Trademark Claims Sub Team Recommendations for RPM PDP Working Group Discussion

[Draft as of 02 July 2019]

Table 1 is a snapshot of the overall status of the Trademark Claims Sub Team's deliberation on each agreed charter question and development of proposed answers, preliminary recommendations (if any), and proposed questions for community input (if any).

Table 2 aims to consolidate, in a clear and concise manner, the Sub Team's proposed answers, preliminary recommendations, and proposed questions for community input in relation to each agreed Trademark Claims charter question. The Sub Team has finalized the text during its meeting on 25 June 2019 at ICANN65.

Table 3 is a snapshot, based on Sub Team Co-Chairs' preliminary assessment, of the results of the review of all individual proposals received from Working Group members. Details and additional context are contained in the Sub Team's Summary Table and the Sub Team's weekly progress reports.

Table 1: Status of Sub Team Deliberation

Question	Overall Status	Open Item
Q1	Sub Team reviewed draft text on 22 May, staff revised proposed answers and preliminary recommendations incorporating input from Sub Team, Sub Team provided final input to the revised draft text on 25 June	None
Q2	Sub Team reviewed draft text on 25 June, staff revised proposed answers and preliminary recommendations incorporating input from Sub Team	None
Q3	Sub Team reviewed draft text on 29 May, ST Co-Chairs and staff revised proposed answers, preliminary recommendations, and proposed questions incorporating input from Sub Team, Sub Team provided final input to the revised draft text on 25 June	None

Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input

Q4	Sub Teamreviewed the draft text on 5 June, 12 June, and 25 June, staff revised proposed answers and preliminary recommendations incorporating input from Sub Team, Sub Team provided final input to the revised draft text on 25 June	None
Q5	Sub Team reviewed draft text on 25 June, staff revised proposed answers and preliminary recommendations incorporating input from Sub Team	None

Table 2: Proposed Answers to Agreed Charter Questions & Preliminary Recommendations

QUESTION 1		
Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input[1]
Q1: *Is the Trademark Claims service having its intended effect?* **Proposed Answer:** The Sub Team did not come to agreement as to whether the Trademark Claims service is "probably" or "likely" having its intended effect, although the Sub Team could determine that the service is at least "possibly" having its intended effect.	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.	
Q1(a): *Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing Claims Notice to domain name applicants?*		

[1] In the initial report, it should be noted that public commenters should respond with rationale and evidence wherever possible to all proposed questions for community input.

Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
<u>Proposed Answer</u>: The Sub Team did not come to agreement as to whether the Trademark Claims service is "probably" or "likely" 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. The Sub Team could not determine the extent of deterrence that occurred, if any.		
Q1(b): *Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications?* **<u>Proposed Answer</u>:** The Sub Team generally agreed that the Trademark Claims service may possibly have unintended consequences, such as deterring good-faith domain name applications.		
QUESTION 2		
Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
Q2(a): *Should the Claims period be extended - if so, for how long (up to permanently)?* **<u>Proposed Answer</u>:** The Sub Team generally agreed that where there is a mandatory Claims period (see Q2(d)), it should not be extended. However, the Sub Team generally	The Trademark Claims Sub Team recommends, in general, that the current requirement for a mandatory Claims Period be maintained, including the minimum initial 90-day period when a TLD opens for general registration.	

Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.		
Q2(b): *Should the Claims period be shortened?* **Proposed Answer:** The Sub Team generally agreed that where there is a mandatory Claims Period (see Q2(d)), it should not be shortened.		
Q2(c): *Should the Claims period be mandatory?* **Proposed Answer:** The Sub Team generally agreed that where there is a Claims period, it should be mandatory (see Q2(d)). However, the Sub Team generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period, provided this does not involve shortening the Claims Period.		
Q2(d): *Should any TLDs be exempt from the Claims RPM and if so, which ones and why?* **Proposed Answer:** Some Sub Team members believe that some future TLDs should be		Some Trademark Claims Sub Team members recommend that public comment be sought on the following questions: 1) Is there a use case for exempting a gTLD

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exempt from the Claims RPM. Some Sub Team members suggested that public comment should 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.		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) "highly regulated" TLDs that have stringent requirements for registering entities, on the order of .bank; and/or (ii) "Dot Brand" TLDs whose proposed registration model demonstrates that the use of a Claims Service is unnecessary. 2) If the WG recommends exemption language, what are the appropriate guardrails ICANN should use when granting the exception (e.g. single-registrant? Highly-regulated or manually hand-registered domains? Something else?)
Q2(e): *Should the proof of use requirements for Sunrise be extended to include the issuance of TMCH notices?* **Proposed Answer:** The Sub Team had diverging opinions on whether the proof of use requirements for Sunrise should be extended to include the issuance of TMCH notices.		
QUESTION 3		

Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input

Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
Q3(a): *Does the Trademark Claims Notice to domain name applicants meet its intended purpose?* **Proposed Answer:** The Sub Team generally agreed that 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. However, the Sub Team also recognized the inadequacies and shortcomings of the Trademark Claims Notice as set out in the proposed answers to Q3(a)(i)-(iii).	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). 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: ● The Claims Notice must be clearly comprehensible to a layperson unfamiliar with trademark law; ● The current version of the Claims Notice should 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; ● The Sub Team advises that ICANN Org considers input from external resources.	Some Trademark Claims Sub Team members recommend that public comment be sought on the following questions: ● Have you identified any inadequacies or shortcomings of the Claims Notice? If so, what are they? ● Do you have suggestions on how to improve the Claims Notice in order to address the inadequacies or shortcomings?
Q3(a)(i): *If not, is it intimidating, hard to understand, or otherwise inadequate? If inadequate, how can it be improved?* **Proposed Answer:** The Sub Team generally agreed that for some of the actual and potential registrant respondents, the Claims Notice is intimidating, hard to understand, or otherwise inadequate. The Sub Team made preliminary recommendations to improve the Claims Notice, and also sought community input to address its inadequacy.		
Q3(a)(ii): *Does it inform domain name*		

