

Adobe Connect chat transcript for 08 February 2017:

Terri Agnew:Welcome to the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group on Wednesday, 08 February 2017 at 18:00 UTC for 60 minutes

Terri Agnew:agenda wiki page: https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_Q53DAw&d=DwlFaQ&c=FmY1u3PjP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmKXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=Wl6HIIDRgUTbbS1FAgk-6K7JyNiSrXBJrv1SeGlj7p4&s=SHlx7tui6WpaWADTn2cmYHV8hhINFKfjgpZu6M2CoKw&e=

Petter Rindforth:Hi, just a note that I have to be on another call at the same time, so I will only follow you/participate (mutely) online this time.

Terri Agnew:thank you for this information Petter

George Kirikos:Hi folks.

Maxim Alzoba (FAITID):Hello All

Philip Corwin:hello/dialing in now

Ivett Paulovics:Hi everyone!

Paul Tattersfield:Hi Everyone

GraceM:hey

Salvador Camacho:Hello everybody

Ankur Raheja:Hello

Martin Silva:Hi all

Steve Levy:Hello all!

George Kirikos:Perhaps Rebecca can email her statement to the mailing list.

Rebecca Tushnet:My comment--my apologies for having to leave so soon:

Rebecca Tushnet:the text symbols accepted into the TMCH and used to send notifications in case of matches, or used for Sunrise registration, should themselves be valid marks; if the symbols alone do not fully comprise a registered mark, the registration should not be accepted into the TMCH.]Special Trademark Issues Review TeamRecommendations, Rough consensus: The TC Database should be required to include nationally or multinationally registered "text mark" trademarks, from all jurisdictions, ... (The trademarks to be included in the TC are text marks because "design marks" provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.) Minority opinion of BC: did not like this overall provision because they wanted broader matching, but did not argue that text + design marks should be accepted as text entries in TMCH

Mary Wong:Thanks, Rebecca - staff will note your comment.

George Kirikos:Very fast typing! (or copy/paste) :-)

Rebecca Tushnet:That last bit was a quote from the recommendations; it is my belief that the current rules implemented by the TMCH are not consistent with this direction

Rebecca Tushnet:Sorry for going out of order!

Paul Keating:hi sorry for being late.

Mary Wong:@George, if you think Rebecca types quickly (she DOES!) you should see her live-blogging. It's awesome :)

George Kirikos::-)

George Kirikos:The middle column is new, I think.

J. Scott Evans:Yes, I had seen this last week.

Paul Tattersfield:It was in two? parts

Paul Tattersfield:it was available in parts earlier this week

Susan Payne:it does pull together information we have seen already, ie responses from Deloitte and responses from the Registries which we have discussed

George Kirikos:Right, first time consolidated like this before the "live" working group calls.

Maxim Alzoba (FAITID):I wonder, is the situation when TMDB does not allow Registries to connect due to technical issues is a part of RPMs (do mind mediocre response time of IBM service, few days without a meaningful response is expected)

J. Scott Evans:I still remain unconvinced that there needs to be any education on the Clearinghouse.

J. Scott Evans:In contrast, I think registrars should be educating their customers about Sunrise and Trademark Claims.

Mary Wong:Maybe one basic question is whether the TMCH should be educating other parties besides rights holders.

Kristine Dorrain - Amazon Registry Services:@Mary, for instance, what would they educate on?

Kristine Dorrain - Amazon Registry Services:They do educate THEIR users.

Mary Wong:@Kristine, right - it may make a difference whether we are talking about the existence and scope of the TMCH vs how Claims and Sunrise work.

Kristine Dorrain - Amazon Registry Services:and claims and sunrise are ICANN policies.

George Kirikos:If challenges to TMCH records are allowed, then it's prospective domain name registrants who would want to be educated (to be able to deny someone else a sunrise registration).

Susan Payne:I don't need to speak - completely agree with everything J.Scott has just said, which is what I was going to say

Paul Keating:I think what is included and how the inclusion decision is made IS an important aspect to openly disclose.

Kristine Dorrain - Amazon Registry Services:Paul, that information is readily available. Is it necessary to make that information super easily digestible for the average internet user? If you care enough about the detailed workings of the TMCH, you can find that.

J. Scott Evans:Are we sure they don't already? One of the big issues in educating users is to make sure there is not a glut of information.

J. Scott Evans:Too much information is just as confusing as no information.

Mary Wong:Note that what the TMCH is, what it does, and the Guidelines it uses for verification, are all available on the TMCH website and to some extent on the ICANN New gTLDs microsite.

Paul Keating:j. Scott, education does it only imply formal education. education occurs when information is disclosed, e.g. transparency.

