TMCH CHARTER QUESTIONS & PROPOSED ANSWERS	CO-CHAIRS' PROPOSED NEXT STEPS	ADDITIONAL STAFF NOTES	WG DISCUSSION

Status of WG Discussions on Agreed TMCH Charter Questions
(originally circulated on 30 March 2017; further updated by ICANN staff in September 2019)

Background

- Starting in end-2016, the RPM PDP Working Group deliberated on the TMCH Structure and Operations topic based on the table of categorized questions first developed by the TMCH Charter Questions Sub Team. By the end of March 2017, the Working Group did not conclude the discussions of the agreed TMCH Charter Questions (categories 1-2 Charter Questions were not discussed). The Working Group agreed to return to all the agreed TMCH Charter Questions following its review of the Sunrise and Trademark Claims services.
- This document includes all agreed TMCH Charter Questions. In September 2019, Staff have included updates since March 2017 to indicate further discussions by the Working Group (and its Sub Teams) and additional information that the Working Group received that are pertaining to the deliberation on the TMCH Charter Questions. Updates are highlighted in yellow in the fourth column.
- Taking into consideration the updated information, Staff conducted a preliminary assessment and identified the questions that can be potentially closed (highlighted in red), pending Working Group's consideration and agreement. Some of those potentially closed questions are eclipsed by the conclusion of the Working Group's review of Sunrise and Trademark Claims services.

CATEGORIES 3-6

TMCH Category 3: Breadth & Reach (Scope)			
TMCH CHARTER QUESTIONS	**CO-CHAIRS' PROPOSED NEXT STEPS (as of March 2017)**	**ADDITIONAL STAFF NOTES (as of March 2017)**	**WG DISCUSSION/FOLLOW UP**
Q7: How are design marks currently handled by the TMCH provider?	Still awaiting answers from Deloitte to the appendix examples in our follow-up question. Still a very active area of discussion. Recommend: more discussion after response from Deloitte.	Deloitte presentation of updated data at ICANN58 (March 2017): ● Verification focuses on words in a design mark, but not the design aspect – note example from TMCH Guidelines ● Disclaimers to exclusive use of marks not factored in,	● Further discussion after Deloitte sends further response ● ACTION ITEM: WG will return to substantive discussion on Q7 when further information is shared by Deloitte ● UPDATE: Response from Deloitte received on additional

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		verification process involves only matching factual data against corresponding trademark certificate - no legal opinion provided by TMCH on exclusive use ● Verification of generic words also matched against corresponding trademark certificate ● Noted that some jurisdictions do not distinguish between different types of marks (e.g. word vs figurative/design mark); no separate statistics on design marks per se	follow up questions (April 2017) (see Q6)
Q8: How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?	Lots of discussion on this question, and we do have answer from Deloitte: they are accepting geographical indications from the EU (and elsewhere) and are not checking to see if there is an associated trademark registration for them. This gathered from the USPTO, who made the effort	GNSO recommendations and AGB text allow for 3 different categories/types of submissions (reg'd TM, court-validated mark, statute/treaty-protected mark). Deloitte's TMCH Guidelines follow this categorization and assume there is no need for a mark protected by statute/treaty to also be a reg'd TM.	● GI entries in TMCH are included when/if they are marks protected by statutes/treaties, regardless of whether or not they are registered trademarks ● Consider whether or not trademarks protected by statute/treaty should remain in the TMCH, if they are not registered trademarks

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	to join us through the session and participate from the standing microphone. This is an area in which the Applicant Guidebook rules do not follow the rules passed by the GNSO Council and the Board. Recommend: more discussion	Question for the WG: Did the GNSO's recommendations intend that "marks protected by statute or treaty" ALSO must be a registered trademark in at least one jurisdiction?	● Should design marks and trademarks protected by statute/treaty be considered separately? ● Need clarity on why marks protected by statute/treaty (how are those defined) are being included in the TMCH, despite recommendations from the GNSO and ICANN Board regarding limiting inclusion to registered trademarks ● ACTION ITEM: WG will return to substantive discussion on Q8 when further information is shared by Deloitte ● UPDATE: Response from Deloitte on follow up questions (April 2017) (see Q7)
Q9: *Should the TM+50[1] be retained as is, amended or removed?* **[CLOSED QUESTION]** **Proposed Answer:** In the absence of wide support for a change to the status quo, the Working Group recommends that the TM +50 should be retained as is.	This one is not garnering discussion. Recommend: close this question unless something new is raised.	Deloitte data demonstrated extent of use of this option to date and does not seem to indicate a demand for expansion; opening up the scope of registrations to an unlimited number of variations could decrease the accuracy and value of the TMCH	● No substantive remarks on why TM+50 should be limited or expanded ● No indication that TM+50 is being abused ● ACTION ITEM: Proceed as suggested by WG leadership team – Close this question unless something new is raised

