

ICANN
COMMUNITY FORUM

64

KOBE

9–14 March 2019



Working Session of the GNSO Review of All Rights Protection Mechanisms in gTLDs PDP Working Group



Sunday, 10 March 2019

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Introduction

- ⦿ This two-phased PDP was launched in February 2016, and the WG [charter](#) approved by the GNSO Council in March 2016.
- ⦿ The WG has completed its review of the Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP), as well as the structure and operations of the Trademark Clearinghouse (TMCH), although several remaining questions have been deferred pending review of the Sunrise and Claims RPMs that are offered through the TMCH.
- ⦿ The GNSO Council approved a data collection exercise to obtain quantitative & anecdotal information from various groups to assist with the Working Group review of the Sunrise and Trademark Claims services offered through the TMCH.

Introduction

- ⦿ ICANN Org commissioned Analysis Group, Inc. to develop and administer professional surveys in close collaboration with the Data Sub Team
- ⦿ Survey field period: 6 September - 5 October 2018.
- ⦿ Following a report from Analysis Group at ICANN63, the WG formed two Sub Teams – Trademark Claims Sub Team and Sunrise Sub Team – to analyze the survey data, previously collected data, and additional data sources to see if they can help answer the agreed Sunrise and Trademark Claims questions.
- ⦿ At ICANN64 the Sub Teams are presenting to the WG the summary reports of their discussions and comments on the data.

Trademark Claims Sub Team Data Review

Disclaimer

- ⦿ The Trademark Claims Sub Team reviewed the following data sets with a view toward answering the agreed questions:
 - Analysis Group’s Sunrise & Claims survey results;
 - Previously collected data prior to the Analysis Group surveys; and
 - Additional data submitted in February 2019.

- ⦿ Slides provide a very high level summary of the comments and discussions by Sub Team members:
 - 2nd row: a very high-level summary of whether each data set had relevant information;
 - 3rd row: a very high-level summary of Sub Team members’ comments and discussions;
 - “Not Applicable” refers to the situation where the data reviewed do not really assist in answering the agreed question; and
 - Agreed questions with no data assisting in answering are colored in orange.

- ⦿ This information is provided in much greater detail in the Summary Tables distributed prior to ICANN64.

Trademark Claims Agreed Question 1

Is the Trademark Claims service having its intended effect?

(a) Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing Claims Notice to domain name applicants?

(b) Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|--|--|
| Assist in answering (a), (b) | Assist in answering (a), (b) | Assist in answering (b) |
| (a) Maybe having its intended effect to some extent (b) Maybe having unintended consequences | (a) Maybe having its intended effect (b) Maybe having unintended consequences | (b) Maybe having unintended consequences |

Trademark Claims Agreed Question 2

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?

- (a) Should the Claims period be extended - if so, for how long (up to permanently)?
- (b) Should the Claims period be shortened?
- (c) Should the Claims period be mandatory?
- (d) Should any TLDs be exempt from the Claims RPM and if so, which ones and why?
- (e) Should the proof of use requirements for Sunrise be extended to include the issuance of TMCH notices?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|--|--|
| Assist in answering (a), (b), (c), (e) | Assist in answering (a), (b), (c) | Assist in answering (c) |
| (a) Mixed opinions (b) Mixed opinions (c) Mixed opinions (e) Registry Operators desire extending the proof of use requirements | (a) Mixed opinions (b) Trademark owners believe Claims period should not be shortened (c) Trademark owners believe Claims period should be mandatory | (c) Issues related to the TMCH may be a factor to consider |

