**SUMMARY TABLE – REVIEW OF AGREED TRADEMARK CLAIMS CHARTER QUESTIONS AND RELATED DATA**

*Prepared by ICANN staff for use by the proposed new Trademark Claims Review Sub Team*

| **LIST OF FINAL AGREED TRADEMARK CLAIMS CHARTER QUESTIONS[[1]](#footnote-1)** | **RELEVANT AG CLAIMS SURVEY RESULTS** | **RELEVANT DATA REVIEWED PREVIOUSLY[[2]](#footnote-2)** | **SUB TEAM POLICY/OPERATIONAL FIX RECOMMENDATIONS (for WG discussion)** |
| --- | --- | --- | --- |
| Q1  Is the Trademark Claims service having its intended effect? Consider the following questions specifically in the context both of a Claims Notice as well as a Notice of Registered Name:   1. Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing notice to domain name applicants? 2. Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications? | **Summary**  The AG survey results assist in answering this question, including both of its sub questions (a) and (b):   1. The Trademark Claims service is clearly having its intended effect of providing Claims Notice to domain name applicants. The Trademark Claims service may be having its intended effect of deterring bad-faith registrations to some extent, as there is evidence that the Claims Notice does affect the applicant’s decision whether or not to proceed with a registration. Nevertheless, there is no data indicating whether these applicants are limited to only “bad faith” registration. 2. The Trademark Claims service may have unintended consequences, such as deterring good-faith domain name applications, due to the collateral damage caused by its confusing and/or intimidating wording perceived by some potential and actual registrant respondents. Notably, the abandonment rate of non-ICANN-experienced potential and actual registrant respondents seem to be materially higher than those involved in ICANN. Other unintended consequences include the reduced publicity for the marks that are being protected or the conflicting domains that are being registered, negative impacts to Registry Operator and Registrar respondents.   **Data (See:** [**Survey Analysis Tool**](https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWlPZt0yyNF-Vs1qmUuIjg/edit?usp=sharing)**)**  Actual & Potential Registrants tab: cells D-E-F12-27  Registrant - Q11b tab  Registrant - Q11c tab  TM & Brand Owners tab: F50-52, F81  Registry - Q26 tab: cells B8-14  Registry - Q28 tab: cells D-E-G-H-I-J5-7  Registrar - Q10 tab: cells D6-8  Registrar - Q11 tab: cells A7, A25, B6-8, D5  **Details** <https://docs.google.com/document/d/1A5PSNNrAFS2bFvNoMFx-5DQUNhXpnocOrEbT1XL480E/edit?usp=sharing>  **Sub Team Discussion:** [19 December 2018](https://community.icann.org/x/QAj_BQ)**,** [2 January 2019](https://community.icann.org/x/lwj_BQ), [9 January 2019](https://community.icann.org/x/mQj_BQ) |  |  |
| Q2  If the answers to 1.a. is “no” or 1.b. is “yes”, or if it could be better: What about the Trademark Claims Notice and/or the Notice of Registered Name should be adjusted, added or eliminated in order for it to have its intended effect, under each of the following questions?   1. Should the Claims period be extended - if so, for how long (up to permanently)? 2. Should the Claims period be shortened? 3. Should the Claims period be mandatory? 4. Should any TLDs be exempt from the Claims RPM and if so, which ones and why? 5. Should the proof of use requirements for Sunrise be extended to include the issuance of TMCH notices? | **Summary**  The AG survey results assist in answering the sub questions (a), (b), (c), and (e):  (a) The Claims period should be extended, preferably on a permanent basis, based on most, if not all trademark and brand owner responses. Some Registry Operator and Registrar respondents support an extended Claims period, including a “perpetual” length.  (b) The Claims period should not be shortened based on most, if not all, trademark and brand owner responses. The Claims period should be shortened based on the majority of Registry Operator and Registrar responses. Nevertheless, there is no data showing substantial inappropriate deterrent effect of the period on actual and potential registrants.  (c) The Claims period should be mandatory based on most, if not all, trademark and brand owner responses. It should not be mandatory based on the majority of Registry Operator and Registrar responses.  (e) Some Registry Operator responses imply the desire of extending the proof of use requirements for Sunrise to include the issuance of TMCH notices due to overly generic terms.  The survey results do not assist in answering the sub question (d).  **Data (See:** [**Survey Analysis Tool**](https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWlPZt0yyNF-Vs1qmUuIjg/edit?usp=sharing)**)**  Registries & Registrars tab: cells D-H60-62, F29, F31, F-G63-66, F81, G74  Registry - Q26 tab: cells B8-14  Registry - Q28 tab  Actual & Potential Registrants tab: cells E-F12-27  TM & Brand Owners tab: D-G45-55, F84-85  **Details**  <https://docs.google.com/document/d/1hvt63HvVdNdYIZxKVMXHq3fIEFxfnweT0F3ZXsJU_Q8/edit?usp=sharing>  **Sub Team Discussion:** [23 January 2019](https://community.icann.org/x/ngj_BQ) |  |  |
| Q3  (a) Does the Trademark Claims Notice to domain name applicants meet its intended purpose?   1. If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved? 2. Does it inform domain name applicants of the scope and limitations of trademark holders’ rights? If not, how can it be improved? 3. Are translations of the Trademark Claims Notice effective in informing domain name applicants of the scope and limitation of trademark holders’ rights?   (b) Should Claims Notifications only be sent to registrants who complete domain name registrations, as opposed to those who are attempting to register domain names that are matches to entries in the TMCH? | **Summary**  The AG survey results assist in answering this question, including all of its sub questions (a), (a)(i), (a)(ii), (a)(iii), and (b):  (a) The Claims Notice to domain name applicants seems to fall short of meeting its intended purpose, although there is evidence that the Claims Notice does affect the applicant’s decision whether or not to proceed with a registration.  (a)(i) The Claims Notice seems intimidating and hard understand to the majority of actual and potential registrant respondents, implying the need for improvement. Some registrar respondents hold the same opinion. Trademark and brand owner respondents have mixed responses on its adequacy.  (a)(ii) The Claims Notice does not seem to adequately inform domain name applicants of the scope and limitations of trademark holders’ rights based on many actual and potential registrants’ responses. Some registrar respondents hold the same opinion.  (a)(iii) There are issues with regard to translations of the Claims Notice in informing domain name applicants of the scope and limitation of trademark holders’ rights. Some Registrar respondents do not translate the Claims Notice into all of the languages that they use when doing business with new gTLD registrants. As the survey data shows that the Claims Notice does not work well in the language in which it was initially drafted, it is implied that it would unlikely be more comprehensible in translation.  (b) The majority of trademark and brand owner respondents think the Claims Notice should be sent to registrants who are attempting to register domain names that are matches to entries in the TMCH. Registrar respondents have mixed opinions, but half think that the Claims notice should be sent to registrants when they proceed to check out the domain names. Some Registar respondents report challenges regarding sending the Claims Notice for pre-order names, including expired Claims Notice and order flow issues. Registry Operator respondents mostly find that Claims Notice would not add too much cost.  **Data (See:** [**Survey Analysis Tool**](https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWlPZt0yyNF-Vs1qmUuIjg/edit?usp=sharing)**)**  Actual & Potential Registrants tab: cells D-E-F12-27  Registrant - Q11 tab  Registrant - Q11b tab  Registrant - Q11c tab  Registry & Registrars tab: cell D-F56, G70, G72, G74, G67-68, G75  Registry - Q26 tab  TM & Brand Owners tab: cells F50-55, F56  TM Owner - Q27 tab  **Details**  <https://docs.google.com/document/d/1WLE91cg73avpWHkzczNCnxw1ALWyhWqGZOnnrmqTsH4/edit?usp=sharing>  **Sub Team Discussion:** [16 January 2019](https://community.icann.org/x/nAj_BQ), [23 January 2019](https://community.icann.org/x/ngj_BQ) |  |  |