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[1] Trademark owners can add up to 50 variations that are similar to each valid submission in the TMCH—within the notification process—provided that the variant of the mark was awarded to the trademark holder in a prior UDRP case.

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Q10: Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark? **[CLOSED QUESTION]**
 	
Proposed Answer: In the absence of wide support for a change to the status quo, the Working Group recommends that the current TMCH matching rules should be maintained.
	This one did get discussion, on both sides, in Copenhagen and previously. It is also one that Analysis Group spent a good amount of time evaluating at the request of the GAC and it has a good discussion in the revised report.
	
	Recommend: Hold until we bring the Analysis Group back to present -- and then finalize discussion.
		Question raised as to whether trademarks are being adequately protection by only being entitled to safeguard exact matches; further question on how to develop rules and fee structure for protection of additional matches - e.g. "trademarks plus generic terms" (example apple plus computer), or "trademarks plus trademarks" (example: apple plus ipad)?	● Defer discussion on this question until The Analysis Group has had an opportunity to present its findings on this question to the WG
			● UPDATE: Analysis Group met with the WG to present its findings in April 2017; follow up questions were sent and responded to by Analysis Group in July 2017)
			● UPDATE: Both Sunrise and Trademark Claims Sub Teams deliberated on this question and developed the following recommendations that were endorsed by the RPM PDP WG:
			  ○ In the absence of wide support for a change to the status quo, the Sunrise Sub Team recommends that the current availability of Sunrise registrations only for identical matches should be maintained, and the matching process should not 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

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			the Claims Notice be maintained.
*Q11: Should the scope of the **RPMs associated with the** TMCH be limited to apply only to **TLDs that are related to** the categories of goods and services in which the dictionary term(s) within a trademark are protected* [CLOSED QUESTION] **Proposed Answer:** In the absence of wide support for a change to the status quo, the Working Group does not recommend that the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected.	Technically, we have heard it is difficult; but deep concerns raised in the recent EFF/Trademarks Scholars letter. <u>Recommend</u>: more discussion	Concern noted over lack of differentiation leading to possible expansion of rights of TM holders; difficult to develop general policies for differentiation – may be possible only by developing specific rules for Sunrise and Claims in different types of gTLDs? (If so, return to this question when reviewing Sunrise/Claims)	● This question, despite having been subject to discussion, will require further consideration in light of letter from EFF and co-signatories ● ACTION ITEM: Consider this question along with each of the RPMs associated with the TMCH when the WG has them on its agenda ● UPDATE: The Sunrise Sub Team deliberated on this question and developed the following recommendation that was endorsed by the RPM PDP WG: ○ In the absence of wide support for a change to the status quo, the Sunrise Sub Team does not recommend that the scope of Sunrise Registrations be limited to the categories of goods and services for which the trademark is actually registered and put in the Clearinghouse.
TMCH Category 4: Costs & Other Fundamental Features			
TMCH CHARTER QUESTIONS	CO-CHAIRS' PROPOSED NEXT STEPS (as of March 2017)	ADDITIONAL STAFF NOTES (as of March 2017)	WG DISCUSSION/FOLLOW UP

