

## **Adobe Connect chat transcript for 21 September 2016:**

Terri Agnew: Welcome to the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group held on Wednesday, 21 September 2016 at 21:00 UTC

Terri Agnew: agenda wiki page: [https://urldefense.proofpoint.com/v2/url?u=https-3A\\_community.icann.org\\_x\\_sAO4Aw&d=DQIFaQ&c=FmY1u3PJP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=MIB8y\\_wp\\_LdN7ia8TdzYfGoi2d0ilYHQQimeMGoB\\_1U&s=CX5bgnyJaRsmwwWasrQcmHHga2-EfQ3QXrEqkwhhA4&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_sAO4Aw&d=DQIFaQ&c=FmY1u3PJP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=MIB8y_wp_LdN7ia8TdzYfGoi2d0ilYHQQimeMGoB_1U&s=CX5bgnyJaRsmwwWasrQcmHHga2-EfQ3QXrEqkwhhA4&e=)

George Kirikos: Hi folks.

Maxim Alzoba (FAITID): Hello All

Philip Corwin: Hello. I'm dialing in

Vaibhav Aggarwal: Morning folks

Kathy: Hi All!

Paul McGrady: Good M/A/E!

Kristine Dorrain - Amazon Registry: Greeting all, apologies for being late.

Phil Marano (Mayer Brown): Indeed, it is sixty days notice either way.

Marina Lewis: Hi all... sorry to be joining late.

George Kirikos: Not sixty days notice, but 60 days minimum total period.

Kurt Pritz: @ George: Did I say "60 days notice"?

George Kirikos: @Kurt: I was responding to Phil Marano's statement in the chat.

Paul Tattersfield: Are registry reserved names excluded from a sunrise period? And if so do the reserved names have to be related to purposes or running a registry (other than ICANN mandated reserved names?)

Kurt Pritz: ok - whew

Maxim Alzoba (FAITID): what was intended for protection of local small TMs who were not included into TMCH?

Phil Marano (Mayer Brown): Put another way, either way, folks are aware of the sunrise period for sixty days.

Maxim Alzoba (FAITID): @Paul, for GEOs we had to reserve things like POLICE for local police depts

George Kirikos: I think the Calzone.org had a calendar of new gTLD program "events" --- one can probably go back and create the data (or just ask the registries directly) re: ALP / QLP.

Maxim Alzoba (FAITID): QLP of 100 names for cities of few K of street names was not enough

Maxim Alzoba (FAITID): ALP did not work at all ... remember .madrid

Kathy: For these slides, can Staff take control of slides?

David Tait: Kathy, Phil asked for them to be scrollable

Paul Tattersfield: thanks Maxim

Kathy: David, I thought it might help us read the slide...

Maxim Alzoba (FAITID): PPT needs to be reformatted (smaller fonts?)

David Tait: "Identical matches" means a domain name label is an identical match to the trademark, meaning that the label must consist of the complete and identical textual elements of the trademark in accordance with section 4.2.1 of the Clearinghouse Guidelines. For example, if the Trademark Holder's trademark is AB, then the domain name label that is applicable must be AB for it to be deemed an Identical Match. If the Trademark Holder's Trademark label is èè, then the identical label is èè and not ee. "Premium names" – a registry operator may reserve certain premium names for later release (after the Sunrise Period) at its sole discretion. Registry operators may classify generic terms as premium names, and, in that event, such names are not available for registration during the Sunrise period even if they are the subject of a trademark record. "Reserved names" - a registry operator may reserve a

domain name from registration as allowed by Specification 9, Registry Operator Code of Conduct, Section 1

David Tait:1(b), of the New gTLD Registry Agreement. "Landrush"- Land Rush is the commencement of the "go live" period of a new TLD launch where the registry begins accepting live domain registrations from registrants through registrars.

Paul Tattersfield:text is now cut off here as well was ok before

David Tait:"Trademark Clearing House-verified trademarks" means all marks accepted and verified by the TMCH. These will be accepted from (i) nationally or regionally or registered trademarks; (ii) court-validated marks; and (iii) marks protected by statute or treaty. The verified trademark data will support both trademark claims and sunrise services required for all new gTLDs. In addition, the Clearinghouse may accept and verify other types of marks upon the request of registries.

Mary Wong:Sorry for the formatting/display issues

David Maher:APOlogies for being late

David Tait:"Sunrise Period" - a pre-launch phase providing trademark holders the opportunity to register domain names in a gTLD before registration is made generally available to the public.