Trademark Claims Agreed Question 3

- (a) Does the Trademark Claims Notice to domain name applicants meet its intended purpose?
- (i) If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved?
- (ii) Does it inform domain name applicants of the scope and limitations of trademark holders' rights? If not, how can it be improved?
- (iii) 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?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|---|--|
| Assist in answering (a), (a)(i), (a)(ii), (a)(iii), (b) | Assist in answering (a), (a)(i), (a)(ii) | Assist in answering (a), (a)(ii) |
| (a) Falls short of meeting its intended purpose (a)(i) Intimidating & hard to understand (a)(ii) Not adequate (a)(iii) Issues with translation (b) Mixed opinions | (a) Falls short of meeting its intended purpose (a)(i) Intimidating & hard to understand (a)(ii) Not adequate | (a) Issues related to the TMCH may be a factor to consider (a)(ii) A proposal for Claims Notice rewrite submitted |

Trademark Claims Agreed Question 4

Is the exact match requirement for Trademark Claims serving the intended purposes of the Trademark Claims RPM?

- (a) What is the evidence of harm under the existing system?
- (b) Should the matching criteria for Notices be expanded?
 - (i) 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?
 - (ii) What results (including unintended consequences) might each suggested form of expansion of matching criteria have?
 - (iii) What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?
- (iv) What is the resulting list of non-exact match criteria recommended by the WG, if any?
- (c) What is the feasibility of implementation for each form of expanded matches?
 - (d) If an expansion of matches solution were to be implemented:
 - (i) Should the existing TM Claims Notice be amended? If so, how?
 - (ii) Should the Claim period differ for exact matches versus non-exact matches?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|--|--|
| Assist in answering (a), (b) | Assist in answering Q4, (b), (b)(i), (b)(iv), (c) | Assist in answering (a), (b) |
| (a) There is evidence of harm (b) Trademark owners desire matching criteria expansion | (Q4) Maybe serving its intended purposes (b) Mixed opinions (b)(i) Marks in the TMCH may not be the basis (b)(iv) Spelling variations, plural & charter removal typos (c) Maybe not feasible | (a) Issues related to the TMCH may be a factor to consider (b) High number of Claims Notice generated & issues related to the TMCH may be a factor to consider; consider “scaling back” the matching criteria |

Trademark Claims Agreed Question 5

Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|--|-----------------|
| Assist in answering Q5 | Assist in answering Q5 | Not Applicable |
| (Q5) Currently not uniform; mixed opinions on uniformity: Registry Operators may be neutral; Registrars may not desire uniformity | (Q5) Currently not uniform; may be difficult to enforce uniformity | |

Sunrise Sub Team Data Review

Disclaimer

- ⦿ The Trademark Claims Sub Team reviewed the following data sets with a view toward answering the agreed questions:
 - Analysis Group’s Sunrise & Claims survey results;
 - Previously collected data prior to the Analysis Group surveys; and
 - Additional data submitted in February 2019.

- ⦿ Slides provide a very high level summary of the comments and discussions by Sub Team members:
 - 2nd row: a very high-level summary of whether each data set had relevant information;
 - 3rd row: a very high-level summary of Sub Team members’ comments and discussions;
 - “Not Applicable” refers to the situation where the data reviewed do not really assist in answering the agreed question; and
 - Agreed questions with no data assisting in answering are colored in orange.

- ⦿ This information is provided in much greater detail in the Summary Tables distributed prior to ICANN64.

Sunrise Agreed Question 1

- (a) Should the availability of Sunrise registrations only for identical matches be reviewed?
(b) If the matching process is expanded, how can Registrant free expression and fair use rights be protected and balanced against trademark rights?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|---------------------------|--|
| Somewhat assist in answering (a) | Assist in answering (a) | Assist in answering |
| (a) Should not be only for identical matches | (a) Mixed opinions | (a) Issues related to the TMCH and anecdotes about actual/potential abuses of Sunrise TMCH may be a factor to consider |

Sunrise Agreed Question 2

- (a) Does Registry Sunrise or Premium Name pricing practices unfairly limit the ability of trademark owners to participate during Sunrise?
(b) If so, how extensive is this problem?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|---|-----------------|
| Assist in answering (a), (b) | Assist in answering (a), (b) | Not Applicable |
| (a) Premium Name pricing unfairly limited the ability of trademark owners to participate in Sunrise (b) An extensive problem | (a) Premium Name pricing unfairly limited the ability of trademark owners to participate in Sunrise (b) An extensive problem | |