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Q12: Are there concerns about operational considerations (such as cost, reliability, global reach, service diversity and consistency) due to the TMCH Database being provided by a single Provider? If so, how may they be addressed?	The only issue that came up was cost. No refutation of comment that evidence appears to show Deloitte has done a good job on operational matters. Recommend: narrow this question to cost only.	Question whether cost, pricing and reliability issues are implementation rather than policy; potential problems (e.g. technical issues, inconsistent validation and service levels) noted with multiple providers; consider single back-end TMDB provider but using multiple front-end services to connect to centralized TMDB	● ACTION ITEM: Defer decision on costs to the implementation phase, but communicate to the implementation team that the working group did consider whether competition would lower costs, whether the single provider model is the most efficient and effective for stakeholders, and that apart from costs, feedback on the quality of Deloitte's service from an operational perspective to-date has been positive ● Of relevance may be that parties other than Deloitte have had interest in the past to conduct validation portion of the TMCH function ● Delays due to multiple contractors may affect timeline (delays) for a second round of new gTLD applications – consideration of this is required ● Not necessarily true that second round be postponed while all policy/implementation efforts on RPMs are concluded
Q13: Are the costs and benefits of the TMCH reasonably proportionate amongst rights	Similar to Question 16.	Combining discussion of Questions 13 and 16, to be conducted following completion of Sunrise and	Proceed with WG leadership team suggestion – table question until the end of RPMs discussion

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holders, registries, registrars, registrants, other members of the community and ICANN?	Recommend: Perhaps table this question and return to it at the end of the RPMs discussion.	Claims reviews, proposed at ICANN58	
TMCH Category 5: Access & Accessibility			
TMCH CHARTER QUESTIONS	**CO-CHAIRS' PROPOSED NEXT STEPS (as of March 2017)**	**ADDITIONAL STAFF NOTES (as of March 2017)**	**WG DISCUSSION/FOLLOW UP**
Q14: How accessible [2] is the TMCH Database and RPM Rights Protection Actions and Defenses to individuals, organizations and rights-holders; as well as trademark agents in developing countries? **[CLOSED QUESTION]** **Proposed Answer:** The Working Group discussed this question but was unable to conclude how accessible the TMCH Database and RPM Rights Protection Actions and Defenses are to individuals, organizations and rights-holders, as well as trademark agents in developing countries.	The push for knowing more about trademark agents and where the rights holders are located seems to have subsided -- and Deloitte does not know where the rights-holders who use TM Agents are located. Recommend: Shall we close this question?	Comment that low numbers may indicate low interest rather than low accessibility	Close question, as per data currently on-hand
Q15: What concerns are being raised about the TMCH	This is a question that is the subject of debate. We can	While general transparency and openness may be beneficial to good	● Still an open question (currently no WG consensus)

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[2] This word is used in the sense of asking whether the TMCH (its existence, purposes and how it is to be used) is known to the types of stakeholders mentioned.

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Database being confidential, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain confidential or become open?	either have the debate now, or table it to be reviewed after the RPMs are reviewed -- to better understand the impact of the confidentiality on Sunrise, private lists, etc. Recommend: either continue discussion or table and return to later	faith actors (e.g. informing them what TMCH registrations should be avoided ahead of receiving claims notices), several WG members described rights-holders' reasons for keeping the TMDB closed, including the risk of thereby disclosing commercially sensitive information such as TM value and brand strategies Note recent letter sent to WG co-chairs citing concerns with TMCH, sent by TM scholars and practitioners Any information made available should only be about the mark (publicly-available TM information) and not extend to TM user or account information Suggestion that If TMCH is to remain confidential, restrictions should be put in place on the TMCH provider being allowed to provide additional (ancillary) services	● Information in the TMCH is a subset of publicly available information accessible elsewhere ● If costs of TMCH entries are lowered, possible to include all trademarks as opposed to subset – could solve problems regarding TMCH transparency ● Discussions held by the Implementation Assistance Group (IAG) did not adequately consider transparency of TMCH ● Registry representatives were advocates for TMCH transparency, but convinced otherwise (refer to STI and IAG for reasons cited at the time, as well as other resources) ● (Suggestion from the AC Chat) Jon Nevett: what about releasing a simple list of dictionary terms in the TMCH? Not opening up the entire database with all the records ● Continue discussion on this question on-list and on future calls ● UPDATE: Some Sunrise Sub Team members believe that the limited access to the TMCH and the lack of trademark information to identify whether a complaint is

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			well-grounded makes it difficult to challenge a registration via the SDRP. The Sunrise Sub Team have proposed a preliminary recommendation that will eliminate the non-functional parts of the SDRP requirements and codify the current practice. o The new version of the AGB should include the TMCH dispute resolution procedure for challenging the validity of trademark recordals entered into the TMCH. This procedure is currently published at: https://www.trademark-clearinghouse.com/dispute#3.3. ICANN org should ensure that its contract for the provision of TMCH services makes the operation of the TMCH dispute resolution procedure a requirement for the TMCH Provider. o Section 6.2.4 of the current Trademark Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB) must be amended to remove grounds (i) and (iii). o The Trademark

