**FINAL LIST OF SUGGESTED CHARTER QUESTIONS FOR REVIEW OF THE TMCH**

**Updated by ICANN Staff on 14 DECEMBER 2016**

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| **SUGGESTED CHARTER QUESTION** | **COMMENTS FROM THE TMCH CHARTER QUESTIONS SUB TEAM/WORKING GROUP CO-CHAIRS** | **WORKING GROUP DISCUSSION** | | **WORKING GROUP NOTES** |
| **Category 1: Guidance** | | |
| 1. Should the verification criteria used by the TMCH to determine if a submitted mark meets the eligibility and other requirements of the TMCH be clarified or amended? If so how? (NOTE: See the TMCH Guidelines at <http://trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf)> | 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 word mark? Goods or services? |  | | * Clarify what is meant by “verification criteria” and add link to TMCH Guidelines (DONE) * Agreed that Q1 is not about design marks (see Q4) |
| 1. Is the TMCH undertake clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about recordals in the TMCH? |  |  | |  |
| 1. Should the TMCH be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the TMCH is not to be responsible, who should be? |  |  | |  |
| 1. (a) How are design marks currently handled by the TMCH provider? (NOTE: The Working Group is using the more commonly-used term “design marks” to refer to what the TMCH Guidelines describe as “device” or "image" marks, or otherwise marks that do not exclusively consist of letters, words, numerals, special characters (see TMCH Guidelines p. 20))   (b) How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider? |  |  | | The Data Gathering Sub Team has asked the TMCH Provider for details on how it handles design marks. |
| 1. 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 does the TMCH share data and for what purposes? | Note from staff – this may need to be discussed in tandem with the Co-Chairs’ Paper on Private Protection Mechanisms (see separate paper) |  | |  |
| **Category 2: Verification & Updating of TMCH Data** | | |
| 1. Should there be an additional or a different recourse mechanism to challenge rejected submissions for recordals in the TMCH? |  | Justine Chew (5 Dec) with a follow up suggestion:  “If answered in the positive, should such mechanism be incorporated into and administered under the TMCH Dispute Resolution Procedures?” | |  |
| 1. How quickly can and should a cancelled trademark be removed from the TMCH Database? |  |  | | The Data Gathering Sub Team has asked the TMCH Provider for details on how it handles cancelled trademarks. |
| **Category 3: Balance** | | |
| 1. 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 rights of non-trademark registrants? |  |  | |  |
| 1. Should the scope of the **RPMs associated with the** TMCH be limited to apply only to **TLDs that are related to** the categories of goods and services in which the dictionary term(s) within a trademark are protected? | Proposal from Co-Chairs (13 Dec):  “Should the scope of the TMCH be limited to apply only to the categories of goods and services in which the dictionary term(s) within a trademark are protected? If so, how?  (Note: In responding to this question, you should note that the original submitters of the related Charter questions seem to be been particularly concerned about "generic terms" representing the common or class name for the goods and services)” | Beth Allegretti (WG call, 14 Dec): Who determines what is “related”?  Marie Patullo (WG call, 14 Dec): How would this work with those gTLDs that are not category-specific (e.g. .shop)?  Greg Shatan (Email, 13 Dec): As reformulated, this should be moved to Sunrise/Claims  Kathy Kleiman (WG call, 14 Dec): If the reformulated question is moved to Sunrise/Claims, should some form of it nevertheless be retained here? | | Move reformulated question to Sunrise/Claims? |
| 1. Should the TM+50[[1]](#footnote-1) be retained as is, amended or removed? |  |  | |  |
| 1. 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? |  |  | |  |
| **Category 4: Access & Accessibility** | | |
| 1. How accessible is the TMCH database and RPM Rights Protection Actions and Defenses to individuals, orgs, trademark owners and trademark agents in developing countries? | Findings on this issue should be shared with the New gTLD Subsequent Procedures PDP Working Group |  | |  |
| 1. 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? |  |  | |  |
| **Category 5: Costs & Other Fundamental TMCH Features** | | |
| 1. 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? | WG input sought on the following 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?" | As of 6 Dec, three WG members have indicated a preference for Proposal 2.  George Kirikos (4 Dec) notes:  “There's no technical reason why a central database would be required. There could instead be multiple  independent databases, which registrars and/or registries could query  in parallel via a standardized API. There'd only need to be a central \*list\* of which TMCH providers needed to be queried. From a coding  perspective, the registrar/registry could simply query the entire list  of providers, and collate the results.  Most registrars already have this technology/capability, as they often query multiple registries (and secondary marketplaces) in parallel  when customers attempt a new domain name registration (e.g. customer  searches for EXAMPLE.COM, but they'll query not only the  Verisign-operated .com registry, but also .net/org/biz/info/us and hundreds of other TLDs, marketplaces like Sedo/Afternic, and they'll  even generate and query variations of "EXAMPLE.TLD" for availability, presenting the customer with a list of hundreds of alternatives).” | |  |
| 1. Are the costs and benefits of the TMCH, for rights holders, for ICANN, for the community, proportionate? |  |  | |  |

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)