



ARI Registry Services

Trademark Clearing House – Issues P1, P2 & General Comments

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About ARI Registry Services

In October 2011, AusRegistry International evolved to a name and brand identity in a move to support the continued expansion of the organisation and position it as a dominant force in the global TLD Registry Services marketplace.

ARI Registry Services is now used as a trading name of the AusRegistry International corporate entity.

Document Purpose

Communicate ARI Registry Service feedback on issues with the Trademark Clearing House implementation

Document Scope

Comments to ICANN on issues P1, P2 and General issues

Intended Audience

ICANNs Trademark Clearing House Implementation Assistance Group

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1. Introduction

This document was prepared in a short amount of time, apologies for any mistakes, incorrect formatting or the sometimes ‘rushed’ nature of the language. Hopefully our point is understandable and we are more than happy to clarify or answer questions.

Firstly we are concerned that breaking up the work the way that is proposed is potentially going to be troublesome as most of the answers to the technical issues will be driven by the process decisions and realistically all of those needs to be made first however the technical possibilities may guide those decisions.

Additionally, the decisions shouldn’t necessarily be made in isolation, as what may work for sending trademark claims notices to mark holders, may not work for displaying claims notices to potential Registrant for example. The processes decisions will identify the requirements, and the technical ‘team’ needs all the requirements in order to submit a model (or number of models) that will meet the process requirements, however the process requirements need to be flexible (Must do, Should do, Nice to do) so that an appropriate technical solution can be found more easily.

That being said, perhaps there is enough overlap between the two tracks in terms of interested parties that it won’t be an issue, and as long as the group is open to revisiting past decisions as we move through the process in order to come up with an effective model that works across the board, that we will be able to pull this off.

2. How Information Gets Into the Clearing House

Before P1 and P2 are discussed we need to consider how information gets into the clearing house.

This process is just as important and influences what needs to be done in later steps (Sunrise and Trademark Claims). For now the important thing is that we are assuming that part of the entry process involves validation of not only of the mark but that the entity submitting the mark is the true and correct entity who actually owns that mark. We are also assuming that the entry in the clearing house is also collecting the contact details of the mark holder for communicating with them later.

The parts of this information that are public or private will need to be established, but as far as this group is concerned we only need to worry about the data required to be given outside of the clearing house.

1. Information needs to get into the clearing house – this is currently out of scope for the discussion however is important as it will impact the technical design.
 - 1.1. How the information gets into the clearing house at this point of time we are not concerned about.
 - 1.2. What information gets into the clearing house needs to be defined
 - 1.2.1. What information is required – this will probably be dictated as a result of defining this process (e.g. the details required to be in trademark notices)
 - 1.2.2. Of that information what is public and what is held private
 - 1.2.3. Of that information what can be shared with a 3rd party (Registrar, Registry etc.) and what cannot
2. Timing issues
 - 2.1. When someone makes an entry into the clearinghouse and it is ‘approved’ by the TMCH then how long is it expected to take before that entry is ‘present’ in local copies (if they are used) or so forth (this may mean that TMCH needs to be queried all the time)? – Said another way, what time constraints are there, if any, between the verified data being entered into the clearing house database and the use of said data in sunrise and trademark claims processes?
 - 2.2. When someone updates an entry (eg. their contact details) how long before this is meant to be ‘present’ everywhere? – i.e. similar to the above what time constraints, if any, are there between modifications to clearinghouse data (eg. contact details) and the use of that data in sunrise and trademark claims processes?
3. What response do people get from the clearing house? – again I think this may be dictated by the work we are doing on the processes below. But for example:
 - 3.1. If there is a unique way to identify their registration in the clearing house then this may be helpful
 - 3.2. If there is a private piece of authorization information associated with the registration this may make other processes extremely easy to implement

3. Sunrise Process

We would suggest that the flow chart process required some clarification and potential re-order of some steps. Our proposed process is below:

