**CHARTER & COMMUNITY QUESTIONS ON THE TMCH: TABULATED WITH CONTEXTUAL BACKGROUND AND ADDITIONAL COMMENTS**

**Updated 2 December 2016**

**prepared by ICANN staff for the TMCH Charter Questions Sub Team of the RPM Review PDP Working Group**

Current Suggested Categories:

Guidance; Verification & Updating of TMCH Data; Balance; Access & Accessibility; Costs & Other Fundamental Features

Items highlighted in green have been agreed by the sub-team, items highlighted in orange are to be moved for consideration during the WG’s consideration of other aspects of the RPMs.

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| **SUGGESTED CATEGORY: GUIDANCE**  |
| **No.**  | **Original Question/Question as agreed** | **Context/Background/Origin** | **Comments/Suggestions** | **Proposed Edited Question**  |
|  | Should the verification criteria be clarified or amended? If so how? Clarifying paragraph: This issue was raised by various public comments to the Draft RPM Staff Paper (Feb 2015), referring to administrative challenges (e.g. inconsistent submission requirements such as for on non-Latin text marks, error corrections and certifications required), as well as the need for clearer communications and better guidelines from the TMCH; also supported by several commenters to the Preliminary Issue Report (Oct 2015) – though one noted the need to define what “different” means (e.g. jurisdiction? Design vs work mark? Goods or services? | Supported by various public comments to the Draft RPM Staff Paper (Feb 2015), referring to administrative challenges (e.g. inconsistent submission requirements such as for on non-Latin text marks, error corrections and certifications required), as well as the need for clearer communications and better guidelines from the TMCH; also supported by several commenters to the Preliminary Issue Report (Oct 2015) – though one noted the need to define what “different” means (e.g. jurisdiction? Design vs work mark? Goods or services?) | Seems to go toward the process of verification by Deloitte and not the scope/standards of qualifying for entry into the TMCH | No change; agreed on and presented at ICANN57 |
|  | What activities does the TMCH undertake to communicate (i) criteria does the TMCH apply when determining whether or not to accept marks and (ii) what to do when registrations are challenged? | Question proposed during RPM working group sub-team deliberations on Charter questions. |  | What activities does the TMCH undertake to communicate: (i) the criteria it applies when determining whether or not to accept marks; and (ii) what to do when registrations are challenged?COMMENT: Edited for grammer; agreed on and presented at ICANN57 |
|  | Should (and if so, how) the TMCH be responsible for education services for trademark owners, domain name registrants and potential registrants? If the TMCH is not to be responsible, who should be? | Public comments to Preliminary Issue Report (Oct 2015) (specific question suggested by one commenter) |  | Should the TMCH be responsible for education services for trademark owners, domain name registrants and potential registrants? If so, how? If the TMCH is not to be responsible, who should be?COMMENT: Edited for clarity, agreed on and presented at ICANN57 |
|  | How are design marks currently handled by the TMCH provider?  |  |  | NOTE: Agree to delete (may be a more appropriate question for the TMCH provider) |
|  | What information on the following aspects of the operation of the TMCH is available and where can it be found:* TMCH Services;
* Contractual relationships between the TMCH providers and private parties; and

With whom the TMCH shares data and for what purposes? | Public comments to Preliminary Issue Report (specific question suggested) | Proposal to move this question to guidance questios section.KK: Perhaps divide this question into two?1\_ How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies?2 How can the TMCH be much more transparent in terms of what is offered to private New gTLD registries pursuant to private contracts? [KK note: may want to move the second question to a section on private uses of the TMCH Database] | NOTE: Agree to delete (may be a more appropriate question for the TMCH provider – note also prospective WG discussion on private protective blocking mechanisms/lists) |

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| **SUGGESTED CATEGORY: VERIFICATION AND UPDATING OF TMCH DATA** |
| **No.** | **Original Question** | **Context/Background/Origin** | **Comments/Suggestions** | **Proposed Edited Question** |
|  | Should there be an additional or a different recourse mechanism to challenge rejected trademarks?  | Supported by several public comments to Preliminary Issue Report |  | No change – original question presented at ICANN57 |
|  | How quickly can and should a cancelled trademark be removed from the TMCH to avoid discouraging or losing domain names registration? Is this satisfactory? | Public comments to Preliminary Issue Report (specific question suggested by one commenter) |  | No change – original question presented at ICANN57 |

