

Status of TMCH and related RPM discussions (including TMCH Structure & Operations; Sunrise; Trademark Claims; Additional Marketplace RPMs)

Summary prepared by ICANN staff for Working Group reference (27 November 2018)

I. TMCH

Sub Teams - Two TMCH-related Sub Teams (TMCH Charter Questions & TMCH Data Gathering) Data - Deloitte reports; TMCH Data Gathering Sub Team surveys

Timeline Overview (July 2016 - July 2017)

- **July 2016:** **TMCH Data Gathering Sub Team** begins work to develop an initial survey for Registry Operators, Registrars and the TMCH validator/provider (Deloitte).
- **October 2016:** **TMCH Charter Questions Sub Team** begins work
- **November/December 2016:**
 - **TMCH Data Gathering Sub Team completes work:**
<https://community.icann.org/x/VAm5Aw>
 - Surveys sent to TMCH providers, registry operators and registrars:
<https://community.icann.org/download/attachments/61606228/Questions%20sent%20to%20Registries%20and%20Registrars%20-%20Nov%202016.docx?version=1&modificationDate=1481048842000&api=v2> and
<https://community.icann.org/download/attachments/61606228/FINAL%20list%20of%20TMCH%20Provider%20questions%20from%20Data%20Gathering%20Sub%20Team%20-%205%20Dec.docx?version=1&modificationDate=1481048882000&api=v2>
- **November 2016 (ICANN57):**
 - WG discusses proposed refined Charter questions (as received to date) from TMCH Charter Questions Sub Team
- **December 2016:**
 - Three registry operators respond to TMCH Data Gathering Sub Team questions:
<https://community.icann.org/download/attachments/64066042/Registry%20Responses%20to%20TMCH%20Data%20Sub%20Team%20-%202013%20Dec.pdf?version=1&modificationDate=1485897782000&api=v2>
 - **TMCH Charter Questions Sub Team completes work;** see Sub Team report as sent to the Working Group:
<https://community.icann.org/download/attachments/63149439/Tabulated%20Categories%20-%20TMCH%20Questions%202%20Dec%202016.docx?version=1&modificationDate=1480978925000&api=v2>
 - Working Group continues discussion of proposed refined Charter questions.
- **January 2017:**
 - Deloitte responds to TMCH Data Gathering Sub Team questions:
<https://community.icann.org/download/attachments/64066042/Deloitte%20responses>

<https://community.icann.org/download/attachments/64066042/TMCH%20Data%20Gathering%20Sub%20Team%20questions%20-%20Jan%202017.docx?version=1&modificationDate=1485897782000&api=v2>

- Working Group begins discussion of TMCH structure and operations (based on agreed list of categorized charter questions)
- Working Group reviews registry operator responses to TMCH Data Gathering Sub Team questions
- **February 2017:** Working Group reviews Deloitte responses to TMCH Data Gathering Sub Team questions
- **March 2017:**
 - Follow up questions (with illustrative examples) sent to Deloitte:
<https://community.icann.org/download/attachments/64066042/Follow%20Up%20Questions%20for%20Deloitte%20-%20Updated%205%20March%202017.docx?version=1&modificationDate=1488753827000&api=v2> and
<https://community.icann.org/download/attachments/64066042/Deloitte%20Follow%20Up%20Questions%20Annex%20-%2004%20March%202017.docx?version=1&modificationDate=1488752114000&api=v2>
 - Working Group meets with Deloitte (at ICANN58):
<https://community.icann.org/download/attachments/64066042/ICANN%20TMCH%20Report%20Feb%202017.pdf?version=1&modificationDate=1490348967000&api=v2>
 - Working Group discusses approach for completing discussion of TMCH charter questions (i.e. what can be closed out, what remains open):
<https://community.icann.org/display/RARPMRIAGPWG/2017-03-29+Review+of+all+Rights+Protection+Mechanisms+%28RPMs%29+in+all+gTLDs+PDP+WG>
 - Three questions deferred till Sunrise & Trademark Claims review complete and/or end of Phase One:
 - *TMCH Question 11: 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?*
 - *TMCH Question 13: Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the ICANN community and ICANN?*
 - *TMCH Question 16: 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?*
 - Working Group asked for views on the following question with respect to TMCH Education and Validation/Updating of TMCH Database; no specific suggestions received:
 - *Based on Deloitte's information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?*
- **April 2017:**