David Tait:"Sunrise pricing practices" - the current TMCH fee structure includes Sunrise services for all new gTLD Sunrise periods, not just one.

David Tait:"Sunrise process" - A process in which owners of Legal Rights have the opportunity to register domain names before the Landrush process open to the public. Registries that used a Sunrise Process identified the Legal Rights on which a Sunrise Process registration could be based.

Greg Shatan:Which brings up back to do, do, do, do.

Greg Shatan:up = us.

Maxim Alzoba (FAITID):QUESTION: Please add questions of ALP, QLP where these periods in need of review?

Rebecca Tushnet:Are we going to address TMCH eligibility for marks separately?

Josh Partington:Hi all, sorry to join late

Kristine Dorrain - Amazon Registry:Rebecca, this slide show is just about sunrise (we discussed the TMCH as an entity last week). We have a whole list of charter questions regarding the TMCH apart from sunrise. :)

David Tait:We're trying to put up a better version

George Kirikos:It seems that most of the sunrise periods are producing fewer than 1000 registrations. Is it really "working" as intended?

Rebecca Tushnet:Thanks, Kristine--I must have missed the separate questions there.

Paul Keating:Sorry for being late.

Maxim Alzoba (FAITID):why the rights are to be extended beyond what is protected by law?

George Kirikos:If "variants" were allowed, someone with a low value mark of "Appl" might try to register the superior domain "variant" of "Apple".

George Kirikos:Flickr ---> Flickr

Greg Shatan:You can't register a domain for a TM=50 string in Sunrise.

Maxim Alzoba (FAITID):no it is too easy to be gamed

George Kirikos:Agreed, too easy to be gamed.

Paul Keating:yes, they should NOT. The tm registration during sunrise is registration. The notice is corrective/preventative.

Edward Morris:(on adobe only). Is it possible to expand the charter questions to include some of the underlying TMCH questions concerning TM scope in the sunrise period? Two I have in mind: 1. When the TM registered in the TMCH database is a generic or descriptive word, and sunrise is used for registering that mark as a domain name completely unrelated to the goods and service category of TM

protection, is that fair for other/future/potential DN registrants. 2. (and related) should Sunrise rights be limited to the categories of goods and services of the TM? (still trying to get on audio - apologies)

Maxim Alzoba (FAITID):@Edward, nobody reads the chat

Greg Shatan:How would you game that? You need to win a domain name dispute in order to get a TM+50 TMCH regn.

Marina Lewis:I don't think TM owners should be the ones to register multiple variations of their marks - I think the TMCH should expand the claims service to include near-identical domains.

George Kirikos:Are we seeing more UDRP/URS filings from companies that didn't register in sunrise periods? Or are they from companies that did register in sunrise, but then the variants got registered? (we'd need to compile data, and cross-reference their registrations)

Maxim Alzoba (FAITID):it is possible to grab mark via affiliated company and to go to the local court

Kristine Dorrain - Amazon Registry:Maxim, we do!!!

Maxim Alzoba (FAITID):hmm ... my question on QLPs ALPs was not read :)

Mary Wong:@Ed, that's one thing the co-chairs are asking that WG members do (review the Charter questions). Your suggestions - like the last bullet point on the next-to-last slide (which was a suggestion from the co-chairs) - can be added to the list for consideration by the WG.

Edward Morris:@Maxim. As our wonderful audio service is not working here in northern England at the moment I hope that is not true!

Greg Shatan:Maxim, you have a rich and vivid imagination.

Kathy:@David and Mary: we are seeing an array of questions in the chat room - can you add them to our Notes and Actions?

David Tait:Ed, can we do a dial out to you?

George Kirikos:Raise your hand, to join the queue.

Maxim Alzoba (FAITID):not able to speak (1am)

Marina Lewis:In my experience, most TM owners aren't interested in acquiring domains during sunrise for their own use. It's usually a cost-benefit issue: is it cheaper to register this domain or fight to wrestle it out of the hands of a cyberaquatter? If the answer is yes, then it make sense to register the domain defensively.

Edward Morris:@Phil. Technical problems here: If you could consider my question as well I'd be grateful.