| Q4  Is the exact match requirement for Trademark Claims serving the intended purposes of the Trademark Claims RPM? In conducting this analysis, recall that IDNs and Latin-based words with accents and umlauts are currently not serviced or recognized by many registries.   1. What is the evidence of harm under the existing system? 2. Should the matching criteria for Notices be expanded? 3. Should the marks in the TMCH be the basis for an expansion of matches for the purpose of providing a broader range of claims notices? 4. What results (including unintended consequences) might each suggested form of expansion of matching criteria have? 5. What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications? 6. What is the resulting list of non-exact match criteria recommended by the WG, if any? 7. What is the feasibility of implementation for each form of expanded matches? 8. If an expansion of matches solution were to be implemented:    1. Should the existing TM Claims Notice be amended? If so, how?    2. Should the Claim period differ for exact matches versus non-exact matches? | **Summary**  The AG survey results assist in answering its sub question (a). Trademark and brand owner responses indicate that there is evidence of harm under the existing exact match system. Examples include the constraints of registering a company mark including a ‘Co’, as well as limitations in deterring potential bad faith registration of confusingly similar names, creative misspelling, combination of exact match with other terms/charters, etc. Consequently, Trademark and brand owner respondents have to pursue greater enforcement actions.  The survey results do not assist in answering the other sub questions. Nevertheless, Trademark and brand owner respondents overwhelming desire expanded matches (answer to sub question (b)); the anecdotal evidence cited above (sub question (a)) supports this idea.  **Data (See:** [**Survey Analysis Tool**](https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWlPZt0yyNF-Vs1qmUuIjg/edit?usp=sharing)**)**  TM & Brand Owners tab: cells F9, F55, F66-68, F70-73, F80-81  Registry - Q29a tab: cell A7  Actual & Potential Registrants: G12, E13, G19, F27  **Details**  <https://docs.google.com/document/d/1WBfc0bWkylDY4Ijr2I_-5hRjnYKPDjSYw9DQnlh7WHY/edit?usp=sharing>  **Sub Team Discussion:** [23 January 2019](https://community.icann.org/x/ngj_BQ) |  |  |
| Q5  Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds? | **Summary**  The AG survey results assist in answering this question. Registry Operator responses seem to indicate that Registry Operators would likely be neutral with respect to a uniform Trademark Claims period for all types of gTLDs in subsequent rounds. Registrar responses seem to indicate that they may not desire a uniform Trademark Claims period. Registry Operator and Registrar responses show that: (1) Trademark Claims period is not uniform at present, (2) there is flexibility desire to add non-trademarks in some geoTLDs, (3) there are varying opinions on the ideal length of the Claims period, possibly due to consideration of operating cost/technical burden.  **Data (See:** [**Survey Analysis Tool**](https://docs.google.com/spreadsheets/d/1aBw-dW2gBzvBfhUgl3u6ShWlPZt0yyNF-Vs1qmUuIjg/edit?usp=sharing)**)**  Registries & Registrars tab: cells F31, F59, F60, G65, F61, G63-64, G78, F79, F81, F84-85  TM & Brand Owners tab: cell F84  TM Owner - Q27 Tab: rows 5, 8, 9  TM Owner - Q27a tab: column A  Registries & Registrars tab: cells D-F30-31, D-F54, C-F59-66  Registry - Q26 tab  Registry - Q28 tab  Registry - Q29 tab  Registry -Q29a tab  Registrar-Q4i tab  Registrar - Q10 tab  Registrar - Q11 tab  **Details**  <https://docs.google.com/document/d/1mzlgFxnIeG1zrJGKap0zllmQaKfu4U3UMuSp8FhcYc8/edit?usp=sharing>  **Sub Team Discussion:** [23 January 2019](https://community.icann.org/x/ngj_BQ) |  |  |

