

### **Attendance - 10 Members**

George Kirikos  
Greg Shatan  
Griffin Barnett  
Kathy Kleiman  
Kristine Dorrain  
Martin Silva Valent  
Michael Graham  
Rebecca L Tushnet  
Susan Payne (SCA/valideus)  
Zak Muscovitch

**Apologies:** Sara Bockey, Phil Corwin, Brian Beckham, Cyntia King

**Staff:** Ariel Liang, Julie Hedlund, Berry Cobb, Julie Bisland

### **AC Chat:**

Julie Bisland: Welcome to the RPMs Sub team for Trademark Claims Data Review call on Wednesday, 06 February 2019 at 17:00 UTC

Julie Bisland: Agenda wiki: <https://community.icann.org/x/8Z8WBg>

George Kirikos: Hi folks.

Martin Silva Valent: hi all

Griffin Barnett: Hi I just wanted to note that I had prepared responses for the current HW assignment and once again forgot to get them in before the Google Doc was locked, so my apologies for that

Griffin Barnett: I am happy to add these in following the call today

Griffin Barnett: And if helpful would be happy to present my comments on the call, if appropriate

Rebecca L Tushnet: Does anyone else have trouble getting the passcode accepted?

Julie Hedlund: @Griffin: That would be very helpful, thank you!

Kristine Dorrain: Hi all. I'm here but stepping away for a second...BRB

Martin Silva Valent: It worked ok for me

Rebecca L Tushnet: I used the alternate # and succeeded

George Kirikos: @Rebecca: I used the 1-866 number. I had problems sometimes in the past, as some numbers didn't seem to access the pass codes.

George Kirikos: didn't seem to \*accept\* the pass codes.

Brian Beckham - WIPO: @Julie, Staff, I have another call I am supposed to be on right now - is this call going to be recorded?

George Kirikos: They're all recorded, Brian.

Brian Beckham - WIPO: Thanks - in that case, with your understanding, I will take that other call and listen to this later.

Julie Bisland: thank you, Brian, noted

Griffin Barnett: @George, can we save substantive discussion on your point for when we reach AOB?

Kristine Dorrain: I'm back.

George Kirikos: Echos.

Kristine Dorrain: Oh god

George Kirikos: My ears are bleeding.

George Kirikos: We all know the charter questions. Can we dispense with reading them?

Julie Bisland:apologies for the unrelated message: just checking on the phone numbers ending in 4330 and also 6759. Please chat me if one belongs to you :)

George Kirikos:425 area code = Washington state, probably Michael G or Kristine; 703 = Virginia

Kristine Dorrain:(not it)

Julie Bisland::) thank you

Griffin Barnett:As I understand it, the TMCH is recording marks where there is a discernable textual component of the mark, even if the mark also includes design elements. This makes sense in terms of TM law because someone using just the text component of a mark, even without design elements, could be committing infringement based on the likelihood of confusion test

Griffin Barnett:Specifically, in light that our conversation here is in the context of Claims, this makes sense

Kristine Dorrain:a record in the Clearinghouse does not mean it's active.

George Kirikos:SMD-related stuff in the next hour, as per those Google docs.

Kathy Kleiman:Does anyone remember the source?

Kathy Kleiman:Sorry == confusing Sunrise and TM Claims (where SMD fields are on the table) :-)

Rebecca L Tushnet:Kathy is correct though that computers just do what you tell them; even if no one intended it this is worth being clear about what is going on.

Kathy Kleiman:@Griffin, TMCH accepting letters and words, even if those letters and words have been disclaimed -- even if they are completely generic to their business or industry. There would be no confusion of another group in that industry or group using that mark

Kathy Kleiman:(by law)

Kathy Kleiman:@Griffin, can we put that source back in the record?

Griffin Barnett:@Kathy, which source?

Greg Shatan:The issue of disclaimer is much more narrow than the issue of submitting stylized marks or marks containing design elements. Also, disclaimers are often partial rather than total, and thus may well not include the "word mark" in the disclaimer.

