

**TRADEMARK CLAIMS SUB TEAM - TABLE OF CHARTER QUESTIONS**

#	Original Charter Questions	Context	Sub Team Discussion	Additional Comments	Suggested Rewording
3.	Does a Trademark Claims <sup>1</sup> period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?	Discussed in several comments to the PDP Preliminary Issue Report (Oct 2015); one commentator suggested more data/metrics will be needed (referring to the Analysis Group report that had not yet been published at the time)	Suggest replacing “genuine” with “good faith”  Potentially applicable only to the Claims Notice and not the Notice of Registered Name?	<u>As of 21 April:</u> [KDorain] I think this goes with #5. Effects of claims, generally: scaring good faith registrants away? Valid deterrent against would-be bad actors? [KKleiman] Perhaps combine 3, 4, 5 and place before 1,2 (research first)?  <u>After 21 April:</u> [Staff] Analysis Group findings should be reviewed for these questions; Sub Team should identify additional data gaps/needs	[Consolidating Q3 & 5, and continued further below in Q1 & 2]  General Question: <ul style="list-style-type: none"> <li>• <b>Is the mandatory 90-day Trademark Claims period having the intended effect<sup>2</sup>? If not, or if there are unintended consequences, what should be adjusted, added or eliminated?</b></li> </ul> Specific Questions: <ul style="list-style-type: none"> <li>• <b>Does having a mandatory pre-registration Trademark Claims Notice create a potential</b></li> </ul>

<sup>1</sup> The Sub Team agrees that, as used in this list of Charter questions, the phrase “Trademark Claims” covers both the pre-registration Claims Notice that is sent to a prospective registrant who is attempting to register a domain name that matches a trademark label in the TMCH, and the post-registration Notice of Registered Name that is sent to the relevant rights-holder when the registrant proceeds to complete the registration.

<sup>2</sup> Refer to historical documentation including IRT Report and STI Recommendations.

					<p><b>“chilling effect” on good faith registrations?</b></p> <ul style="list-style-type: none"> <li>• <b>Does having a mandatory Claims service (as structured currently) deter bad faith registrations?</b></li> <li>• <b>Would any actual or potential “chilling effect” be reduced or minimized if the Claims period was of a shorter duration?</b></li> <li>• <b>If so, what would be the appropriate shorter period?</b></li> </ul>
5.	<p>What is the effect of the 90-day Trademark Claims process?</p>	<p>At least one comment to the PDP Preliminary Issue Report noted the need to review the topics/suggestions noted in the 2015 RPM Staff Paper as well as the specific questions from the PDP Preliminary Issue Report.</p>		<p>[Susan Payne] Not sure I understand the question, more background required? It appears to be a preliminary question about how the Claims works, but if so does this still need to be considered or do we all understand how the Claims works?</p>	<p>See above for suggested consolidated rewording.</p>

				<p>[KDorrain] Suggest discussing together with #3 about all effects. We can withhold value judgments for now (maybe). Is there a deterrent effect? Is it good, bad, or depends?</p>	
4.	<p>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)?</p>	<p>Suggested by one commentator to the PDP Preliminary Issue Report (Oct 2015).</p>		<p>As of 21 April: I would remove this question from CLAIMS and address in connection with the TMCH itself.</p> <p>[Susan Payne] Move - this is a question which has been somewhat aired in relation to the TMCH, and/or is in scope for Sunrise. On its face, it is not a question for the Claims.</p> <p>[KDorrain] Agree, this is not a claims question.</p> <p>[KKleiman] Seems to be a Sunrise Subgroup</p>	<p>NONE - Sub Team recommends MOVING this question to the overarching discussion by the full WG (Note: question may also come under consideration by Sunrise Sub Team)</p>

				question.  <u>After 21 April:</u>	
1	Should the Trademark Claims period be extended beyond ninety (90) days?	Supported by several comments to the RPM Staff Paper (Feb 2015); comments to the PDP Preliminary Issue Report (Oct 2015) included reminder that the various RPMs were the result of carefully negotiated compromise so changes will need to be thoroughly considered.	Follow up questions: <ul style="list-style-type: none"> <li>• If so, what would be appropriate?</li> <li>• If not, should the period be shortened?</li> <li>• Should the Claims period be uniform for all types of gTLDs?</li> </ul>	<u>After 21 April:</u>	[Continuing from Q3 & 5] <ul style="list-style-type: none"> <li>• <b>Conversely, should the Claims period be extended beyond 90 days?</b></li> <li>• <b>If so, what would be the appropriate duration?</b></li> </ul>
2.	Should the Trademark Claims period continue to apply to all new gTLDs?	Supported by several comments to the PDP Preliminary Issue Report (Oct 2015).	May need to clarify if this means “for all subsequent rounds” or something else	<u>As of 21 April:</u> [KDorrain] This can be reviewed together with #1. The idea of *if* there should be a claims period segues directly into “under what terms” such as “how long” and “for which TLDs.”  <u>After 21 April:</u>	<ul style="list-style-type: none"> <li>• <b>Should there be a mandatory Trademark Claims period (comprising a pre-registration Claims Notice and a post-registration Notice of Registered Name) for all subsequent</b></li> </ul>

