**UPDATED SCOPING DOCUMENT FOR TMCH SUB TEAM – 22 JULY 2016**

1. **Suggestions for Data Sources**

* ICANN staff (GDD)
* TMCH Provider
* Analysis Group (TMCH Independent Examiner)

1. **Suggestions for Documents & Materials**

* ICANN Staff RPM Review Paper (September 2015): <http://newgtlds.icann.org/en/reviews/rpm/rpm-review-11sep15-en.pdf>
* Analysis Group’s Draft Report on the TMCH (publication expected on 25 July 2016)

1. **Suggestions for Questions/Topics for Meeting with Analysis Group**
2. What sorts of data did Analysis Group seek from the TMCH and what could they not obtain?
3. What documents/sources did they find most useful and what (if any) would they recommend that the Sub Team look at? (NOTE: This can include documents that are not included either in the report (including the bibliography and footnotes) and materials consulted in the course of researching the report)
4. **WG & Community Suggestions for Questions/Topics to be Addressed to the TMCH Provider[[1]](#footnote-1)**
5. How many marks were registered?
6. Where did the trademarks originate?
7. How many TM holders took advantage of TM+ 50?
8. How many used the extended registration service (notice of identical matches being registered past the sunrise and claims periods)?
9. How many trademarks were denied validation by the TMCH and for what reasons (by %)?[[2]](#footnote-2)
10. How quickly can a cancelled trademark be removed from the TMCH?[[3]](#footnote-3)
11. In relation to questions of procedure, was procedure followed correctly in all cases? In the case of deviations why were the deviations caused, who were the deviations helping?
12. How many domains were registered to users that were not the registered holder, and were: (a) eventually challenged by the TMCH claim holder, and (b) where ownership was then moved from the user that registered the domain to the claim holder?

(Exemplar time line: 1. Trademark holder registers claim at TMCH for "water". 2. Non Trademark holder accepts claim for the "water" trademark for the domain "water.guru". 3. Trademark holder files a complaint on the registration on the domain "water.guru". 4. Domain is moved from the non-trademark holder to the trademark holder)

1. How many private users are using the TMCH, particularly registries, and for what additional purposes?
2. Can you provide the updated Deloitte monthly activity reports to this group?
3. What additional data/information can we obtain (in aggregated form)?

Additional, More General Questions:

* How many cases have helped existing rights holders?
* How many cases have helped Internet users that do not own the rights at the time that they come to the TMCH?

**ANNEX A:**

**Sources of Data regarding the TMCH, as used for the 2015 ICANN Staff RPM Review Paper**

* *Source: Deloitte Monthly Trademark Activity Reports*
  + Number of jurisdictions, which a Mark has been submitted for
  + Number of dispute resolution cases related to the Trademark Clearinghouse
  + Number of Trademarks opting-in to Ancillary Services
  + Total number of Trademarks submitted
  + Total number of Verified Trademarks
  + Total number of Verified Trademarks submitted prior to the Sunrise period
  + Total number of Trademarks NOT verified
  + Total number of domain names/labels derived from those Trademarks
  + Total number of Verified Trademarks that are Sunrise Eligible
  + Total number of Verified Trademarks that are NOT Sunrise Eligible
  + Total number of Verified Trademarks now deactivated
  + Total number of Verified Trademarks that are Sunrise Eligible now deactivated
  + Total number of domain names/labels derived from those Trademarks
  + Total number of Verified Trademark Holders
  + Trademark Holders represented by Trademark Agents
  + Total number of Verified Trademark Agents
  + Trademark Agents & Holder failing e-mail verification
  + SLO Reporting
  + Total number Nationally or regionally Registered Trademarks
  + Total number of Trademarks validated by a court of law or judicial proceeding
  + Total number of Trademarks protected by statute or treaty
  + Any other Trademarks constituting intellectual property
  + # of TMCH records
  + # of Jurisdictions
  + # of Abused labels
  + Breakdown of scripts/languages represented
* *Source: Deloitte Ticket Summary Report* (not provided monthly to ICANN, but available upon request)
  + API Issues
  + Claims Notification Issue
  + Profile Management Issues
  + Sunrise File Issues
  + Sunrise Notification Issues
  + Trademark Management Issues
  + Other Issues
* *Source:* <http://trademark-clearinghouse.com/content/trademark-clearinghouse-fees>