Sunrise Agreed Question 3

- (a) Should Registry Operators be required to create a mechanism that allows trademark owners to challenge the determination that a second level name is a Premium Name or Reserved Name?
- (b) Additionally, should Registry Operators be required to create a release mechanism in the event that a Premium Name or Reserved Name is challenged successfully, so that the trademark owner can register that name during the Sunrise Period?
- (c) What concerns might be raised by either or both of these requirements?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|---|-----------------|
| Assist in answering (a), (b), (c) | Assist in answering (a), (b) | Not Applicable |
| (a) Trademark owners believe Registry Operators should be required to create such mechanism (b) Trademark owners believe Registry Operators should be required to create a release mechanism (c) Registry Operators may have concerns about less flexibility in Reserved Names | (a) Trademark owners believe Registry Operators should be required to create such mechanism (b) Trademark owners believe Registry Operators should be required to create a release mechanism | |

Sunrise Agreed Question 4

- (a) Are Registry Operator Reserved Names practices unfairly limiting participation in Sunrise by trademark owners?
- (b) Should Section 1.3.3 of Specification 1 of the Registry Agreement be modified to address these concerns?
- (c) Should Registry Operators be required to publish their Reserved Names lists -- what Registry concerns would be raised by that publication, and what problem(s) would it solve?
- (d) Should Registry Operators be required to provide trademark owners in the TMCH notice, and the opportunity to register, the domain name should the Registry Operator release it – what Registry concerns would be raised by this requirement?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|---------------------------|-----------------|
| Assist in answering (a), (b), (c), (d) | Assist in answering (a) | Not Applicable |
| (a) Reserved Names practice limited Sunrise participation (b) Section 1.3.3 may require modification (c) Mixed opinions (d) Mixed opinions | (a) Mixed opinions | |

Sunrise Agreed Question 5(a)

Does the current 30-day minimum for a Sunrise Period serve its intended purpose, particularly in view of the fact that many registry operators actually ran a 60-day Sunrise Period?

- (i) Are there any unintended results?
- (ii) Does the ability of Registry Operators to expand their Sunrise Periods create uniformity concerns that should be addressed by this WG?
- (iii) Are there any benefits observed when the Sunrise Period is extended beyond 30 days?
- (iv) Are there any disadvantages?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|--|-----------------|
| Assist in answering (a), (i), (ii),(iii), (iv) | Assist in answering (a), (iii), (iv) | Not Applicable |
| (a) Maybe serving its intended purpose (i) There are unintended results (ii) Uniformity concerns should be addressed (iii) Benefits for trademark owners (iv) Disadvantages to Registry Operators / Registrars | (a) Maybe serving its intended purpose (iii) Benefits for trademark owners (iv) Longer Sunrise might not result in more trademark owners registering | |

Sunrise Agreed Question 5(b)

In light of evidence gathered above, should the Sunrise Period continue to be mandatory or become optional?

(i) Should the WG consider returning to the original recommendation from the IRT and STI of Sunrise Period OR Trademark Claims in light of other concerns, including freedom of expression and fair use?

(ii) In considering mandatory vs optional, should Registry Operators be allowed to choose between Sunrise and Claims (that is, make ONE mandatory)?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|--|--|
| Assist in answering (b), (i), (ii) | Assist in answering (b), (i), (ii) | Assist in answering (b), (ii) |
| <p>(b) Trademark owners believe Sunrise should continue being mandatory</p> <p>(i) WG may consider returning to the original recommendations</p> <p>(ii) Registry Operators prefer Sunrise and Claims to be optional, slight preference for Sunrise to be mandatory (if has to)</p> | <p>(b) Mixed opinions</p> <p>(i) WG may consider returning to the original recommendations</p> <p>(ii) Registry Operators should be allowed to choose between Sunrise and Claims</p> | <p>(b) Issues related to the TMCH and anecdotes about actual/potential abuses of Sunrise may be a factor to consider</p> <p>(ii) Information shared during WG June 2017 Johannesburg meeting may be relevant</p> |