					<p>rounds?</p> <ul style="list-style-type: none"> <li>Should the Claims period be uniform for all types of gTLDs in subsequent rounds?</li> </ul>
	<p>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? Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?</p>			<p>As of 21 April: [KKleiman] this question got dropped in the transfer from charter to table. Particularly the second part of the questions seems relevant to TM Claims evaluation.</p>	<p>NONE - this question had been moved previously to the TMCH section.</p>

---

#	General Charter Questions	Sub Team Discussion	Additional Comments	Proposal: Add (with appropriate edits)? Y/N
---	---------------------------	---------------------	---------------------	---

1	Do the RPMs work for registrants and trademark holders in other scripts/languages, and should any of them be further “internationalized” (such as in terms of service providers, languages served)?		KDorrain: In which languages are claims notices presented? Who decides? If this is not common knowledge, then I think this may be a threshold question.	
2	Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?	K Dorrain: As a bit of pre-work, before the WG gets to Claims, I suggest that sub team experts attempt to put together a bulleted list answering this question to avoid the long threaded discussions on the email list. This list should be created by the registrants who feel their freedom of expression is inadequately protected, or their representatives.	KDorrain: This is subsumed in Qs 3 and 5 and the WG should balance registrant protection with consumer protection.	
3	Have there been abuses of the RPMs that can be documented and how can these be addressed?		[Susan Payne] I think this is a question that should be borne in mind throughout the WG deliberations, including Claims KDorrain: +1	
4	Examine the protection of country names and geographical indications, and generally of indications of source, within the RPMs		[Susan Payne] we are discussing GIs in relation to what can be recorded in the TMCH. Depending on that, it may be necessary to go on to consider treatment under Sunrise and Claims	

5	In the light of concrete cases (case law) and from the perspective of owners of protected signs and of marks, which are the identified deficits of the RPMs?	K Dorrain: As a bit of pre-work, before the WG gets to Claims, I suggest that sub team experts attempt to put together a bulleted list answering this question to avoid the long threaded discussions on the email list. This list should be created by the owners of protected signs and marks, or their representatives.	[Susan Payne] I think this is a question that should be borne in mind throughout the WG deliberations, including Claims	
6	Are recent and strong ICANN work seeking to understand and incorporate Human Rights into the policy considerations of ICANN relevant to the UDRP or any of the RPMs?		KDorrain: Can anyone supply an example of how Claims would suppress Human Rights?	
7	Are there any barriers that can prevent an end user to access any or all RPMs?		[Susan Payne] I think this is a question that should be borne in mind throughout the WG deliberations, including Claims	
8	How can costs be lowered so end users can easily access RPMs?		[Susan Payne] I think this is a question that should be borne in mind throughout the WG deliberations, including Claims	
<b>Specific Questions regarding Service Providers:</b>				

1 .	Are the processes being adopted by Providers of UDRP, URS, and TMCH services fair and reasonable?			
2 .	Are the Providers' procedures fair and equitable for all stakeholders and participants?			
3 .	Are the Providers consulting with all stakeholders and participants in the evaluation, adoption and review of these new procedures?			
4 .	Are the Providers training both the Complainants and the Respondents, and their communities and representatives, fairly and equally in these new procedures?			
5 .	Are Providers exceeding the scope of their authority in any of the procedures they are adopting?			
6 .	Is ICANN reaching out properly and sufficiently to the multi-stakeholder community when such procedures are being evaluated by ICANN at the Providers' request? Is this an open and transparent process? expeditiously and fairly created?			
7 .	What changes need to be made to ensure that procedures adopted by providers are consistent with the			



	ICANN policies and are fair and balanced?			
8	What remedies exist, or should exist, to allow questions about new policies by the Providers offering UDRP, URS and TMCH services, and how can they be expeditiously and fairly created?			
9	Assess the benefit of the Arbitration Forums self-reviews, including the <i>WIPO Advanced Workshop on Domain Name Dispute Resolution, May 2015</i> [italics in original], in which inconsistencies of decisions, including in the free speech/freedom of expression area were candidly discussed and contemplated	1.	2.	
<b>Over-arching Questions for the Overall PDP:</b>				
1	Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed?			

2 .	Should any of the New gTLD Program RPMs (such as the URS), like the UDRP, be Consensus Policies applicable to all gTLDs, and if so what are the transitional issues that would have to be dealt with as a consequence?			
3 .	Whether, and if so to what extent, changes to one RPM will need to be offset by concomitant changes to the others			