Griffin Barnett:@Kathy, even if something may not rise to infringement it could still rise to bad faith registration/use perhaps

Kathy Kleiman: @George - would you recommend more information in the TM Claims Notice?

George Kirikos:@Kathy: I'd eliminate claims entirely. But, if TM claims exist, certainly more should be present, to actually locate the record. As you've argued, it should be fully public.

Kristine Dorrain:Can I get some clarification....are we substantively debating recommendations here or just reviewing the potential data sources?

George Kirikos:(John Berryhill made the same argument, in a document that's not a "historical document" in this PDP, and which burdens have been placed in submitting it!)

Griffin Barnett:Kristine, great point

Martin Silva Valent:only data sources, you are right

Griffin Barnett:We may be getting ahead of ourselves

Kristine Dorrain:(without prejudice to my future intent to agree with the current speaker, I just want to make sure we stay on track today)

Griffin Barnett:+1

Michael Graham:@Rebecca -- Word mark registration may be desirable, but having worked with startups and SMEs through IP Clinics, they will more often register the design + word mark than word mark alone when they must limit their registration expenditures.

Kristine Dorrain:OK, some people think the data on design marks is relevant. Let's please carry on.

Griffin Barnett:@Rebecca, it is not just for really clear conflicts... it can be any context of potential bad faith registration and use; wouldn't even need to necessarily meet an infringement standard

Rebecca L Tushnet:Griffin that's not the Claims Notice standard unless you want an infringement inquiry before a notice is sent

Griffin Barnett:Yes I get what you're saying, the standard is "exact match"

Rebecca L Tushnet:If it's going to be automated, then it should be limited to the rights that exist as a result of registration (even though plenty of rights in unregistered marks also exist)

Griffin Barnett:But we have to think about what that means in the context of a potential legal issue

Rebecca L Tushnet:As I tell my students, there's always a \*potential\* legal issue

Rebecca L Tushnet:The question is what should be singled out

Griffin Barnett:In any case, going back to earlier comments, I'm not sure we are at the stage now of getting into substantive debate on the issues, but should really be focusing on what the data here is and whether it is relevant to those discussions

Kristine Dorrain:+1 Griffin

Rebecca L Tushnet:And I think it's quite relevant that design marks interact with the language of the notice, which is misleading as to them.

George Kirikos:Low volume.

Julie Hedlund 2:You are very faint Greg

Griffin Barnett:Rebecca, I agree that if the language in the claims notice is misleading we should try and correct that

Julie Bisland:Greg:please speak closer to your mic

Rebecca L Tushnet:+1 more volume please

Michael Graham:What negative effect arises from TMCH recordation of the Discernable Word portion of a Design/Stylized trademark? If anything, it would enhance the searchability of the TMCH -- if it were open to search, which I do not believe appropriate.

Greg Shatan:Sorry about the low volume; boosted now.

Kathy Kleiman:@Michael - happy to talk offline -- and about the detailed STI discussions on this.

Kathy Kleiman:Who is talking?

Michael Graham:@Rebecca and Griffin -- Agree ( I think we all do) that Notice Language should be reviewed/clarified.

susan payne:+1 griffin. which would support the suggestion already made to revise the Claims Notice language

Michael Graham:@Kathy -- I do know the STI discussions -- I believe TMCH searchability would be far secondary to TM Register/Common Law-Online searches for trademarks.

Julie Hedlund 2:Question 2 is loaded and unsynced

Griffin Barnett:I assume Greg's hand is an old hand?

Kathy Kleiman:@Michael -- to your question -- What negative effect arises from TMCH recordation of the Discernable Word portion of a Design/Stylized trademark? If anything, it would enhance the searchability of the TMCH -- if it were open to search, which I do not believe appropriate. Happy to talk!

Julie Hedlund 2:@Greg: Is that an old hand?

Griffin Barnett:I agree there was no relevant data in this document set for this Q

Michael Graham:@Kathy -- Thanks. for the offer. Will consider -- though I'm in post-vacation catchup mode.

