REMAINING TMCH CHARTER QUESTIONS MATCHED WITH DOCUMENTATION FROM THE APPLICANT GUIDEBOOK AND OTHER MATERIALS DEVELOPED FOR THE 2012 NEW gTLD PROGRAM – CATEGORIES 4, 5 & 6
5 March 2017

CATEGORY 4 – COSTS & OTHER FUNDAMENTAL FEATURES

Charter Questions	STI Recommendations (approved by GNSO Council & ICANN Board)	Applicant Guidebook	Deloitte Guidelines/Other Materials Developed for the Program	WG Discussion to Date
12. Are there concerns about operational considerations (such as cost, reliability, global reach, service diversity and consistency) due to the TMCH Database being provided by a single Provider? If so, how may they be addressed?	2.1: Separation of Functions[1] Staff should have the discretion to determine whether the same provider could serve both functions, or whether two providers would be more appropriate. 2.4 Global Submission of Data[2] The TC should be able to accommodate submissions from all over the world. To accommodate this principle, the entry point for trademark holders to submit their data into the TC database could be regional entities or one entity (provided that can demonstrate it can accommodate language/currency/cultural issues globally). The system to be adopted by the TC Service Provider for	1.2 The Clearinghouse will be required to separate its two primary functions … Whether the same provider could serve both functions or whether two providers will be determined in the tender process. 1.3 The Registry shall only need to connect with one centralized database to obtain the information it needs to conduct its Sunrise or Trademark Claims Services regardless of the details of the Trademark Clearinghouse Service Provider's contract(s) with ICANN. 2.2 Public commentary has suggested that the best way to protect the integrity of the data and to avoid concerns that arise through		No follow up needed with Deloitte; WG to discuss further. WG to ask IBM if there are any cost, operational or technical concerns with the TM Database being maintained and serviced by one provider.

---

[1] This recommendation achieved Rough Consensus among the STI, with the ALAC filing a Minority Position.
[2] This recommendation achieved Unanimous Consensus among the STI.

	submissions from trademark holders should allow for different/local languages, with the exact implementation details to be left to Staff. 2.6 One Centralized Database[3] Registry should only need to connect with one centralized database to obtain the information it needs to conduct its sunrise processes or TM Claims Services (TM Claims), regardless of the details of the TC service provider and its contract(s) with ICANN. 3.1 ICANN Accreditation Agreement for Validation Services[4] The Service Provider(s) providing the validation of the trademarks submitted into the TC should adhere to rigorous standards and requirements that would be specified in an ICANN contractual agreement. The model to be suggested for this contractual relationship would be similar to the detailed registrar accreditation agreement, rather than the minimal accreditation practice adopted by ICANN for UDRP	sole-source providers would be to separate the functions of database administration and data authentication/validation. 2.3 Discretion will be used, balancing effectiveness, security and other important factors, to determine whether ICANN will contract with one or two entities - one to authenticate and validate, and the other to, administer in order to preserve integrity of the data. 2.4.2 [Providers] will be selected through an open and transparent process to ensure low costs and reliable, consistent service for all those utilizing the Clearinghouse services. 2.4.4 The contract shall include service level requirements, customer service availability (with the goal of seven days per week, 24 hours per day, 365 days per year), data escrow requirements, and equal access requirements for all persons and entities required to access the Trademark Clearinghouse database.		

---

[3] This recommendation achieved Unanimous Consensus among the STI.

[4] This recommendation achieved Rough Consensus among the STI, with the BC filing a Minority Position.

providers (e.g., WIPO, NAF, and others). 3.2 ICANN Agreement for Database Services[5] The TC Service Provider responsible for maintaining the centralized database should have formal, detailed contract with ICANN. The contract should include service level agreement metrics, customer service availability (seven days per week, 24 hours per day, 365 days per year), data escrow requirements, and equal access requirements for all persons and entities required to access the TC database. 10.1 Costs of Operating Clearinghouse[6] Costs should be completely borne by the parties utilizing the services. ICANN should not be expected to fund the costs of the operating the TC. The TC should not be expected to fund ICANN from its fees.	2.5 The Clearinghouse Service Provider(s) should utilize regional marks authentication service providers (whether directly or through sub- contractors) to take advantage of local experts who understand the nuances of the trademark in question. [Non-exhaustive examples are also listed of performance criteria and SLA requirements] 3.1 The trademark holder will submit to one entity – a single entity for entry will facilitate access to the entire Clearinghouse database. If regional entry points are used, ICANN will publish an information page describing how to locate regional submission points. Regardless of the entry point into the Clearinghouse, the authentication procedures established will be uniform. 8. Costs should be completely borne by the parties utilizing the services. Trademark holders will pay to register the Clearinghouse, and

---

[5] This recommendation achieved Rough Consensus among the STI, with the BC filing a Minority Position.
[6] This recommendation achieved Rough Consensus among the STI, with the RySG and NCSG jointly filing a Minority Position, and the BC filing a separate Minority Position.

		registries will pay for Trademark Claims and Sunrise services. Registrars and others who avail themselves of Clearinghouse services will pay the Clearinghouse directly.		
13. Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the community and ICANN?	No specific recommendation, though introductory comments to the report include the following: "The STI recognizes that a Trademark Clearinghouse could serve as a convenient location to store registered trademark information in a centralized location on behalf of trademark holders, and could create efficiencies for trademark owners, as well as registries which will benefit from having one centralized database from which to interact to obtain the necessary trademark information to support its pre-launch rights protections mechanisms. The Business Constituency has widespread concerns regarding the Trademark Clearinghouse as expressed in its minority statement [and] [o]ther minority opinions have been included … to address specific issues raised by the STI proposal."	No express provisions.		No follow up needed with Deloitte; WG to discuss further.

