

TMCH SUB TEAM INITIAL MEETING: NOTES & SCOPING

List of Charter Questions concerning the TMCH (for guidance)

1. Should further guidance on verification guidelines for different categories of marks be considered?
2. Is the protection of the TMCH too broad? Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word? Should TM+50 be reversed?
3. Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
4. How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
5. Should the TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?
6. Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
7. How quickly can a cancelled trademark be removed from the TMCH?
8. How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies vs. what is offered to private New gTLD registries pursuant to private contracts?
9. Should there be a review on accessibility to TMCH for individuals, private trademark holders and trademark agents in developing countries?
10. How can the TMCH provide education services not only for trademark owners, but for the registrants and potential registrants who are equally impacted by their services?

Additional Questions Suggested by the Community at ICANN56

- Does the TMCH provide avenues that are procedurally and substantively fair so effectively balance the rights of rights holders versus normal Internet users?
- Does the trademark clearinghouse create a tendency to perpetuate the status quo?
- How accessible is the TMCH to reviewing accessibility for trademark agents in developing countries?
- Should the TMCH remain a single provider or should we open it to different providers, of course with a central database that should be accessed by the different providers?
- Are the costs of the TMCH, for rights holders, for ICANN, for the community proportionate to the benefits it provides?
- How do we determine what is "good chilling effect" and "bad chilling effect" in relation to RPMs?

Suggestions for Data Sources and Types (for discussion; taken from WG members and Helsinki community discussions)

Suggested Initial Sources:

- ICANN staff (GDD)
- TMCH Providers
- Analysis Group (TMCH Independent Examiner)

Suggested Types of Data:

- How many marks were registered
- Where did the trademarks originate
- How many TM holders took advantage of TM+ 50
- How many used the extended registration service (notice of identical matches being registered past the sunrise and claims periods)
- How many cases have helped existing rights holders
- How many cases have helped Internet users that do not own the rights at the time that they come to the TMCH
- In relation to questions of procedure, was procedure followed correctly in all cases? In the case of deviations why were the deviations caused, who were the deviations helping?
- How many domains were registered to users that were not the registered holder that were eventually challenged by the TMCH claim holder and whose ownership was then moved from the user that registered the domain to the claim holder? (Exemplar time line: 1. Trademark holder registers claim at TMCH for "water". 2. Non Trademark holder accepts claim for the "water" trademark for the domain "water.guru". 3. Trademark holder files a complaint on the registration on the domain "water.guru". 4. Domain is moved from the non-trademark holder to the trademark holder)

Sources of Data regarding the TMCH, used for the 2015 ICANN Staff RPM Review Paper (for discussion)

- *Source: Deloitte Monthly Trademark Activity Reports*
 - Number of jurisdictions, which a Mark has been submitted for
 - Number of dispute resolution cases related to the Trademark Clearinghouse
 - Number of Trademarks opting-in to Ancillary Services
 - Total number of Trademarks submitted
 - Total number of Verified Trademarks
 - Total number of Verified Trademarks submitted prior to the Sunrise period
 - Total number of Trademarks NOT verified
 - Total number of domain names/labels derived from those Trademarks
 - Total number of Verified Trademarks that are Sunrise Eligible
 - Total number of Verified Trademarks that are NOT Sunrise Eligible

- Total number of Verified Trademarks now deactivated
 - Total number of Verified Trademarks that are Sunrise Eligible now deactivated
 - Total number of domain names/labels derived from those Trademarks
 - Total number of Verified Trademark Holders
 - Trademark Holders represented by Trademark Agents
 - Total number of Verified Trademark Agents
 - Trademark Agents & Holder failing e-mail verification
 - SLO Reporting
 - Total number Nationally or regionally Registered Trademarks
 - Total number of Trademarks validated by a court of law or judicial proceeding
 - Total number of Trademarks protected by statute or treaty
 - Any other Trademarks constituting intellectual property
 - # of TMCH records
 - # of Jurisdictions
 - # of Abused labels
 - Breakdown of scripts/languages represented
- *Source: Deloitte Ticket Summary Report* (not provided monthly to ICANN, but available upon request)
 - API Issues
 - Claims Notification Issue
 - Profile Management Issues
 - Sunrise File Issues
 - Sunrise Notification Issues
 - Trademark Management Issues
 - Other Issues
- *Source: <http://trademark-clearinghouse.com/content/trademark-clearinghouse-fees>
http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/trademarkclearinghouse_fee_structure_01-04-2015_2.pdf*
 - Fee structure for record inclusion in the TMCH
 - Costs for Abused Domain Name Label service