

Proposed Answer	Preliminary Recommendation
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[Status Check] Trademark Claims Sub Team Recommendations for RPM PDP Working Group Discussion

Table 1 of this document consolidates, for Working Group discussion, the Trademark Claims Sub Team’s proposed answers and preliminary recommendations in relation to each agreed Trademark Claims charter question. It also reflects how preliminary recommendations correspond to the proposed answers to specific sub questions. Table 2 includes a snapshot of the results of the Trademark Claims Sub Team’s review of all individual proposals received from Working Group members. For more details and additional context, please refer to the Trademark Claims Sub Team’s Summary Table and the Sub Team’s weekly progress reports.

Table 1: Proposed Answers to Agreed Charter Questions & Preliminary Recommendations

QUESTION 1	
Proposed Answer	Preliminary Recommendation
<p>Q1: <i>Is the Trademark Claims service having its intended effect?</i></p> <p>Proposed Answer: With limited data, the Sub Team did not come to agreement as to whether the Trademark Claims service is “absolutely” having its intended effect; although the Sub Team could determine that the service is at least “possibly” having its intended effect.</p>	<p>The Trademark Claims Sub Team recommends that the language of the Trademark Claims Notice be revised, in accordance with the Implementation Guidance outlined in the Sub Team’s recommendations for Question 3 (below). This recommendation aims to help enhance the intended effect of the Trademark Claims Notice by improving the understanding of recipients, while decreasing any unintended effects of deterring good-faith domain name applications.</p>
<p>Q1(a): <i>Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing Claims Notice to domain name applicants?</i></p> <p>Proposed Answer: With limited data, the Sub Team did not come to</p>	

Commented [1]: Review of Proposal #6 - Not Completed

Proposed Answer	Preliminary Recommendation
<p>agreement as to whether the Trademark Claims service is “absolutely” having its intended effect of deterring bad-faith registrations; although the Sub Team could determine that the service is at least “possibly” having its intended effect. Some Sub Team members drew this conclusion based on the low number of UDRP proceedings/challenges in new gTLDs compared to that in legacy TLDs. There is insufficient data to determine the extent of deterrence, if any occurred.</p>	
<p>Q1(b): <i>Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications?</i></p> <p>Proposed Answer: The Trademark Claims service may possibly have unintended consequences, such as deterring good-faith domain name applications. There is insufficient data to determine the extent of deterrence, if any occurred.</p>	
QUESTION 2	
Proposed Answer	Preliminary Recommendation
<p>Q2(a): <i>Should the Claims period be extended - if so, for how long (up to permanently)?</i></p> <p>Proposed Answer: The current mandatory Claims period should not be extended. However, registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period.</p>	<p>The Trademark Claims Sub Team recommends, in general, that the current requirement for a mandatory Claims Period be maintained, including for the minimum initial 90-day period when a TLD opens for general registration.</p> <p>The Trademark Claims Sub Team recommends that public comment be sought on whether registries should have the option to conduct a</p>
<p>Q2(b): <i>Should the Claims period be shortened?</i></p> <p>Proposed Answer: The current mandatory Claims Period should not</p>	

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 Preliminary Recommendation - Not Completed
 Review of Proposal #12 - Not Completed.

Proposed Answer	Preliminary Recommendation
<p>be shortened.</p>	<p>permanent Trademark Claims period.¹</p>
<p>Q2(c): <i>Should the Claims period be mandatory?</i></p> <p>Proposed Answer: There should be a mandatory Claims Period. However, registries should have a certain degree of flexibility to create a suitable business model in providing the Claims Service, provided this does not involve shortening the mandatory Claims Period.</p>	<p>(Staff note as of 13 May: Michael Graham will provide language for a potential additional preliminary recommendation pertaining to developing a list of data/information that should be gathered to facilitate the future review of RPMs.)</p>
<p>Q2(d): <i>Should any TLDs be exempt from the Claims RPM and if so, which ones and why?</i></p> <p>Proposed Answer: TLDs -- not including legacy TLDs as the mechanism is applicable to gTLDs launched during the 2012 New gTLD Program and future new gTLD Program(s) -- should not be exempt from the Claims RPM. However, based on the limited data, public comment will be sought on whether there is a use case for exempting a TLD from the requirement of a mandatory Claims Period due to the particular nature of the TLD.</p>	<p>The Trademark Claims Sub Team recommends that public comment be sought on whether there is a use case for exempting a gTLD that is approved in subsequent expansion rounds from the requirement of a mandatory Claims Period due to the particular nature of that gTLD. Such type of gTLD might include: (i) restricted TLDs² that bar any commercial use due to their terms of use or acceptable use policy; and (ii) "Dot Brand" TLDs whose proposed registration model demonstrates that the use of a Claims Service is unnecessary.</p>
<p>Q2(e): <i>Should the proof of use requirements for Sunrise be extended to include the issuance of TMCH notices?</i></p> <p>Proposed Answer: The Sub Team has differing opinions on whether the proof of use requirements for Sunrise should be extended to include the issuance of TMCH notices. The Sub Team has not reached agreement on any proposed answer to this question.</p>	

