ICANN 58
COMMUNITY FORUM

COPENHAGEN
11–16 March 2017

GNSO Review of All Rights Protection Mechanisms (RPMs) in All gTLDs Policy Development Process

Open Community Session ‖ 15 March 2017

Agenda for the session today

1 Overview of the PDP

2 Status update - where we are in Phase 1 of the PDP

3 Community discussion on Trademark Clearinghouse questions

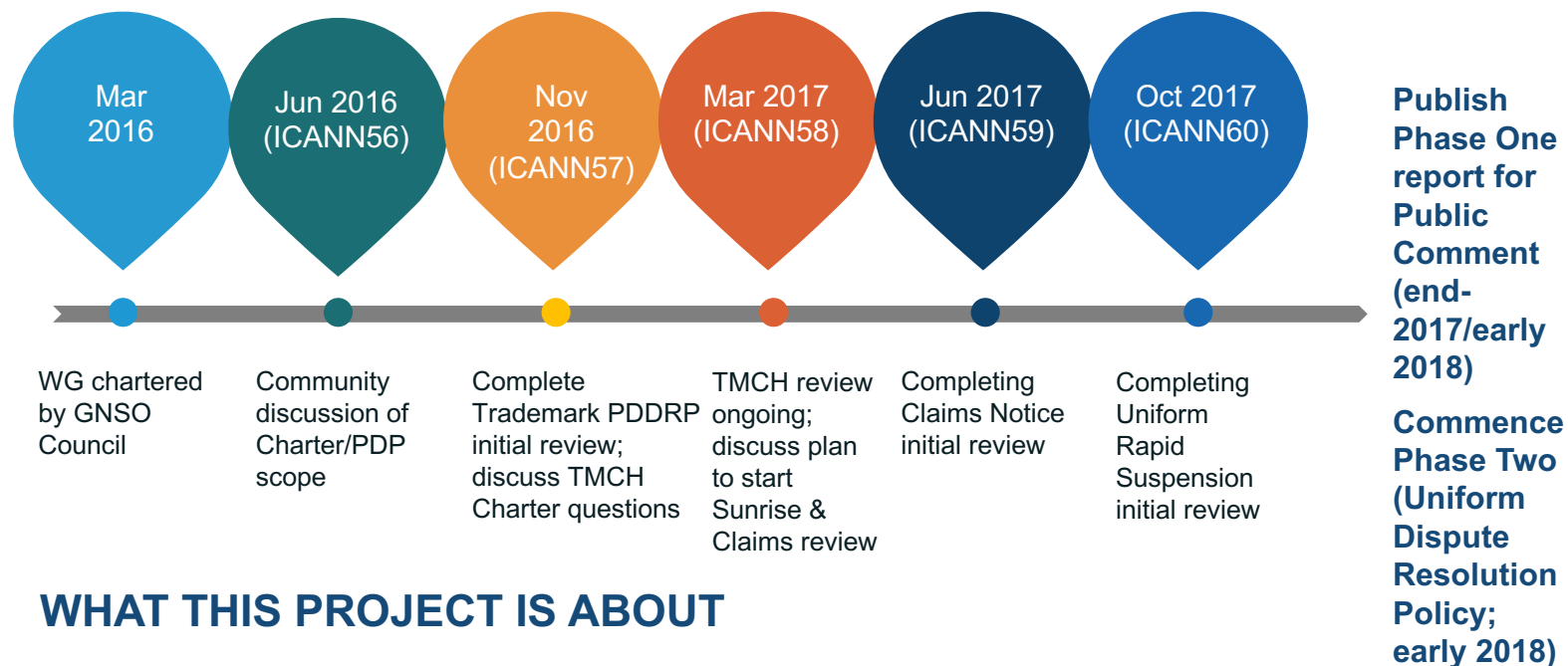**4** Community feedback on initial Charter questions for Sunrise & Claims

5 Next steps and PDP timeline

Overview of this PDP

- PDP Working Group chartered by GNSO Council to review <u>all existing ICANN trademark-related rights protection mechanisms (RPMs) in all gTLDs</u>, in two phases

    Phase One – all RPMs developed for the 2012 New gTLD Program:

    - *Trademark Clearinghouse (TMCH) and associated mandatory RPMs offered through it, i.e. Sunrise Registration Periods and Trademark Claims Notices*
    - *Uniform Rapid Suspension dispute resolution procedure (URS)*
    - *Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)*

    Phase Two – the Uniform Dispute Resolution Policy (UDRP)

- Ultimately, the PDP will examine the *"overarching question as to whether all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify the policy goals"*.

