Trademark Claims Sub Team Update

Overall Status

- Discussed five (5) Agreed Trademark Claims Charter Questions and reviewed five (5) Individual Proposals. The standard for accepting answers and proposals was whether they had gained 'wide support.'

- Completed discussions, which took place during meetings and via discussion threads on the mailing list

- Reviewed the draft language for proposed answers, preliminary recommendations, and proposed questions for community input

- There was not wide support in the Sub Team for any of the individual proposals

- In ICANN65, completed the review of the draft language and provided final input; finalized the determination on the individual proposals

Question 1	Proposed Answers
Q1: *Is the Trademark Claims service having its intended effect?*	The Sub Team could determine that the service is at least "possibly" having its intended effect.
Q1(a): *Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing Claims Notice to domain name applicants?*	The Sub Team could determine that the service is at least "possibly" having its intended effect. The Sub Team could not determine the extent of deterrence that occurred, if any.
Q1(b): *Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications?*	The Sub Team generally agreed that the Trademark Claims service may possibly have unintended consequences, such as deterring good-faith domain name applications. The Sub Team could not determine the extent of deterrence that occurred, if any.

Preliminary Recommendation
The Trademark Claims Sub Team recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined in the Sub Team's recommendations for Question 3 (below). This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing any unintended effects of deterring good-faith domain name applications.

Question 2	Proposed Answers
Q2(a): Should the Claims period be extended - if so, for how long (up to permanently)?	The Sub Team generally agreed that where there is a mandatory Claims period (see Q2(d)), it should not be extended. However, the Sub Team generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.
Q2(b): Should the Claims period be shortened?	The Sub Team generally agreed that where there is a mandatory Claims Period (see Q2(d)), it should not be shortened.
Q2(c): Should the Claims period be mandatory?	The Sub Team generally agreed that where there is a Claims period, it should be mandatory (see Q2(d)). However, the Sub Team generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.

Preliminary Recommendation
The Trademark Claims Sub Team recommends, in general, that the current requirement for a mandatory Claims Period be maintained, including the minimum initial 90-day period when a TLD opens for general registration.

Question 2, Cont.	Proposed Answers
Q2(d): *Should any TLDs be exempt from the Claims RPM and if so, which ones and why?*	Some Sub Team members believe that some future TLDs should be exempt from the Claims RPM. Some Sub Team members suggested that public comment should be sought on whether there is a use case for exempting a TLD from the requirement of a mandatory Claims Period due to the particular nature of the TLD.
Q2(e): *Should the proof of use requirements for Sunrise be extended to include the issuance of TMCH notices?*	The Sub Team had diverging opinions on whether the proof of use requirements for Sunrise should be extended to include the issuance of TMCH notices.

Proposed Questions for Community Input:

Some Sub Team members recommend that public comment be sought on the following questions:

1. Is there a use case for exempting a gTLD that is approved in subsequent expansion rounds from the requirement of a mandatory Claims Period due to the particular nature of that gTLD? Such type of gTLD might include: (i) "highly regulated" TLDs that have stringent requirements for registering entities, on the order of .bank; and/or (ii) "Dot Brand" TLDs whose proposed registration model demonstrates that the use of a Claims Service is unnecessary.
2. If the WG recommends exemption language, what are the appropriate guardrails ICANN should use when granting the exception (e.g. single-registrant? Highly-regulated or manually hand-registered domains? Something else?)

Question 3	Proposed Answers
Q3(a): Does the Trademark Claims Notice to domain name applicants meet its intended purpose?	The Sub Team generally agreed that the Trademark Claims Notice generally meets its intended purpose of notifying prospective domain name registrants that the applied-for domain name matches at least one trademark in the Trademark Clearinghouse. However, the Sub Team also recognized the inadequacies and shortcomings of the Trademark Claims Notice as set out in the proposed answers to Q3(a)(i)-(iii).

Preliminary Recommendation:
The Trademark Claims Sub Team recommends that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal consequences or describing what actions potential registrants may be able to take following receipt of a notice). To assist the Implementation Review Team (IRT) that will be formed to implement recommendations from this PDP in redrafting the Claims Notice, the Trademark Claims Sub Team has developed the following Implementation Guidance:
- The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law;
- The current version of the Claims Notice should be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications;
- The Sub Team advices that ICANN Org considers input from external resources including the American University Intellectual Property, INTA Internet Committee, Electronic Frontier Foundation, and Clinica Defensa Nombres de dominio UCN Dominio.