Sunrise Agreed Question 6

- (a) What are Sunrise Dispute Resolution Policies (SDRPs), and are any changes needed?
- (b) Are SDRPs serving the purpose(s) for which they were created?
- (c) If not, should they be better publicized, better used or changed?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|--|-----------------|
| Not Applicable | Assist in answering (a), (b), (c) | Not Applicable |
| (a)-(c) However, survey results suggest possible recommendations to solve problems related to Sunrise through SDRP | (a) Changes may be needed to make SDRPs more well-known, understood, effective (b) SDRPs do not seem to serve the purposes for which they were created (c) SDRPs should be better publicized, better used or changed | |

Sunrise Agreed Question 7

- (a) Can SMD files be used for Sunrise Period registrations after they have been canceled or revoked?
- (b) How prevalent is this as a problem?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|-----------------------|---|-----------------|
| Not Applicable | Assist in answering (a), (b) | Not Applicable |
| | (a) While SMD files may still conceivably work, they cannot be used if underlying trademarks have been canceled or revoked (b) Not a prevalent problem | |

Sunrise Agreed Question 8

- (a) Are Limited Registration Periods in need of review vis a vis the Sunrise Period? Approved Launch Programs? Qualified Launch programs?
- (b) Are the ALP and QLP periods in need of review?
- (c) What aspects of the LRP are in need of review?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|---|--|
| Assist in answering (a), (b), (c) | Assist in answering (a), (b), (c) | Assist in answering (a), (b), (c) |
| <p>(a) Limited Registration Periods are in need of review, particularly the ALP</p> <p>(b) ALP and QLP periods are in need of review</p> <p>(c) Lack of clarity/understanding, conflict between locally protected terms and TMCH, eligibility issues, locally-targeted TLD, IDN, ICANN staff process, GEO TLDs, overly generic strings</p> | <p>(a) Limited Registration Periods are in need of review</p> <p>(b) ALP and QLP periods are in need of review</p> <p>(c) “Slow approval” process</p> | <p>(a) Limited Registration Periods are in need of review, particularly the ALP</p> <p>(b) ALP periods are in need of review</p> <p>(c) ICANN staff approval process</p> |

Sunrise Agreed Question 9

In light of the evidence gathered above, should the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|---------------------------|---|
| Assist in answering Q9 | Assist in answering Q9 | Assist in answering Q9 |
| (Q9) Sunrise Registration may be limited to the categories of goods and services for which the trademark is actually registered | (Q9) Mixed opinions | Issues related to the TMCH and anecdotes about actual/potential abuses of Sunrise may be a factor to consider |

Sunrise Agreed Question 10

Explore use and the types of proof required by the TMCH when purchasing domains in the sunrise period.

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|--|--|
| Not Applicable | Assist in answering Q10 | Not Applicable |
| (Q9) However, trademark and brand owner respondents provided information on how many TMCH records had proof of use submitted, as well as the reasons why proof of use was not submitted | (Q9) Deloitte is accepting the proof of use and has clearly defined verification process and online manual; the range of samples accepted by TMCH is intended to be flexible | (Q9) Issues related to the TMCH and anecdotes about actual/potential abuses of Sunrise may be a factor to consider |