Ivett Paulovics:I agree with Philip Corwin

J. Scott Evans:@Paul. What transparency are you wanting?

J. Scott Evans:If you get a Claims Notice for adobe.software, the claims notice tells you that Adobe is claiming trademark rights in Adobe.

J. Scott Evans:If I get adobe.software in a Sunrise Period, it is clear and transparent that I have registered my Adobe trademark registration in the Clearinghouse and that has been verified.

George Kirikos:Volume is a bit low for Kristine.

Kurt Pritz:One question on education: Should there be affirmative outreach to Trademark holders to make them aware of the TMCH, Sunrise and Claims? I.e., it is one matter for a trademark holder to decide to not participate in the TMCH;it is another matter that a trademark holder not participate because they are unaware of the TMCH one-stop shop.

Kristine Dorrain - Amazon Registry Services:Sorry George, will speak up next time.

Paul Keating:e.g list of registered marks having rights in sunrise. just the list would show the number of potentially expansive registrations such as "the" as noted earlier this week.

J. Scott Evans:Again, the free market allows for different versions of these things. Hence, it is up to registries and registrars to educate their consumers.

Paul McGrady:@Kristine - agree. There are lots of things people need to know to participate in commerce. I'm not sure how this is in ICANN's remit (or the remit of its contracted parties or vendors for that matter).

Marc Trachtenberg:+1 to J. Scott

J. Scott Evans:Paul. The Trademark Community will not agree to disclose that information. It is a trade secret.

Paul keating:@j Scott. neither of those have sufficient gross revenues to embark on education.

Paul keating:how is a list of sunrise qualified registered trademarks a trade secret?

George Kirikos:+1 Pauk Keating

Kurt Pritz:I think it is ICANN's remit to ensure Trademark holders are aware of the TMCH protections

J. Scott Evans:@Paul. How do you know what a registry or registrars revenues are? It seems to me that a service provider (who is smart) will want to ensure that their customers understand the system.

Kristine Dorrain - Amazon Registry Services:@ PaulK, gross revenues? Again, it's not global education. It's a registry/registrar providing customer service.

George Kirikos:Not a trade secret, when anyone can run a dictionary search to reverse engineer the entire list.

Paul keating:I work for them

J. Scott Evans:Agree with Kristine Dorrain.

Marc Trachtenberg:@ George - how could you run a dictionary search that would show what registrations are entered into the TMCH or registered in various jurisdictions?

Paul keating:@kristine. question is who is better positioned to educate. I say all should. you want only the entity with t)3 least interest and least amount of revenue per domain.

J. Scott Evans:@George. Yes it is. You do not know which of my 3,000 marks I have deemed important enough to put in the TMCH. THAT tidbit is simply a road map for abuse. We will not agree to that and we were VERY clear during the STI and IRT that this information should not be publicly available.

George Kirikos:@Marc: attempt to register tens of thousands of domain names (i.e. working through a "dictionary" -- e.g. a list of all USPTO marks, or some other list(s)), and see which generate notices.

Kristine Dorrain - Amazon Registry Services:@PaulK, as others have pointed out, the people with the direct relationship to their own customer should be educating their customer.

Paul McGrady:+1 Kristine.

Kristine Dorrain - Amazon Registry Services:TMCH=brand owners, RgY/Rgr=RgT

George Kirikos:@J.Scott: If I tried to register each of those 3,000 marks, and saw which ones generated TM claims notices, it would be easy to to know which were "deemed important enough to put in the TMCH"

Kurt Pritz:Why are we leaving education behind - it seems like we are right in the middle of discussion and at what point to we attempt to answer these questions and get them behind us?

Terri Agnew:as a reminder, to active your AC mic, top tool bar, select the telephone icon and follow the prompts

Paul keating:j. Scott, I still fail to see how the list is a trade secret. if you have sunrise rights how can that be abused? I want to know the nature of words that have been reserved exclusively for sunrise.

J. Scott Evans:@George. There is a difference btwn. handing someone a trade secret and a third party doing a work around or reverse engineering.

George Kirikos:"I tried to register each of these 3,000 marks" == "I tried to register them as domain names in new gTLDs".

Marie Pattullo:But that's not education about how the TMCH works George, that's education about Adobe's commercial choices. Not the same thing.

George Kirikos:@J.Scott: not a big one, when it can be automated at low cost (for someone who cared; I personally don't care to do it, but it wouldn't be hard).

Paul keating:the issue is finding abuse.