¹ The orange text are "tentative". They are either potential amendment to preliminary recommendations as a possible result of the Sub Team discussions related to Individual Proposals OR initial ideas/proposals the Sub Team just started discussing. The final document will only include preliminary recommendations that the Sub Team has agreed on.

² **Restricted TLDs:** The TLD whose registration is limited to people or entities that satisfy certain criteria set by the TLD's Registry Operator.

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QUESTION 3

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<p>Q3(a): Does the Trademark Claims Notice to domain name applicants meet its intended purpose?</p> <p>Proposed Answer: The Trademark Claims Notice generally meets its intended purpose of notifying prospective domain name registrants that the applied-for domain name matches at least one trademark in the Trademark Clearinghouse.</p>	<p>The Trademark Claims Sub Team recommends that the Trademark Claims Notice be revised to reflect more specific information about the trademark(s) for which it is being issued, and to more effectively communicate the meaning and implications of the Claims Notice (e.g., outlining possible legal consequences or describing what actions potential registrants may be able to take following receipt of a notice).</p> <p>The Trademark Claims Sub Team recommends, accordingly, that the current version of the Claims Notice be revised to maintain brevity, improve user-friendliness, and provide additional relevant information or links to multilingual external resources that can aid prospective registrants in understanding the Claims Notice and its implications.</p>
<p>Q3(a)(i): If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved?</p> <p>Proposed Answer: Based on the data, the Claims Notice is intimidating, hard to understand, or otherwise inadequate (e.g., lack of identifying details of the trademark, issues with figurative/design marks).</p>	<p>To assist the Implementation Review Team (IRT) that will be formed to implement recommendations from this PDP in redrafting the Claims Notice, the Trademark Claims Sub Team has developed the following Implementation Guidance:</p> <ul style="list-style-type: none"> • The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law; • [Albeit unspecified, agreed terms, concepts, parameters, objectives, and principles should be taken into account when the IRT redrafts the Claims Notice]; • A suggestion was made that ICANN Org consider partnering with external resources that have already indicated an interest in helping redraft the Claims Notice (e.g., AUIP clinic).
<p>Q3(a)(ii): Does it inform domain name applicants of the scope and limitations of trademark holders' rights? If not, how can it be improved?</p> <p>Proposed Answer: Based on the data, the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights.</p>	

Commented [4]: Sub Team will need to develop more specific terms, concepts, parameters, objectives, and principles

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<p>Q3(a)(iii): <i>Are translations of the Trademark Claims Notice effective in informing domain name applicants of the scope and limitation of trademark holders' rights?</i></p> <p>Proposed Answer: Based on the data, the current requirement on translations of the Trademark Claims Notice does not seem effective in informing domain name applicants of the scope and limitation of trademark holders' rights. The Sub Team noted, however, that it may become quite complex for a registrar to operate the Claims Notice if all possible translations are required.</p>	<p>The Trademark Claims Sub Team recommends that delivery of the Trademark Claims Notice be both in English as well as the language of the registration agreement. In this regard, the Trademark Claims Sub Team recommends changing the relevant language in the current Trademark Clearinghouse Requirements on this topic to "...registrars <u>must</u> provide the Claims Notice in English and in the language of the registration agreement."</p> <p>The Trademark Claims Sub Team also recommends that, where feasible, the Claims Notice include links on the ICANN Org website to translations of the Claims Notice in all six UN languages.</p>
<p>Q3(b): <i>Should Claims Notifications only be sent to registrants who complete domain name registrations, as opposed to those who are attempting to register domain names that are matches to entries in the TMCH?</i></p> <p>Proposed Answer: The Claims Notice should not be sent only to registrants who complete domain name registrations. The Claims Notice should generally be sent to potential registrants, who are attempting to register domain names that are matches to entries in the TMCH, at some point before the domain name registration is completed. However, one Sub Team member strongly opposed sending the Claims Notice before the registration is completed.</p>	<p>The Trademark Claims Sub Team recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained.</p> <p>The Trademark Claims Sub Team also recognizes that there may be operational issues with presenting the Claims Notice to registrants who pre-registered domain names, due to the current 48-hour expiration period of the Claims Notice.</p> <p>The Trademark Claims Sub Team therefore recommends that the Implementation Review Team consider ways in which ICANN Org can work with registrars to address this implementation issue.</p>
QUESTION 4	
Proposed Answer	Preliminary Recommendation
<p>Q4: <i>Is the exact match requirement for Trademark Claims serving the intended purposes of the Trademark Claims RPM? In conducting this analysis, recall that IDNs and Latin-based words with accents and</i></p>	

