

COMPILATION OF REGISTRY RESPONSES TO QUESTIONS DEVELOPED BY THE TMCH DATA GATHERING SUB TEAM (as of 13 December 2016)

These questions have been prepared by a sub-team of the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group which has been charged with gathering information regarding the operation of the Trademark Clearing House (TMCH). This is the first attempt by the sub-team at gathering information on this critical topic and as such there may be further additional or follow-up questions to follow. Should you wish your responses to be provided on a confidential or anonymous basis please do not hesitate to raise this with ICANN staff (Mary Wong, mary.wong@icann.org or David Tait david.tait@icann.org).

(A). Questions for New gTLD Registries:

- 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>)[newgtlds.icann.org]?

PIR: No.

DONUTS: Yes. We use the TMCH to verify Domains Protected Marks List (DPML) block requests. We also look at the SNL and TCN lists for business intelligence such as confirming if numbers reported in industry blogs and ICANN reports are accurate.

AFNIC (.paris): No.

- 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?

PIR: For the .ngo and .ong TLDs, we had 35 registrations for each TLD during its respective sunrise. Our Sunrise Dispute Policy was previously located with the other .ngo and .ong Policies at <https://pir.org/policies/ngo-ong-policies/>[pir.org]. However, since the Sunrise period for those TLDs expired well over a year ago, we removed the Sunrise Dispute Policy from that page. The Sunrise Dispute Policy was never used.

DONUTS: We register 125 sunrise names per TLD on average.

Our Sunrise dispute policy is posted at:

<http://www.donuts.domains/policies/sunrise-and-dpml-dispute-resolution-policy>. We have never used the sunrise dispute policy. The checks and safeguards implemented by the TMCH prevent any SMD files from being issued to non-qualified parties. Only qualified parties can

participate in our sunrise. Therefore the requirement for a sunrise dispute policy is unnecessary.

AFNIC: 1687 domain names were registered during the sunrise/priority periods (796 during the Sunrise period and 891 during LRP). .Paris Sunrise Dispute Policy is available here: http://bienvenue.paris/wp-content/uploads/2014/09/VDP-pointParis-SDRP_2014_9_02.pdf[bienvenue.paris]. It has been used twice during those phases.

- 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?

PIR: No. We did not receive any such inquiries.

DONUTS: As a registry, we typically do not have direct contact with registrants, so we have not heard directly from potential registrants who were deterred by a claims notice. Registrars would be more likely to have that information. We did have a handful of registrants wanting to participate in Sunrise but they were not able to get their SMD file in time.

AFNIC: No, not to our knowledge.

- Have you used the TMCH option to limit registrations by goods and services in a particular registration period?

PIR: No.

DONUTS: No.

AFNIC: No.

- Are you using any capabilities of the TMCH other than for Sunrise Periods and TM Claims Notices? If so, what?

PIR: No.

DONUTS: Yes, we leverage the SMD files as qualifiers for our DPML service.

AFNIC: No.

- Do you make any other uses of the SMD file or TMCH Database?

PIR: No.

DONUTS: No.

AFNIC: No.

- Can you provide information regarding any use of the SMD file or TMCH Database in relation to any QLP or ALP services you offer?

PIR: N/A.

DONUTS: No.

AFNIC: No.

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(B). Questions for New gTLD Registries offering Blocking Mechanism Services:

PIR: This section is not applicable to Public Interest Registry.

AFNIC: Not applicable – we do not offer this service.

- 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 blocking mechanism service but not put their marks into the TMCH?

DONUTS: Only a few registrars complained about the cost and effort required to acquire an SMD file to participate in the DPML program.

- Please describe what you are able to block with a given SMD file.

DONUTS: The SMD file is used to: 1. authenticate the right of the registrant to request a label to be blocked. 2. Validate the blocked term. (The SMD file doesn't have any inherent blocking capability). The customer requests the block and submits the SMD file. Our system then reads the SMD file to verify that it contains the label as either an exact match or in "contains" format before completing the transaction. When the request for a block is complete, our system will then block most new registrations of such names.

- 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 in blocking mechanism services, but not to make any Sunrise registrations?

DONUTS: Yes.

- 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?

DONUTS: It is outside of the remit of ICANN to consider pricing issues on these services. Prices are determined by the competitive marketplace.

- What are number of DPML-type registrations that are in each of the registries that offer them, vs the number of sunrise registrations?

DONUTS: We have registered thousands of DPML blocks. The DPML service is of very high value to our customers: the average cost of a sunrise registration is \$100 but the cost of a block is about \$2 per domain. That is roughly 10% of the cost of an average domain registration in our TLDs.

- How do you structure your blocking mechanism service? I.e., briefly describe the way your blocking mechanism service works – that is, what the brand owner is getting as a result of using your brand protection service.

DONUTS: The DPML block prevents the registration of a domain that matches or contains the block holder’s label. The mark holder pays a single fee for a domain, such as “example.dpml.zone”. Later, when a registrant attempts to register “example.TLD,” after a DPML block is in place, our registry system queries the DNS to see if “example.dpml.zone” exists. If it does, the registration of “example.TLD” fails, with certain exceptions. The customer is informed of the number of TLDs in which a block will occur. They also are provided with the list of premium names that they can register at any time.

The DPML block does not prevent a sunrise registration. For our standard DPML service, another SMD file containing the same label can be used to override the block during sunrise or at any time the block is in place (multiple parties can have marks for the same label, and therefore, SMD files containing the same label). This rule ensures that DPML blocks are not preventing legitimate mark holders from registering and using their names.

- How many marks are on the blocking mechanism service (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 blocking mechanism service?

DONUTS: The list of marks being blocked is created by DPML block holders. We do not use a “black list” process, whereby the registry makes a list of names that will be blocked. Except for the required ICANN reserved list and a handful of super premium labels, *all SLDs are available for registration by anyone unless a mark holder has purchased a block*. The block prevents registration of the mark by anyone without a matching SMD file.