- Objective is also to create a coherent framework for future RPM reviews

Timeline for the PDP – being conducted in two phases

Mar 2016	Jun 2016 (ICANN56)	Nov 2016 (ICANN57)	Mar 2017 (ICANN58)	Jun 2017 (ICANN59)	Oct 2017 (ICANN60)
WG chartered by GNSO Council	Community discussion of Charter/PDP scope	Complete Trademark PDDRP initial review; discuss TMCH Charter questions	TMCH review ongoing; discuss plan to start Sunrise & Claims review	Completing Claims Notice initial review	Completing Uniform Rapid Suspension initial review

Publish Phase One report for Public Comment (end-2017/early 2018)

Commence Phase Two (Uniform Dispute Resolution Policy; early 2018)

WHAT THIS PROJECT IS ABOUT

This PDP was chartered by the GNSO Council to review all the Rights Protection Mechanisms (RPMs) that are currently in operation

- Phase One focuses on the RPMs created for the 2012 New gTLD Program
- Phase Two on the 1999 Uniform Dispute Resolution Policy (which applies to all gTLDs).

Status Update

- **PDP is currently in Phase One** – Working Group elected to begin work with review of the Trademark Post Delegation Dispute Resolution Procedure (TM-PDDRP)

- Working Group completed initial review of TM-PDDRP at ICANN57 (Nov 2016)

- **Current work**
  - For ICANN58 – continue initial review of Trademark Clearinghouse (TMCH)
  - Mid-April 2017 - begin review of Sunrise & Claims; followed by Uniform Rapid Suspension (URS) dispute resolution procedure

- Aim to **complete Phase One by end-2017/early 2018**
  - No projected date set yet for completion of Phase Two and full PDP

COMMUNITY DISCUSSION TOPIC #1
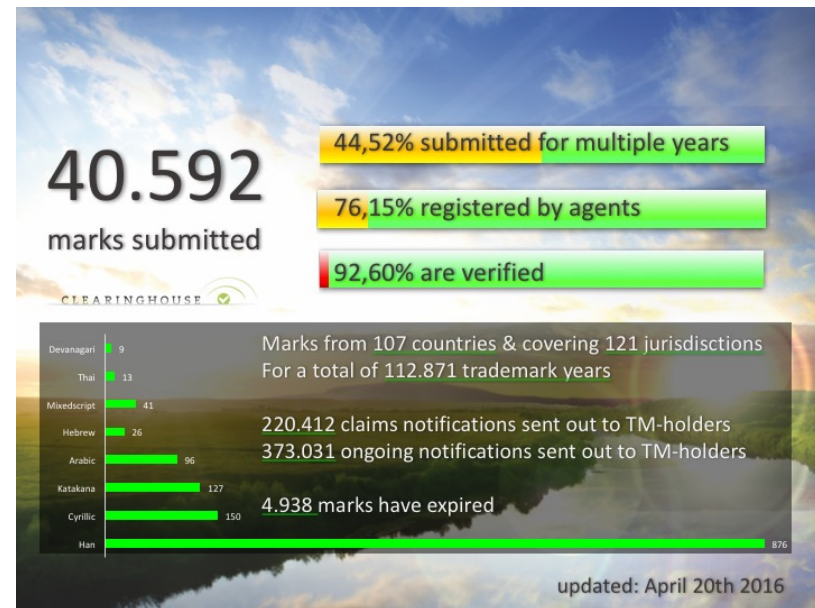
TMCH Charter Questions