<http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/trademarkclearinghouse_fee_structure_01-04-2015_2.pdf>

* + Fee structure for record inclusion in the TMCH
  + Costs for Abused Domain Name Label service

**ANNEX B**

1. **List of Charter Questions concerning the TMCH**
2. Should further guidance on verification guidelines for different categories of marks be considered?
3. Is the protection of the TMCH too broad? Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word? Should TM+50 be reversed?
4. Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
5. How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
6. Should the TMCH matching rules be expanded, e.g. to include plurals, ‘marks contained’ or ‘mark+keyword’, and/or common typos of a mark?
7. Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
8. How quickly can a cancelled trademark be removed from the TMCH?
9. How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies vs. what is offered to private New gTLD registries pursuant to private contracts?
10. Should there be a review on accessibility to TMCH for individuals, private trademark holders and trademark agents in developing countries?
11. How can the TMCH provide education services not only for trademark owners, but for the registrants and potential registrants who are equally impacted by their services?
12. **Additional Questions Suggested by the Community at ICANN56**
13. Does the TMCH provide avenues that are procedurally and substantively fair so effectively balance the rights of rights holders versus normal Internet users?
14. Does the TMCH create a tendency to perpetuate the status quo?
15. How accessible is the TMCH to reviewing accessibility for trademark agents in developing countries?
16. Should the TMCH remain a single provider or should we open it to different providers, of course with a central database that should be accessed by the different providers?
17. Are the costs of the TMCH, for rights holders, for ICANN, for the community proportionate to the benefits it provides?
18. How do we determine what is “good chilling effect” and “bad chilling effect” in relation to RPMs?
19. **Additional Questions Suggested by WG Members**
20. Are the fees reasonable?
    1. Why does the Basic Fee not apply to Agents, but only TM holders?
    2. What are the fee drivers? (or put another way, "what TMCH policy or implementation requirements affect the fees?")
    3. Can any of those requirements be eliminated or modified?
21. Should there be multiple TMCH Providers?
22. What % of contemplated domain name registrations were deterred due to the notices of a matching mark in the TMCH database? (note: registrars might have this information, e.g. via abandoned shopping carts for new gTLDs vs ccTLDs or legacy gTLDs)
23. Strength of the marks in the TMCH, i.e. what % are fanciful, vs. descriptive, generic, etc. (note: interest here is finding out whether a TMCH registration allows "weak" marks to gain some advantage, vs. the first-come first serve system)
24. Should there be a time limit on Claims notices? (query whether this should be considered under the TMCH review or the Claims Period review – interest here is finding out whether there is an increase in registrations after the Claims Notices end)
25. How many trademarks were denied validation by the TMCH and for what reasons (by %)?  Along with the other questions presented below, this will be helpful in evaluating whether existing TMCH rules/procedures produced desired (or other) results.
26. Also, per the gTLD Applicant Guidebook, trademarks containing a “dot” were not accepted by the TMCH.  Is this something we need to consider within our PDP given the New gTLD Subsequent Procedures PDP?
27. Should we draw any consequence from the fact that, as marks protected by statute or treaty, certain Geographical Indication (GIs) can be registered in the TMCH? In other words, once GIs have been admitted in the TMCH, one might argue that they are recognized as distinctive signs that deserve attention in the domain name system (sunrise periods, blocking domain services). If so, providing GIs with access to dispute resolution mechanisms – UDRP in particular – might be appropriate. In this respect, I share the point of view of the ones that, at the last meeting, considered that any improvement of other mechanisms cannot be considered in isolation from the UDRP.
28. Should the TMCH database be publicly accessible for transparency purposes?
29. Can we envisage to apply blocking registration and claims services also to misspellings or some variations of the marks contained in the TMCH?

1. WG members had also suggested surveying markholders who didn't register in the TMCH, to understand why, as well as registrars and registrants, to see whether TMCH match notices/warnings caused them undue pressure to not register names (i.e. a "chilling effect" due to the warnings). [↑](#footnote-ref-1)
2. Taken from the WG Charter. [↑](#footnote-ref-2)
3. Taken from the WG Charter. [↑](#footnote-ref-3)