1. Registry decides on eligibility criteria for obtaining a domain name in the namespace
 - 1.1. Eligibility criteria are what requirements a registrant needs to meet in order to register a name in the namespace. For example, a namespace .medical may require the registrant to be a certified medical institution or professional (where the meaning of certified is out of scope for this example), or the .melbourne TLD may require registrants to be living, or have a place of trading in Melbourne
2. Registry then decides how many phases of Sunrise it wants to run and the requirements for participation in each phase
 - 2.1. At a minimum the registry must run one phase where eligible registrants can register exact matches of marks in the TMCH as domain names.
 - 2.2. The registry may choose to run multiple phases with differing requirements for each phases. Requirements may be looser eligibility for each round, or may be looser matching of marks to the request string, or a combination of the two, or indeed any other changes the Registry may wish. For example
 - 2.2.1. .medical may run phases such as:
 - 2.2.1.1. Phase 1: Only medical organizations that meet the eligibility criteria and have a mark in the TMCH that is an exact match for their proposed domain name
 - 2.2.1.2. Phase 2: Only medical professionals that meet the eligibility criteria and have a mark in the TMCH that is an exact match for their proposed domain name
 - 2.2.1.3. Phase 3: Both medial organizations and professionals that meet the eligibility criteria and have a mark in the TMCH that are contained with the proposed domain name
 - 2.2.1.4. NOTE: some of the eligibility criteria for a namespace, or for participation in a sunrise round may be only marks of a particular class (for example)
 - 2.2.2. .melbourne may do a similar process (however there is a question of governments, who are giving permission to use their geographic name, but are wanting first right to names for their own use – this should be allowed for in the new gTLD processes but restricted to any time a geographic letter is required for the TLD)
 - 2.3. This is all just examples, the base point here is that the actual implementation of ‘sunrise’ in terms of number of rounds etc should be left to the registry as long as there is at least 60 days of sunrise and during that time mark holders can apply for names that match their trademark.
3. The sunrise process commences and applications for particular names are submitted to Registrars
 - 3.1. Registrar will need to collect the standard domain name information from the registrants as well as
 - 3.1.1. A mechanism for referencing the entry in the TMCH
 - 3.1.2. Any other information required to verify the potential registrants eligibility under the registries policies – this is a per registry requirement, up to them how they do it in conjunction with their Registrars and out of scope for this discussion.
4. Registrars pass the information to the registry

- 4.1. The Registrar can OPTIONALLY elect to verify any of the eligibility information (or indeed may be required to verify it as part of their registry-registrar agreement) including the fact that the mark is in the clearing house however this does not preclude the responsibility of the registry to at least check the mark with the clearing house. Depending on how difficult the check process is, will determine if Registrars choose to do this or not.
- 4.2. How the information passes between the Registry and Registrar is between Registrars and Registries to resolve however we would encourage a standardized approach for the mandatory information
5. The requested name is to be checked against matches for any other marks in the clearing house and a notice of seeking registration sent to those trademark owners.
 - 5.1. It needs to be determined how this is to be done, and when. We propose the following:
 - 5.1.1. The trademark clearing house should send these notices as they have the relationship with the trademark holder. (see more information below)
6. The registry determines if the name meets the eligibility criteria, which will include a check that the mark being used for the registration is in the clearing house. This may take place after the closure of the sunrise process as applications are processed in bulk. It may happen in real time, or it may be done once a week – this should be determined by the Registry.
 - 6.1. Even if the Registry relies on the Registrar to check all other eligibility information (probably not recommended to require registrars to do such checks as it will reduce their desire to participate, however this is a registry-registrar matter) the registry still needs to validate the mark is listed in the clearing house.
 - 6.2. Key pieces of information are required by the Registry:
 - 6.2.1. The name of the mark
 - 6.2.2. Proof that it is in the clearing house
 - 6.2.3. Proof that the person or entity applying is in fact authorized to register this name on behalf of the owner of the mark – We would suggest that the owner of the mark should be the registrant and that a mark owner CANNOT use their mark to give another registrant the ability to Register a name.
 - 6.3. Other information that MAY be required by the registry:
 - 6.3.1. Specific details about the mark, such as the class, date of registration, the jurisdiction and any identification numbers – Some registries will choose to display this information in the Whols (for example see microsoft.info in the Afiliis Whols) however we would strongly suggest that this is NOT mandated
7. At the end of the sunrise phase, the registry then collates all validated registrations together, works out which registrations are in contention and resolved those based on its contention resolution policy (which could be FCFS, auction, precedence of marks, precedence of location or some other mechanisms which is up to the Registry to determine) and allocates the names through a process which is to be agreed between Registry and Registrar

This process raises the following questions:

- In step 2 – Can governments who give permission to use geographic names have rights to names before trademark holders?
- In step 5 – Who should be responsible for sending notices to mark holders?
- In step 6 – How does the Registry get the key information that is required and how does it validate it? How does the Registry get the optional information?
- In step 6 – Should Trademark information be displayed in the Whols?

