

Terri Agnew:Welcome to the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group call held on Wednesday, 14 September 2016 at 17:00

Terri Agnew:wiki agenda page: <https://community.icann.org/x/jBysAw>

George Kirikos:Hi folks.

George Kirikos:This might be the first time I logged in before Petter. :-)

Petter Rindforth:Congratulations!

George Kirikos:lol It's hard to beat your record of early arrivals. ;-)

George Kirikos:Can we unlock the slides, so that we can browse them ourselves?

susan payne:sorry, I think that was me

George Kirikos:*6 to mute/unmute

susan payne:oh, maybe not just me

Martin Silva Valent:Hi all

Steve Levy:Hello all!

Elizabeth Featherman:Hi everyone!

susan payne:I hardly know where to start :)

David Tait:Can do kathy

David Tait:Will do

Kurt Pritz:Did we / Should we ask Deloitte to present?

Vaibhav Aggarwal:this should b skipped as this is legal in nature

George Kirikos:The "use" here can easily be gamed, i.e. "token use" or "de minimus" use that wouldn't actually rise to the level to grant trademark rights, see: <http://www.fr.com/news/dont-be-confused-about-whether-your-trademark-is-used/>

Vaibhav Aggarwal:this is not unquestionably different so lure

George Kirikos:(I made this point on the mailing list a couple of weeks ago)

David Tait:I dont think so Kathy

Vaibhav Aggarwal:plural nature if diff should b allowed

Vaibhav Aggarwal:problem is that the TMCH should I n,y a repository and be an agency nodal to check validity of trade mark

Vaibhav Aggarwal:not become a statutory agency

Greg Shatan:Sorry to join late; was watching the IANA Transition Senate hearings.

Vaibhav Aggarwal:the senate intelligence committee. is also interested in the process :-) though IANA is irrelevant to this group

George Kirikos:Can we unlock the slides, so we can scroll back?

George Kirikos:Thank you.

David Tait:I've unlocked them unless kathy has an objection

Kathy Kleiman:great

George Kirikos:The reason those "validations" exist are due to the gaming issue, i.e. where folks use TMCH to claim domains in sunrises. If that benefit of TMCH registration was removed, it would simplify things immensely, and eliminate the incentives for that gaming.

Kristine Dorrain - Amazon Registry:Vaibhav, the TMCH is only a repository.

Kristine Dorrain - Amazon Registry:It does only check validity...

Kristine Dorrain - Amazon Registry:George contends that validity check can be gamed, which is a different issue, but the TMCH does not grant anyone rights.

George Kirikos:That's false, Kristine. You get sunrise access, being in the TMCH, see #2 of <http://www.trademark-clearinghouse.com/content/reasons-record-your-marks-trademark-clearinghouse>

Kristine Dorrain - Amazon Registry:Yes, that's the reason you put your marks in. But you don't get a TM because you put a mark in.

George Kirikos:Eliminate #2, and a lot of problems disappear.

Steve Levy:Sunrise access does not grant any TM rights. Even a domain acquired through gaming sunrise is subject to UDRP

George Kirikos:For a generic domain name, you defend it without having to point to a de minimis TM.

George Kirikos:The key is to get to it first.

Jeff Neuman:I am confused by Kathy's intervention. You can have multiple entries for any mark in the TMCH

Greg Shatan:There's no such thing as a "generic domain name."

George Kirikos:And so, if you can get priority access via a piece of paper, folks will game the system to get that piece of paper.

George Kirikos:Greg: I meant, for valuable strings, like common dictionary words, short acronyms, etc.

Jeff Neuman:As you can see, it is very difficult to separate the TMCH as a database from the Sunrise and TMCH

susan payne:@George, there is a sunrise dispute process in addition to the UDRP

Dominic DeLuca(FORUM):If a Registry is allowing this "gaming" to take place, would that be a possible use for the PDDR?P

Greg Shatan:Those may be "generic" in the hands of one registrant and valuable trademarks in the hands of another registrant.

George Kirikos:e.g. "ASK" in the class of "Plectrums" for the .EU sunrise:

https://eu.adr.eu/adr/decisions/decision.php?dispute_id=2438

Vaibhav Aggarwal:we can make more relevant use of the "repository" if v reduce the cost and encourage the TM owners just deposit the TM claims irrespective of the d Omani name activity - that will take care of the long term use of the repository and cut on the time and energy of the right parties or serious applicants

John:If we are talking about issues relating to becoming a TMCH agent, we should also look at the terms of the contract to be an Agent which are prohibitive (in addition to the cost)

Vaibhav Aggarwal:+1 John

susan payne:John, don't disagree with you but would you mind identifying yourself

Kathy Kleiman:Vaibhav is that a new or old hand?

Vaibhav Aggarwal:old

Vaibhav Aggarwal:sorry

Greg Shatan:There's no reason ASK cannot be a valid trademark if it meets the appropriate criteria. The DRP panel you link to found that it was, and that respondent violated complainant's rights (and a bad actor generally) and duly transferred the domain name.

Vaibhav Aggarwal:in the car chauffeur is a little rough

John:@Susan - McElwaine: I entered just my first name once and Adobe is not automatically using that :)

susan payne:hello

Jeff Neuman:I dont believe allocation of names outside the Sunrise Process is in the scope of this PDP (except to the extent that those allocation mechanisms are inconsistent with the RPMS)

Dominic DeLuca(FORUM):Thanks, Jeff.

Vaibhav Aggarwal::-)

George Kirikos:Obviously fanciful marks like "EXXON" or "VERIZON" are considered the strongest.

