

DRAFT#1—FOR DISCUSSION ONLY

Co-Chair Statement regarding WG Inquiry into Blocking Mechanisms and other TMCH and Registry-Sponsored Additional RPMs

The [Charter](#) of this Working Group describes our mission, in part, as follows:

At a minimum, in each Phase of this PDP, the Working Group is expected to first assess the effectiveness of the relevant RPM(s), for which the Working Group should seek the input of experienced online dispute resolution providers and other subject matter experts, as may be appropriate. The Working Group should also consider the interplay between and complementary roles of each RPM in seeking to more fully understand their overall functioning and effectiveness. (Emphasis added)

The Objectives and Goals portion of the Charter further states:

In addition to an assessment of the effectiveness of each RPM, the PDP Working Group is expected to consider, at the appropriate stage of its work, the overarching issue as to whether or not all the RPMs collectively fulfill the purposes for which they were created, or whether additional policy recommendations are needed, including to clarify and unify the policy goals. If such additional policy recommendations are needed, the Working Group is expected to develop recommendations to address the specific issues identified. (Emphasis added)

Finally, the first and overarching of the questions attached to the Charter reads:

Do the RPMs collectively fulfil the objectives for their creation, namely “to provide trademark holders with either preventative or curative protections against cybersquatting and other abusive uses of their legally-recognized trademarks? In other words, have all the RPMs, in the aggregate, been sufficient to meet their objectives or do new or additional mechanisms, or changes to existing RPMs, need to be developed? (Emphasis added)

Given this Working Group’s responsibility to consider the interplay between the RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency, it is the view of the Co-Chairs that the WG should undertake some notice and understanding of the blocking mechanisms, and any other additional RPMs that are being offered by registries or the TMCH as additions to the mandatory ICANN RPMs.

We believe that market offerings provide additional information about the benefits and limitations of the RPMs, and that viewing the market holistically may spur better informed policy discussion within the WG.

The additional RPMs that the Chairs are aware of include:

- The [Ongoing Notifications](#) service offered by the TMCH, through which it provides notice to rights holders of any potential intellectual property infringement indefinitely, beyond the original 90 day period, when either exact mark matches or various types of additional variations are registered at a new gTLD.
- The voluntary extension by some registries of the Claims service beyond the minimum 90 days' duration.
- Protected Marks List blocking services offered by the portfolio new gTLD operators Donuts, Minds & Machines, and Rightside, and which are suggested as an alternative to more costly sunrise registrations.

In addition to our general rationale for the suggested inquiry, the Co-Chairs believe that the indisputable tie between market-provided domain blocking services and the TMCH provides this WG with clear Charter-based jurisdiction to review such services. As the Clearinghouse explains at its information [page](#) on Blocking Mechanisms for TMCH-clients (DPML):

As hundreds of new gTLD's are launching, managing defensive registrations can become burdensome and that is why 3rd party service providers are offering so-called blocking mechanisms allowing you to block a multitude of domain extensions at a lower fee than the total of multiple [Sunrise](#) Registrations.

Each blocking mechanism is operated by a specific Registry Operator and covers their TLD or TLDs (some Registry Operators operate tens or even hundreds of new gTLDs).

This page covers the different services that are available and are supported by records in the [Trademark Clearinghouse](#).

Please bear mind that these services:
- require a VAILD SMD FILE; issued by the [Trademark Clearinghouse](#)
- are sold by [Registrars](#) and not the Registry themselves
- apply to specific Registry Operators and their TLDs
- may contain override mechanisms or exemptions, so you need to be well informed of the limitations (Emphasis added)

This Working group's mandate to review the overall functioning of the TMCH provides a demonstrable mandate to review its participation in support of private sector RPMs that

are supported by its validated records. In addition, some of the questions attached to the Charter and pertaining to the TMCH raise such relevant issues as:

- *Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services? Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?*
- *How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?*
- *How can TMCH services be much more transparent in terms of what is offered for ICANN pursuant to ICANN contracts and policies vs. what services are offered to private New gTLD registries pursuant to private contract?*

The WG inquiry may also consider whether, and to what extent, additional protective services should be consistent with either policy decisions reflected in the shaping of the ICANN-required RPMs (noting that it may have always been contemplated that such RPMs could constitute a “floor” and not an overall limitation on additional market-provided protections) or with the recognized scope of trademark law. For example, should a rights holder be able to block the registration of unlimited variations of its registered mark, and should one trademark owner be able to block the registration of a mark that another has equivalent rights to for separate classes of goods and services?

Overall, ICANN-mandated RPMs must be considered in combination with additional marketplace offerings to fully understand the RPM ecosystem available to trademark holders. On one hand, the availability of additional protections may provide trademark protections in a more cost-effective manner than the alternatives of sunrise registrations and the potential filing of a UDRP or a URS action. On the other hand, TM owners are presented with an RPM landscape in which additional protections of varying scope and cost are available from some but not all registry operators.

The Co-Chairs also wish to better understand the process, if any, by which registry operators gain approval for the offering of such additional RPMs. Section 2.1 of the standard new gTLD registry agreement permits a registry operator to offer Registry Service that is an Approved Service, but requires it to request approval under the Registry Services Evaluation Policy (RSEP) if it wishes to offer any service that is not an Approved Service or is a material modification of an Approved Services. It is important for the WG to understand whether registry-offered RPMs, especially those based upon TMCH mark registrations, have been subject to any such approval review and, if so, what criteria were utilized in their evaluation.

To be clear, the Co-Chairs believe that the ultimate scope and depth of inquiry into blocking services and other additional RPMs undertaken by this WG, and the content of any resulting policy recommendations, should be determined through WG consensus. What we did want to make clear at this time, and initiate discussion upon, is our collective determination that knowledgeably answering the key Charter questions relating to the mandatory RPMs required some understanding and appraisal of the additional RPMs that have been made available in the marketplace.

We welcome feedback from WG members in regard to this Statement.