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| **SUGGESTED CATEGORY: BALANCE** |
| **No.** | **Original Question** | **Context/Background/Origin** | **Comments/Suggestions** | **Proposed Edited Question** |
|  | Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrants? In particular are:* legitimate noncommercial, commercial and individual registrants; and
* legitimate rights holders;

losing legitimate opportunities to register domain names in New gTLDs? | Public comments to Preliminary Issue Report (specific question suggested by one commenter) |  | Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrants? COMMENT: Edited for clarity, agreed on and presented at ICANN57 |
|  | How do we determine what is “good chilling effect” and “bad chilling effect” in relation to RPMs? | Community suggestion at ICANN56 | Agreed to move to questions on TM Claims and Sunrise.Note: Kathy can explain “bad chilling effect” and Jeff Neuman can explain “good chilling effect.” |  |
|  | Should the scope of the TMCH be limited to apply only to the categories of goods and services in which the generic term(s) within a trademark are protected? If so, how? | Public comments to Preliminary Issue Report (specific question suggested) |  |  |
|  | Should the TM+50[[1]](#footnote-1) be retained or removed? | Issue highlighted in various public comments to draft RPM Staff Paper (noting under-utilization, high costs, verification standards, arbitrary nature) and Preliminary Issue Report |  |  |
|  | Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, ‘marks contained’ or ‘mark+keyword’, and/or common typos of a mark? | Supported by various public comments to draft RPM Staff Paper and Preliminary Issue Report; however, one commenter to the Preliminary Issue Report noted the origin of this in the balance struck in the STI |  |  |

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| **SUGGESTED CATEGORY: ACCESS & ACCESSIBILITY** |
| **No.** | **Original Question** | **Context/Background/Origin** | **Comments/Suggestions** | **Proposed Edited Question** |
|  | How accessible is the TMCH database and RPM Rights Protection Actions and Defenses to individuals, orgs, trademark owners and trademark agents in developing countries? | Supported by various public comments to draft RPM Staff Paper (i.e. that greater outreach is needed in regions that underutilized TMCH); public comments to Preliminary Issue Report (suggesting this specific question). This question merges two similar questions | Agreed that the findings relating to this issue should be shared with the new gTLD SubPro WG. |  |
|  | What concerns are being raised about the TMCH being closed, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain closed or become open? | Suggested on WG call of 5 Oct 2016 |  |  |

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| **SUGGESTED CATEGORY: COSTS AND OTHER FUNDAMENTAL FEATURES OF THE TMCH** |
| **No.** | **Original Question** | **Context/Background/Origin** | **Comments/Suggestions** | **Proposed Edited Question** |
|  | 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? Is it practical to have more than one provider? | Noted in public comments to Preliminary Issue Report (on single provider issue) | Which aspects of the TMCH’s operations are most important and should be taken into consideration for the next round? Aspects that can be considered are:* cost,
* reliability,
* global reach,
* diversity of services,
* consistency.

What implementation guidelines should be given to ICANN to achieve these goals in the proper balance? | The Sub-team is seeking the input of the full WG on the following two options:Proposal 1 "Does the present structuring of the TMCH optimize such operational considerations as cost, reliability, global reach, and service diversity and consistency, or should significant changes be considered?"Proposal 2 "What are the concerns with the TMCH Database being provided by a single Provider - and how might those concerns be addressed?" |
|  | Are the costs and benefits of the TMCH, for rights holders, for ICANN, for the community, proportionate? | Derived generally from various public comments to draft RPM Staff Paper and Preliminary Issue Report | [KK Comment: This does not appear to be a rewrite of the charter question. But the charter question (left column) may fall within the scope of the “balance question” above. that is: “Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrant….?”] |  |

1. Trademark owners can add up to 50 variations that are similar to each valid submission in the TMCH—within the notification process—provided that the variant of the mark was awarded to the trademark holder in a prior UDRP case. [↑](#footnote-ref-1)