

LIST OF QUESTIONS COMPILED FROM TMCH SUB TEAM CALLS OF 12 & 26 AUGUST 2016 (updated by ICANN staff, 15 September 2016)(edited 9-22)

Deleted: .  
Formatted: Font color: Red  
Deleted: 9

I. LIST OF QUESTIONS

Questions for New gTLD Registries:

Moved down [1]: Please describe what you are able to block with a given SMD file. .

Are you accessing data and records in the TMCH for purposes other than obtaining information necessary for the provision of sunrise and claims services in accordance with ICANN's user manuals and technical requirements (see <https://newgtlds.icann.org/en/about/trademark-clearinghouse/registries-registrars>)?

- If you are willing, please tell us, for each new gTLD, how many sunrise registrations you had during each sunrise period? Where can we find your Sunrise Dispute Policy? Was it ever used?
- Did your support teams receive any inquiries from 'anchor tenants' / pioneers who were unable or unwilling to proceed with registration due to issues arising from the issuance of a TM claims notice? If these potential Registrants did not want to proceed after receiving the TM claims notice, do you have any information or data on why not?
- Have you used the TMCH option to limit registrations by goods and services in a particular registration period?
- Are you using any capabilities of the TMCH other than for Sunrise Periods and TM Claims Notices? If so, what?

Deleted: .

Deleted: <#>Why do you think so many potential registrants do not proceed further with registering a domain name when they receive a TM Claims notice? .

Deleted: Can

Deleted: Are you willing you to

Deleted: each new gTLD by

Deleted: your

Deleted: .

Deleted: <#>Do you wish to provide addition input, information or data for our consideration of modification to RPMs?

Formatted: Indent: Left: 0.5", No bullets or numbering

Deleted: .

Comment [KK3]: This should capture not only PPML uses, but the other types of uses we examined in the WG on Wed- such as a special repository specific to the New gTLD.

Comment [KK5]: I see PPML used more than BMS...

Questions for New gTLD Registries offering Blocking Mechanism Services:

- A valid TMCH SMD file is required to use a blocking mechanism service (such as DPML). Was there push back from people who wanted to use a PPML but not put their marks into the TMCH?
- Please describe what you are able to block with a given SMD file.
- Did the various blocking mechanism services drive users to the TMCH – that is, are you aware of any brand owners that entered their TMs in to the TMCH just to be able to participate?
- Are there adequate and suitable mechanisms that protect registrants against price escalations in blocking mechanism services prompted by the availability of blocking mechanism services and other "private" uses of the TMCH?

Deleted: PPML

Formatted: Underline

Deleted: Private Protected Marks List (PPML)

Moved (insertion) [1]

Deleted: PPML

Deleted: Are these third party, additional services promoting the use of the TMCH?

Comment [DK10]: Raising prices on what? TMCH? PPML services? Something else?

Deleted: <#>Is the 'chilling effect' being extended through these private uses of the TMCH? .

Formatted: Strikethrough

Formatted: Strikethrough

Formatted: Strikethrough

Deleted: PPML

Formatted: Indent: Left: 0.5", No bullets or numbering

- How many trademark owners are using the TMCH solely to be able to participate in the PPML, but NOT to make any Sunrise Registrations? – or -- What are number of DPML-type registrations that are in each of the registries that offer them, vs the number of sunrise registrations?
- How do you structure your PPML? I.e., briefly describe the way your PPML works – that is, what the brand owner is getting as a result of using your brand protection service.
- How many marks are on the PPML (either or both of: just the marks as indicated by the relevant SMD file; and all extensions blocked, based on that SMD file)? Are generic and dictionary words included in the PPML?

Questions for Registrars:

- Are you accessing data and records in the TMCH for purposes other than obtaining information necessary for the provision of sunrise and claims services in accordance with ICANN’s user manuals and technical requirements (see <https://newgtlds.icann.org/en/about/trademark-clearinghouse/registries-registrars>)?
- The Analysis Group’s Draft Report on the TMCH seemed to show a high number of Claims Notices issued resulting in a low number of actual consequent registrations. However, the Analysis Group’s data did not include a breakdown of Claims Notices by registrar. Can you provide us with the number of Claims Notices sent by each of your accredited registrars for each new gTLD for which they sold registrations?
- To assist us in understanding whether and how the existence and duration of the TM Claims period may have contributed to the low number of registrations, can each registrar tell us what is the rate of cart abandonment for new gTLDs when a potential registrant is exposed to a TM Claims Notice in comparison with the rate following the end of the Claims period? How do those numbers compare to [legacy] gTLDs?
- Do you have any evidence to suggest why so many potential registrants apparently do not proceed further with a registration when they receive a TM Claims Notice?
- What would you like to see improved about the Claims Notice that you believe will:
  - assist legitimate users to move forward with registrations and why?
  - deter cyber squatters and other so-called “bad actors” from proceeding further with the registration process?
 Or, is there any data or specific information you have that can help inform the Working Group’s deliberations on this topic? Include feedback from registrants.
- Can you describe the timing for which a Claims Notice is displayed to a potential registrant? Are there Potential Registrants who would not see a TM Claims Notice in realtime?