Julie Hedlund 2:Question 3 is loaded and unsynced

George Kirikos:Right, but the only data that was in the Deloitte document was what is actually in the claims notice.

Griffin Barnett:I would again caution us not to get into substantive discussion yet

Griffin Barnett:@Kathy

George Kirikos:(all the rest was simply commenting how that's insufficient, but wasn't in Deloitte, but making inferences due to the inadequacy)

George Kirikos:I agree with everything Kathy is saying (just pointing out we said it all in Q1).

Michael Graham:@Kathy -- Geo/Design/etc. marks -- Agree that TM Claims Notice revision should consider whether there should be separate forms based on nature of TMCH registration.

Greg Shatan:It would be helpful if we can we stick to "How (if at all) does the data assist in answering this Question?"

Kristine Dorrain:+1 susan

Kristine Dorrain:We all need to exercise that self control. When one person starts, everyone else wants to follow along.

Greg Shatan:Advocacy begets counteradvocacy, which takes us away from the data ID exercise.

Griffin Barnett:@Kathy, I'm not saying we won't connect those dots from what the data says to how we ultimately answer the questions, but as others have said that is not our exercise right now

Griffin Barnett:That's all

Greg Shatan:Maybe we should let the data speak for itself at this point.

George Kirikos:For #4, this is the same tidbit that Kristine identified in Q1.

George Kirikos:Although, the 2nd part is different.

Kathy Kleiman:So #4 covered?

Kathy Kleiman:sounds good!

George Kirikos:#5 had nothing

George Kirikos:(at least, nothing I can find)

Julie Hedlund 2:@Kathy: We having covered Q4 -- moving to AOB so there is time.

Griffin Barnett:So next time, we will pick up gong through the data for Q4... in the meantime I will be sure to add my written comments to the Google Doc

Julie Hedlund 2:Sorry -- haven't covered Q4.

Martin Silva Valent:we didn'tcovered q4

Michael Graham:@Greg -- Agree -- need to be empirical.

George Kirikos:if it's not "final", then that means this Friday's deadline isn't binding?

Greg Shatan:The work plan is a work in progress, and the current plan is in effect until the next iteration comes along.

Griffin Barnett:Seems like the work/deadline is evolving as dictated by how far we get with the HW and calls discussion

Kathy Kleiman:do people think the INTA and Analysis Group (early) reports are reasonable?

Kathy Kleiman:it's 163 pages

Kristine Dorrain:AGree with Griffin.

Griffin Barnett:I would say any "deadline" is probably just a hopeful suggestion

Kristine Dorrain:+1

George Kirikos:I've already suggested by Mid-March.

Kathy Kleiman:What's reasonable for next week?

Griffin Barnett:I would be comfortable with adding the INTA and other AG report as HW for next week

George Kirikos:Saying that the "work plan is evolving" seems like a way of avoiding saying what is the current work plan, to me.

George Kirikos:Either there is a plan, or there isn't one.

George Kirikos:We should assign only 30 pages for next week.

Griffin Barnett:@George, practically speaking, what is the concern?

Julie Bisland:Next call: Wednesday, 13 February 2019 at 17:00 UTC for 60 minutes.

George Kirikos:Not the entire 250+ pages left.

George Kirikos:@Griffin: deadline for this Friday is unreasonable.

George Kirikos:Can't expect to do in 2 days what staff failed to do in 1.5 years.

Griffin Barnett:Right, and if that deadline was only intended as a hopeful suggestion, then what's the problem?

Griffin Barnett:(i.e. if folks are free to complete that task beyond the deadline, no problem right?)

George Kirikos:@Griffin: but, read the google doc, it says Anything not submitted by Friday is OUT OF ORDER and wont; be considereed.

George Kirikos:I've said this on the mailing list and in the section 3.7 appeal, to only be ignored.

Griffin Barnett:Understood.... so we can impress upon the leadership that the deadline is not practical and should be pushed back

George Kirikos:Anyhow, on to the next call (need to switch rooms).

Griffin Barnett:Indeed

George Kirikos:@Griffin: i've tried!

George Kirikos:They're ignoring me.