

# Trademark Clearinghouse (TMCH) Implementation Assistance Group Call #2



Wednesday, November 30, 2011  
05:00 UTC

# Housekeeping

- Please MUTE your phone when not speaking (\*6)
- Please log into Adobe Connect for each call where possible
  - Raise hand via the User Icon
- All participants should declare their interests when participating
  - Potential bidders should make this explicit
- Follow-up will occur via e-mail outside the call
- Participants can use the distribution list for discussion

# Agenda

- ( 5 min) Background and 15 Nov 2011 Meeting Highlights
- (10 min) Discuss Trademark Clearinghouse Terminology
- (30 min) Review Comments Received for P1
  - Recommendations Received
  - Clarifying Questions and Discussion Period
- (30 min) Review Comments Received for P2
  - Recommendations Received
  - Clarifying Questions and Discussion Period
- (10 min) Introduce New Issues P3 and P5
- ( 5 min) Wrap-Up

# Background

- Purpose of the group is to provide advice on key TMCH processes and technical implementation issues
- Goal is for ICANN to deliver a set of business requirements to the service provider(s) selected out of the TMCH RFI Process
- 15 Nov 2011 Kickoff Meeting Highlights:
  - Requested SOI submissions from IAG participants
  - Discussed IAG process for submitting comments and critical dates
  - Wiki at <https://community.icann.org/display/cctrdmrkclrnghsiag/Home>
    - Meeting materials, IAG calendar, other documents (e.g. Statements of Interest)
  - Reviewed P1, P2 and called for written recommendations

# Terminology

- Authentication: Establishing that trademark information is genuine and trademark belongs to the mark holder
- Validation: Establishing proof of use or rights based on statute/treaty or court proceeding
- Clearinghouse “registration”
  - Approval – Deposit – Listing – Recording – Entry
  - Deposits – Listings – Records - Entries
- “Authcode”
  - Token – Code – Validation Code – Contact Code – Sunrise Code/Token
- Clearinghouse “registrant”
  - Trademark owner -- Applicant

# P1 –Sunrise Domain Registration Authorization

- Background (see *TMCH-Implementation-Issues-22oct11.pdf*)
- Comments last meeting
  - Registry responsibilities in Sunrise: the registry is contractually responsible for authorization (and there is precedent for registry interaction with clearinghouse-type services)
  - Codes: streamline the sunrise process, minimize work on registrars, draft extensions to EPP may facilitate the use of unique codes

# P1 –Sunrise Domain Registration Authorization

- Written comments and recommendations
  - Most responses agree the TMCH should use a code (option “a”) to confirm eligibility to participate in sunrise.
  - Code should be issued by the TMCH
  - Several commented that issuing a different code for each mark could be burdensome to mark holders.
  - Common suggestion to issue a unique code to each mark holder, which can be used for any of their marks that they have listed with the TMCH.

# P1 –Sunrise Domain Registration Authorization

- Clarifying Questions
  - Unclear as to how or why an agent might be used to obtain a sunrise registration
  - Do mark holders receive notices of third-party domain name registrations matching the holder's marks during sunrise?
- Discussion Period
  - Should a code represent a mark or a markholder?
  - What data should the code provide access to?



## P2 –Responsibility for Registrant Claims Notice

- Background (see *TMCH-Implementation-Issues-22oct11.pdf*)
- Comments last meeting
  - Notice: linkage between who sends the notice, the form of the notice itself, and the form of the lookup service (whether or not it is real-time)
  - Registry vs. Registrar: the acceptance event must be captured, but the content of the notice could be hosted by the registry or clearinghouse. Other comments noted that the registrar is the entity with the primary relationship with the registrant

## P2 –Responsibility for Registrant Claims Notice

- Written comments and recommendations
  - Majority view that the registrar is the most appropriate entity to present the trademark claims notice to a registrant
  - Implicit majority view that the trademark claims check should support real-time processes
  - The trademark claims process must be flexible to accommodate multiple registry approaches

# P2 –Responsibility for Registrant Claims Notice

- Clarifying Questions
  - Is the business requirement “transmission of notices must be verifiable” correct?
  - Who will determine the wording of the claims notice to mark holders?
  - Unclear as to why registrar would need access to markholder contact information.
  - Unclear on “agent” definition: would prefer both agent and ultimate mark holder information available in trademark clearinghouse records.
- Discussion Period
  - If the registrar presents the claims notice, which entity should create it?

# New Issues

- P3 – Responsibility for Trademark Holder Registration Notice
  - Who should send the notice, the registry, registrar, or clearinghouse?
- P5 – Responsibility to Perform Trademark Claims Checks
  - Who should perform the check, the registry or the registrar?

# Wrap-Up

- There will be a final comment period for recommendations on P1 & P2 closing 12 Dec
  - Please don't resubmit prior comments; only send new recommendations
- Comments on P3 & P5 are due 14 Dec (23:59 UTC 13 Dec)
  - TMCH Implementation Issues document discusses each issue and the alternatives in more detail