**TMCH CHARTER QUESTIONS CATEGORIES 3-6**

**Updated 22 February 2017**

**CATEGORY 3 – BREADTH AND REACH (SCOPE)**

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| **Charter Questions** | **Further WG Questions** | **Deloitte Input (if applicable)[[1]](#footnote-1)** | **Other Input & Responses (if applicable)** | **WG Discussion** |
| 1. 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)) |  | Please define what is exactly understood under “design marks” as there is no globally consistently accepted definition of this mark type.However, we refer to Section 5 of the Trademark Clearinghouse Guidelines in order to better understand our verification process | RPM Staff Paper (2015):* ICANN has received feedback that only “word marks” as defined by a particular jurisdiction should be accepted in the Trademark Clearinghouse. ICANN has also received feedback supporting the Clearinghouse Guidelines that any mark containing word elements, such as design or figurative marks, should remain eligible for entry in the Clearinghouse so long as they can be distilled into just the word mark itself. Others, however, maintain that the Clearinghouse Guidelines should be adjusted to exclude the registration of design marks. While there is no generally accepted or international definition of a word mark, there are multiple laws that distinguish between a mark that is comprised of characters versus a mark that protects the manner in which those characters are presented. Furthermore, input was received inquiring into how many design marks have been accepted into the Clearinghouses. While we currently do not have an analysis on the different types of marks that are in the Clearinghouse database in terms of how many of each type have been accepted, ICANN welcomes the suggestions received and will explore conducting additional analysis on this as part of the independent review of the Trademark Clearinghouse. There are over 100 definitions of a “word mark” across trademark jurisdictions. Relying on multiple different definitions of types of marks per submission would further complicate the verification process and could also lead to a preferential bias toward one jurisdiction or another.
 | Follow up with Deloitte on original Sub Team question (especially on validation criteria used and how they differentiate between design marks); add request for: (1) examples of marks that were accepted and marks that were rejected; and (2) Deloitte’s view as to whether select WG examples would have been accepted or rejected (e.g. “parents”).Rebecca Tushnet to take lead in developing examples for (2), above.WG to review and discuss if original intent for the TMCH included the acceptance of design marks. |
| 1. How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?
 | Who else, besides certification bodies/associations, would have the standing to submit G.I.s? | As of January 2017, no registry operator has pursued the option of including marks within the category of “"Other marks that constitute intellectual property and meet a registry's individual requirements"[[2]](#footnote-2). |  | Deloitte seems to have accepted marks with geographical overtones/elements. This Q8 to be sent to Deloitte, asking specifically how these marks are handled.Following Deloitte’s response, WG to discuss whether G.I.s, P.D.O.s and A.O.C.s should be accepted into the TMCH if they are not also nationally/regionally registered TMs, court-validated or protected by statute/treaty (i.e. the current TMCH criteria). Staff to find out from OriGIn who might be able to submit GIs.* From Massimo Vittori (OriGIn): “GIs associations or groups (called Federations, Consorzia, Consejos Reguladores, Comités interprofessionels, depending on their country and language) are responsible to protect their respective GIs. In practice, they perform the procedures of GIs registration and enforcement at the national level as well as in in foreign jurisdictions where they seek protection. If we use the expression “GIs governance bodies” (rather than “certification bodies/associations”), I believe we will capture the essence of such GIs associations or groups, notwithstanding their country or language.”
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| 1. Should the TM+50[[3]](#footnote-3) be retained as is, amended or removed?
 |  | The abused domain name labels[[4]](#footnote-4) can only be added in the event that a submitted trademark record has been verified. In this respect, 209 UDRP cases have been submitted to the trademark records linked to 209 TMCH records. These URDP cases cover in total 375 abused domain name labels.  | Registries SG:* Several of the metrics currently provided by the TMCH would benefit from additional context or clarification, including whether TM+50 labels are included in the reported number of marks in the TMCH
* WG should request additional data on:
* The number of Previously abused labels recorded in the TMCH
* The number of Trademark Claims against Previously Abused Labels;
* The number of domains registered that correspond to Previously Abused Labels