Maxim Alzoba (FAITID):yes

bradley silver:+1 to Marina's response

Mary Wong:Yes we are noting the additional suggested questions

Maxim Alzoba (FAITID):@Greg , cost of litigation in some countries is lower than UDRP

Edward Morris:@ Mary. Thank you!

Mary Wong:We have information on which registries offer a QLP but don't have data on how much they are used - for this we will have to approach each individual registry operator.

Kristine Dorrain - Amazon Registry:I note that ALP and QLP are not really RPMs. They offer the registry a chance to promote the TLD. Not to counter Maxim's question, but just a thought...

Maxim Alzoba (FAITID):QLP is an addendum to RPMs

George Kirikos:@Marina: plus, a markholder will also need to assess whether the damage from the cybersquatting is too minor to litigate or defensively register. Given the lack of traffic most of those domains receive, it's likely not worth pursuing most of them (i.e. minor irritants).

Paul Keating:Phil, I t hink he is referencing post registration use.

Maxim Alzoba (FAITID):ALP was intended to be a way for GEOs and alike to have special rules (for example for protection of small local business too in addition of TMCH)

George Kirikos:If it's a US TM holder, it'd be smarter to use the ACPA and seek \$100K in statutory damages, rather than waste time on URS/UDRP. Do it a few times, and that'll deter cybersquatting.

Kristine Dorrain - Amazon Registry:Maxim, I don't disagree. I just note that neither one is there to protect brands.

Maxim Alzoba (FAITID):@Kristine , the point is , we review things relevant to RPMs

Marina Lewis:@George - agreed, with the additional comment that this is often an unknown at the time of registration. The TM owner has no way of knowing whether the domain will be used for a pay-per-click site or (God forbid) a child porn site. Sometimes it's safer to just cough up the money for the registration fee.

Scott R. Austin:Is there an equivalent of a "legislative history" of the concerns or business goals for registries that the LRP, ALP and QLP were created to address?

George Kirikos:Right, Marina. I think that's why some markholders see the potential scaremongering as a "protection racket", i.e. "if you don't register, then ....."

Edward Morris:Thanks Kathy.

George Kirikos:Do we have anyone here from CSC or MarkMonitor? It seems they drive a lot of the sunrise registrations, so might have insights to share.

Marina Lewis:@George +1

Maxim Alzoba (FAITID):do we see situations with TMCH entries for companies who made only one shipment to be accredited as gaming?(proof of use)

Paul McGrady:@Kathy, what if it were for a site for presidential vehicles? I was just at the Henry Ford Museum and there is a huge display. :)

George Kirikos:(there are a few other "corporate" registrars, but those 2 are the largest I think) Netnames, and a few others also might have insights.

Kathy:Henry Ford - that's a good example too!

Phil Marano (Mayer Brown):@Paul or for a president's day sale :)

Kathy:@Paul: I think this is a very important area for discussion.

Paul Keating:@Phil. I think that a "use" requirement should be incorporated to preserve a sunrise registration.

Paul Keating:ALSO, what evidence of "actual use" does the TMCH require?

Edward Morris:Thnks Phil.

Kathy:@Paul, is this a question you would like to add to our questions list?

Mary Wong:@PaulK - this is what the TMCH says about proof of use:

[https://urldefense.proofpoint.com/v2/url?u=http-3A\\_www.trademark-2Dclearinghouse.com\\_help\\_faq\\_what-2Dproof-2Duse-2Dfile&d=DQIFaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0A1gn-H4xR2EBk&m=Mib8y\\_wp\\_LdN7ia8TdzyfGoi2d0ilYHQQimeMGoB\\_1U&s=ZZ4SGQLbQfVold10PouE9DPNo fyeeohpVOh\\_Tccr7rM&e=](https://urldefense.proofpoint.com/v2/url?u=http-3A_www.trademark-2Dclearinghouse.com_help_faq_what-2Dproof-2Duse-2Dfile&d=DQIFaQ&c=FmY1u3PJp6wrcrwll3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0A1gn-H4xR2EBk&m=Mib8y_wp_LdN7ia8TdzyfGoi2d0ilYHQQimeMGoB_1U&s=ZZ4SGQLbQfVold10PouE9DPNo fyeeohpVOh_Tccr7rM&e=)

Paul McGrady:@Kathy - interesting for sure. would be more straightforward if there was a GPML (since we are looking at flaws in the current system). :)

George Kirikos:It shouldn't apply to "all gTLDs", given there's no notion of "premium names" in com/net/org, etc.