**APPENDIX**

**Data available to date:**

* Analysis Group Revised Report on the TMCH (February 2017): <https://community.icann.org/download/attachments/64066042/Analysis%20Group%20Revised%20TMCH%20Report%20-%20March%202017.pdf?version=1&modificationDate=1490349029000&api=v2>
  + Analysis Group responses to questions from the Working Group:
    - June 2017: <https://mm.icann.org/pipermail/gnso-rpm-wg/2017-June/002043.html>
    - July 2017: <https://mm.icann.org/pipermail/gnso-rpm-wg/2017-July/002257.html>
* Registry Operator responses to initial survey from TMCH Data Gathering Sub Team (December 2016): <https://community.icann.org/download/attachments/64066042/Registry%20Responses%20to%20TMCH%20Data%20Sub%20Team%20-%2013%20Dec.pdf?version=1&modificationDate=1485897782000&api=v2>
  + RPM Data Sub Team meeting with Jon Nevett, Donuts (March 2018): <https://community.icann.org/download/attachments/79438928/Transcription%20ICANN61%20GNSO%20RPM%20Data%20Sub%20Team%20Meeting%2010%20March%202018.pdf?version=1&modificationDate=1521579214000&api=v2>
* Deloitte responses to initial questions from TMCH Data Gathering Sub Team (January 2017): <https://community.icann.org/download/attachments/64066042/Deloitte%20responses%20to%20TMCH%20Data%20Gathering%20Sub%20Team%20questions%20-%20Jan%202017.docx?version=1&modificationDate=1485897782000&api=v2>
  + Follow up questions from Working Group (March 2017): <https://community.icann.org/download/attachments/64066042/Follow%20Up%20Questions%20for%20Deloitte%20-%20updated%205%20March%202017.docx?version=1&modificationDate=1488753827000&api=v2> and <https://community.icann.org/download/attachments/64066042/Deloitte%20Follow%20Up%20Questions%20Annex%20-%204%20March%202017.docx?version=1&modificationDate=1488752114000&api=v2>
  + Deloitte response to follow up questions (April 2017): <https://community.icann.org/download/attachments/64066042/Deloitte%20Follow%20Up%20Questions%20Annex%20-%204%20March%202017.docx?version=1&modificationDate=1488752114000&api=v2>
  + Deloitte numbers report as discussed with the Working Group at ICANN58 (March 2017): <https://community.icann.org/download/attachments/64066042/Deloitte%20Follow%20Up%20Questions%20Annex%20-%204%20March%202017.docx?version=1&modificationDate=1488752114000&api=v2>
* INTA cost impact survey: <https://community.icann.org/download/attachments/69277722/INTA%20New%20gTLD%20Cost%20Impact%20Study%20Presentation%20-%2030%20Aug.pdf?version=1&modificationDate=1504147055000&api=v2> and <https://urldefense.proofpoint.com/v2/url?u=https-3A__community.icann.org_download_attachments_61606864_INTA-2520Cost-2520Impact-2520Report-2520revised-25204-2D13-2D17-2520v2.1.pdf-3Fversion-3D1-26modificationDate-3D1500376749000-26api-3Dv2&d=DwMGaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpCIgmkXhFzL7ar9Qfqa0AIgn-H4xR2EBk&m=MLOyWdAdSdj4cRa39aHRCVYsVa9ub30XpFPLr1fc51I&s=KXW3vtHBAKxxiT4X6sLxZQO2dlKSW8Zc-BhfZ1t7lAA&e>
* ICANN Org-maintained list of Registry Operators and relevant dates for Sunrise, Trademark Claims and other specific approved program periods (e.g. Limited Registration Periods, Qualified Launch Programs): <https://newgtlds.icann.org/en/program-status/sunrise-claims-periods>
* Analysis Group Sunrise & Trademark Claims survey results:
  + Inception Report (September 2018): <https://community.icann.org/download/attachments/90771305/9.6.2018%20Inception%20Report.pdf?version=1&modificationDate=1536257221000&api=v2>
  + Final Report (October 2018): <https://community.icann.org/download/attachments/90773066/Final%20ICANN%20RPM%20Survey%20Report%202018.10.18.pdf?version=1&modificationDate=1540302625000&api=v2>
  + All data files reported: <https://community.icann.org/pages/viewpage.action?pageId=90771305>
  + Analysis Group response to follow up questions (November 2018): <https://community.icann.org/download/attachments/99483940/Questions%20%26%20Comments%20-%20Final%20Report%20RPM%20Survey%20-%20AG%20comments.pdf?version=1&modificationDate=1543271647000&api=v2>

Additional sources suggested previously:

* Articles from DNS industry and trademark-related blogs touching on Sunrise and Trademark Claims (list of suggested blogs posted at <https://community.icann.org/display/RARPMRIAGPWG/2017-08-16+Review+of+all+Rights+Protection+Mechanisms+%28RPMs%29+in+all+gTLDs+PDP+WG>)
* News articles and research on Sunrise and Trademark Claims from Lexis-Nexis (or similar) databases

Other potential sources:

* Metrics reports from ICANN Org relevant to Competition, Consumer Protection & Consumer Trust Reviews: <https://www.icann.org/resources/reviews/cct/metrics> (includes updated data on IDN gTLDs, Sunrise and UDRP & URS decisions)

1. For the actual text of the proposed refined questions submitted by the Trademark Claims Charter Questions Sub Team to the full Working Group, please see the accompanying Status of TMCH & Related RPM Discussions summary document also circulated by ICANN staff (3 December 2018). Between the date of the Sub Team’s report and the submission of a Working Group data request to the GNSO Council in September 2017, the Working Group discussed the Sub Team’s suggestions for refining the original Charter questions as well as for data collection. [↑](#footnote-ref-1)
2. See attached Appendix for a list of the data collected and reviewed by the Working Group to date. [↑](#footnote-ref-2)