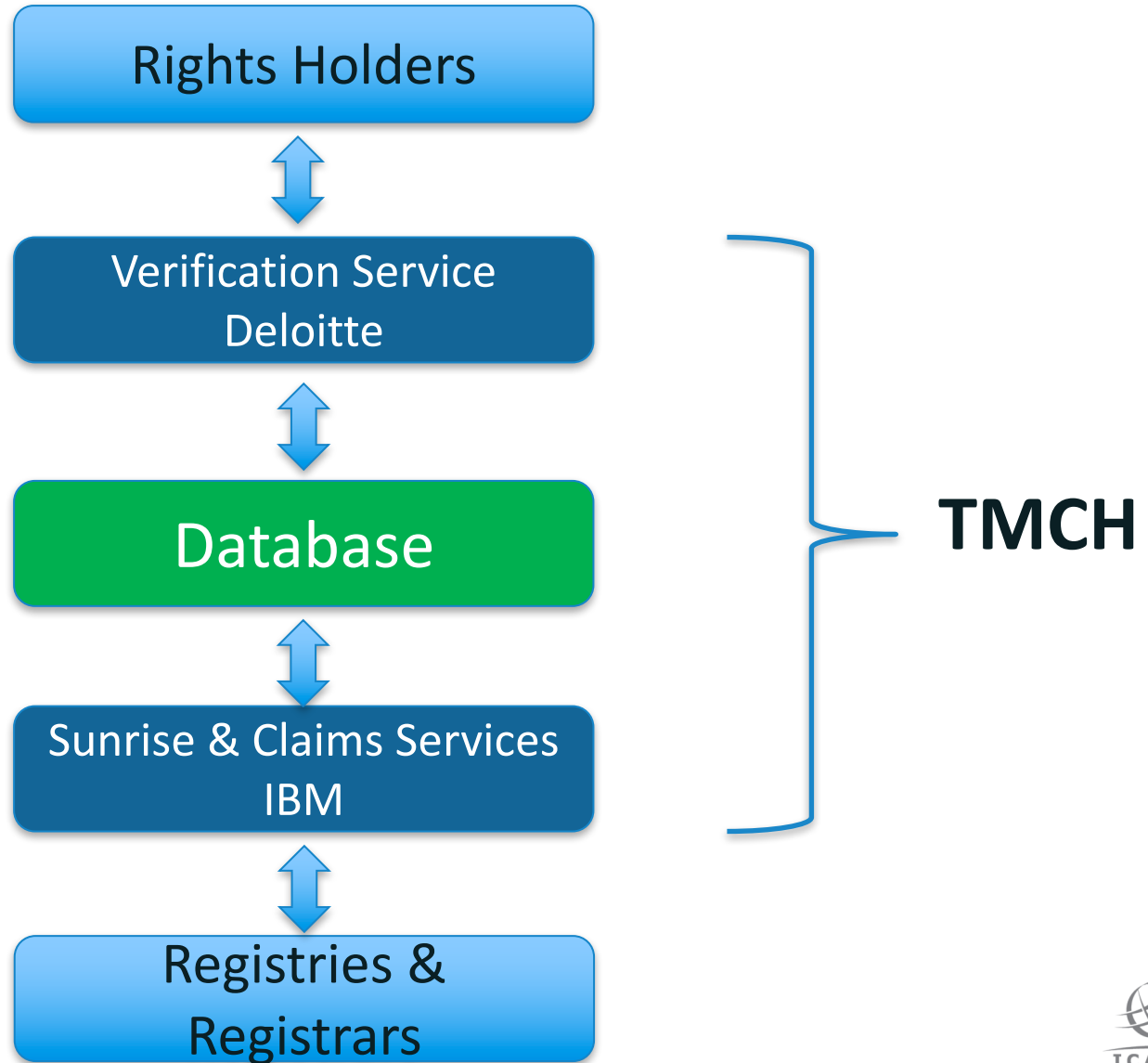# The Trademark Clearinghouse (TMCH)

- ◉ **What is it?**
  - ✓ Global database of verified trademark information
  - ✓ Supports Sunrise Registrations & Trademark Claims notice service
  - ✓ Verifies trademark data received – does <u>not</u> adjudicate or create TM rights

- ◉ **Key statistics:**
  - ✓ **90%** of submissions verified and included into TMCH
  - ✓ **92%** of verified submissions had marks verified for proof of use
  - ✓ As of August 2015, over **37,000 marks from 121 jurisdictions** had been submitted

40.592
marks submitted

CLEARINGHOUSE ✓

44,52% submitted for multiple years

76,15% registered by agents

92,60% are verified

Devanagari	9
Thai	13
Mixedscript	41
Hebrew	26
Arabic	96
Katakana	127
Cyrillic	150
Han	876

Marks from 107 countries & covering 121 jurisdisctions
For a total of 112.871 trademark years

220.412 claims notifications sent out to TM-holders
373.031 ongoing notifications sent out to TM-holders

4.938 marks have expired

updated: April 20th 2016

Trademark Clearinghouse Functions

Rights Holders

↕

Verification Service
Deloitte

↕

Database

↕

Sunrise & Claims Services
IBM

↕

Registries &
Registrars

TMCH

ICANN

42051 total trademark records submitted:

- 38172 successfully verified
- 27228 successfully verified to minimum Sunrise eligibility

41937 nationally or regionally registered trademarks submitted

- 38093 successfully verified

16 court-validated marks submitted

- 4 successfully verified

98 marks protected by statute or treaty submitted

- 75 successfully verified

Number of Previously Abused Labels ("TM+50"):

- 209 cases, 375 labels

Reviewing the TMCH – PDP Charter Questions (as refined by the Working Group)

Six categories:

- ⊙ Education
- ⊙ Verification & Updating of TMCH Database
- ⊙ Breadth & Reach (Scope)
- ⊙ Access &Accessibility
- ⊙ Costs & Other Fundamental Features
- ⊙ Balance

TMCH Review – Category 1: Education

1. Is the TMCH clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about recordals in the TMCH?

2. Should the TMCH be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the TMCH is not to be responsible, who should be?