RPM Staff Paper (2015):* [The Abused Domain Name Label service] is generally described as underutilized and featuring validation price points that are seen as too high. Of particular concern to many commenters was the fact that previously abused labels are only eligible for the Claims service and not for Sunrise service.
* [A]n important principle was that the process should protect existing trademark rights and should not create additional ones … Some of the feedback received expressed that the standards for verification of previously abused labels could be modified to be less strict, as well as lower in cost, resulting in an increased number of labels for inclusion. However, others oppose any easing of the TMCH verification requirements and fear that this service could lead to an unlimited inclusion of names and abuse by trademark holders.
* ICANN has also received some feedback in regard to the documentation required to verify UDRP cases. To verify that the mark that was the subject of the case is the same as the mark in the Trademark Clearinghouse record is difficult in some cases if the rights holder no longer has the UDRP or court filings or records, or where the trademark information was not included in the original complaints.
 | WG to review questions suggested by Registries SG, to see if any/some/all should be followed up with Deloitte on.WG to ask Deloitte if a separate SMD file is created for every additional Previously Abused Label submitted.* Note from AC chat: As the TM+50 labels are used only for Claims and not Sunrise, SMD files for these additional labels are not needed.
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| 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?
 |  |  | RPM Staff Paper (2015):* The matching rules are intended to support protection of trademarks during the domain name registration process by providing an objective, automatable way of determining a match, rather than the Clearinghouse making subjective determinations. Indeed, an expansion of this requirement could require subjective judgment on which domain names are determined to be a “match” to a trademark, on a case-by-case basis. There may be a middle ground between existing matching rules and completely subjective judgment, e.g., additional algorithms to determine matches.

[See also forthcoming TMCH Review Final Report from the Analysis Group] | No follow up needed with Deloitte; WG to discuss further. |
| 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?
 |  | Upon request of the community, the SMD-file was designed in such a way that the Registry Operator had at all times the necessary information to limit registration by goods and services themselves. As such the TMCH has not been involved in the management or decisions in relation to any restrictions implemented by the Registry Operator[[5]](#footnote-5).  | PIR, AFNIC and Donuts have not used the TMCH option to limit registrations by goods and services in a particular registration period.RySG Input:* We expect that one topic under consideration by the Working Group will be the inclusion of generic trademarks in the TMCH. We believe that the continued inclusion of generic marks in the TMCH is appropriate and necessary to allow brand owners to protect their intellectual property. However, we believe that RPMs need to strike a balance: given the volume of generic marks in the TMCH and the potential for legitimate registrations by third parties we would strongly oppose efforts by the Working Group to restrict registries from reserving or including on their premium lists any names that are recorded in the TMCH.

RPM Staff Paper (2015):* ICANN has received questions about verification standards and generic marks … However, it should be noted that what is generic in one context may not be in another … As the Clearinghouse records marks from any jurisdiction, it accepts all marks that meet the criteria in the Guidelines. Clearinghouse processes are designed to verify trademark information as it has been issued by the authorities in the various jurisdictions; the Clearinghouse does not play the role of trademark examiners.
 | No follow up needed with Deloitte; WG to discuss further. |

**CATEGORY 4 – COSTS AND OTHER FUNDAMENTAL FEATURES**

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| **Charter Questions** | **Further WG Questions** | **Deloitte Response (if applicable)** | **Other Input & Responses (if applicable)** | **WG Discussion** |
| 1. Are there concerns about operational considerations (such as cost, reliability, global reach, service diversity and consistency) due to the TMCH Database being provided by a single Provider? If so, how may they be addressed?
 |  |  | RPM Staff Paper (2015):* feedback was received requesting that ICANN incorporate into its review data related to the provider’s expenses related to the verification process, such as costs to Deloitte to conduct verification, costs to IBM to provide the trademark database admin and support, as well as which regions of the world were problematic in terms of verification.

RySG Input:* One critical decision made by ICANN in implementing the new gTLD RPMs was the decision to require that all registries and trademark holders integrate with a single TMCH provider rather than allowing multiple providers to offer TMCH services. This could have potentially created a competitive marketplace for these services and driven down the costs associated with implementation and brand protection for registries and trademark holders, respectively. It also would have better incented providers to provide high-levels of service. To the extent possible, the Working Group should study the impact of using a single provider and consider whether the Sunrise and Claims services could have benefitted from the use of multiple providers.
 | No follow up needed with Deloitte; WG to discuss further.WG to ask IBM if there are any cost, operational or technical concerns with the TM Database being maintained and serviced by one provider. |
| 1. Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the community and ICANN?
 |  |  | RySG Input: * [A] key principle that we believe must be accounted for… is the cost-effectiveness of the new gTLD RPMs. This should include an assessment of the costs incurred by providers [and] the cost to registries and registrars to implement the new gTLD RPMs, and to trademark holders … Relevant data points to these ends could include:
* Costs to Deloitte to carry out trademark verification
* The extent to which these costs varies by region
* The costs to registries and registrars including, but not limited to the integration fees
 | No follow up needed with Deloitte; WG to discuss further.  |