Commented [5]: - Answer to Q4, Q4(a), Q4(b), Q4(b)(iv), Q4(d)(i), Q4(d)(ii) - Not Completed
 - Preliminary Recommendation - Not Completed

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<p><i>umlauts are currently not serviced or recognized by many registries.</i></p> <p>Proposed Answer: The Sub Team has differing opinions on whether the exact match requirement is serving the intended purposes of the Trademark Claims RPM.</p>	
<p>Q4(a): <i>What is the evidence of harm under the existing system?</i></p> <p>Proposed Answer: The Sub Team has differing opinions on whether there is evidence of harm under the existing system of exact match.</p> <p>Some Sub Team members believe that the existing system does not have a clear deterrence effect against registrations of confusingly similar matches, including typosquat variants and “exact trademark plus word” domain name applications. They believe that this system harms trademark owners’ ability to protect their trademarks in a cost-effective manner and increases their curative mechanisms burden after the harm has already taken place (especially the harm from cybersquatters). They also believe it harms the prospective registrants who may be unaware that some non-exact matches can be “actionable” under trademark laws or dispute resolution mechanisms for trademark infringement.</p> <p>One Sub Team member does not believe there is evidence of harm under the existing system, but that nevertheless the exact match requirement for Trademark Claims already harms registrants.</p>	
<p>Q4(b): <i>Should the matching criteria for Notices be expanded?</i></p> <p>Proposed Answer: The Sub Team has differing opinions on whether the matching criteria for the Claims Notice should be expanded.</p>	<p>Staff Note: As of 14 May, the Trademark Claims Sub Team has not yet developed a preliminary recommendation, but has discussed some related issues.</p> <p>1) The Sub Team acknowledged the usefulness of the Abused Domain</p>

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	<p>Name Labels service (“50 Plus”), which allows rights holders to register up to 50 abused labels related to a registered trademark in the TMCH. However, 50 Plus is limited to abused labels that have already been adjudicated, and those labels will unlikely be reregistered.</p> <p>2) One Sub Team member mentioned the issue of registrars selling domain names to registrants who are not allowed to own them due to potential trademark infringement. Another Sub Team member commented that it is impossible for a registrar to know the registrant’s intent to register/use a domain name, hence registrars cannot be held responsible for the registrant’s subsequent infringement.</p> <p>3) Some Sub Team members discussed the Ongoing Notification service provided by the TMCH. It will notify the trademark owner, following the 90 day Trademark Claims Period, when someone has activated a domain name in a new gTLD that contains the exact match or additional variation labels of the registered trademark in the TMCH.</p> <p>One Sub Team member suggested that the Sub Team may consider discussing whether the Ongoing Notification service for additional variation labels should <i>also</i> be provided during the Trademark Claims Period. This would raise several follow-up questions:</p> <ul style="list-style-type: none">• Will domain name applicants also receive notice?• Should there be any cost for the service during the Trademark Claims Period?• How do the specific variations accepted by the Ongoing Notifications service stack up against the ideas for expanded match currently being discussed in the Sub Team?

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<p>Q4(b)(i): <i>Should the marks in the TMCH be the basis for an expansion of matches for the purpose of providing a broader range of claims notices?</i></p> <p>Proposed Answer: If the matching criteria for the Claims Notice were to be expanded, the marks in the TMCH should be the basis for an expansion of matches for the purpose of providing a broader range of Claims Notice.</p>	
<p>Q4(b)(ii): <i>What results (including unintended consequences) might each suggested form of expansion of matching criteria have?</i></p> <p>Proposed Answer: Some Sub Team members believe that expansion of matching criteria, in general, might help trademark owners better protect their trademarks in a cost-effective manner. Otherwise, trademark owners are forced to “engage in curative mechanisms for the variants that skirt the exact-match notice rules”.</p> <p>In a previous study, the Analysis Group had concluded that the unintended consequences may include an increase of the implementation costs for registries and registrars. However, this conclusion was not based on any cost-benefit analysis. One Sub Team member commented that the expanded matching criteria still cannot usefully capture the “bewildering variety” of non-exact matches.</p>	
<p>Q4(b)(iii): <i>What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?</i></p> <p>Proposed Answer: The balance is between generating a comprehensive non-exact match criteria that covers as many applicable scenarios as possible <i>and</i> avoiding a potential overflow of false positives due to “bad matches”.</p>	