**Comment [SP11]:** This is an interesting and useful question to try to answer, but I don’t see how a Registry would know that – they have no idea what the same trademark owner is registering in other registries than their own.

Perhaps we should be asking what the number of DPMLs are in the registries that offer them, vs the number of sunrise registrations. This might give an indication of whether sunrise registrations are lower than average where a DPML is available

**Comment [DK12R11]:** Agree with Susan.

**Formatted:** Indent: Left: 0.5", No bullets or numbering

**Comment [MW13]:** I think we need to be more specific here.

**Comment [DK14R13]:** How about: “Briefly describe the way your PPML works – that is, what the brand owner is getting as a result of using your brand protection service”

**Formatted:** Normal, No bullets or numbering

**Comment [MW15]:** Do we mean just the marks as indicated by the relevant SMD file or all extensions blocked, based on that SMD file?

**Deleted:** it

**Deleted:** -

**Comment [DK22]:** For these two, I suggest instead: As you created your PPML, were you concerned about removing terms from your registration pool that others may have had a right to? If so, how did you address that? If not, why not?

**Deleted:** Are generic words and descriptions included ... [1]

**Deleted:** ?

**Deleted:** [Gather statistics on the number of claims notices sent by registrars in light of what seems to have been an unusually high number of claims versus actual registrations – purpose is to try to get some insight as to whether some registrars may have been using chee ... [2]

**Comment [KP23]:** We could add in the explanation t ... [3]

**Deleted:** Why do you think

**Deleted:** they

**Comment [KK25]:** I don’t understand the clause in ... [5]

**Formatted:**

**Deleted:** (what problem would your suggestion k ... [4]

**Comment [SP26]:** I think it would be helpful to move ... [6]

**Comment [SP27]:** “Or feedback received from registrants”;

**Formatted:** ... [7]

**Deleted:** !

**Formatted:** Indent: Left: 0.5", No bullets or numbering

**Comment [SP28]:** I don’t understand what this quest ... [8]

**Deleted:** tell us the amount of time

**Deleted:**

- How many TM+50 claims notices were issued? How many resulted in abandoned registrations?

**Deleted:** <#>Is there anything about the current Claims Notice that you think can be improved and which you believe can deter cyber squatters and other so-called "bad actors" from proceeding further with the registration process? -

**Deleted:** <#>Are there examples of trademark terms not being made available to brand owners during the sunrise period on the basis that they were included on a (blocked), reserved or premium list. -

... [9]

**Deleted:** -

... [10]

**Formatted:** Underline

Questions for the TMCH Providers (Deloitte and/or IBM)

Deleted: Section Break (Next Page)

(a) From the Sub Team:

- What is the rate of rejection of an attempted trademark registrations by country/region?
- What were the most frequently asked questions? (Note – not necessarily what made it to the website but, rather, what questions did you get the most?)
- If you are able, please provide the number and/or percentages of SMD files that were used in Sunrise periods corresponding to specific time periods (e.g. Jan/June/Sept 2014; Apr/Sept 2015; Apr/Sept 2016)?
- Are the registration totals contained within the various monthly/quarterly reports made to ICANN cumulative?
- What is meant by the term ‘expired marks’ in the various monthly/quarterly reports made to ICANN?
- In relation to the statistics regarding the number of marks submitted to the TMCH, as noted in the various monthly/quarterly reports to ICANN, does this statistic relate to individual marks that are submitted, or the number of labels generated, or the number of SMD files created?
- How are marks cancelled within national/regional registries handled at the TMCH level?
- If it is possible, please provide a break down of where the corporate headquarters of those registrants using TM agents are located?
- Some data has been provided regarding outreach efforts; if you can, please provide additional information on the precise nature of the activities undertaken and who was the audience for this? Were any outreach efforts made to potential registrants or trademark owners?
  - How much time and resource were expended on educating TM owners and/or Registrants on the TMCH?
  - Was outreach and education part of the TMCH remit? What are the contractual obligations for education imposed by ICANN, if any?
  - In what regions/languages were outreach sessions held?
- How many design marks have been submitted and validated? What is your criteria for validating these? How are you differentiating between design marks in the practical application of the TMCH guidelines?