**CATEGORY 5 – ACCESS AND ACCESSIBILITY**

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| **Charter Questions** | **WG Notes & Further Questions** | **Deloitte Response (if applicable)** | **Other Input & Responses (if applicable)** | **WG Discussion/Follow Up** |
| 1. How accessible[[6]](#footnote-6) is the TMCH Database and RPM Rights Protection Actions and Defenses to individuals, organizations and rights-holders; as well as trademark agents in developing countries?
 | WG appreciates that TMCH website is translated into several languages (although not all versions seem to work as well).WG notes Deloitte’s response that it conducted sessions in Europe, Russia, China, Japan, Taiwan, Middle East, Europe and US in various languages – is this sufficient? | No information on corporate headquarters of registrants who use TM agents, as this is not part of TMCH scope.Outreach & education was not defined as being part of the TMCH scope. [[7]](#footnote-7)However, the necessity of education and outreach became very clear from the start of the TMCH as there was limited awareness of the gTLD program and by consequence also the TMCH. Taking this into account, the TMCH has invested a lot of time & effort in creating awareness through:* Organizing various webinars
* Attending all ICANN meetings
* Attending and promoting the TMCH at INTA
* Organizing various workshops together with our agents
* Creating educational brochures and video’s
* Creating marketing material
* Drafting articles for various IP magazines

Sessions and materials were delivered and provided in various regions and languages. More specifically the TMCH has hosted and sponsored various IP meetings and seminars in various countries of Europe, Russia, China, Taiwan, Japan, the Middle East and in the US in the various languages spoken in these countries. |  | Deloitte’s response on corporate headquarters confirms that while it may know where TM agents are located, it cannot know where the rights-holders who instructed those TM agents are located. Are there other sources of information (besides Deloitte) that can be approached for more input on this question? |
| 1. What concerns are being raised about the TMCH Database being confidential, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain confidential or become open?
 |  |  |  | No follow up needed with Deloitte; WG to discuss further. |

**CATEGORY 6 - BALANCE**

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| **Charter Questions** | **Further WG Questions** | **Deloitte Response (if applicable)** | **Other Input & Responses (if applicable)** | **WG Discussion** |
| 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?
 |  |  | RySG Input:* We believe that the new gTLD RPMs have been generally effective, well-balanced, and sufficient to provide protections to intellectual property (IP) rights holders with the advent of the new gTLD program. That said, there are specific implementation details applicable to each of the major RPMs under study during Phase 1 that we believe should be taken into account by the Working Group.
 | No follow up needed with Deloitte; WG to discuss further. Since the full scope of the question also includes the uses of the TMCH, the WG will return to this question after reviewing Sunrise and Claims.Staff to check if RySG input included the “specific implementation details” that they thought should be taken into account.* Staff Note: Yes, the RySG provided details. For the TMCH, these related to generic marks, lack of Service Level Agrements with the TMCH Providers, possible benefits f using multiple (rather than a single) Provider, and suggestions to obtain and publish statistics. All these have been previously added to the appropriate Charter question.
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1. Note that while Deloitte’s input to the Working Group has been included where it concerned the topic of the Charter questions, Deloitte was not asked the specific Charter questions. The questions sent to Deloitte were developed by a Sub Team of the Working Group. [↑](#footnote-ref-1)
2. Note that Deloitte was not asked specifically about geographical indications; the question actually asked of Deloitte was “How many marks in the TMCH fall under the following category: "Other marks that constitute intellectual property and meet a registry's individual requirements"? [↑](#footnote-ref-2)
3. 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-3)
4. The specific question asked of Deloitte was: “How many TMCH records include a TM+50 list; and how many are on this list on average? How many registrations were made for entries on the TM+50 list?” [↑](#footnote-ref-4)
5. The specific question asked of Deloitte was: “Have any gTLDs used the TMCH option to limit registrations by goods and services during a particular registration period? (NOTE: the question refers to the following from the TMCH RPMs Requirements: *2.3.1.1 Registry Operator MAY apply restrictions relating to the underlying rights of a Trademark Record related to the purpose of the TLD (e.g., restrictions on the class of goods or jurisdiction of the Trademark Record that are related to the TLD).* This question also refers to the ability of registry operators to use the TMCH to register additional terms into a Provider database tailored to the specific use/need of the New gTLD.” [↑](#footnote-ref-5)
6. This word is used in the sense of asking whether the TMCH (its existence, purposes and how it is to be used) is known to the types of stakeholders mentioned. [↑](#footnote-ref-6)
7. The following paragraphs were also reproduced in the Tabular Summary for TMCH Categories 1 & 2, in relation to Q2 in the Education category. [↑](#footnote-ref-7)