IAG summary: P1: Sunrise Domain Registration Authorization

From: Tom Barrett - EnCirca

Here are some fresh thoughts about P1 based on the November 30 discussion.

Regarding Tokens or Codes
I think there is consensus on requiring the sunrise applicant to provide a token or code during the sunrise, thereby eliminating the need to match the sunrise applicant with the validated trademark owner. This implies that the sunrise applicant would not need to match the trademark owner of the token.

The question remains: what does this code stand for? One for each owner? ("Contact code"). Or, one for each validated trademark? ("Trademark code"). Or something else?

On the call, I proposed one scenario could be:

1. Contact code plus requested domain name string.

The questions rose with this approach included:
1. If a trademark owner has thousands of trademarks validated in the TMCH, each with many possible domain names, can the TMCH determine if there is a match without a significant delay?

2. What if the applicant has multiple validated trademarks that match this domain name, are they all linked to the sunrise Registration?

3. How do we know which associated trademark was matched for this domain name string? (Important to know for possible disputes later).

4. What if the Registry has restrictions that disqualify some of the matching trademarks? Would the TMCH be aware of these and take this into consideration?

While I believe the approach could address all of these questions, it is clear that a more transparent approach would be preferred.

An approach where each validated trademark had its own token would make the process more transparent. But no one expressed enthusiasm in keeping track of a unique code for each validated trademark.

Let me propose a hybrid approach that could resolve this issue: We already have a way to uniquely identify a trademark in the TMCH: its jurisdiction and Registration number. There is no need to create a new trademark-specific token when these two existing fields already give us what we need. The sunrise applicant could simply provide the jurisdiction and Registration number of the validated trademark that matches their requested domain name string, along with their unique Contact code (from scenario 1). Thus, the trademark owner would only need to provide one token for all of their sunrise applications.

(Note for special cases: the TMCH might need to generate Registration numbers for records in the TMCH due to court orders or treaties, as well as jurisdictions that use only application numbers. Also, we should recognize there could be multiple rights owners to the same jurisdiction/ Registration number pair, such as an owner-of-record and its licensees. Each would have their own unique Contact code)

Role of TMCH vs. Registry in Sunrise Authorization
Another important issue that came up is the distribution of work (i.e. "sunrise authorization") between the TMCH and the Registry/Registrar.

In other words, what sunrise eligibility checking does the TMCH do and what checking does it <u>not</u> do?

I would propose the following rule or guideline to determine which party performs the checks:
- TMCH does the eligibility check if it is based on data existing in the TMCH
- Registry does the eligibility check if it is based on data not existing in the TMCH

TMCH Data Fields
Let's first review a partial list of record-related data that could be in the TMCH:

1. authentication status
2. validation status
3. authentication approval date
4. validation approval date
5. trademark string
6. Registration date
7. jurisdiction of Registration
8. trademark class(es)
9. goods and services
10. locality of trademark owner
11. disclaimed text and other miscellaneous fields
12. language of the trademark (collected at time of application)
13. eligible domain name strings based on special character substitution

TLD Sunrise Restrictions
When a TLD has a sunrise restriction, whose job is it to check to see if a validated trademark is eligible? The TMCH or Registry?

The one restriction that all TLD's will have is a "sunrise eligibility date". The TMCH record's "validation approval date" would need to be earlier than the TLD's "sunrise eligibility date".

There are two approaches to satisfy the "sunrise eligibility date" restriction:

1. The TMCH stores the sunrise eligibility date for each TLD. When a sunrise application is sent to the TMCH for authorization, the TMCH verifies the trademark was validated before the TLD's eligibility date, or:

2. The TMCH is unaware of the TLD specific cut-off date. When the sunrise application is sent to the TMCH, it returns the "validation approval date" to the TLD and lets the TLD determine if application is eligible.

I propose the first approach where the TMCH is doing this check is the preferred approach. This means that the TMCH will maintain a sunrise eligibility date specific to each sunrise it supports

Note: a TLD might have several sunrises. For example: .AFRICA might have one for regional trademarks and then another for the rest of the world.

So what other TLD-specific sunrise restrictions could the TMCH be responsible for checking?

Sunrise restrictions based on data existing in the TMCH
Any sunrise restrictions related to data already maintained by the TMCH, should be checked by the TMCH. For example, if a Registry decided to have a sunrise restricted to trademarks from a particular jurisdiction or goods and services, the TMCH could easily incorporate this check as part of the authorization process. For example: .AFRICA might elect to have a sunrise only for trademarks registered in an African country.

The types of sunrise restrictions that the TMCH could check include:
- jurisdiction of the trademark owner
- locality of the trademark owner
- trademark class or goods and services
- language of trademark

Sunrise restriction based on data not existing in the TMCH
The Registry would be responsible for performing any restriction checks for data not existing in the TMCH. However, nothing prohibits the Registry from contracting with the TMCH to perform these checks.

Eligible domain name strings based on special character substitution
There were some questions during the call whether the TMCH or Registry would determine what constitutes an exact match of a requested domain name. In other words, would the TMCH generate the list of eligible domain names for each validated trademark and share this with each Registry somehow or leave this to each Registry to generate?

Here I am referring only to whether the TMCH or Registry should be responsible for converting any special characters existing in a trademark into eligible domain name strings. The actual rules for the substitution of special characters in trademarks is the subject of a later IAG session.

Special characters are not to be confused with IDN's. In fact, many IDN code points do not even include many special characters.

A special character is defined as "any character in a trademark that can not be represented in a domain name". Examples include: a space, hyphen ("-"), plus sign ("+"), !,@,#,$,%,^,&,*, etc. When a special character exists in a trademark, then exact matches with domain names are determined after first replacing the special character with one of the following:
1. It is omitted entirely
2. It is replaced with a hyphen ("-")

3. It can be transcribed into a word. For example, the plus sign "+" for an English-language trademark, might be replaced with the text string "plus" or "and"

Rule number 3 is language-specific. So, a "plus" sign for a Greek-language trademark would be replaced with the Greek language spelling(s) of a "plus" sign.

These language-specific substitutions of special characters should be:
   a. determined via a community-driven effort for each language that trademarks can be filed in at PTO's
   b. published and available for public review
   c. applied by the TMCH to generate the list of eligible domain name strings for each trademark based on the language of the trademark

To be explicit: I am proposing that Registries not be allowed to generate their own rules for the substitution of special characters for their TLD's. Further, I am proposing that the TMCH be responsible for generating the list of eligible domain names for the validated trademarks based on the community-generated rules.

These lists would be used for both sunrise and trademark claims processing for all applicable TLD's. The lists could be made available (or distributed), in a limited searchable interface, to registries, registrars, and for research purposes, to trademark owners and potential registrants. This is a subject of a later IAG topic.

Comments welcomed.

Sincerely,

Tom Barrett
EnCirca