Deleted: It will be helpful to get data to see if the TMCH is considered inaccessible or too complicated or hard for TM owners/agents in developing countries – as a starting point, can we get

Deleted: [Suggested by ICANN staff based on Sub Team discussions and data extracted to date] Are

Deleted: to

Deleted: us with

Deleted: Is it

Deleted: to get

Deleted: -

Deleted: D

Deleted: can further

Deleted: be provided

Deleted: .

Deleted: .

Comment [DK31]: I thought only word marks were accepted.

- In relation to Claims Notice statistics, can any discernible trends be noted in relation to: (i) registrar gaming and (ii) registrant turn-back as a result of a possible “chilling effect” resulting from the issuance of a Claims Notice?
- How many contracts are there for private uses of the TMCH? How many of them involve the PPML?
  - Are there contracts for other uses, and if so, how many?
  - If there are no such contracts, is the TMCH aware of other uses?
- How many "court-validated" marks are there currently in the TMCH? (Deloitte)
- How many marks in the TMCH fall under the following category: "Other marks that constitute intellectual property and meet a registry's individual requirements"? Follow-up question: how would Deloitte keep these marks from being used in the Sunrise and TM Claims periods of other registries? (Deloitte)
- Did any trademarks that applied for entry into the Clearinghouse fail in the “actual use” test? If so, how many? Did you receive any complaints of trademarks registered in the Clearinghouse that they were not in actual use?
- How many TMCH records include a +50 list; and how many are on this list on average?
- Have any gTLDs used the TMCH option to limit registrations by goods and services in a particular registration period?
- How many marks were rejected? What is a breakdown of the reasons?
- What is the TMCH process (if any) relating to marks that are cancelled or expire: reactive (e.g. TM owner/agent obligations) and proactive, if any.
- How many SMD files has the TMCH cancelled? How many TMCH disputes have been brought relating to SMD file validity for TMs that are cancelled/expired?
- Have there been any Sunrise DRPs relating to marks relied on at Sunrise which had already expired or been cancelled?
- How many DPML services are you supporting?
- What is the geographic distribution of those who record marks in the TMCH – bearing in mind that TMCH agents may be in a different country to the TM owner and that TM owners may record a mark registered in a different country to the one they are based in.

**Comment [DK32]:** How would the TMCH know what domains were ultimately registered despite the Claims Notice?

**Comment [DK33]:** How will we define registrar gaming?

**Comment [DK34]:** The point of a TMCH entry is to prevent a matching name from being registered in bad faith, how could the TMCH know if registrants being turned back are thinking better of their bad faith actions vs being “chilled.” We should use a more accurate description of the activity we want to discuss.

Deleted: -

Deleted:

**Comment [KP35]:** I am not sure what this question means.

Deleted: which

Deleted: which

Deleted: s

- What is the percentage of trademark registrations, sunrise registrations and claims notices sent by country / region? (Bearing in mind that TMCH agents may be in a different country than the TM owner and that TM owners may record a mark registered in a different country from the one in which they are based.)

Deleted: - ... [11]

Deleted: -

Deleted: - ... [12]

Deleted: -

Page 2: [1] Deleted Kurt Pritz 9/15/16 5:10:00 PM

~~Are generic words [MW1][DK2] and descriptions [MW3][DK4] included?  
How many of the marks are coined or fanciful terms [MW5][DK6]~~

Page 2: [2] Deleted Mary Wong 9/5/16 4:15:00 PM

~~[Gather statistics on the number of claims notices sent by registrars in light of what seems to have been an unusually high number of claims versus actual registrations — purpose is to try to get some insight as to whether some registrars may have been using checks with the TMCH to develop their premium pricing (Note: Analysis Group does not have breakdown of claims notices by registrars)] REPLACE with the following specific question:~~

Page 2: [3] Commented Kurt Pritz 8/26/16 7:41:00 AM

We could add in the explanation to this question that we are trying to understand how the existence of the Claims period might have harmed actual registrations. This information would be helpful to registrars when we discuss whether the Claims period should be extended (or help justify why we are not extending it).

Page 2: [4] Deleted Kathy Kleiman 9/22/16 1:06:00 PM

(what problem would your suggestion be solving)

Page 2: [5] Commented Kathy Kleiman 9/22/16 1:06:00 PM

I don't understand the clause in parentheses and it might discourage responses to the question.

