTLD Trademark Clearinghouse Issue Analysis Sunrise and Trademark Claims Processes Discussion Draft

### Introduction

ICANN formed an Implementation Recommendation Team (IRT) in March 2009 to develop and propose rights protection mechanisms for the new gTLD program. The IRT, consisting of 18 geographically diverse subject matter experts from the intellectual property arena, made several specific recommendations to enhance trademark protection. One recommendation was the establishment of a Trademark Clearinghouse (see <http://www.icann.org/en/topics/new-gtlds/trademark-clearinghouse-clean-19sep11-en.pdf>) to provide certain services during new gTLD startup processes. As a result, ICANN has specified in the Applicant Guidebook (AGB) that all new gTLD registry operators will offer a Sunrise period and a Trademark Claims service, supported by use of a Trademark Clearinghouse. The business processes for these two services are depicted in Appendices 1 and 2. In an effort to capture the business requirements for implementing these processes, ICANN is seeking input on the issues identified below.

The issues for discussion are organized by “Priority.” Each priority’s position in the Clearinghouse operating process flow is indicated in the appendices, which depict the issues in a process-logic order for Sunrise and Trademark Claims.

In summary:

Priority	Issue
P1	Sunrise Domain Registration Authorization
P4	Community Audit/Logging/Compliance Requirements
T1	Data Locations
T2	Data Access
T3	Communications Protocols
P2	Responsibility for Registrant Claims Notice
P3	Responsibility for Trademark Holder Registration Notice
P5	Responsibility to Perform Trademark Claims Check

Priority: P1 (see Appendix 1)

Issue: Sunrise Domain Registration Authorization

Description: Sunrise eligibility requirements must be met for any domain name registered in the sunrise period. Confirmation that eligibility requirements have been met is called "authorization." The Sunrise Process should identify where in the process the authorization check(s) will occur.

Business Requirements:

- (1) Maximize efficiency of customer registration experience
- (2) Ensure the process accommodates the use of authorized agents during Sunrise to register new domains
- (3) Minimize impact on registration process flows

Approach	Advantages	Disadvantages
<p>(1) Registrant provides a pre-issued code to evidence authorization</p> <p>The registrant would be provided with an authorization code (“authcode”) as part of the process of registering their trademarks with the clearinghouse and/or confirming sunrise eligibility. The registrant would obtain this authcode in advance from the TMCH. The code is then offered to a registrar by the registrant for validation by the registry or the registrar as part of the sunrise domain registration process.</p> <p>The authcode will be verified as authentic and valid by either the registry or registrar.</p>	<ul style="list-style-type: none"> <li>▪ Simplifies the domain registration process by reducing the number of queries</li> <li>▪ Facilitates the ability to use agents to manage domain registration</li> <li>▪ Accommodates diverse design approaches for location and access to clearinghouse data</li> <li>▪ Reduces need to transmit live data</li> </ul>	<ul style="list-style-type: none"> <li>▪ Registrant must keep track of auth codes</li> <li>▪ Creates risk of authcode forgery, theft, or misappropriation</li> <li>▪ Authcodes may create a new sunrise challenge stemming from erroneous acceptance or rejection.</li> <li>▪ There is a cost to the clearinghouse associated with the systems and processes for authcode repudiation and re-issue</li> </ul>
<p>(2) Registrar queries the clearinghouse to verify authorization</p> <p>The sunrise registrar(s) would query against the clearinghouse as part of the processing of the registrant’s request and would confirm authorization at that time</p>	<ul style="list-style-type: none"> <li>▪ Simplifies the registrant experience</li> <li>▪ Effectively no change of behavior required for registrants</li> </ul>	<ul style="list-style-type: none"> <li>▪ Requires every participating registrar to implement clearinghouse subsystems</li> <li>▪ Requires registrars to have query access or a local cache of clearinghouse data and more complicated queries against that data</li> <li>▪ May not accommodate agent use scenarios where the agent differs from the clearinghouse registration record</li> </ul>
<p>(3) Registry queries the clearinghouse to verify authorization</p> <p>The registry would query against the clearinghouse as part of the processing the registrar’s request to register a domain.</p>	<ul style="list-style-type: none"> <li>▪ Simplifies the registrant experience</li> <li>▪ Fewer players impacted: While registries must implement changes, avoids technical implementations in large number of registrars</li> </ul>	<ul style="list-style-type: none"> <li>▪ Requires registries to have query access or a local cache of clearinghouse data and more complicated queries against that data</li> <li>▪ May not accommodate agent use scenarios where the agent differs from the clearinghouse registration record</li> </ul>