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<p>Prospective registrants should be appropriately notified by a well-crafted Claims Notice regarding a potential problem with their chosen domain names.</p>	
<p>Q4(b)(iv): <i>What is the resulting list of non-exact match criteria recommended by the WG, if any?</i></p> <p>Proposed Answer: The Sub Team has not developed a proposed list of non-exact match criteria, if the matching criteria for the Claims Notice were to be expanded.</p>	<p>Staff Note: As of 14 May, the Trademark Claims Sub Team has not yet developed a preliminary recommendation, but has discussed some initial ideas/concepts/proposals for the expanded match, if the matching criteria for the Claims Notice were to be expanded.</p> <p>1) Some Sub Team members suggested that the expansion of match criteria, if any, should not be limitless and should be narrowly based on real work experience with infringement, as well as technical implementability by the TMCH. They include:</p> <ul style="list-style-type: none"> ● term indicating the product/service related to the business of the trademark owner; ● business descriptor indicating the type of an entity (e.g., INC, CO, CROP, LLC, GMBH, SARL); ● industry keyword related to the trademark; ● accent and umlaut. <p>2) One Sub Team member suggested that the list of non-exact match criteria can possibly be developed based on the domain names challenged in URS and UDRP cases.</p> <p>Another Sub Team member commented that based on URS cases, there is no “pattern” suggesting that trademarks plus brand related keywords make up a significant portion of cybersquatting domains.</p> <p>Other Sub Team members commented that the URS is underutilized due to the limitations of the remedy, hence it is not an appropriate basis upon which to discern the “pattern” of problematic new gTLD</p>

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	<p>registrations.</p> <p>3) One Sub Team member suggested that the Claims Notice be issued for a domain name where the string contains the exact match of the trademark registered in the TMCH. This idea did not receive wide support from the Sub Team.</p> <p>4) One Sub Team member suggested that the “Proposal for Smarter Non-Exact Matches” submitted during the TMCH discussion in 2017 should be reconsidered. The Sub Team has not yet discussed this proposal.</p>
<p>Q4(c): <i>What is the feasibility of implementation for each form of expanded matches?</i></p> <p>Proposed Answer: The Sub Team team has differing opinions on the feasibility of implementing expanded matches.</p> <p>Some Sub Team members believe it is feasible due to the existence of the 50 Plus service. One Sub Team member explained that the 50 Plus service is still technically based on exact match.</p> <p>Some Sub Team members believe that the feasibility is low due to the difficulty of amending the Trademark Claims Notice in order to effectively explain the issue of non-exact matches to prospective registrants. They believe that there is a likelihood that the Claims Notice may become even more intimidating, hard to understand, or otherwise inadequate. Furthermore, these Sub Team members believe it is difficult to strike a balance between generating a comprehensive non-exact match criteria that covers many applicable scenarios and avoiding a potential overflow of false positives due to “bad matches”.</p>	

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<p>Q4(d)(i): <i>If an expansion of matches solution were to be implemented, should the existing TM Claims Notice be amended? If so, how?</i></p> <p>Proposed Answer: If an expansion of matches solution were to be implemented, the existing Trademark Claims Notice should be amended.</p> <p>The Sub Team was unsure what additional Implementation Guidance should be included besides those outlined in the Sub Team’s recommendations for Question 3 with regard to revising the language of the Claims Notice (above).</p> <p>It was also unclear from the Sub Team discussion who should receive the notification of the non-exact match. One Sub Team member noted that a “broader” notice, which refers to both the Claims Notice to the prospective registrants and the NORN to trademark owners, should be provided to appropriately notify all affected parties of a non-exact match.</p>	
<p>Q4(d)(ii): <i>If an expansion of matches solution were to be implemented, should the Claim period differ for exact matches versus non-exact matches?</i></p> <p>Proposed Answer:</p>	
<p>QUESTION 5</p>	
Proposed Answer	Preliminary Recommendation
<p>Q5: Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds?</p> <p>Proposed Answer:</p>	

Commented [6]: Not Reviewed

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Table 2: Status of Individual Proposals Review

Proposal No.	Status
Proposal #1	Review Completed - It did not receive wide support from the Trademark Claims Sub Team for inclusion in the Initial Report.
Proposal #5	Review Completed - It did not receive wide support from the Trademark Claims Sub Team for inclusion in the Initial Report.
Proposal #6	Review Not Completed - It may affect the preliminary recommendations for the agreed Trademark Claims Charter Question 1.
Proposal #11	Review Not Started
Proposal #12	Review Not Completed - It may affect the preliminary recommendations for the agreed Trademark Claims Charter Question 2.