- Deloitte responds to follow up questions sent in March:
 - <https://community.icann.org/download/attachments/64066042/Deloitte%20Responses%20to%20Follow%20Up%20Questions.pdf?version=1&modificationDate=149334176600&api=v2>
- Working Group members invited to submit policy proposals (with accompanying rationale) for the open TMCH Charter questions (see <https://community.icann.org/download/attachments/64080915/Remaining%20Open%20TMCH%20Charter%20Questions.pdf?version=1&modificationDate=1491864334000&api=v2>), viz.:
 - *TMCH Question 7: How are design marks currently handled by the TMCH provider?*
 - proposals received from Kathy Kleiman and Greg Shatan
 - *TMCH Question 8: How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?*
 - proposals received from Paul McGrady, Kathy Kleiman, Jonathan Agmon and Claudio di Gangi
 - *TMCH Question 10: 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?*
 - proposals received from Michael Graham, Greg Shatan and Brian Winterfeldt
 - *TMCH Question 15: 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 specific proposals received
- Working Group begins discussion of proposals received on the remaining open TMCH Charter questions
- **June-July 2017:**
 - Following presentation of proposals received and further discussions in April and May, Working Group conducts a poll on the open TMCH Charter questions and discusses the poll results:
 - <https://community.icann.org/download/attachments/69271559/Annotated%20Results%20-%20Open%20TMCH%20Questions%20Poll?version=1&modificationDate=1501019162000&api=v2>, with the following results:
 - For Question 7: may need to revisit question of whether TMCH should seek additional information from TM holders when submitting marks for inclusion in the TMCH (in relation to stylized marks and marks that include graphical elements)
 - For Question 8: may need to revisit question of whether additional guidance or rephrasing of the “marks protected by statute or treaty” category is needed.

- For Question 10: discussion deferred.
- For Question 15: discussion deferred.

Notes & Conclusions

- **Data Gathering for TMCH Structure & Operations:** No additional data collection needs identified
- **TMCH Charter Questions:** No additional work required to review either the original or refined list of agreed questions, given the extensive work of the TMCH Charter Questions Sub Team and the Working Group's review and subsequent discussions of the proposed questions
- **Next steps:**
 - Working Group to pick up discussion from July 2017 for the remaining open TMCH questions (Q7, 8, 10, 15)
 - Working Group to return to deferred discussions after completing Sunrise & Trademark Claims review (Q11, 13, 16)
 - Working Group to develop preliminary recommendations for TMCH following completion of discussions over open and deferred questions

II. Sunrise & Trademark Claims

Sub Teams - Three Sub Teams (Sunrise Charter Questions, Trademark Claims Charter Questions, RPM Data Sub Team)

Data - Analysis Group Report on TMCH; INTA Cost Impact Survey; Staff Compilation of Sunrise Data; Analysis Group Survey Results on Sunrise & Trademark Claims

Timeline Overview (February 2017 - November 2018)

- **February 2017:** Analysis Group (AG) revised report on Independent Review of TMCH Services published:
<https://community.icann.org/download/attachments/64066042/Analysis%20Group%20Revised%20TMCH%20Report%20-%20March%202017.pdf?version=1&modificationDate=149034902900&api=v2>
- **March 2017:** Working Group agrees to form Sub Teams -- [Sunrise Registrations](#) and [Trademark Claims](#) -- to refine the original Sunrise & Trademark Claims Charter Questions
- **April-May 2017:**
 - Working Group meets with Analysis Group on TMCH review report
 - Follow up questions sent to Analysis Group
 - Working Group discusses scope of work for Sunrise Registrations & Trademark Claims Sub Teams
 - Sub Teams begin work and provide periodic status reports to the full Working Group