## Schedule:

- IAG Review – 15 Nov 2011
- IAG Recommendation – 31 Jan 2011

Priority: P4 (see Appendix 1, 2)

Issue: Community Audit/Logging/Compliance Requirements

Description: Complying with best practices and statutes for audit and compliance may require clearinghouse information to be retained or other reporting and audit mechanisms to be implemented. Clearinghouse processes should incorporate the community requirements for retention, publication, and disclosure of clearinghouse information, including audit and logging trails.

#### Business

Requirements\*:

- (1) Show effectiveness of TMCH in supporting rights protection mechanisms
- (2) Ensure excellence in technical operations
- (3) Foster productive community interaction
- (4) Identify gaps in policy and inform future discussions about trademark issues
- (5) Prevent misuse and/or abuse of the TMCH mechanisms
- (6) Ensure compliance with applicable statutes and regulations

\*There may be other objectives that could become specific requirements. For example:

1. Create Transparency
2. Accountability and investigation trail to support dispute resolution procedures

#### Approaches:

TBD. Requires additional input on community objectives.

#### Schedule:

- IAG Review – 15 Jan 2011
- IAG Recommendation – 30 Jan 2011

Priority: T1

Issue: Implementation: Data Locations (see Appendix 1, 2)

Description: The clearinghouse is expected to grow into a large database of information about trademarks and authorized contacts. When that information is needed during trademark claims service processing period, where will the data reside? What are the policies surrounding this data?

Requirements: (1) Avoid introduction of performance impacts that degrade domain name registration SLAs  
(2) Minimize erroneous decisions introduced by data update delays

Approach	Advantages	Disadvantages
(1) Locate data at clearinghouse only	<ul style="list-style-type: none"> <li>▪ Maintain maximum confidentiality controls</li> <li>▪ Only one party responsible and accountable</li> </ul>	<ul style="list-style-type: none"> <li>▪ Could introduce SLA problems for registries</li> <li>▪ Could make clearinghouse critical infrastructure for domain registration processes</li> <li>▪ Requires contingency process if clearinghouse is offline</li> </ul>
(2) Distribute clearinghouse data to registries, registrars, or both to minimize performance impacts	<ul style="list-style-type: none"> <li>▪ Highest performance</li> </ul>	<ul style="list-style-type: none"> <li>▪ Data synchronization and update delays could introduce errors</li> <li>▪ Multiple parties are responsible for the confidentiality and integrity of data</li> </ul>

Schedule:

- IAG Review – 15 Dec 2011
- IAG Recommendation – 31 Mar 2011

Priority: T2 (see Appendix 1, 2)

Issue: Implementation: Data Access

Description: In order to meet statutory and regulatory obligations, which data can be shared by the TMCH with registries, registrars and/or the public as part of the clearinghouse transaction? What implementation constraints should be incorporated into the clearinghouse design in order to ensure that community requirements on access restrictions are taken into account?

Requirements: (1) Limit information to a Need to Know basis  
 (2) Minimize performance impacts on the registration process  
 (3) Use of industry best practices for data encryption and protection  
 (4) A clear industry standard for how clearinghouse data is used

The following draft data classification table illustrates how requirements could be captured:

Data Use	Description			
Internal	Information is not published or distributed except as required by court orders			
Public	Information may be published or distributed without restriction			
Partner	Distribution is limited to specific parties. Clear text is available to recipients			
Restricted	Distribution is limited to specific parties. Clear text is not available to recipients			
Class of data	Internal	Public	Partner	Restricted
Trademarks (includes jurisdiction, class, and documentation)				
Mark Holder or Agent Contact Information				
Strings Potentially Registerable as Domain Names				
Domain Registrant Contact Information				
Authentication and Validation History				
Transactional Information				

Schedule:

- IAG Review – 15 Jan 2011
- IAG Recommendation – 31 Mar 2011

Priority: T3 (see Appendix 1, 2)

Issue: Implementation: Communication Protocols

Description: Protocol-level changes may be required to support specific clearinghouse models and functionality. For example:

- Querying TM Claimant Contact Information
- Receiving Domain Name Registrant Contact Information
- Receiving Notice Event Information
- Receiving Trademark Validation Status
- Receiving Registration Status Information

While it is expected that registrar-registry communications will continue to use EPP, this may require extensions to convey the additional information needed for Sunrise and Trademark Claims processes. The protocol(s) used to implement these data exchanges between the clearinghouse and registries or registrars are also a necessary decision point in designing the architecture.

Requirements: (1) Minimize the cost and impact of implementation on the existing framework and infrastructure of the domain name registration system wherever possible.

Approach	Advantages	Disadvantages
(1) Use EPP	<ul style="list-style-type: none"> <li>▪ EPP is already used in registrars and registries</li> <li>▪ EPP is designed for the "provisioning and management of objects stored in a shared central repository" – such as a trademark database</li> <li>▪ The protocol definition already includes guidelines for extending EPP, which would help to shape the technical discussions</li> </ul>	<ul style="list-style-type: none"> <li>▪ Once the protocol is extended, each registry or registrar that requires these extensions still must implement them.</li> <li>▪ The use of EPP may not necessarily be more cost effective to implement than the development and implementation of a different protocol</li> </ul>
(2) Use EPP and other Protocol(s)	<ul style="list-style-type: none"> <li>▪ Some required clearinghouse exchanges may fall neatly within other protocols and thus could leverage prior public implementation work in those protocols</li> </ul>	<ul style="list-style-type: none"> <li>▪ Some of the problems EPP has already addressed may include issues that will need to be solved for other protocols. This may result in some "re-inventing the wheel" in terms of protocol design and implementation effort</li> </ul>

Schedule:

- IAG Review – 15 Dec 2011
- IAG Recommendation – 31 Mar 2011

Priority: P2 (see Appendix 2)

Issue: Responsibility for Registrant Claims Notice

Description: The trademark claims service requires a registrant to be notified (prior to completing domain name registration) that a claim has been asserted for a colliding string associated with one or more marks registered in the clearinghouse. This notice allows the registrant to decide whether or not to proceed with the registration. The party responsible for transmitting these notices to the applicable recipient, and the data points contained in the notice, must be defined as part of completing the model.

#### Business

Requirements: (1) Notifications should be sent by a party that the registrant has an existing relationship with.  
(2) Transmission of notices must be verifiable.

Approach	Advantages	Disadvantages
(1) Registrar provides trademark claims notices to domain registrants	<ul style="list-style-type: none"> <li>▪ Communication with known party follows existing relationship</li> </ul>	<ul style="list-style-type: none"> <li>▪ Requires implementation at every participating registrar</li> <li>▪ May require EPP protocol enhancements</li> <li>▪ Registrar must have access to mark holder contact information</li> <li>▪ Difficult for clearinghouse or registry to verify that notice was sent</li> </ul>
(2) Registry provides trademark claims notices to domain registrants	<ul style="list-style-type: none"> <li>▪ Less work for the registry to verify that claims notices are sent to registrant</li> </ul>	<ul style="list-style-type: none"> <li>▪ Difficult for clearinghouse to verify that notice was sent</li> <li>▪ Registrant communication with a possibly unknown or unfamiliar party</li> <li>▪ Registry must have access to mark holder contact information</li> </ul>
(3) Clearinghouse provides trademark claims notices to domain registrants	<ul style="list-style-type: none"> <li>▪ Implementation primarily required with the clearinghouse (limited registrar to clearinghouse transmission implementation required)</li> <li>▪ Straightforward to demonstrate claims notices were transmitted</li> <li>▪ Reduces need for transmission of clearinghouse data</li> </ul>	<ul style="list-style-type: none"> <li>▪ Registrant communication with an unknown or at least unfamiliar party</li> <li>▪ Clearinghouse must be informed that trademark claims notice is required</li> <li>▪ Clearinghouse must receive domain name registrant information</li> </ul>

#### Schedule:

- IAG Review – 15 Nov 2011
- IAG Recommendation – 31 Jan 2011

Priority: P3 (see Appendix 2)

Issue: Responsibility for Trademark Holder Registration Notice

Description: After domain name registration has occurred within the period specified for the trademark claims service, a notification is to be sent to mark holders when the string that has been registered in a TLD collides with a mark registered in the clearinghouse. The party responsible for transmitting these notices to the applicable recipient must be defined as part of completing the model.

