

November 20, 2011

Trademark Clearinghouse IAG

Scope of IAG Comments

- P1: Sunrise Domain Name Registration
- P2: Responsibility for Registrant Claims Notice
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P1: Sunrise Domain Name Registration

Terminology:

Suggestion: We should refer to trademarks in the TMCH as “records”.

A TMCH record may have one or more verified contacts, including the trademark owner, assignee, licensee, etc. TMCH accounts could have records from one or more trademark owners. There may even be multiple authorized users per account.

The term “authorization” is problematic for the process of determining if a sunrise domain name registration is eligible for sunrise. It is too similar to “authentication”, another term being used for a TMCH process. Both become commonly abbreviated as “auth”

Suggestion: I suggest the following: “Confirmation” instead of “Authorization”

Also, the term is “auth-code” is also problematic: both for the reason above as well as the similarity to codes used for inter-registrar transfers. In the TMCH sunrise context, the two codes that might exist are: validation-code, which refers to a validated trademark and contact-code, which refers to a verified contact for a trademark.

Let’s describe P1 as follows:

Determine if the domain name string being requested by the sunrise applicant is eligible for this TLD sunrise for this particular sunrise applicant.

Note the following exceptions: some TLD’s may decide to have additional eligibility requirements for its sunrise, such as requiring a specific trademark jurisdiction, presence in a geographic region, or the trademark belonging to a particular class or goods and services. If this TLD requests the TMCH to perform this extra validation, then a trademark could have multiple validation codes attached to it. Let’s defer on the question of whether the TLD has any special sunrise requirements.

For all TLD’s, P1 is, at minimum, a two-part problem:

- Does the applicant match a TMCH record owner, or designated contact?
- Is the requested domain name a match to one of the applicant’s TMCH records, after allowing for substitution of special characters?

Does the applicant match a TMCH record owner, or designated contact?

This would require the sunrise applicant's organization, and possibly their address information, to match the contact details for their TMCH record.

I would submit that many applicants would fail miserably in this task, resulting in non-automated handling of sunrise registrations. This is not a desirable outcome.

It would make no difference if it was the registrar or registry doing this check.

The use of a contact-code would eliminate this problem. The possession of a contact-code gives the sunrise applicant authorization to apply for one or more domain names matching trademarks associated with the contact-code's owner. The contact-code can be used for all of the validated trademarks associated with the contact-code. It can also be used across multiple gTLD's running the standard sunrise process.

Contrast the use of a contact-code with the use of a validation-code unique to each trademark. Using a validation-code would require companies with many trademarks to use a different validation-code for each trademark record they have in the TMCH. This could prove to be a cumbersome process for large trademark owners.

Is the requested domain name a match to one of the applicant's TMCH records, after allowing for substitution of special characters?

Once the sunrise applicant provides a valid contact-code, then you can address whether the requested domain name matches one of the trademarks associated with contact-code.

If the trademark contains special characters, including a single space, then there would be multiple domain name strings that the trademark owner could apply for during sunrise. These strings might be language-specific and could be TLD-specific if there are IDN restrictions of a TLD.

Both a contact-code and a domain name string are needed for sunrise confirmation. There would be an examination process (called T1 on the sunrise process model) of the requested domain name string to see if it matches a validated trademark associated with the contact code. Later in this IAG process we will examine whether this examination process is best done by the TMCH, registry or registrar.

In terms of the three approaches:

Approach 1:

I would recommend approach 1 since it is the only one suggesting a code issued by the TMCH. We suggest that this code be a contact-code associated with a verified contact as opposed to a code associated with a specific trademark record. The contact, in turn, is associated with one or more validated trademarks.

I propose that the sunrise Whois applicant organization and contact details does not need to be verified as matching the corresponding trademark information associated with the contact-code.

Approach 2 and 3 are not recommended since both require a process of verifying contact information during sunrise, something which is bound to fail and something the TMCH has already completed as part of its validation process. Neither one simplifies the registrant experience since registrants would need to use the exact contact details in the sunrise registration that was used for the trademark validation. This defeats the purpose of validating prior to sunrise.

Note that the description in approach 1 should be revised: “validation” is performed by the TMCH. We should not use the same term to describe a step performed by the registry.

Gaming Potential: The TMCH is intended to charge registries for use of the TMCH, presumably on a transaction basis. Some back-end registry providers running multiple TLD’s may cache contact-code and domain name combinations as a way to avoid paying TMCH fees on other TLD’s.

P2: Responsibility for Registrant Claims Notice

The question for P2 is to determine if the business requirements are true:

Business Requirements:

1. Transmission of notices must be verifiable
2. Notifications should be sent by a party that the registrant has an existing relationship with

Transmission of notices must be verifiable

Do we know what this means? Does this have the same standard as other registrar-registrant requirements, such as having registrants agree to UDRP and maintaining accurate whois records? Or does it have a higher standard?

Most registrars satisfy the registrant requirements through a simple checkbox with a link to terms and conditions. How is this verifiable? ICANN compliance can register a name at the registrar and see if they have a checkbox in the registration process.

Could the processing for claims notices be verifiable in the same way? The registrar would display a link to a claims notice with a checkbox that says “I verified that I have reviewed this claims notice and the use of the name does not infringe on a third-parties rights.....”

Or, do we want to require that registrars actually force registrants to view the full claims notice?

Notifications should be sent by a party that the registrant has an existing relationship with.

Suggestion: The word “sent” implies the possibility of a post-registration event. This should be changed to “displayed”

The claims process must occur before the registrar sends a “create” command to the registry. Let’s reject a scenario that has the registry placing a domain name into a “pending” status while waiting for acknowledgment of a claims notice, as unworkable. This would entail complications related gaming and dropping of names.

The only existing relationship we can be assured that the (potential) registrant has, is with the registrar. If the business requirement is that notices can be sent only by those with a relationship with the registrant, then the registrar needs to send the notice.

I think that making registrants aware of the TMCH is desirable, since they might want to use it for research purposes. So it would not necessarily be bad for them to receive email from the TMCH.

Since the real requirement is that the notice must be displayed to the registrant before the domain name is registered at the registry, the question is, how can this be accomplished in the midst of a process that is under the control of the registrar by anyone else other than the registrar?

I propose that the registrar have the responsibility of displaying this notice.

Discussion is needed whether the registrar can use the same standard that is followed for other registrar requirements and simply display a link or does it need to include actual record information.

All registrars should undergo an OT&E to verify they correctly handle claims processing.

Comments on Sunrise Process Flow Diagram

3.6. Clarify if step 3.6 is a claims-type notice occurring during sunrise. In other words, do trademark owners receive notices of third-party domain name registrations during sunrise that match their authenticated trademark? There is no text in the guidebook referring to this.

Comments on the Claims Notice

The second sentence “You may or may not be entitled to register the domain name depending on your intended use and whether “this use” [words added] is the same or significantly overlaps with the “use of” [words added] trademarks below.

Also, who will determine the wording of the Claims notice to Trademark owners?

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