Note: this is the a working document prepared by some members of the TMCH Subgroup seeking to understand charter questions better in order to facilitate the data-gathering tasks of the Subgroup. This is not intended to be an interpretation of the TMCH Charter and Helsinki questions, as that is the work of the full WG.

1. **List of Charter Questions concerning the TMCH**
2. Should further guidance on verification guidelines for different categories of marks be considered?

**Problem identification** – Need to identify the background leading to this question. Which TMCH-provided guidance was unclear or led to disparate treatment and which types of marks were affected?

**Proposed source for identification of problem** – Staff summary of comments on the staff rpm review and the draft issue report; current TMCH verification guidelines

**Data Request** – Might require a survey, out of scope for us.

1. 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?

**Source** - TMCH? Registries?

**Source** –TM community

**Data gathering** – Are there examples of Claims notices being received in relation to [[[generic]]] terms, the use of which is likely to have been generic in the context of the TLD, but where the registrant then did not proceed?

**Data Request** – What is the abandonment rate during the claims period vs the abandonment rate after the claims period?

**Source** - Registrars?

1. Should TM+50 be reversed?

**Problem identification** - Are there examples of terms included on a TM plus 50 list which were not sufficiently close to the trade mark and prevented a legitimate registration

What safeguards or criteria exist to provide reasonable limits on the TM+50

**Data gathering** – how many TMCH records include a +50 list; and how many are on this list on average?

How many claims notices have been sent for domains on a TM +50 list

How many of these resulted in the domain registration not proceeding?

**Data Request –** How many 50+ claims notices were issued? How many resulted in abandoned registrations?

**Source –** TMCH, Registrars

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

**See 2 above**

1. 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?

**Problem identification** - NB term “how should” is presumptive. Better expressed as “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? If so, how?”

Flows from 2 and 4 above – ie if a problem is identified, would limiting the scope for sunrise registrations be a means to address this?

**Data gather** – Has anyone ever proposed a solution to address limited sunrise registrations that are limited by goods and services?

* Have any gTLDs used the TMCH option to limit registrations by goods and services in a particular registration period?

1. Should the TMCH matching rules be expanded, e.g. to include plurals, ‘marks contained’ or ‘mark+keyword’, and/or common typos of a mark?

**Problem Identification** – Is there a significant level of TM-infringing domains which consist of “expanded matches”?

**Data gathering** – Are there examples of domains being registered by third parties which fall within the scope of the “expanded matching”, how does this compare to the overall registration levels in new gTLDs? Are there examples of trademark owners who were unable to secure a name during the sunrise (due to the narrow matching rules) and then unable to register in GA because the name was secured by someone else?

**Data Request** – Have there been URS/UDRP proceedings on mark + Keyword registrations? (Ask STAFF)

**Source** – Analysis Group Report (note this did not address mark + keyword); TMCH; zone file data? TM owners

1. Should there be an additional or a different recourse mechanism to challenge rejected trademarks?

**Problem Identification** – Need to identify the background leading to this question. What are the current TMCH recourse mechanisms for rejected marks and how are they perceived to be inadequate or unfair?

**Proposed source for identification of problem** – Staff summary of comments on the staff rpm review and the draft issue report; current TMCH process

**Data Request** – How many marks were rejected? What is a breakdown of the reasons?

1. How quickly can a cancelled trademark be removed from the TMCH?

**Data gathering** – what is the TMCH process (if any) relating to marks which are cancelled or expire: reactive (eg TM owner/agent obligations) and proactive, if any.

**Source** – TMCH

**Data gathering** – How many SMD files has the TMCH cancelled? How many TMCH disputes have been brought relating to SMD file validity for TMs which are cancelled/expired?

**Source** – TMCH

**Data gathering** – have there been any Sunrise DRPs relating to marks relied on at sunrise which had already expired or been cancelled?

**Source** – Registries

1. 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?

**Problem Identification** – Need to identify the background leading to this question. Appears to be saying – what is the TMCH doing as required in its contract with ICANN vs added value services which it is not obliged to offer, and can there be more transparency on whether these value-adds use the trademark data submitted for the purposes of the RPMs?

**Proposed source for identification of problem** – Staff summary of comments on the staff rpm review and the draft issue report

**[[[I think this is public information]]]**

1. Should there be a review on accessibility to TMCH for individuals, private trademark holders and trademark agents in developing countries?

**Problem Identification** – Need to identify the background leading to this question.

**Proposed source for identification of problem** – Staff summary of comments on the staff rpm review and the draft issue report

**Data gathering** – what is the geographic distribution of those who record marks in the TMCH – bearing in mind that TMCH agents may be in a different country to the TM owner and that TM owners may record a mark registered in a different country to the one they are based in.

**Data Request** – Percentage of Trademark registrations, sunrise registrations and claims notices sent by country / region?

**Source** - TMCH

1. 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?

**Data gathering** – What, if any, education services does the TMCH and/or ICANN provide. What are the contractual obligations for education imposed by ICANN, if any?

**Source** – TMCH, ICANN staff

**Data Request** – This requires a survey, out of scope for this sub-group.

1. **Additional Questions Suggested by the Community at ICANN56**
2. Does the TMCH provide avenues that are procedurally and substantively fair so effectively balance the rights of rights holders versus normal Internet users?

**Note** - Seems to be considering the issues referred to above at QA2-6 in particular.

1. Does the TMCH create a tendency to perpetuate the status quo?

**Note** – Not clear what this is asking

1. How accessible is the TMCH to reviewing accessibility for trademark agents in developing countries?

**Note** – See QA10

1. 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?

**Data gathering** – what are the costs of a TMCH registration. Are there any other examples of verification services (eg for registry launches pre-TMCH) which could be a comparator and might demonstrate whether the TMCH service is value for money.

1. Are the costs of the TMCH, for rights holders, for ICANN, for the community proportionate to the benefits it provides?

**Data gathering** – Cost for trademark owners of protecting their brands in the new gTLD space. Cost for registries to connect to the TMCH.

**Source** – Forthcoming ICANN/INTA survey of trademark owners. Registry fee to connect to TMCH; Average sunrise price increase compared to GA

1. How do we determine what is “good chilling effect” and “bad chilling effect” in relation to RPMs?

**Data gathering** – rate of abandonment in response to Claims notices compared to a normal abandonment rate

**Source** - Registrars

1. **Additional Questions Suggested by WG Members**
2. 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?

**Note** – see B4 above

1. Should there be multiple TMCH Providers?

**Note** – see B4 above

1. 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)

**Note** – see B6 above

1. 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)

**Note** - see section A above, and query can TMCH data identify % fanciful v descriptive vs generic?

1. 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)

**Note**  - This was within scope for the Analysis Group review, however their data was acknowledged to be inadequate to form a determination.

1. 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.

**Source** -TMCH

1. 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?

**Problem identification** – Question for the wider WG – Is there a perceived problem from not registering trademarks which include a dot? With current matching rules requiring exact match, the dot could not be registered at the second level.

1. 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.

**Problem identification** – Question for the wider WG – need to understand what is being asked here in relation to the TMCH

1. Should the TMCH database be publicly accessible for transparency purposes?

**Data gathering** – this was considered when the TMCH was proposed; consider the pros and cons considered then?

1. Can we envisage to apply blocking registration and claims services also to misspellings or some variations of the marks contained in the TMCH?

**Note** – See A6 above