**DRAFT QUESTIONS FOR ADDITIONAL MARKETPLACE RPMS SUB TEAM**

**4 AUGUST 2017**

Preliminary Note from the Co-Chairs:

Given this Working Group’s responsibility to consider the interplay between the RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency, it is the view of the Co-Chairs that the WG should undertake some notice and understanding of the additional marketplace RPMs that are being offered by registries or the TMCH as additions to the mandatory ICANN RPMs. We believe that market offerings provide additional information about the benefits and limitations of the RPMs, and that viewing the market holistically may spur better informed policy discussion within the WG.

Overall, ICANN-mandated RPMs should be considered in combination with additional marketplace offerings to fully understand the RPM ecosystem available to trademark holders. What we want to make clear at this time, and initiate discussion upon, is our collective determination that knowledgably answering the key Charter questions relating to the mandatory RPMs would benefit from some understanding and appraisal of the additional RPMs that have been made available in the marketplace.

From the TMCH review (Category 1, Question 3):

1. What information on the following aspects of the operation of the TMCH is available and where can it be found?
2. Ancillary services offered by the TMCH which are not mandated by the ICANN RPMs, including but not limited to:
3. the post-90 days’ ongoing notification service; and
4. other services in support of registry-specific offerings
5. With whom and under what arrangements does the TMCH share data, and for what non-mandated RPMs purposes[[1]](#footnote-1)?

In considering this Question (1) the Working Group should take into account and avoid duplicating other work undertaken by the Working Group in reviewing the TMCH. The Working Group should also distinguish between services related to the TMCH database and those provided by the TMCH validator.

1. \*\* Are registry operators relying on the results of the TMCH validation services, or accessing the TMCH database, to provide Additional Marketplace RPMs, and, if so, in what ways? Are these uses of the TMCH services or database by these registry operators permitted under ICANN’s current rules for the TMCH? [Is there language in the current adopted TMCH policy or related documents that expressly permits or prohibits [such use by registry operators]?] Are registry operators able to provide the same or similar Additional Marketplace RPMs without relying on the TMCH validation services or access to the TMCH database?  If so, what will be the increase in costs, if any, to stakeholders along the value chain (i.e. brand owners, registries, registrars, other registrants)?

\*\* SUB TEAM EXPLANATORY NOTE ON QUESTION 2:

The Sub Team’s discussion of this question resulted in agreement amongst most Sub Team members that the answer to the question as to whether, and how, some registry operators are relying on the TMCH validation services and/or accessing the TMCH database in order to provide Additional Marketplace RPMs is “Yes”. This is based on information provided by some registry operator members of the Sub Team as well as registry responses to a poll conducted by the Working Group in December 2016. The poll questions included the following: (1) Are you accessing data and records in the TMCH for purposes other than obtaining information necessary for the provision of Sunrise and Claims services in accordance with ICANN’s user manuals and technical requirements; and (2) Are you using any capabilities of the TMCH other than for Sunrise Periods and TM Claims Notices? Two registries (PIR and Afnic) responded “no” to both questions, while Donuts responded “Yes” to both (for (1), it was to verify Domains Protected Marks List (DPML) block requests, and for (2), it was to leverage SMD files as qualifiers for the DPML service[[2]](#footnote-2)).

The Sub Team is adding this Explanatory Note to provide information as to how the TMCH may be leveraged by some registry operators to offer Additional Marketplace RPMs, as it believes that even if the answer to the initial question is “Yes”, this is essential information for the rest of the Working Group.

Other questions proposed for consideration by the Working Group co-chairs:

1. What are each registry operator’s rules for each type of Additional Marketplace RPM it offers (noting that some new gTLD registry operators offer more than one version of a Protected Marks List service)[[3]](#footnote-3)?

* Where a trademark holder uses a Protected Marks List service (e.g. a blocking service) for one class of goods or services, are they able to block another rights-holder who holds the same trademark, but for a different class(es) of goods or services?
* Do all registry operators use the valid SMD File contained in the TMCH database as a condition for using Protected Marks List (e.g. blocking) services?