Sunrise Agreed Question 11

- (a) How effectively can trademark holders who use non-English scripts/languages able to participate in Sunrise (including IDN Sunrises)?
- (b) Should any of them be further “internationalized” (such as in terms of service providers, languages served)?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|--|--|
| Assist in answering (a), (b) | Assist in answering (a), (b) | Assist in answering (a), (b) |
| (a) Some trademark and brand owners cannot effectively use non-English scripts/languages to be able to participate in Sunrise (b) Service providers and languages served may be further “internationalized” | (a) Trademark holders who use non-English scripts/languages may not be able to effectively participate in Sunrise (b) Somewhat related -- expansion of IDN-related matching criteria (e.g., IDN matches for ä, ö, ü). | (a)-(b) Information shared during WG June 2017 Johannesburg meeting may be relevant |

Sunrise Agreed Question 12

- (a) Should Sunrise Registrations have priority over other registrations under specialized gTLDs?
- (b) Should there be a different rule for some registries, such as certain types of specialized gTLDs (e.g. community or geo TLDs), based on their published registration/eligibility policies? Examples include POLICE.PARIS and POLICE.NYC for geo-TLDs, and WINDOWS.CONSTRUCTION for specialized gTLDs.

| Analysis Group Survey | Previously Collected Data | Additional Data |
|---|--|---|
| Assist in answering (a), (b) | Assist in answering (a), (b) | Assist in answering (a), (b) |
| (a) Sunrise Registrations should not have priority over other registrations under specialized gTLDs (b) Mixed opinions | (a) Sunrise Registrations should not have priority over other registrations under specialized gTLDs (b) There may be a different rules for some registries based on their published registration/eligibility policies | (a)-(b) Information shared during WG June 2017 Johannesburg meeting and Issues related to the TMCH and anecdotes about actual/potential abuses of Sunrise may be a factor to consider |

Sunrise Preamble Agreed Question

- (a) Is the Sunrise Period serving its intended purpose?
- (b) Is it having unintended effects?
- (c) Is the TMCH Provider requiring appropriate forms of “use” (if not, how can this corrected)?
- (d) Have abuses of the Sunrise Period been documented by trademark owners?
- (e) Have abuses of the Sunrise Period been documented by Registrants?
- (f) Have abuses of the Sunrise Period been documented by Registries and Registrars?

| Analysis Group Survey | Previously Collected Data | Additional Data |
|--|--|--|
| Assist in answering (a), (b), (c), (d) | Assist in answering (a), (b), (c), (d), (e), (f) | Assist in answering (b), (d), (e), (f) |
| (a) Maybe serving its intended purpose (b) Has unintended effect (c) Not a major issue (d) There is abuse by Registry Operators | (a) Maybe serving its intended purpose (b) Has unintended effect (c) Deloitte requires appropriate forms of use (d-f) There is abuse by Registry Operators; no concrete evidence of abuse by trademark owners | (b) Has unintended effect (d-f) There is actual/potential abuse by registrants, trademark owners, Registry Operators taking advantage of the TMCH |

Thank You and Questions

Timeline/Next Steps

Sub Teams:

10 Mar-03 Apr – Develop Preliminary Recommendations

10 Apr-01 May – Discuss Individual Proposals

08-15 May – Discuss Modifications of Preliminary Recommendations based on Individual Proposals

Full WG:

22 May-12 Jun – Discuss Preliminary Recommendations

24-24 Jul – Discuss Open TMCH Questions (over ICANN65)

31 Jul-14 Aug – Discuss Deferred TMCH Questions

Timeline/Next Steps, Cont.

Full WG, Cont.:

21 Aug-11 Sept – Review all Preliminary Recommendations (Uniform Rapid Suspension (URS), Sunrise, Trademark Claims, and TMCH)