Paul Keating:I am fine with it being a question to be considered

Paul Keating:I do not however feel it should be changed

Paul Keating:VERY good question

Edward Morris:Agree with Rebecca.

Marina Lewis:Re Rebecca's question, I think "rights" as used in RPM does specifically refer to IP rights, yes?

Mary Wong:@Paul K - can you restate the question? Is it whether the use requirement should be reviewed?

Kathy:@Mary, can we add PaulK's question regarding exploration into use and Rebecca's question on pricing and what rights it protects to our Notes and Actions for future evaluation?

George Kirikos:If "Verizon.TLD" or "EXXON.TLD" were listed as premium domains, i.e. fanciful marks, then it's more likely to be abusive.

Paul Tattersfield:depends on the strength of the business rather than the strength of the mark sometimes

Paul Keating:@Paul, is that not the result of the trademark being a "generic" term?

Maxim Alzoba (FAITID):Are we into regulation of pricing? I thought it is not regulated , at least ICANN says they are not into this business

Mary Wong:@Kathy,@Paul K - can one of you restate Paul's question? Is it to review the use requirement, or something more specific about what is required to show proof of use

Maxim Alzoba (FAITID):or apple?

George Kirikos:Perhaps placing a cap on how many domains can be declared "premium" would reduce the potential for that abuse.

Vaibhav Aggarwal:@Jeff Your voice is not clear

Scott R. Austin:@Paul M +1

Mary Wong:@Paul M - short of searching a number of trademark databases and comparing them to each registry's list of premium names, how would we get the data?

Kathy:@Mary: how about a general question asking the WG to further explore "use" and the types of proof used by the TMCH/Deloitted

Vaibhav Aggarwal:As per Key Terms & Definitions - the price needs to be Defined too

Vaibhav Aggarwal:@Rebeca Your example is not the right Comparison

Vaibhav Aggarwal:Unreasonable Pricing is definitely an Abuse of the System and poisiton. Infact it can be classified in Monopolistic Business Practices

Vaibhav Aggarwal:+1 Phil

George Kirikos:To the extent that a registry operator raises the registration price, it reduces the odds that anyone will register the domains (which means a cybersquatter won't grab them).

Paul KEATING:gouged is not prevented.

Vaibhav Aggarwal:As a TM owner I am authorised to get a Normal Domain Name Pricing

George Kirikos:Although, in some sense the markholder might claim that it's now the registry itself that is being the "cybersquatter".

Paul KEATING:so if a trademark registration with the PTO cost 10,000 it would be unfair?.

Scott Harlan:Agree that it is relevant. There is also the issue of timing of the notification that a name is premium, which often occured after a Sunrise order was placed and was close to the end of the relevant Sunrise Period. This either foreclosed the Sunrise period for those names or made it less effective.

Paul KEATING:this issue is NOT resolved.

Vaibhav Aggarwal:Yes they are Infringinng at least w.r.t. the to teh registered TMs

Paul Tattersfield:Couldn't we just say that all sunrise names can not cost more than general release prices?

George Kirikos:Some domains like Cars.blog are 6-figures per year, I believe.

Vaibhav Aggarwal:+1 Marina

Paul KEATING:no Paul, we cannot limit pricing.

Terri Agnew:next call for the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Groupis scheduled for Wednesday, 28 September 2016 at 16:00 UTC for 60 minutes.

George Kirikos:But, that's likely due to the inherent value of the term "cars", not some markholder for 'cars'.

Phil Marano (Mayer Brown):Pricing aside, premium names tend to be registry reserved names, which are generally exempt from sunrise and claims services, depending on when it is released for registration per RPM Requirements Section 2.4.3.

David Tait:That is correct

David Tait:1600 UTC

Vaibhav Aggarwal:Thanks Guys

khoulood Dawahi:16utc

George Kirikos:Bye everyone.

Maxim Alzoba (FAITID):bye all

Scott Harlan:By "it" was referring to the issue of "premium names"

Kathy:And TM Claims Overview next week

Steve Levy:Thanks all!

Vaibhav Aggarwal:How is the Asia Pacific Participants Getting Accomodated ? Its 0330 AM in New Delhi

Marina Lewis:thanks all!!

Vaibhav Aggarwal:Ciao Guys

Paul KEATING:thanks all. good night

khoulood Dawahi:thank you all .

Vaibhav Aggarwal:Night