1. For registry operators that extended the Trademark Claims Service beyond the required 90 days, what has been their experience in terms of exact matches generated beyond the mandatory period[[4]](#footnote-4)?
2. How does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?
3. [PROPOSAL TO DELETE] What approval process (if any) from ICANN is required to offer these services; RSEP, other or none?

* Initial review of RSEP requests indicates that some Protected Marks List services were submitted for and received RSEP approval, while others did not request approval – what explains this difference?)

(Informational Note: Section 2.1 of the standard new gTLD registry agreement permits a registry operator to offer Registry Service that is an Approved Service, but requires it to request approval under the Registry Services Evaluation Policy (RSEP) if it wishes to offer any service that is not an Approved Service or is a material modification of an Approved Services. It is important for the WG to understand whether registry-offered RPMs, especially those based upon TMCH mark registrations, have been subject to any such approval review and, if so, what criteria were utilized in their evaluation).

1. How much and what manner of use does each registry operator make of proprietary data, whether derived from the TMCH or the trademark holder, in providing its Protected Marks List service (e.g. a blocking service)?
2. [PROPOSAL TO DELETE] Given the decision that ICANN should not provide a Globally Protected Marks List as a mandatory RPM, should the offering of Protected Marks List services (e.g. blocking services) be viewed as inconsistent with that decision, or as an expected and beneficial marketplace supplement? What options for the WG might exist and how might they be pursued?

About the role of the TMCH Providers:

1. What roles do the TMCH Providers play in the provision of Additional Marketplace RPMs by registry operators: both the front-end (Deloitte) and the back end (IBM)?
2. What role does the TMCH Provider (front-end) play in “servicing” the Additional Marketplace RPMs? For example:
   1. What website and webinar services is the TMCH Provider providing?
   2. What support to TM Owners and Registrants is the TMCH Provider providing?
   3. Are these services separated from the ICANN-mandated and supported services, and if so, how?
   4. Are these services supported by the ICANN contract and fees?

DEFERRED FOR FURTHER DISCUSSION AS TO ANY MISSING ISSUES THAT MAY NEED TO BE ADDRESSED IF THE QUESTION IS DELETED:

1. [Original Question 2] How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies and what services Deloitte and IBM provide to registries via private contract? Correspondingly, how can the Working Group and the public better understand what services Deloitte and IBM are offering to registries via private contract, e.g., private protections using the Trademark Clearinghouse database and special webinars about these private services? What changes might provide a clearer line?

1. Additional Marketplace RPMs are mechanisms offered by registry operators independent of the TMCH and not the same as “ancillary services” that may be offered by the TMCH provider. Ancillary services may be offered by the TMCH provider (see Section 1.4 of the TMCH description in Module 5 of the Applicant Guidebook (June 2012): “Trademark Clearinghouse Service Provider may provide ancillary services, as long as those services and any data used for those services are kept separate from the Clearinghouse database”); however, under Deloitte’s contract with ICANN any such “ancillary services” require ICANN’s consent. To date, only the provision of the post-90 days’ ongoing notification service has been approved by ICANN (for a description of this service, see <http://www.trademark-clearinghouse.com/content/ongoing-notifications>). [↑](#footnote-ref-1)
2. The questions and full results of the poll can be found on the Working Group wiki space here: <https://community.icann.org/download/attachments/61606228/Registry%20Responses%20to%20TMCH%20Data%20Sub%20Team%20-%2013%20Dec.pdf?version=1&modificationDate=1484721921000&api=v2>. [↑](#footnote-ref-2)
3. The Sub Team notes that this question is intended to allow for a compilation of all the various Additional Marketplace RPMs that have been offered in the 2012 New gTLD Program round. [↑](#footnote-ref-3)
4. The Sub Team notes that the previous formulation of this question asked about the number of registry operators that extended the Trademark Claims Service. The Sub Team believes that the data collection exercise that will be conducted as part of the Working Group’s review of the Trademark Claims Service will provide the relevant data in answer to this query. [↑](#footnote-ref-4)