CATEGORY 5: ACCESS & ACCESSIBILITY

Charter Questions	STI Recommendations (approved by GNSO Council & ICANN Board)	Applicant Guidebook	Other Program Documentation	WG Discussion to Date
14. How accessible[7] is the TMCH Database and RPM Rights Protection Actions and Defenses to individuals, organizations and rights-holders; as well as trademark agents in developing countries?	No specific recommendation, although other recommendations contemplate submissions from all over the world, in multiple languages, and possibly capitalizing on regional entities with specialized knowledge.	No express provisions, although scope contemplates submissions from all over the world, in multiple languages, and possibly capitalizing on regional entities with specialized knowledge as well as the use of globally accessible and scalable systems so that multiple marks from multiple sources in multiple languages can be accommodated.		Deloitte's response on corporate headquarters confirms that while it may know where TM agents are located, it cannot know where the rights-holders who instructed those TM agents are located.

Are there other sources of information (besides Deloitte) that can be approached for more input on this question? |
| 15. What concerns are being raised about the TMCH Database being confidential, what are the reasons for having/keeping the | No specific recommendation. | 4.1 Consent by trademark owners to the use of their data in the TMCH will "extend only to use in connection with the stated purpose of the Trademark | **The TMCH Implementation Assistance Group (IAG) Report[8]:**
To minimize abuse, distribution of TMCH data should be limited to | No follow up needed with Deloitte; WG to discuss further. |

---

[7] This word is used in the sense of asking whether the TMCH (its existence, purposes and how it is to be used) is known to the types of stakeholders mentioned.

[8] See the September 2012 IAG report for the full context and discussion, especially pp.15-17 concerning data access: https://newgtlds.icann.org/en/about/trademark-clearinghouse/summary-iag-input-26sep12-en.pdf.

TMCH Database private, and should the TMCH Database remain confidential or become open?		Clearinghouse Database for Sunrise or Trademark Claims services. The reason for such a provision would be to presently prevent the Clearinghouse from using the data in other ways without permission." 4.3 Misuse of the data by the service providers would be grounds for immediate termination.	situations where necessary to implement TMCH functionality. It should also be justified by technical, performance, uptime, availability, and economic factors. At a minimum, there should be sufficient contractual restrictions to provide enforcement capabilities to guard against abuse of the access and information provided through the TMCH. Specifically, rights holders have expressed concerns related to the aggregation of mark data through the TMCH, which may expose their brand protection strategies or be used to gather competitive intelligence by competitors. If the TMCH database is freely searchable and accessible, it could be possible to identify a rights holder's gaps in its intellectual property protection strategies. For example, it might be possible to identify jurisdictions in which the rights holder has not registered its trademarks or in which it has not chosen	

			to defensively register domain names. In this regard, this information could be misused by criminals, such as to conduct phishing attacks or other types of social engineering attacks. In addition, concerns were raised with regard to limiting information submitted in the TMCH that may be valuable to a competitor, especially with regards to a brand-related registry. If it is possible to do extensive searching of the database to compile a list of marks that a mark holder has registered, some IAG members believed that this can reveal the mark holder's brand protection strategy because it shows which marks it believes are more valuable than others. If someone can access all of the countries where a specific brand is registered, this may also create competitive advantage because a competitor might go to the unprotected jurisdiction and register the mark before the mark holder.	

| | | | The TMCH should not allow extensive searching to be done in a manner where a trademark holder's entire portfolio could be easily accessed. Accordingly, the TMCH should be structured to address how to minimize data mining by a registry of a competitor's trademark registration patterns.

In order to minimize abuse, the TMCH should restrict access to the data wherever possible. The TMCH should apply varying levels of technological and contractual restrictions depending upon the type of data accessed and the sensitivity of the data.

With regard to data associated with the trademark claims service, it is believed that this information generally has more sensitive information, and may raise privacy concerns. From the registry or registrar perspective, there may be fewer performance requirements necessary for | |
|---|---|---|---|---|

| | | | querying trademarks claims data, because this information is not required to sustain real-time registrations.

Deloitte's Terms & Conditions for Validation: Deloitte represents and warrants that it "will not disclose or use any Trademark Record information for any purpose other than providing the services … or as required by law". | |

CATEGORY 6: BALANCE

Charter Questions	STI Recommendations (approved by GNSO Council & ICANN Board)	Applicant Guidebook	Other Program Documentation	WG Discussion
16. 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 rights of non-trademark registrants?	No specific recommendation, although the report noted that while the final proposal "does not reflect the opinion or approval, of any constituency or stakeholder group, it does reflect the informed effort of the diverse group of representatives".	No express provisions.		No follow up needed with Deloitte; WG to discuss further. Since the full scope of the question also includes the uses of the TMCH, the WG will return to this question after reviewing Sunrise and Claims.

| | | | | Staff to check if RySG input included the "specific implementation details" that they thought should be taken into account.

Staff Note: Yes, the RySG provided details. For the TMCH, these related to generic marks, lack of Service Level Agrements with the TMCH Providers, possible benefits f using multiple (rather than a single) Provider, and suggestions to obtain and publish statistics. All these have been previously added to the appropriate Charter question. |
|---|---|---|---|---|

GENERAL NOTE:

From the Applicant Guidebook –
1.5: [TMCH] functions will be performed in accordance with a limited charter, and will not have any discretionary powers other than what will be set out in the charter with respect to authentication and validation. The Clearinghouse administrator(s) cannot create policy. Before material changes are made to the Clearinghouse functions, they will be reviewed through the ICANN public participation model.