George Kirikos: Adobe doesn't seem to keep its TMs much of a secret, given they post the list on their website: https://urldefense.proofpoint.com/v2/url?u=http-3A_wwwimages.adobe.com_content_dam_acom_en_legal_licenses-2Dterms_pdf_adobe-5Ftrademark-5Fdatabase-5Fexternal.pdf&d=DwIFaQ&c=FmY1u3PjP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=Wl6HIIDRgUTbbS1FAgk-6K7JyNiSrXBJrv1SeGIj7p4&s=vjZsIR76XOM58Wc4-4jAKOhcutq3E7FJ2rhEK5plcLg&e=

George Kirikos: (although, that list isn't complete)

Paul McGrady: RE: "1 year from now", we are just applying ICANN calendar calculation rules, e.g. This is the first round of what is to be an ongoing process for the introduction of new TLDs = at least an 6 year gap. :)

Marie Pattullo: Agree with Susan.

Kristine Dorrain - Amazon Registry Services: I'm having a hard time connecting the chat discussion about making the list of marks in the TMCH available to anyone (apparently for the purpose of policing the entries for abuse (as subjectively determined by a 3P?)) with the discussion about education.

J. Scott Evans: Oh George. You are just missing my point. None of our trademarks are secret, by virtue of the fact they are trademarks. However, which of those marks publicly listed that are in the TMCH, is not a public record.

Marie Pattullo: And agree with Kristine too!

George Kirikos: @Susan: it's easy to infer their strategy, though. Not being in the TMCH doesn't act as some waiver of the TM owner's rights.

Paul Keating: @Mary Phil, per J. Scott suggestion pls ask Deloitte for list of all registrations in tmch with sunrise preference and which are dictionary terms.

Kurt Pritz: Is question #4 where we would discuss "proof of use" - its efficacy, importance, cost, benefits, etc?

J. Scott Evans: @Paul. Yes, but enforcing trademark rights is an expensive endeavor.

Susan Payne: @George of course not I did not suggest anything of the sort

George Kirikos: @PaulK: @Mary: plus all acronyms less than 5 characters.

Paul Keating: Deloitte should of course NOT identify the trademark owner. but should list if there are multiple entries for any given term.

Paul McGrady: @Paul K - none of the numbers in our social security numbers are secret, but I suspect we would all resist not only posting the individual numbers in order in the chat, but posting the individual numbers at all.

Paul Keating: @JScott, enforcing any right is expensive. missing a valuable generic/descriptive domain registration is also expensive.

Kathy Kleiman: ... and on the last call too, Phil.

Vinzenz Heussler: the link leading to the TMCH guidelines doesn't work

Kathy Kleiman: People seemed pretty satisfied.

Mary Wong: @Vincenz, we will check and fix the link, thank you for spotting it.

J. Scott Evans: @Paul. What makes you think you or anyone deserves to use a word it believes is generic and I have trademarked?

George Kirikos: https://urldefense.proofpoint.com/v2/url?u=http-3A__thettablog.blogspot.ca_2017_02_new-2Dpost-2Dregistration-2Dproof-2Dof-2Duse-2Drule.html&d=DwIFaQ&c=FmY1u3PjP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=Wl6HIIDRgUTbbS1FAgk-6K7JyNiSrXBJrv1SeGIj7p4&s=iW6-xeCm8MPJa22a0NSZ9VXXI0Y6VOrFa--SRZrkqYQ&e= "A register that does not accurately reflect marks in use in commerce in the United States for the goods/services identified in registrations imposes costs and burdens on the public."

Paul keating:@paul G, agreed but let's drop the trade secret label and agree that we can protect against inappropriate disclosure. the underlying issue is important.

George Kirikos:@JScott: That's like suggesting a TM provides a monopoly. No one needs to "deserve" it; they have a right to use terms in a non-infringing manner.

Marie Pattullo:And what happens if a string of letters is fanciful in language A, a trade mark in language B, and against public policy rules in language 3?

George Kirikos:+1 Kathy.

J. Scott Evans:George. A trademark is a monopoly. See McCarthy on Trademarks and Unfair Competition.

George Kirikos:lol I just said the word "Adobe", J. Scott. Are you saying I can't use that word now? :-)

Paul keating:@phil, there should be a mechanism set out, even if it is nothing but an agreement as to jurisdiction.

George Kirikos:I can say "Adobe products are great." Did you stop me from saying that? :-)

J. Scott Evans:@Kathy. Shouldn't we look at the TMCH website and see if this information is available and, if not, then asked the question.

George Kirikos:Or, I designed my house in the adobe style of Mexico.....

Kristine Dorrain - Amazon Registry Services:Here you go, Kathy...

https://urldefense.proofpoint.com/v2/url?u=http-3A_trademark-2Dclearinghouse.com_dispute&d=DwIFaQ&c=FmY1u3PJp6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAVSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=Wl6HIIDRgUTbbS1Fagk-6K7JyNiSrXBJrv1SeGij7p4&s=VZaLNs7LQSC8oDXx6eMvp3d3FtEUv_XlzJ8Qos2NpgY&e=

J. Scott Evans:George. You clearly do not understand trademark law.

Marie Pattullo:+ 1 to J.Scott...

