

**FINAL LIST OF SUGGESTED CHARTER QUESTIONS FOR REVIEW OF THE TMCH**  
 Updated by ICANN Staff on ~~6-13~~ DECEMBER 2016

SUGGESTED CHARTER QUESTION	COMMENTS FROM THE TMCH CHARTER QUESTIONS SUB TEAM/ <u>WORKING GROUP CO-CHAIRS</u>	WORKING GROUP DISCUSSION	WORKING GROUP NOTES
<b>Category 1: Guidance</b>			
<p>1. Should the verification criteria used by the TMCH <u>to determine if a submitted mark meets the eligibility and other requirements of the TMCH</u> be clarified or amended? If so how? <b>(NOTE: See the TMCH Guidelines at <a href="http://trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf">http://trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.2_0.pdf</a>)</b></p>	<p>This issue was raised by various public comments to the Draft RPM Staff Paper (Feb 2015), referring to administrative challenges (e.g. inconsistent submission requirements such as for on non-Latin text marks, error corrections and certifications required), as well as the need for clearer communications and better guidelines from the TMCH; also supported by several commenters to the Preliminary Issue Report (Oct 2015) – though one noted the need to define what “different” means (e.g. jurisdiction? Design vs <del>work</del> <u>word</u> mark? Goods or services?)</p>	<p>Rebecca Tushnet (1 Dec), seeking clarity on Q1 esp. in relation to Q4:</p> <p>“It seems to me that Q4, and maybe Q1, goes to the problem that the TMCH is only supposed to accept marks that are valid as word marks, not marks that are only valid in combination with a design. E.g., PARENTS + design for magazines should not be accepted into the TMCH, because the registrant has no rights in the word "parents" as such, even though that's the only word component of the mark. See Gruner + Jahr USA v. Meredith Corp., 991 F.2d 1072 (2d Cir. 1993). Am I mistaken about what Q1 is supposed to cover? It does appear to me that the TMCH's current handling of word + design marks is inconsistent with the instructions provided by ICANN.”</p>	<ul style="list-style-type: none"> <li>• <u>Clarify what is meant by “verification criteria” and add link to TMCH Guidelines (DONE)</u></li> <li>• <u>Agreed that Q1 is not about design marks (see Q4)</u></li> </ul>
<p>2. <del>What activities does</del> the TMCH undertake <del>to</del> <u>clearly</u> communicate: (i) the criteria it applies when</p>			

Commented [MW1]: Should this be deleted? Have these concerns been adequately covered by the final questions?

<p>determining whether or not to accept marks <u>for entry into the TMCH</u>; (ii) <u>options for rights-holders when their submissions are rejected</u>; and (iii) <u>options for third parties who may have challenges to or questions about records in the TMCH?</u></p> <p>2. <u>what to do when registrations are challenged?</u></p>			
<p>3. Should the TMCH be responsible for <u>education services for trademark owners educating rights-holders</u>, domain name registrants and potential registrants <u>about the services it provides?</u> If so, how? If the TMCH is not to be responsible, who should be?</p>			
<p>4. How are design marks currently handled by the TMCH provider? <u>(NOTE: The Working Group is using the more commonly-used term "design marks" to refer to what the TMCH Guidelines describe as "device" or "image" marks, or otherwise marks that do not excessively consist of letters, words, nu</u></p>		<p>See comments from Rebecca Tushnet under Q1, above.</p> <p>Mathieu Weill (3 Dec), noting that the TMCH seems to accept marks comprising Geographical Indications and suggesting:</p> <p>"How are Geographical Indications and/or Appellations/Designations of Origin handled by the TMCH provider? How many such</p>	

Commented [MW2]: A further suggestion was to add "and what information does it already provide" to this question; however, staff notes that this may be covered by Q5 below and suggests reviewing these questions together.

<p><a href="#">merals, special characters (see TMCH Guidelines p. 20))</a></p> <p>4.</p>		<p>registrations were submitted / approved?"</p> <p><a href="#">Massimo Vittori (13 Dec):</a></p> <p><a href="#">"How many design marks and marks protected by statute or treaty 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? Under the marks protected by statute or treaty, how many applicants based their requests on titles such as Geographical Indications (GI), Protected Designation of Origin (PDO) or Appellation of Origin (AO)?"</a></p>	
<p>5. What information on the following aspects of the operation of the TMCH is available and where can it be found:</p> <ul style="list-style-type: none"> <li>• TMCH services;</li> <li>• Contractual relationships between the TMCH providers and private parties; and</li> <li>• With whom does the TMCH share data and for what purposes?</li> </ul>	<p>Note from staff – this may need to be discussed in tandem with the Co-Chairs’ Paper on Private Protection Mechanisms (see separate paper)</p>		