- **June 2017:**
 - Analysis Group responds to questions on TMCH report: <https://mm.icann.org/pipermail/gnso-rpm-wg/2017-June/002043.html>
 - **Sunrise Charter Questions Sub Team completes work**; see Sub Team report as sent to the Working Group: <https://community.icann.org/download/attachments/64080548/Sunrise%20Sub%20Team%20Report%20-%2020%20June%202017.pdf?version=1&modificationDate=1498034655000&api=v2>
- **June 2017 (ICANN59 Johannesburg):**
 - Working Group discusses reports from Sunrise Registrations and Trademark Claims Sub Teams: <https://community.icann.org/x/qwffAw>
 - Working Group solicits feedback from registries and registrars on proposed agreed questions on Sunrise and Trademark Claims
- **July 2017:**
 - Analysis Group responds to second set of questions on TMCH report: <https://mm.icann.org/pipermail/gnso-rpm-wg/2017-July/002257.html>
 - **Trademark Claims Sub Team completes work**; see Sub Team report as sent to the Working Group: <https://community.icann.org/download/attachments/64080561/Trademark%20Claims%20Sub%20Team%20Table%20-%2020%20July%202017.pdf?version=1&modificationDate=1498034702000&api=v2>
 - Working Group finalizes agreed questions concerning Sunrise & Trademark Claims
 - Working Group develops data request to the GNSO Council for Sunrise & Trademark Claims data collection based on the agreed questions
- **August 2017:** INTA Cost Impact Survey results presented to Working Group - <https://community.icann.org/download/attachments/69277722/INTA%20New%20gTLD%20Cost%20Impact%20Study%20Presentation%20-%2030%20Aug.pdf?version=1&modificationDate=1504147055000&api=v2> and https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_download_attachments_61606864_INTA-2520Cost-2520Impact-2520Report-2520revised-25204-2D13-2D17-2520v2.1.pdf-3Fversion-3D1-26modificationDate-3D1500376749000-26api-3Dv2&d=DwMGaQ&c=FmY1u3PJp6wrcrwl13mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=MLOyWdAdSdj4cRa39aHRCVysVa9ub30XpFPLr1fc51I&s=KXW3vtHBAKxxiT4X6sLxZQO2dIKSW8Zc-BhfZ1t7IAA&e=
- **September 2017:**
 - Data & Metrics for Policy Making request sent to the GNSO Council: <http://mm.icann.org/pipermail/council/attachments/20170908/7d2c33c9/RPMSunriseTrademarkClaimsMetricsRequestForm-DRAFT-7Sept2017.docx>
 - GNSO Council approves Working Group request for third party surveys on Sunrise & Trademark Claims - <https://mm.icann.org/pipermail/council/2017-September/020426.html>

- **October 2017:**
 - **RPM Data Sub Team** begins work on clarifying data request for surveys, based on agreed refined charter questions and GNSO Council approval of survey request
 - Working Group reviews staff-compiled data on Sunrise registrations (based on data reported to ICANN by Contracted Parties and IBM as the TM Database provider):
<http://mm.icann.org/pipermail/gnso-rpm-wg/attachments/20171010/fc173bd9/Staffcompilationreport-Sunrisedata-3Oct2017-0001.pdf>
- **January 2018:** Request for Proposal (RFP) launched for Sunrise & Trademark Claims surveys -
<https://www.icann.org/resources/pages/governance/rfps-en>
- **February 2018:** **RPM Data Sub Team completes work** on suggested questions and information for survey vendor; materials shared with the Working Group:
<https://mm.icann.org/pipermail/gnso-rpm-wg/2018-February/002782.html>
- **May 2018:**
 - Analysis Group (AG) selected as survey vendor
 - RPM Data Sub Team begins discussions with AG on developing final survey questions
- **July 2018:** TMCH Data Sub Team completes work with Analysis Group
- **August 2018:**
 - Beta testing of final surveys by Working Group volunteers
 - All surveys released into the field -
<https://community.icann.org/pages/viewpage.action?pageId=90771305>
- **September 2018:** AG's Inception Report sent to Working Group:
<https://community.icann.org/download/attachments/90771305/9.6.2018%20Inception%20Report.pdf?version=1&modificationDate=1536257221000&api=v2>
- **October 2018 (ICANN63 Barcelona):** AG presents survey results to Working Group:
<https://community.icann.org/x/aQ9pBQ>