Vaibhav Aggarwal:so for the business of registrations ncrease, TMCH could act as a way to promote business and also assist the applicants

George Kirikos:We need to get raw access to the TMCH database, and can see how many of them are of the strongest type, compared to those that are questionable (like the "ASK" example in the .EU sunrise).

Terri Agnew:@Greg, check your mute

Vaibhav Aggarwal:@George how will TMCH act in reference to TM by common law

Vaibhav Aggarwal:is TMCH responsible for the decision in sunrise?

Vaibhav Aggarwal:if not then who is ?

Petter Rindforth:I have seen more URS cases where the complainant referred to their TM rights and use in a traditional way, rather than a registration at TMCH

Josh Partington:George, is this issue really strength of the marks in the TMCH or is it the "legitimacy" for lack of a better word?

Vaibhav Aggarwal:+1 JEFF

Kristine Dorrain - Amazon Registry:+1 Jeff

Vaibhav Aggarwal:emerging markets

Josh Partington:In the ASK case, my quick read is that the conclusion was the Benelux registration was obtained for the purpose of using the sunrise period as opposed to a legitimate trademark right

Vaibhav Aggarwal:and developing countries / jurisdictions

George Kirikos:Josh: well, if we're talking about sunrise, then I think only fanciful marks should have protection. Of course, illegitimate 'marks' should never be in the repository to begin with.

George Kirikos:But, that requires stronger validation.

Vaibhav Aggarwal:+1 JEFF

Renee Reuter:Although a term can be used as a generic term, if it is registered as a trademark,it should be given the same protection as any other registration in the TMCH

Rebecca Tushnet:That's not really true re: infringement--Apple has a narrower scope than Xerox even though they are quite strong.

Vaibhav Aggarwal:not just in the US but in all Viena Agreement countries

Phil Marano (Mayer Brown):It would be helpful to understand how the charter question re "losing legitimate opportunities", which appears twice in the slides incidentally, relates to the TMCH itself, as opposed to Sunrise versus Claims. Much of the discussion today seems to conflate these three separate concepts.

Kristine Dorrain - Amazon Registry:But all brands are subject to being the victims of cybersquatting....we do not get to decide if a mark is strong. In the US that requires a stringent legal test.

Greg Shatan:We have no business selecting among valid registered trademarks .

George Kirikos:If we're not a "legal authority", then why are we granting these TMs special rights here to begin with? :-) i.e. leave it to the courts.

Vaibhav Aggarwal:book Silk Route by Anupam Chander by UCDavis will answer that

Rebecca Tushnet:Just note that "treat everything alike" means that, functionally, Apple has more rights over unrelated uses than Xerox does.

Renee Reuter:Many jurisdictions, not just the US, have stringent legal tests before a registration is granted.

Vaibhav Aggarwal:if staff can share the abstract from it

Kathy Kleiman:Jeff, is your hand still up?

Kristine Dorrain - Amazon Registry:Yes, Renee, I only wanted to speak to my personal knowledge... :)

susan payne:taken my hand down. it's been said

Jeff Neuman:@Greg - I agree we should not distinguish between registered trademarks in general.

Marie Pattullo:The TMCH does not have the legal authority to question national TM registration and grant procedures, and neither should it have. That's why we have courts.

George Kirikos:The test is whether all marks (regardless of strength) should be granted equal access to the sunrise period (i.e. the main benefit of TMCH registration). In my view, no.

Marie Pattullo:Disagree, George. A TM is a TM.

George Kirikos:I disagree, Jeff. If we're going to give certain companies first dibs on certain domains, we should weigh the costs/benefits of that decision for each type of domain/mark.

Jeff Neuman:Only whether the decision to accept trademarks from jurisdictions that do not perform substantive review was the right choice. And we would need data to prove or disprove

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Phil Marano (Mayer Brown):@Greg, well said re arbitrary marks.

susan payne:agree it is not our job to re-write TM law

Vaibhav Aggarwal:@jeff that s unfair to the authority granting the mark

George Kirikos:e.g. the "cost/benefits" of granting "EXXON" first dibs are much different than the cost/benefits of giving "ASK" (for Plectrums) first dibs.

susan payne:no George they are not

Terri Agnew:next call: Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group is scheduled for Wednesday, 21 September 2016 at 21:00 UTC for 60 minutes.

George Kirikos:For arbitrary marks, there are many non-infringing users of that word. So, the "costs" of granting a markholder first dibs is high.

Vaibhav Aggarwal:thanks Kathy lovely

Martin Silva Valent:Great meeting!!!! I learned a lot!

George Kirikos:Bye folks.

Greg Shatan:I don't think that should be called a "cost."

Martin Silva Valent:Thanks to everyone

George Kirikos:It's an opportunity cost, Greg.

Phil Marano (Mayer Brown):Goodbye all.

George Kirikos:A narrow benefit to one firm, vs. costs that are incurred by othes, who don't get that access.

David Tait:Just as a reminder that the GNSO RPMs survey closes on 15 September please complete it <https://s.zoomerang.com/r/CL3MJLL>

Josh Partington:So the owner of a registration for an arbitrary mark should be on the same footing as anyone else?

Greg Shatan:I recommend reading McCarthy on Trademarks.

Vaibhav Aggarwal:thanks

George Kirikos:Although, registry operators are capturing that value, simply by calling those domains "premium" -- they don't care if a markholder gets it, or a non-markholder, as long as they get paid.

Greg Shatan:It's a little long.... :-)

David Tait:Thanks all!

Steve Levy:Thanks all

George Kirikos:Bye folks.

Salvador Camacho Hernandez:Thanks to everybody