

LIST OF QUESTIONS COMPILED FROM TMCH SUB TEAM CALLS OF 12 & 26 AUGUST 2016 (updated by ICANN staff, 4-58 September 2016)

I. LIST OF QUESTIONS

Questions for New gTLD Registries:

- For “blocking mechanisms” offered by new gTLD registries, a valid SMD file from the TMCH is required. Is there a limit to the number of domains, or gTLD extensions, that can be blocked with a single unique 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>)?
- Why do you think so many potential registrants do not proceed further with registering a domain name when they receive a TM Claims notice?
- Can we have a break-down of the number of sunrise registrations by registry? (see CCT-RT data)
- [Is there anything about the TM Claims Notice that you think can be improved and that you believe will assist legitimate users with proceeding with their registrations?](#)

Commented [KP1]: I don’t quite understand this question. Are you asking how many SMD files are required to block one name in all the (say) Donuts TLDs? I think we should sharpen it a bit.

Commented [MW2]: Staff had wondered as well, so here an attempt to clarify – not sure if this is what was intended though.

Commented [MW3]: Please see this annual list provided the CCT-RT: <https://www.icann.org/en/system/files/files/metric-2-8-10dec15-en.xlsx> (from the CCT-RT page at <https://www.icann.org/resources/pages/cct-metrics-registries-2016-06-27-en#7.2>). Are we asking for more of this, or more details about this?

Questions for New gTLD Registries offering PPML Services:

- A valid TMCH SMD file is required to use a Private Protected Marks List (PPML). Was there push back from people who wanted to use a PPML but not put their marks into the TMCH?
- Did the various PPML services drive users to the TMCH? Are these third party, additional services promoting the use of the TMCH?
- Is the ‘chilling effect’ being extended through these private uses of the TMCH?
- Are there adequate and suitable mechanisms that protect registrants against price escalations prompted by the availability of PPML services and other “private” uses of the TMCH?
- How many trademark owners are using the TMCH solely to be able to participate in the PPML, but NOT to make any Sunrise Registrations?
- How do you structure your PPML?
- How many marks are on it?
- Are generic words and descriptions included?
- How many of the marks are coined or fanciful terms?

Commented [MW4]: Do we mean the rate of registrations vs the number of TM Claims Notices? May want to be more specific.

Commented [MW5]: I think we need to be more specific here.

Commented [MW6]: Do we mean just the marks as indicated by the relevant SMD file or all extensions blocked based on that SMD file?

Commented [MW7]: Was this what was meant by “bad works”?

Commented [MW8]: Should we clarify this?

Commented [MW9]: Won’t they just respond that this legal question they can’t comment on? Is it possible to rephrase?

Questions for Registrars:

- ~~[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:~~ 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 registrar 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?
- Why do you think so many potential registrants 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 they believe will assist legitimate users to move forward with registrations? Is there any data or specific information you have that can help inform the Working Group’s deliberations on this topic?
- Can you tell us the amount of time for which a Claims Notice is displayed to a potential registrant?
- 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?

Commented [KP10]: We could add in the explanation 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).

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

(a) From the Sub Team:

- 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 the rate of rejection 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?)
- [Suggested by ICANN staff based on Sub Team discussions and data extracted to date] Are you able to provide us with 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?
- Is it possible to get a break down of where the corporate head-quarters of those registrants using TM agents are located?
- Data has been provided regarding outreach efforts; can further information be provided 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 on the TMCH?
- 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?

· 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)

(b) From the WG Charter/community discussions:

1. How many marks were registered?
2. Where did the trademarks originate?
3. How many TM holder took advantage of TM+ 50?
4. How many used the extended registration service (notice of identical matches being registered past the sunrise and claims periods)?
5. How many trademarks were denied validation by the TMCH and for what reasons (by %)?
6. How quickly can a cancelled trademark be removed from the TMCH?¹
7. 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?
8. 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)
9. 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 NEWFORMAT*
- 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 PROCESS~~ *COMPLETEDS – 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*