3.1. Can governments who give permission to use geographic names have rights to names before trademark holders?

We think so, but maybe this is not the place to discuss this.

3.2. Who should be responsible for sending notices to mark holders?

I believe this is issue P3 and we are jumping ahead by discussing this, but we can resubmit this information later.

This should be the trademark clearing house because of the TMCH maintains the contact information for the parties interested in receiving notice of registration under the Trademark Claims service. The centralization of this information means that:

1. Interested parties receive communications from only from the TMCH an entity that they are already aware of, having registered their trademark with the entity
2. Contact information is not distributed to third parties (registries and/or registrars)
3. Contact information can be updated without having to synchronize these changes with third parties (registries and/or registrars) – this includes removal of marks that are determined fraudulent or changes to legitimate marks to add, for example, an agent or portfolio manager.
4. The TMCH can offer various forms of notification that suits the needs of the mark holder. This may include immediate notification via email, batch notification via email, or alerts via SMS requesting the party log into a website to view the relevant claims notices (including the WHOIS data for the domain that was registered... etc)
5. Support for international audience, including communication in different languages, can be facilitated through the one “system”

This raises some sub-questions:

- How does the TMCH know it is required to send notice to mark holders in the database about seeking to register a name in sunrise (6.2.1 of trademark clearinghouse attachment to guidebook)?
- How are these notices sent by the clearinghouse - This is probably up to the clearing house to determine they could use email, they could use sms, they could batch them once a say, once a week, they could send individual notices for each registration. They could make premium services out of some of these things
- How does the TMCH deal with a flood of notices being sent to mark holders?
- Etc etc...

There are many issues for the TMCH to resolve however they probably don't need to be determined by this group. We believe this is all part of issue P3 and we will discuss this when the group gets to this issue then. So we are parking this for now.

3.3. How does the Registry get the key information that is required (for TMCH purposes not eligibility purposes which are for each registry to work out themselves) and how does it validate it? How does the Registry get the optional information?

We believe this is the issue P1 is referring to and offer our response in section 4 below.

3.4. Should Trademark information be displayed in the Whols?

We believe this should be a decision left to the Registry to decide.

4. Issue P1

We offer the following solutions for discussion.

1. The registry could just ask registrars to collect all the relevant fields including contract information and then use that information to match to an entry in the clearing house. This doesn't really provide authentication that the person is who they say they are as all the requested information is publically available information. Thus somehow an authentication of the entity would need to occur. Given this has to be done by the TMCH when entering information into the clearing house, it doesn't make sense to repeat that work over and over for each TLD the entity wishes to apply to. Combine this with the need for the registrant to enter the details identically to how they entered them into the clearing house to facilitate matching (especially if automated) and we do not believe this to be a viable option. This option is essentially what would need to be done in option 2 and 3 of the issues paper.
2. A 'code' could be used. The code could be passed from the registrant, via the registrar to the Registry which could then use the code to lookup details in the TMCH. If this code was confidential and only known to the person who entered the details in the clearing house, this code could also be used as an 'authentication' mechanism. This is as discussed in approach number 1 of the issues paper. We believe this is a viable solution however offer the following 3rd solution which we feel is better.
3. This is really an extension to the previous method. An entity who provides details to the trademark clearing house could have the information digitally signed by the clearing house. This digital signature could be verified with the TMCH's public key. The entity need then only supply this verified package as part of the registration and the TMCH public key could be used to validate the package. The actual information that is to be contained in the 'package' is to be confirmed, but it could be a simple XML document with simple fields that is PGP signed and saved as a simple txt file that is provided to the Registrar and passed to the Registry. This has numerous advantages including:
 - The ability to verify the information without needing access to any trademark clearing house data (or database) – this is the highest availability solution and potentially the easiest (cheapest) to implement for all parties
 - The ability to give temporal authentication to data, the signature could expire in a set time and the entity required to resubmit and reconfirm details with the clearing house
 - The fact that no one outside the TMCH actually needs access to the database! All the data is safe and secure in the TMCH.

Disadvantages of this solution are similar to the authcode from a TMCH entry holder's perspective (i.e. needing to keep track of the authenticated package). As well as puts some criticality on the TMCH protecting the private key, however a problem with the key is likely to be detected relatively quickly and can be dealt with at that point. This option would need to be explored more by technical people.