#### Business

Requirements: (1) Notifications should be sent by a party that the customer has an existing relationship with.  
(2) Transmission of notices must be verifiable

Approach	Advantages	Disadvantages
(1) Registry provides trademark claims notice to mark holder	<ul style="list-style-type: none"> <li>▪ Provides opportunity for registry to demonstrate compliance with contractual obligations</li> <li>▪ Avoids registrar and clearinghouse implementation of mark holder notification</li> </ul>	<ul style="list-style-type: none"> <li>▪ Mark holder receipt of communication from an unknown or unfamiliar party</li> <li>▪ Registry must receive mark holder info</li> <li>▪ Difficult for the clearinghouse to verify that notice was sent</li> </ul>
(2) Registrar provides trademark claims notice to mark holder	<ul style="list-style-type: none"> <li>▪ Registrar has the registrant contact info</li> <li>▪ Avoids registry and clearinghouse implementation of mark holder notification functions</li> </ul>	<ul style="list-style-type: none"> <li>▪ Mark holder receipt of communication from an unknown or unfamiliar party</li> <li>▪ Registrar must receive mark holder info</li> <li>▪ Difficult for the registry or clearinghouse to verify that notice was sent</li> <li>▪ All participating registrars must implement notice function</li> </ul>
(3) Clearinghouse provides trademark claims notices to mark holder	<ul style="list-style-type: none"> <li>▪ Clearinghouse has contact info for all existing mark holders</li> <li>▪ Clearinghouse has the business relationship with mark holder</li> <li>▪ Implementation primarily required by clearinghouse (implementing transmission of events occurring in the registry or registrar is still required)</li> <li>▪ Clearinghouse can reliably verify that claims notices were transmitted</li> </ul>	<ul style="list-style-type: none"> <li>▪ Clearinghouse must receive notification that domain registration occurred</li> <li>▪ May require implementation to ensure the registry can verify that notice was sent</li> </ul>

#### Schedule:

- IAG Review – 15 Dec 2011
- IAG Recommendation – 31 Jan 2011

Priority: P5 (see Appendix 2)

Issue: Responsibility to Perform Trademark Claims Checks

Description: For at least the first 60 days of general registration, trademark claims service must be in place in all new gTLDs. Claims service includes a query against the TMCH and – in the event of a collision with a registered string in the clearinghouse a notification must be sent. This notice includes information about each mark where there was a match. The party responsible for performing the claims check for the requested domain name must be defined as part of completing the model.

Performing this check early in the domain name registration process provides more opportunity for domain registrants to ensure that their registrations are clear of intellectual property encumbrances or to perform risk analysis prior to committing to a course of action.

Business

Requirements: (1) Contain the implementation cost/complexity  
 (2) Prevent degradation of the integrity, reliability, and performance of the existing domain name registration process  
 (3) Ensure notices are sent accurately and in a timely manner

