

DRAFT QUESTIONS FOR ADDITIONAL MARKETPLACE RPMs SUB TEAM
Updated by ICANN staff as of [1 September 2017](#)

Deleted: 281 AUGUST

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 knowledgeably 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?
 - a) Ancillary services offered by the TMCH which are not mandated by the ICANN RPMs, including but not limited to:
 - i. the post-90 days' ongoing notification service; and
 - ii. other services in support of registry-specific offerings
 - b) With whom and under what arrangements does the TMCH share data, and for what non-mandated RPMs purposes¹?

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.

2. ** 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? Is there language in the current adopted TMCH policy or related documents that expressly permits, prohibits or otherwise addresses 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? Will there be an increase in costs? If so, what will this be to stakeholders along the value chain (i.e. brand owners, registries, registrars, other registrants)?

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>).

**** 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 service²).

Similarly, the Sub Team came to a similar conclusion in relation to the question about cost increases where a registry operator provides Additional Marketplace RPMs without relying on the TMCH’s validation services or accessing the TMCH database.

The Sub Team believes that even if the answer to these initial questions are “Yes”, the information and any additional input that may be provided as part of the responses will be useful to the Working Group.

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

3. 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?
 - 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?
 - What do registry operators impose as a condition for using Protected Marks List (e.g. blocking) services? For example, do they all use the valid SMD File contained in the TMCH database?
 - [How much and what manner of use does each registry operator make of \[proprietary data, whether derived data from the TMCH \[or the trademark holder\] in providing its Additional Marketplace RPMs?](#)
4. For registry operators that extended the Trademark Claims Service beyond the required 90 days, and for registrars who operated the extended service, what has been their experience in terms of

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-%202013%20Dec.pdf?version=1&modificationDate=1484721921000&api=v2>.

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.

exact matches generated beyond the mandatory period⁴? For example, in terms of registration volume and numbers of exact matches?

5. How does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?
6. [PROPOSAL TO DELETE] What approval process (if any) from ICANN is required to offer Protected Marks List (e.g. blocking) services: RSEP, other or none?
 - It appears that some Protected Marks List services were submitted for and received RSEP approval, while others did not request approval – factual information as to whether all such services must be submitted for ICANN approval will be helpful to assist the Working Group in understanding these Additional Marketplace RPMs, especially those Protected Marks List services that relied on the validation services of the TMCH provider or used the TMCH database. (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).
7. [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:

8. 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)?
9. What role does the TMCH Provider (front-end) play in “servicing” the Additional Marketplace RPMs? For example:
 - a. What website and webinar services is the TMCH Provider providing?
 - b. What support to TM Owners and Registrants is the TMCH Provider providing?
 - c. Are these services separated from the ICANN-mandated and supported services, and if so, how?
 - d. 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:

10. [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

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.

Comment [MW1]: NOTE FROM 4 AUGUST CALL: Sub Team members on the call agreed this is an Overarching Question for this topic; as such, this question can be marked as such and/or re-ordered in the final version of this document.
NOTE FROM 11 & 18 AUGUST CALLS: Question from Claudio di Gangi as to whether this question should more clearly indicate whether any data collection (e.g. of utilization of the Additional Marketplace RPMs) is needed.

Comment [MW2]: NOTE FROM 25 AUGUST CALL: Sub Team to consider amended language from Greg Shatan to REPLACE current phrasing with: **“Which Additional Marketplace RPMs were submitted for RSEP approval, and which Additional Marketplace RPMs were submitted to ICANN for some other form of approval?”**

Comment [MW3]: NOTE FROM 25 AUGUST CALL: Sub Team to consider whether to move this question out of main text and into archived section below, as “Deleted as being outside remit of the Sub Team but archived for Working Group information”.

Comment [MW4]: STAFF NOTE: We are not sure what this phrase means (e.g. supported by who)

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?