Page 2: [6] Commented Susan Payne 9/15/16 5:39:00 PM

I think it would be helpful to move this up so the two "what can be improved" questions are together

Page 2: [7] Formatted Kurt Pritz 9/15/16 5:40:00 PM

Normal, Indent: Left: 0.75", No bullets or numbering

Page 2: [8] Commented Susan Payne 9/9/16 3:17:00 PM

I don't understand what this question is aiming at. The claims notice is sent to the registrant once

Page 3: [9] Deleted Kathy Kleiman 9/22/16 1:08:00 PM

Are there examples of trademark terms not being made available to brand owners during the sunrise period on the basis that they were included on a (blocked), reserved or premium list.

How many sunrise registrations were attempted and not completed because the name was reserved?

Are there examples of Claims notices being received in relation to dictionary words, the use of which is likely to have been generic in the context of the TLD, but where the registrant then did not proceed? (i.e. hypothetical TM: PINK in hypothetical TLD .color)

What is the cart abandonment rate during the claims period vs the cart abandonment rate after the claims period?[KK7]

How many claims notices have been sent for domains on a TM +50 list

What, if any, education services does the TMCH provide? What are the contractual obligations for education imposed by ICANN, if any?

(b) From the WG Charter/community discussions:

How many marks were registered?

Where did the trademarks originate?

How many TM holders took advantage of TM+ 50? How many claims notices have been sent for domains on a TM +50 list?

How many used the extended registration service (notice of identical matches being registered past the sunrise and claims periods)?

How many trademarks were denied validation by the TMCH and for what reasons (by number and %)?

How quickly can a cancelled trademark be removed from the TMCH?<sup>1</sup>

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, and were: (a) eventually challenged by the TMCH claim holder, and (b) where 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 via URS, UDRP or other mechanism.)*

How many private users are using the TMCH, particularly registries, and for what additional purposes?

Questions for Brand/TM Owners/Users/Customers:

Do you understand the purpose of the TMCH?

For brand owners who didn't put their marks in the TMCH -  
Why didn't they?

What would encourage them to participate, if anything?

---



For brand owners who did put their marks in the TMCH –  
Would they do it again? Why or why not?  
Was the value acceptable (e.g. cost/benefit ratio)?

#### Questions for CCT-RT:

What are the types of data, and how much of it is being gathered, that you believe may be applicable to the TMCH review being conducted by the GNSO PDP Working Group that is reviewing all the existing Rights Protection Mechanisms?

#### Questions for Analysis Group

Reference was made to some of the data collected being incorrect due to the incorrect operation of the TMCH by certain registrars. Have the figures in the report been amended to take account of this?

RESPONSE: In regard to one of the registrars conducting the disproportionate amount of bulk downloads, it was indeed brought to ICANN's attention by IBM. The operations team then worked with the registrar who has since corrected this issue. As for the other registrar, while the number of bulk downloads was slightly high, it was not considered an issue by both the TMCH providers and ICANN. With this in mind, these matters are typically approached from the operations side first; however, in the event that a registrar is unwilling to work with ICANN/TMCH providers or if it's a clear violation, only then will the issue be referred to the Compliance team.

## II. ACTION ITEMS & CONTINUING WORK

#### Guidance for Continuing Data Extraction:

Staff to continue data extraction from identified materials and post sources to wiki; as more data is gathered, create a table with specific data points and corresponding milestone time periods for each so as to provide a uniform historical overview of the data from (say) March 2013 to the present

*IN PROCESS – first update provided on 15 August*

*To be updated with most recent data from Deloitte/IBM when available.*

*Staff to clarify whether data contained within Staff RPMs paper has been amended to take account of incorrect operation of the TMCH by some registrars. If not, will it be possible to update?*

Update numbers for Sunrise records (% of SMD files), especially for 2015 – and match these with the number of new gTLDs launched at those times

*IN PROCESS – may need Deloitte assistance for SMD file numbers*

Check meaning of Cumulative Claims Transactions – in general, be consistent across entries/data points so that we are looking at the same type of data for each entry

*SEE 15 AUGUST UPDATE FOR NEW FORMAT*

Try to correlate entries in specific time periods to the trend of new gTLDs being launched at that time (e.g. it was IDNs that went first in late 2013, with more Latin-based script gTLDs following especially in 2015)

*IN PROCESS*

Suggestions for General Search/Other Follow Up:

Do a limited Google search to see if there have been instances where smaller brand owners or TM owners from developing countries may have felt disadvantaged – this can include anecdotal evidence (e.g. blog posts, comments to industry articles)

*IN PROCESSCOMPLETEDS – little specific evidence found*

On the high number of Claims Notices versus small number of completed transactions – check with GDD staff on note in Final Staff RPM Paper regarding possible misunderstanding over these numbers as published in the original draft paper

*COMPLETED – noted in 15 August update*