George Kirikos:@JScott: I do, and also its limitations.

Kristine Dorrain - Amazon Registry Services:+1 J. Scott

Griffin Barnett:+1

Griffin Barnett:(to J. Scott)

Susan Payne:+1 J Scott

Kathy Kleiman:Tx Kristine; and fair enough J. Scott!

George Kirikos:Trademarks are not monopolies: https://urldefense.proofpoint.com/v2/url?u=https-3A_www.lexisnexis.com_legalnewsroom_intellectual-2Dproperty_b_copyright-2Dtrademark-2Dlaw-2Dblog_archive_2013_06_28_trademarks-2Dare-2Dnot-2Dmonopolies.aspx&d=DwIFaQ&c=FmY1u3PJp6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAVSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=Wl6HIIDRgUTbbS1Fagk-6K7JyNiSrXBJrv1SeGij7p4&s=8YD5t1HifTVQId3aH5ze8n3jYttaCHIhjk5z999bXs&e=

J. Scott Evans:George. A trademark is by its very essence a monopoly for the goods and services for which is registered.

Kathy Kleiman:@Mary: proposal again to clarify our question: relocate Category 1, Question, 1, Section iii to Category 2, Question 2. These are similar questions - challenges by TM owners and third parties.

George Kirikos:J. Scott: you're adding a limitation there, "for the goods and services for which it is registered".

Paul McGrady:@George K - I'm unaware of any house built out of domain names, so your example seems unrelated to the conversation.

Mary Wong:@George, I thought Kathy had wanted it moved to Cat 2 Q4 or 5, not Q2

George Kirikos:That's all I'm saying, that that limitation exists. One doesn't have a limitation over the use of the word itself. Scroll up.

George Kirikos:@Paul: I wan't talking about domain names, I was talking about the use of the word "adobe", which Adobe Corporation doesn't exclusively control in the English language.

Paul McGrady:@George K - oh, OK, but the rest of us are talking about domain names, not home construction.

George Kirikos:(i.e. they might have exclusive use of it in the realm of software, but not in the English language for non-infringing uses)

Paul keating:@phil, Deloitte should poll the various public registries to find if cancellation occurred.

Paul keating:@phil, API access is available.

George Kirikos:@Paul: I can certainly find a non-infringing use for Adobe.houses, etc., if you want to talk about domains. Why should Adobe Corp get first dibs on that?

Greg Shatan:Good point, Susan.

George Kirikos:+1 Kathy

J. Scott Evans:Correction: Cancelled registration. REDSKINS remains a valid common law mark.

Paul keating:@ Phil, cancellation includes failure to file section 8 with USPTO. they have a limited number of entries and know the jurisdiction of registration. they can easily verify.

Marc Trachtenberg:@Paul - you are kidding, right? First, there is not API access to every Trademark Office registry. Regardless, this is a gigantic burden on the TMCH and not possible from a practical perspective. It would also require the cooperation of the trademark offices

George Kirikos:REDSKINS is probably still a registered mark, outside the USA.

Paul McGrady:@George K - I am unaware of a <.houses> top level domain name

Paul keating:jscott, perhaps but no longer able to benefit from the TMCH process.

George Kirikos:Yep, Washington Redskins in Canada, TMA251755

Paul Tattersfield:.eco would be a better example that could coexist

George Kirikos:@PaulM: nitpicking typos. I meant ".house"

Paul keating:@mark, I'm not kidding. do you know the source registrations? confirmation is a simple process as it is an exact match and has reg number.

Kristine Dorrain - Amazon Registry Services:with a valid CA mark, then the redskins could keep their mark in the TMCH...not sure what the problem is. US TM DB is not conclusive.

Paul keating:certainly not more silly than domain registrants should conduct a trademark search before registration of a domain.

George Kirikos:"REDSKINS" in the Benelux and other countries, see TMView.

Terri Agnew:next call: Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group is scheduled for Wednesday, 15 February 2017 at 17:00 UTC for 60 minutes

Kathy Kleiman:I'll be in Iceland too

Terri Agnew:@Phil and Kathy apology is noted

Kathy Kleiman:The Slants

George Kirikos:An interesting case, for sure.

Paul keating:@phil, yes but raises the issue of a Tm being cancelled in one j but not others.

J. Scott Evans:adious

J. Scott Evans:ciao

J. Scott Evans:ciao

Maxim Alzoba (FAITID):bye all

Vaibhav Aggarwal, NCSG:Thanks Phil & kathy for leading this WG. It is wonderful to work with gr8 leadership

Paul keating:thank you all for the discussions.

Kathy Kleiman:Tx Phil!

Vaibhav Aggarwal, NCSG:BY Bye

Steve Levy:Ciao

Salvador Camacho:Bye!

Martin Silva:By all!

Paul Tattersfield:thanks bye all