Effectively there are 2 real options here, have the entity requesting registration provide all the details and then have the entity checking those details attempt to find a match, or have the entity provide some private, secure code that matches up to their registration and then having the entity doing the checking, verify that code, and then using the code to get the information. The second

option having the advantage of also authenticating the perspective registrant as the actual ‘owner’ of the TMCH record referenced. Our third solution which combines the two together eliminates the need for the verifier to even need access to the TMCH for this purpose.

5. Issue P2

We have no issue with the high level process described in the diagram. Realistically issue P2 covers two key business requirements:

5.1. Responsibility of sending (or displaying) the Registrant Claims Notice.

The Registrar (being the entity that is accepting the application/registration for the domain name, which as Jeff points out may be the Registry) should be responsible for the presentation of the Claims Notice to the Potential Registrant. It simple makes sense that this screen displayed to a Registrant as part of the process of attempting to Register one of the domains. By having the registry do this the page can be displayed as a ‘step’ in the process probably before payment, the Registrant can read the notice, acknowledge the issue and then proceed or not proceed with the Registration. Introducing either another party into this process (whoever it may be) is just confusing, and delays the registration process. By doing the ‘notice’ as an email or some other out of band process (to the registration screens) delays the registration and turns it into a two-step process – which means Registrar would now need to build system to allow people to come back and ‘continue’ previous registrations. There are many more issues with not doing it this way.

It should be possible for a Registrar to offer a registrant with access to bulk registrations, for example a portfolio holder, the ability to agree to a "claims notice" with similar terms once, and without requiring the Registrant to sight and accept a claims notice for each domain name registration.

The TMCH is the authoritative source of the information that is included in the Claims Notice. How the Registrar receives this information from the TMCH will be discussed as part of T1. The TMCH should be responsible for providing the Registrar with the Registrant Claims Notice template including all translations thereof.

Note that presentation of the claims notice itself does not imply that the notice has to be technically included in the registration process; a referral to the TMCH, similar to how Paypal is embedded in ecommerce websites, could be sufficient, depending on availability requirements. Again though, this can be explored in T1 and/or T2 discussions.

This does however raise another issue:

1. How does the registrar know that the name being registered matches something on the list (for some definition of matches and ignoring what that is at the moment)

We would strongly argue that before we can approach T1 though we must have the discussion about what constitutes a ‘match’. This will be key to all technical (and maybe process) issues going forward. It is currently unclear who is responsible for determining the rules for matching domain names with marks. The hypothetical mark "MadeUp" might match domain names "made-up" and "madeup", however this is perhaps a trivial scenario considering this process should support IDNs. We urge this discussion to happen ASAP.

5.2. Verification of Transmission of Registrant Claims Notice

It is unclear what the driver is behind ‘transmission of notices’ to be verifiable. If the intention is to verify that Registries & Registrars are following the processes then this can simply be verified by

spot checks conducted by ICANN. However if there is a real need to have on record the fact that a person viewed the notice and still chose to proceed with the registration, it is unclear what is requested here.

If it is simply clicking an 'I Agree' button on a website 'evidence' of this is almost non-existent beyond the fact that the system would not have let them proceed without it (thus all is required is a spot check from ICANN to verify that that actually is the case), otherwise if we really require acknowledgement (maybe in the form of an email from the Registrant) then we really are making this a multi-stage, process that will be costly for everyone (which will ultimately be passed on to registrants).

Without further understanding the drivers here we have no clear recommendations to make as yet.

It is our opinion that the registrant claims notice serves no real purpose other than to ward off those who intend to register names for the purpose of abusing the rights of others. It is anticipated that registries will end the trademark claims process after the mandatory 60-day period; registrations outside of this period will not require notice be provided to potential registrants, yet those same registrants are still required not to infringe on the rights of others. To this end, what purpose does the verifiability of transmission serve, other than verify that the process is being followed?

Spot-checks by ICANN or an ICANN-contracted party could ensure that the notice is being displayed to potential registrants by attempting to register domain names. Furthermore, we could require that Registrars (those entities accepting registrations for domain names, which may include Registries) can provide some self-certified audit trail indicating that the user was presented with the notice and agreed to proceed with the registration. It does seem silly to then have this 'evidence' (whatever it actually is – how do you provide evidence someone ticked a tick box or selected 'I accept') passed to the Registry so that it can then 'prove' it has met some contractual requirement. This all requires more discussion.

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