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			Clearinghouse Model of Module 5 of the Applicant Guidebook (AGB) must be amended to include a new Section 6.2.6 – the Registry Operator will, upon receipt from the TMCH of a finding that a Sunrise registration was based upon an invalid TMCH record (pursuant to a TMCH dispute resolution procedure), immediately delete the domain name registration. Registry Operators in their applicable SDRPs will describe the nature and purpose of the TMCH challenge process and provide a link to the TMCH for reference.
TMCH Category 6: Balance			
TMCH CHARTER QUESTIONS	**CO-CHAIRS' PROPOSED NEXT STEPS (as of March 2017)**	**ADDITIONAL STAFF NOTES (as of March 2017)**	**WG DISCUSSION/FOLLOW UP**
Q16: Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the rights of non-trademark registrants?	Recommend: table this question to the end of the RPM mechanisms discussion.	WG had noted previously that it will be appropriate to return to this question following the Sunrise and Claims reviews.	ACTION ITEM: Proceed as suggested by WG leadership - table question until the end of the RPMs discussion

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CATEGORIES 1 & 2

Category 1: Education			
TMCH CHARTER QUESTIONS	**CO-CHAIRS' PROPOSED NEXT STEPS**	**ADDITIONAL STAFF NOTES (as of March 2017)**	**WG DISCUSSION/FOLLOW UP**
Q1: Is the TMCH clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about recordals in the TMCH?		Criteria are listed in TMCH Guidelines; note that having easily comprehensible and clearly accessible data on the TMCH available to the general public can be useful, so that registrants faced with a Claims Notice are better informed on how to react – different information needed for rights-holders who may use the TMCH, and for the general public (who may only need information about the Claims Notice and what it means) Question for the WG: Based on Deloitte's information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?	
Q2: Should the TMCH be responsible for educating		Some support for the "hybrid" model (ICANN to develop different	

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rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the TMCH is not to be responsible, who should be?		sets of materials including for potential registrants and the general public, to be hosted by TMCH and possibly distributed by registrars) – can we close this question?	
Q3: What information on the following aspects of the operation of the TMCH is available and where can it be found? *(a) TMCH services;* *(b) Contractual relationships between the TMCH providers and private parties; and* *(c) With whom does the TMCH share data and for what purposes?*		<u>Question for the WG</u>: Based on Deloitte's information and materials to date, is there a need to develop additional policy recommendations on this topic (possibly aside from the question of Private Blocking Mechanisms, which is yet to be discussed)? Are there remaining concerns that can be addressed via implementation?	
Category 2: Verification & Updating of TMCH Database			
TMCH CHARTER QUESTIONS	CO-CHAIRS' PROPOSED NEXT STEPS	ADDITIONAL STAFF NOTES (as of March 2017)	WG DISCUSSION/FOLLOW UP
Q4: Should the verification criteria used by the TMCH to determine if a submitted mark meets the eligibility and other requirements of the TMCH be clarified or amended? If so how?		<u>Question for the WG</u>: Based on Deloitte's information and materials to date, is there any need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?	

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		==UPDATE: The Sunrise Sub Team deliberated on a related question ("Is the TMCH Provider requiring appropriate forms of "use" (if not, how can this corrected)?") and developed the following answer that was endorsed by the RPM PDP WG: The Sub Team generally agreed that the TMCH Provider is requiring appropriate forms of proof of use, according to the enumerated rules (i.e., Section 2.2.3 of the TMCH guidelines).[3]==	
Q5: Should there be an additional or a different recourse mechanism to challenge rejected submissions for recordals in the TMCH?		Question for the WG: Based on Deloitte's information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?	
Q6: How quickly can and should a cancelled trademark be removed from the TMCH Database?		TMCH users contractually obliged to notify TMCH of cancellations; though no penalties are imposed for failure to notify, there is no evidence to date to indicate that this has been a problem (note that re-verification is done on an annual basis in any event, and that Sunrise	

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[3] See Section 2.2.3 of the TMCH guidelines on pages 8-10 here:
https://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.0%20_1.pdf

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		and most Claims periods run for a very limited period) Question for the WG: Based on Deloitte's information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?	