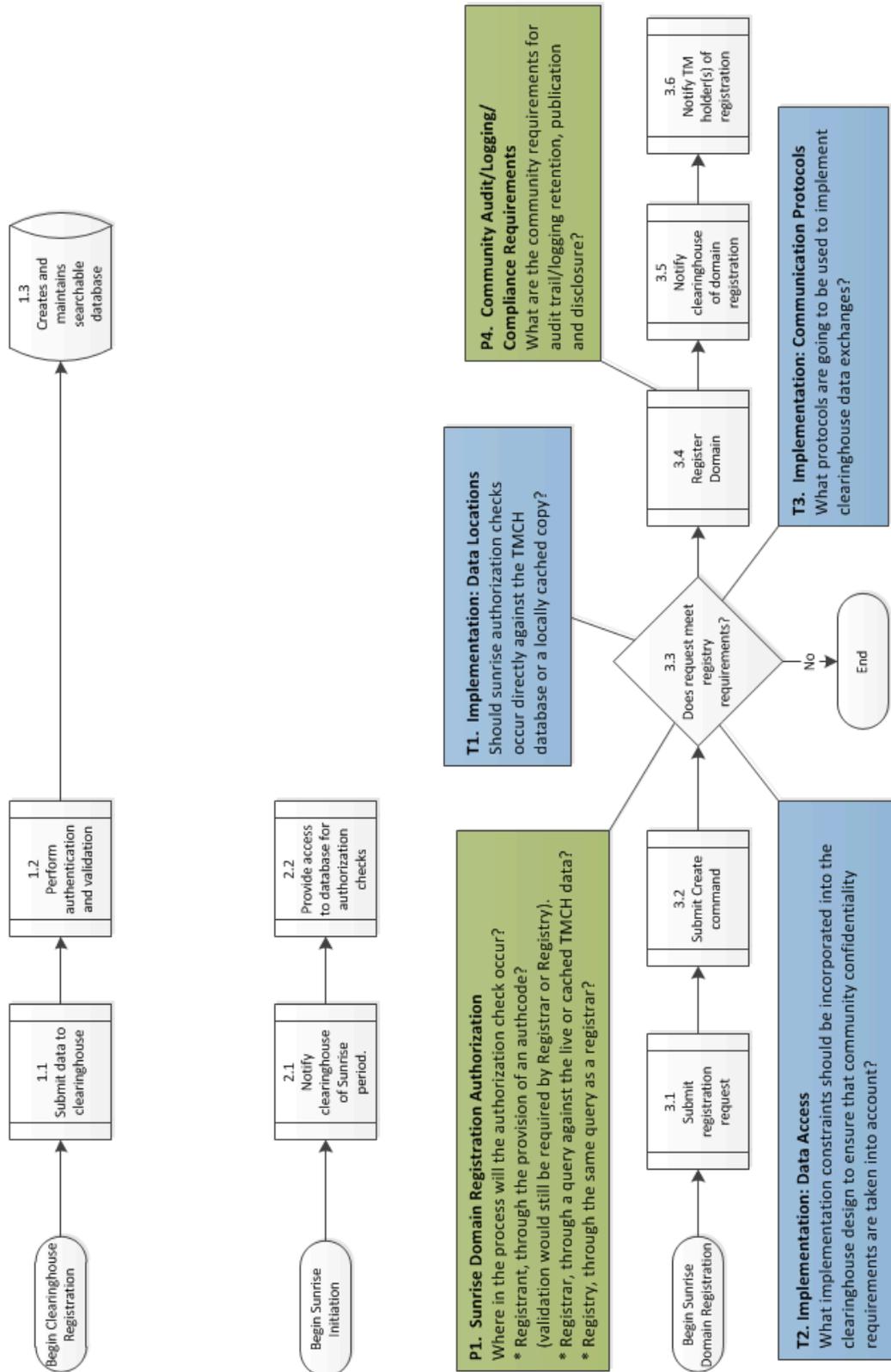
Approach	Advantages	Disadvantages
(1) Registry performs check	<ul style="list-style-type: none"> <li>▪ Registrars do not need to implement this functionality</li> </ul>	<ul style="list-style-type: none"> <li>▪ May require an EPP feature such as PENDING CREATE to implement.</li> <li>▪ May require extensions to EPP to implement</li> <li>▪ Registry SLA becomes dependent on TMCH SLA</li> <li>▪ Varying registry implementations may add complexity for registrars</li> </ul>
(2) Registrar performs check	<ul style="list-style-type: none"> <li>▪ Query takes place at point closest to domain name registration</li> </ul>	<ul style="list-style-type: none"> <li>▪ Potentially complicated to implement</li> <li>▪ May require EPP extensions</li> </ul>

Schedule:

- IAG Review – 15 Jan 2011
- IAG Recommendation – 31 Jan 2011

Appendix 1 – Generic Sunrise Process

Sunrise Process Model Draft



Appendix 2 – Generic Trademark Claims Process

Trademark Claims Process Model Draft