Late Oct – Publish Phase One Initial Report

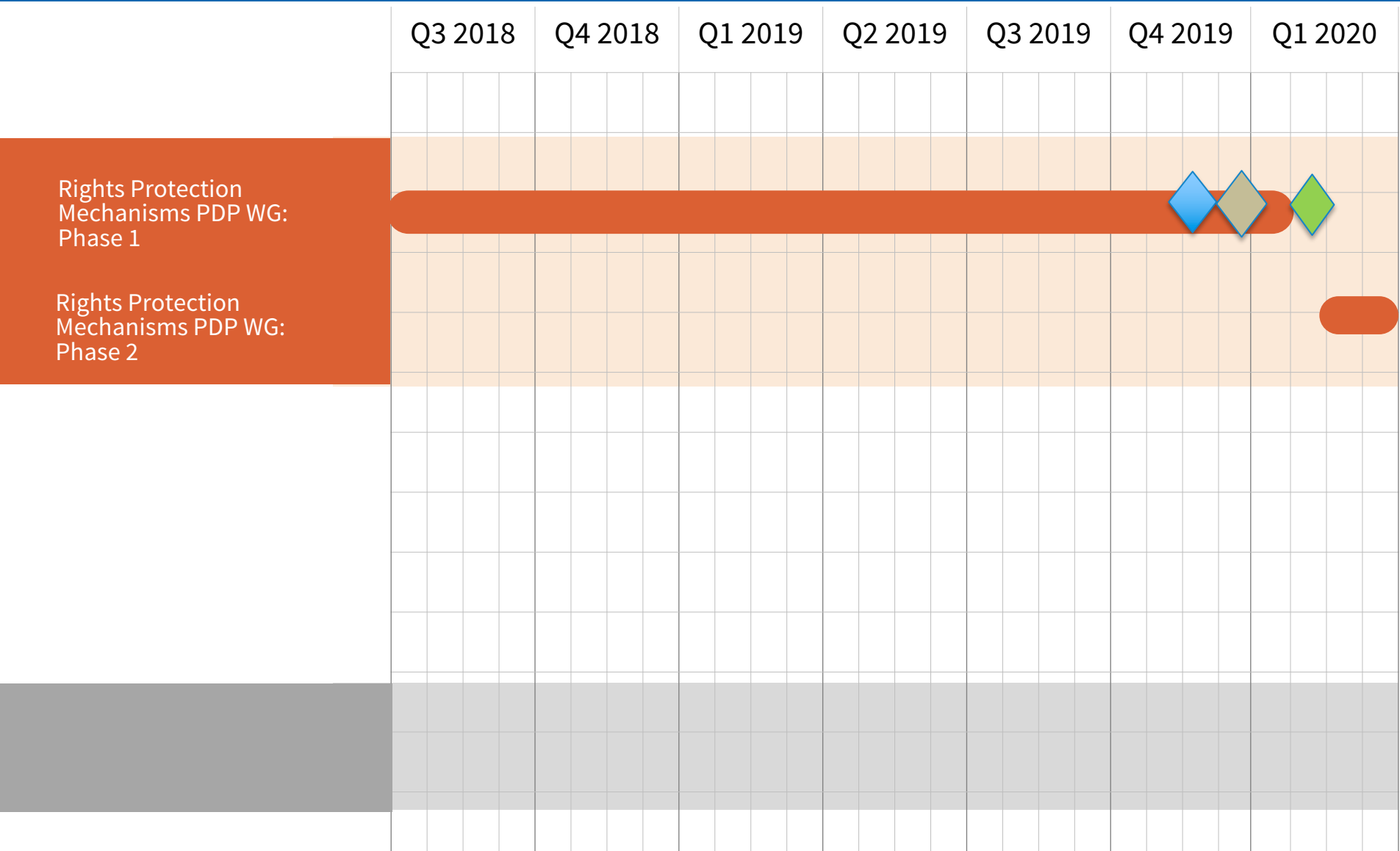
02-07 Nov – ICANN66 – Community Discussion of Phase One Recommendations

Nov 2019-Jan 2020 – Review Public Comments

Mid-Feb – Submit Phase One Initial Report to GNSO Council

07-12 Mar – ICANN67 – GNSO Council Approval

Timeline



KEY



Publish Initial Report



Close of Public Comments



Final Report Delivered to Council

Thank You and Questions