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applicants of the scope and limitations of trademark holders' rights? If not, how can it be improved? **Proposed Answer:** Some Sub Team members believe that the Claims Notice does not adequately inform domain name applicants of the scope and limitations of trademark holders' rights (e.g., lack of identifying details of the trademark, issues with figurative/design marks). The Sub Team made preliminary recommendations to improve the Claims Notice, and also seeks community input to address its inadequacy.	Some Sub Team members suggested external resources including the American University Intellectual Property Clinic, INTA Internet Committee, Electronic Frontier Foundation, and Clinica Defensa Nombres de Dominio UCN .	
Q3(a)(iii): *Are translations of the Trademark Claims Notice effective in informing domain name applicants of the scope and limitation of trademark holders' rights?* **Proposed Answer:** The Sub Team generally agreed that 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 current requirement states: "The Claims Notice MUST be provided by the registrar to the potential domain name registrant in English and SHOULD be provided by the registrar to the potential domain name registrant in the language of the registration agreement".	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 MUST provide the Claims Notice in English and in the language of the registration agreement." 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.	

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Q3(b): *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?* **Proposed Answer:** The Sub Team generally agreed that when there is a Claims Period and the issuance of a Claims Notice is required (see proposed answer to Q2(d)), the Claims Notice should 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.	The Trademark Claims Sub Team recommends that the current requirement for only sending the Claims Notice before a registration is completed be maintained. 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. 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.	
QUESTION 4		
Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
Q4: *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 umlauts are currently not serviced or recognized by many registries.* **Proposed Answer:** The Sub Team had diverging opinions on whether the exact		.

Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
match requirement is serving the intended purposes of the Trademark Claims RPM.		
Q4(a): *What is the evidence of harm under the existing system?* **Proposed Answer:** The Sub Team had diverging opinions on whether there is evidence of harm under the existing system of exact match.		
Q4(b): *Should the matching criteria for Notices be expanded?* **Proposed Answer:** The Sub Team had diverging opinions on whether the matching criteria for the Claims Notice should be expanded.	In the absence of wide support for a change to the status quo, the Trademark Claims Sub Team recommends that the current exact matching criteria for the Claims Notice be maintained.	
Q4(b)(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?* **Proposed Answer:** The Sub Team generally agreed that 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.		

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While there was no agreement within the Sub Team that the matching criteria should be expanded, most Sub Team members generally assumed that the TMCH would be the likely implementation for any expansion because contracted parties are already integrated with, and querying, the TMCH for the Claims Notice today. Nevertheless, the Sub Team did not know how the implementation would technically work.		
Q4(b)(ii): *What results (including unintended consequences) might each suggested form of expansion of matching criteria have?* **Proposed Answer:** Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.		
Q4(b)(iii): *What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?* **Proposed Answer:** The Sub Team believes that the exact match criteria has already struck the current balance of deterring bad-faith registrations but not good-faith domain name applications. The Sub Team believes that the current balance can be enhanced by a well-crafted		

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Claims Notice that appropriately notifies prospective registrants about a potential problem with their chosen domain name, employs clear/concise/informative language, and avoids a potential overflow of false positives.		
Q4(b)(iv): *What is the resulting list of non-exact match criteria recommended by the WG, if any?* **Proposed Answer:** Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.		
Q4(c): *What is the feasibility of implementation for each form of expanded matches?* **Proposed Answer:** Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.		
Q4(d)(i): *If an expansion of matches solution were to be implemented, should the existing TM Claims Notice be amended? If so, how?* **Proposed Answer:** Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in		

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detail.		
Q4(d)(ii): *If an expansion of matches solution were to be implemented, should the Claim period differ for exact matches versus non-exact matches?* **Proposed Answer:** Since the Sub Team did not agree on the expansion of matches, the Sub Team did not consider this question in detail.		
QUESTION 5		
Proposed Answer	Preliminary Recommendation	Proposed Question for Community Input
Q5: Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds? **Proposed Answer:** The Sub Team generally agreed that where the Registry Operator has not obtained an exception (see proposed answer to Q2(d)), the Trademark Claims period, including for the minimum initial 90-day period when a TLD opens for general registration, should continue to be uniform for all types of gTLDs in subsequent rounds. In addition, the Sub Team generally agreed that registries should have a certain degree of flexibility, based on a suitable business model, with the option to extend the Claims Period.	The Trademark Claims Sub Team recommends that the current requirement for a mandatory Claims Period should continue to be uniform for all types of gTLDs in subsequent rounds, including for the minimum initial 90-day period when a TLD opens for general registration. (Note: Some Sub Team members asked for public comment on potential exemptions which would then not be subject to a Claims Period of any length, see Q2(d))	

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Table 3: 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 Completed - It did not receive wide support from the Trademark Claims Sub Team for inclusion in the Initial Report.
Proposal #11	Review Completed - Sub Team does not have a recommendation as it is not applicable to Trademark Claims.
Proposal #12	Review Completed - It did not receive wide support from the Trademark Claims Sub Team for inclusion in the Initial Report.