**Category 2: Verification & Updating of TMCH Data**

<p>1. Should there be an additional or a different recourse</p>		<p>Justine Chew (5 Dec) with a follow up suggestion:</p>	
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mechanism to challenge rejected trademarks?		“If answered in the positive, should such mechanism be incorporated into and administered under the TMCH Dispute Resolution Procedures?”	
2. How quickly can and should a cancelled trademark be removed from the TMCH to avoid discouraging or losing domain names registration? Is this satisfactory?			
<b>Category 3: Balance</b>			
1. Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrants?			
2. Should the scope of the TMCH be limited to apply only to the categories of goods and services in which the generic term(s) within a trademark are protected? If so, how?	<p><u><a href="#">Proposal from Co-Chairs (13 Dec):</a></u></p> <p><u><a href="#">“Should the scope of the TMCH be limited to apply only to the categories of goods and services in which the dictionary term(s) within a trademark are protected? If so, how? (Note: In responding to this question, you should note that the original submitters of the related Charter questions seem to be particularly concerned about</a></u></p>	<p>Kiran Malachandruvil (1 Dec):</p> <p>“I still have serious concerns about the reference to “generics” in Question 10. I think the arguments about why “generics” is a legally inappropriate reference here have all been stated, and I support them. I think it should be deleted completely and I think the prior questions about balancing competing rights (and free speech)</p>	

	<p><u>"generic terms" representing the common or class name for the goods and services)"</u></p>	<p>address the concerns this question tries to get at" and noting possible redundancy in view of earlier questions."</p> <p>Note additional discussion on the WG list on the use of the word "generic" in this question; four additional WG members (as of 6 Dec) support deleting the term – is there alternative wording that will work?</p> <p><u>Phil Corwin (13 Dec):</u></p> <p><u>"Should the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term(s) within a trademark are protected?"</u></p>	
3. Should the TM+50 <sup>1</sup> be retained or removed?			
4. Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or			

<sup>1</sup> Trademark owners can add up to 50 variations that are similar to each valid submission in the TMCH—within the notification process—provided that the variant of the mark was awarded to the trademark holder in a prior UDRP case.

‘mark+keyword’, and/or common typos of a mark?			
<b>Category 4: Access &amp; Accessibility</b>			
1. How accessible is the TMCH database and RPM Rights Protection Actions and Defenses to individuals, orgs, trademark owners and trademark agents in developing countries?	Findings on this issue should be shared with the New gTLD Subsequent Procedures PDP Working Group		
2. What concerns are being raised about the TMCH being closed, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain closed or become open?			
<b>Category 5: Costs &amp; Other Fundamental TMCH Features</b>			
1. Should the TMCH remain a single provider or should we open it to different providers, of course with a central database that should be accessed by the different providers? Is it practical to have more than one provider?	<p>WG input sought on the following options:</p> <p><u>Proposal 1</u> "Does the present structuring of the TMCH optimize such operational considerations as cost, reliability, global reach, and service diversity and consistency, or should significant changes be considered?"</p> <p><u>Proposal 2</u> "What are the concerns with the TMCH Database being provided by a single Provider - and</p>	<p>As of 6 Dec, three WG members have indicated a preference for Proposal 2.</p> <p>George Kirikos (4 Dec) notes: "There's no technical reason why a central database would be required. There could instead be multiple independent databases, which registrars and/or registries could query in parallel via a standardized API. There'd only need to be a central *list* of which TMCH providers needed to be queried. From a coding</p>	

	<p>how might those concerns be addressed?"</p>	<p>perspective, the registrar/registry could simply query the entire list of providers, and collate the results.</p> <p>Most registrars already have this technology/capability, as they often query multiple registries (and secondary marketplaces) in parallel when customers attempt a new domain name registration (e.g. customer searches for EXAMPLE.COM, but they'll query not only the Verisign-operated .com registry, but also .net/org/biz/info/us and hundreds of other TLDs, marketplaces like Sedo/Afternic, and they'll even generate and query variations of "EXAMPLE.TLD" for availability, presenting the customer with a list of hundreds of alternatives)."</p>	
<p>2. Are the costs and benefits of the TMCH, for rights holders, for ICANN, for the community, proportionate?</p>			