Notes & Conclusions

- **Agreed (refined) Sunrise & Trademark Claims Charter Questions:** No additional work required on reviewing either the original or agreed Sunrise and Trademark Claims Charter Questions as:
 - extensive work was done by both Charter Questions Sub Teams in refining the original Charter questions;
 - the Working Group reviewed progress reports as well as the final proposals from both Sub Teams; and
 - the Sunrise and Trademark Claims surveys were conducted following the Working Group's development of the initial data request to the GNSO Council as well as the Data Sub Team's creation of substantial guidance for AG based on the agreed Charter questions.
- **Next steps:**
 - Working Group to agree on how to conduct review of all the survey results, with the objective of determining whether and how the results may answer the agreed questions

- Working Group to develop preliminary recommendations for Sunrise and Trademark Claims following review of the survey results and taking into account the other data that has been collected and analyzed to date as well as previous Working Group discussions on these two RPMs

III. Additional Marketplace RPMs

Timeline Overview (May 2017 - April 2018)

- **May 2017:** Working Group discusses the then co-chairs' proposed questions on Additional Marketplace RPMs (originally called Private Protections):
<https://community.icann.org/download/attachments/66061841/Questions%20for%20Private%20Protections%20Sub%20Team%20-%20For%20WG%20Discussion%20-%2028%20May%202017.pdf?version=1&modificationDate=1496105875000&api=v2>
- **June 2017:** **Additional Marketplace RPMs Sub Team** begins work to develop questions for the Working Group to consider in relation to Additional Marketplace RPMs that would be within scope of the PDP
- **September 2017:** **Additional Marketplace RPM Sub Team completes work**; see Sub Team report as sent to the Working Group:
<https://community.icann.org/download/attachments/69283148/CLEAN%20Draft%20Final%20Additional%20Marketplace%20RPM%20Questions%20-%2015%20September%202017.pdf?version=1&modificationDate=1506023484000&api=v2>
- **October 2017:** Working Group agrees that identifying data and methodology for considering Additional Marketplace RPMs to be discussed by RPM Data Sub Team:
<https://community.icann.org/display/RARPMRIAGPWG/2017-10-04+Review+of+all+Rights+Protection+Mechanisms+%28RPMs%29+in+all+gTLDs+PDP+WG>
- **March 2018:** RPM Data Sub Team discusses any Additional Marketplace RPMs questions not already included in the RFP for the Sunrise & Trademark Claims surveys:
<https://community.icann.org/display/RARPMRIAGPWG/2018-03-02+Sub+Team+for+Data>
- **March 2018 (ICANN61 Puerto Rico):** RPM Data Sub Team meets with Jon Nevett (then with Donuts, the only Registry Operator then offering Additional Marketplace RPMs); agrees that some questions have already been subsumed into the Sunrise and Trademark Claims survey work:
<https://community.icann.org/download/attachments/79438928/Transcription%20ICANN61%20GNSO%20RPM%20Data%20Sub%20Team%20Meeting%2010%20March%202018.pdf?version=1&modificationDate=1521579214000&api=v2>
- **April 2018:** RPM Data Sub Team agrees that remaining questions (in addition to answers provided by Jon Nevett at ICANN61 Puerto Rico) can be sent to Deloitte, with one general

question for the Working Group to consider after the Sunrise & Trademark Claims reviews are completed - <https://community.icann.org/x/LoTpB>

- *How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations?*

Notes & Conclusions

- **Next Steps:** Working Group to: (1) consider whether it will still be helpful to reach out to Deloitte; and (2) pick up on the April 2018 question noted by the RPM Data Sub Team.
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IV. Competition, Consumer Protection & Consumer Trust Review Team (CCT-RT) recommendations

Timeline Overview

- **April 2017:** Working Group informed of publication of CCT-RT Draft Report and specific recommendations relevant to RPM review: <https://mm.icann.org/pipermail/gnso-rpm-wg/2017-April/001341.html>
- **October 2017 (ICANN60):** CCT-RT meets with the Working Group.
- **September 2018:** CCT-RT Final Report published, in which two recommendations were directed at the RPM PDP (circulated to the Working Group by staff: <https://mm.icann.org/pipermail/gnso-rpm-wg/2018-September/003334.html>).

Notes & Conclusions

- **Next Steps:** Working Group to consider if the CCT-RT's recommendations are addressed when developing policy recommendations for Phase One.