Question 3, Cont.	Proposed Answers
Q3(a)(i): *If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved?*	The Sub Team generally agreed that for some of the actual and potential registrant respondents, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. The Sub Team made preliminary recommendations to improve the Claims Notice, and also sought community input to address its inadequacy.
Q3(a)(ii): *Does it inform domain name applicants of the scope and limitations of trademark holders' rights? If not, how can it be improved?*	Some Sub Team members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks). The Sub Team made preliminary recommendations to improve the Claims Notice, and also sought community input to address its inadequacy.

Question 3, Cont.	Proposed Answers
Q3(a)(iii): Are translations of the Trademark Claims Notice effective in informing domain name applicants of the scope and limitation of trademark holders' rights?	The Sub Team generally agreed that the current requirement on translations of the Trademark Claims Notice does not seem effective in informing domain name applicants of the scope and limitation of trademark holders' rights. The current The current requirement states: "The Claims Notice MUST be provided by the registrar to the potential domain name registrant in English and SHOULD be provided by the registrar to the potential domain name registrant in the language of the registration agreement".

Preliminary Recommendation
The Trademark Claims Sub Team recommends that delivery of the Trademark Claims Notice be both in English as well as the language of the registration agreement. In this regard, the Trademark Claims Sub Team recommends changing the relevant language in the current Trademark Clearinghouse Requirements on this topic to "...registrars MUST provide the Claims Notice in English and in the language of the registration agreement."

The Trademark Claims Sub Team also recommends that, where feasible, the Claims Notice include links on the ICANN org website to translations of the Claims Notice in all six UN languages.

Question 3, Cont.	Proposed Answers
Q3(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?*	The Sub Team generally agreed that when there is a Claims Period and the issuance of a Claims Notice is required (see proposed answer to Q2(d)), the Claims Notice should be sent to potential registrants, who are attempting to register domain names that are matches to entries in the TMCH, at some point before the domain name registration is completed.

Preliminary Recommendation
The Trademark Claims Sub Team recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained.

The Trademark Claims Sub Team also recognizes that there may be operational issues with presenting the Claims Notice to registrants who pre-registered domain names, due to the current 48-hour expiration period of the Claims Notice.

The Trademark Claims Sub Team therefore recommends that the Implementation Review Team consider ways in which ICANN org can work with registrars to address this implementation issue.

Question 4	Proposed Answers
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.*	The Sub Team had widely diverging opinions on whether the exact match requirement is serving the intended purposes of the Trademark Claims RPM.
Q4(a): *What is the evidence of harm under the existing system?*	The Sub Team had widely diverging opinions on whether there is evidence of harm under the existing system of exact match.
Q4(b): *Should the matching criteria for Notices be expanded?*	The Sub Team had widely diverging opinions on whether the matching criteria for the Claims Notice should be expanded.
Q4(b)(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?*	The Sub Team generally agreed that if the matching criteria for the Claims Notice were to be expanded, the marks in the TMCH should be the basis for an expansion of matches for the purpose of providing a broader range of Claims Notice.

Question 4, Cont.	Summary of Proposed Answers
Q4(b)(ii): *What results (including unintended consequences) might each suggested form of expansion of matching criteria have?*	Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.
Q4(b)(iii): *What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?*	The Sub Team believes that the exact match criteria has already struck the current balance of deterring bad-faith registrations but not good-faith domain name applications. The Sub Team believes that the current balance can be enhanced by a well-crafted Claims Notice that appropriately notifies prospective registrants about a potential problem with their chosen domain name, employs clear/concise/informative language, and avoids a potential overflow of false positives.

Question 4, Cont.	Proposed Answers
Q4(b)(iv): *What is the resulting list of non-exact match criteria recommended by the WG, if any?*	Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.
Q4(c): *What is the feasibility of implementation for each form of expanded matches?*	Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.
Q4(d)(i): *If an expansion of matches solution were to be implemented, should the existing TM Claims Notice be amended? If so, how?*	Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.
Q4(d)(ii): *If an expansion of matches solution were to be implemented, should the Claim period differ for exact matches versus non-exact matches?*	Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.

Question 5	Proposed Answers
Q5: Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds?	he Sub Team generally agreed that where the Registry Operator has not obtained an exception (see proposed answer to Q2(d)), the Trademark Claims period, including for the minimum initial 90-day period when a TLD opens for general registration, should continue to be uniform for all types of gTLDs in subsequent rounds. In addition, the Sub Team generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period.

Preliminary Recommendation
The Trademark Claims Sub Team recommends that the current requirement for a mandatory Claims Period should continue to be uniform for all types of gTLDs in subsequent rounds, including for the minimum initial 90-day period when a TLD opens for general registration. (Note: Some Sub Team members asked for public comment on potential exemptions which would then not be subject to a Claims Period of any length, see Q2(d))

Thank You and Questions