3. What information on the following aspects of the operation of the TMCH is available and where can it be found?

a) TMCH services;

b) Contractual relationships between the TMCH providers and private parties; and

c) With whom does the TMCH share data and for what purposes

4. Should the verification criteria used by the TMCH to determine if a submitted mark meets the eligibility and other requirements of the TMCH be clarified or amended? If so how ?

5. Should there be an additional or a different recourse mechanism to challenge rejected submissions for recordals in the TMCH?

6. How quickly can and should a cancelled trademark be removed from the TMCH Database?

7. How are design marks currently handled by the TMCH provider?

8. How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?

9. Should the TM+50 be retained as is, amended or removed?

10. Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword' and/or common typos of a mark?

11. Should the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected?

12. Are there concerns about operational considerations (such as cost, reliability, global reach, service diversity and consistency) due to the TMCH Database being provided by a single Provider? If so, how may they be addressed?

13. Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the community and ICANN?

14. How accessible is the TMCH Database and RPM Rights Protection Actions and Defenses to individuals, organizations and rights-holders; as well as trademark agents in developing countries This word is used in the sense of asking whether the TMCH (its existence, purposes and how it is to be used) is known to the types of stakeholders mentioned?

15. What concerns are being raised about the TMCH Database being confidential, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain confidential or become open?

16. Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the rights of non-trademark registrants?

FOR FURTHER INFORMATION

Background to the PDP:

https://gnso.icann.org/en/group-activities/active/rpm

PDP Working Group Charter:

https://community.icann.org/x/2CWAAw

Working Group online wiki space (containing recordings and transcripts of all Working Group and Sub Team calls; draft documents and background materials):

https://community.icann.org/x/wCWAAw

COMMUNITY FEEDBACK:

PDP Charter Questions on Sunrise & Claims**

*** Some questions were moved by the Working Group to the TMCH category; the remaining questions will be refined by Sub Teams for discussion by the full Working Group*

ICANN

Sunrise Registrations (questions not yet refined by the Working Group)

1. Should the availability of Sunrise registrations only for "identical matches" (e.g. without extra generic text) be reviewed?

2. Is the notion of "premium names" relevant to a review of RPMs, and, if so, should it be defined across all gTLDs?

3. Following from Question 2, should there be a mechanism to challenge whether a domain is a 'premium name'?

4. Should there be a specific policy about the reservation and release of "reserved names" (e.g. modification of Section 1.3.3 of Specification 1 of the current Registry Agreement)?

5. Should there be a public, centralized list of all reserved trademarks for any given Sunrise period?

Sunrise Registrations (cont'd)

5. Should holders of TMCH-verified trademarks be given first refusal once a reserved name is released?

6. Should Sunrise periods continue to be mandatory? If so, should the current requirements apply or should they be more uniform, such as a 60-day end-date period?

7. Whether and how to develop a mechanism by which trademark owners can challenge Sunrise pricing practices that flout the purpose of Sunrise

8. Whether more can be done to improve transparency and communication about various Sunrise procedures

Trademark Claims Service (not yet refined by the Working Group)

1. Should the Trademark Claims period be extended beyond ninety (90) days?

2. Should the Trademark Claims period continue to apply to all new gTLDs?

3. Does a Trademark Claims period create a potential "chilling effect" on genuine registrations, and, if so, how should this be addressed?

4. Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services?

5. Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?

6. Is the TMCH and the Sunrise Period allowing key domain names to be cherry-picked and removed from New gTLDs unrelated to those of the categories of goods and services of the trademark owner (e.g., allowing "Windows" to be removed from a future .CLEANING by Microsoft)?

7. What is the effect of the 90-day Trademark Claims process?

ICANN

Thank you for your feedback!

Reach us at:
Email: policy-staff@icann.org
Website: http://gnso.icann.org

twitter.com/icann

soundcloud.com/icann

facebook.com/icannorg

weibo.com/ICANNorg

youtube.com/user/icannnews

flickr.com/photos/icann

linkedin.com/company/icann

slideshare.net/icannpresentations