

**NEXT STEPS IN REVIEWING THE TMCH  
Draft Proposals (updated 28 March 2017)**

**CATEGORIES 3-6**

TMCH CHARTER QUESTIONS	CO-CHAIRS' PROPOSED NEXT STEPS	ADDITIONAL STAFF NOTES	WG DISCUSSION
<b>TMCH Category 3: Breadth &amp; Reach (Scope)</b>			
<p>7. How are design marks currently handled by the TMCH provider?</p>	<p>Still awaiting answers from Deloitte to the appendix examples in our follow-up question. Still a very active area of discussion.</p> <p><u>Recommend:</u> more discussion after response from Deloitte.</p>	<p>Deloitte presentation of updated data at ICANN58:</p> <ul style="list-style-type: none"> <li>• Verification focuses on words in a design mark, but not the design aspect – note example from TMCH Guidelines</li> <li>• Disclaimers to exclusive use of marks not factored in, verification process involves only matching factual data against corresponding trademark certificate - no legal opinion provided by TMCH on exclusive use</li> <li>• Verification of generic words also matched against corresponding trademark certificate</li> <li>• Noted that some jurisdictions do not distinguish between different types of marks (e.g. word vs figurative/design mark); no separate statistics on design marks per se</li> </ul>	
<p>8. How are geographical indications, protected designations of origin, and protected appellations of</p>	<p>Lots of discussion on this question, and we do have answer from Deloitte: they are accepting geographical indications from the EU (and elsewhere) and are not checking to</p>	<p>GNSO recommendations and AGB text allow for 3 different categories/types of submissions (reg'd TM, court-validated mark, statute/treaty-protected mark). Deloitte's TMCH Guidelines follow this categorization</p>	

<p>origin currently handled by the TMCH provider?</p>	<p>see if there is an associated trademark registration for them. This gathered from the USPTO, who made the effort to join us through the session and participate from the standing microphone. This is an area in which the Applicant Guidebook rules do not follow the rules passed by the GNSO Council and the Board.</p> <p><u>Recommend</u>: more discussion</p>	<p>and assume there is no need for a mark protected by statute/treaty to also be a reg'd TM.</p> <p><u>Question for the WG</u>: Did the GNSO's recommendations intend that "marks protected by statute or treaty" ALSO must be a registered trademark in at least one jurisdiction?</p>	
<p>9. Should the TM+50<sup>1</sup> be retained as is, amended or removed?</p>	<p>This one is not garnering discussion.</p> <p><u>Recommend</u>: close this question unless something new is raised.</p>	<p>Deloitte data demonstrated extent of use of this option to date and does not seem to indicate a demand for expansion; opening up the scope of registrations to an unlimited number of variations could decrease the accuracy and value of the TMCH</p>	
<p>10. Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?</p>	<p>This one did get discussion, on both sides, in Copenhagen and previously. It is also one that Analysis Group spent a good amount of time evaluating at the request of the GAC and it has a good discussion in the revised report.</p> <p><u>Recommend</u>: Hold until we bring the Analysis Group back to present -- and then finalize discussion.</p>	<p>Question raised as to whether trademarks are being adequately protection by only being entitled to safeguard exact matches; further question on how to develop rules and fee structure for protection of additional matches - e.g. "trademarks plus generic terms" (example apple plus computer), or "trademarks plus trademarks" (example: apple plus ipad)?</p>	

<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.

11. Should the scope of the <b>RPMs associated with the TMCH</b> be limited to apply only to <b>TLDs that are related to</b> the categories of goods and services in which the dictionary term(s) within a trademark are protected	Technically, we have heard it is difficult; but deep concerns raised in the recent EFF/Trademarks Scholars letter.  <u>Recommend</u> : more discussion	Concern noted over lack of differentiation leading to possible expansion of rights of TM holders; difficult to develop general policies for differentiation – may be possible only by developing specific rules for Sunrise and Claims in different types of gTLDs? (If so, return to this question when reviewing Sunrise/Claims)	
<b>TMCH Category 4: Costs &amp; Other Fundamental Features</b>			
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?	The only issue that came up was cost. No refutation of comment that evidence appears to show Deloitte has done a good job on operational matters.  <u>Recommend</u> : narrow this question to cost only.	Question whether cost, pricing and reliability issues are implementation rather than policy; potential problems (e.g. technical issues, inconsistent validation and service levels) noted with multiple providers; consider single back-end TMDB provider but using multiple front-end services to connect to centralized TMDB	
13. Are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the community and ICANN?	Similar to Question 16.  <u>Recommend</u> : Perhaps table this question and return to it at the end of the RPMs discussion.	Combining discussion of Questions 13 and 16, to be conducted following completion of Sunrise and Claims reviews, proposed at ICANN58	
<b>TMCH Category 5: Access &amp; Accessibility</b>			
14. How accessible <sup>2</sup> is the TMCH Database and RPM Rights	The push for knowing more about trademark agents and where the rights	Comment that low numbers may indicate low interest rather than low accessibility	

<sup>2</sup> 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.

<p>Protection Actions and Defenses to individuals, organizations and rights-holders; as well as trademark agents in developing countries?</p>	<p>holders are located seems to have subsided -- and Deloitte does not know where the rights-holders who use TM Agents are located.</p> <p><u>Recommend</u>: Shall we close this question?</p>		
<p>15. What concerns are being raised about the TMCH Database being confidential, what are the reasons for having/keeping the TMCH Database private, and should the TMCH Database remain confidential or become open?</p>	<p>This is a question that is the subject of debate. We can either have the debate now, or table it to be reviewed after the RPMs are reviewed -- to better understand the impact of the confidentiality on Sunrise, private lists, etc.</p> <p><u>Recommend</u>: either continue discussion or table and return to later</p>	<p>While general transparency and openness may be beneficial to good faith actors (e.g. informing them what TMCH registrations should be avoided ahead of receiving claims notices), several WG members described rights-holders' reasons for keeping the TMDB closed, including the risk of thereby disclosing commercially sensitive information such as TM value and brand strategies</p> <p>Note recent letter sent to WG co-chairs citing concerns with TMCH, sent by TM scholars and practitioners</p> <p>Any information made available should only be about the mark (publicly-available TM information) and not extend to TM user or account information</p> <p>Suggestion that If TMCH is to remain confidential, restrictions should be put in place on the TMCH provider being allowed to provide additional (ancillary) services</p>	
<p><b>TMCH Category 6: Balance</b></p>			

<p>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?</p>	<p><u>Recommend</u>: table this question to the end of the RPM mechanisms discussion.</p>	<p>WG had noted previously that it will be appropriate to return to this question following the Sunrise and Claims reviews.</p>	
--	---	---	--

**CATEGORIES ! & 2**

TMCH CHARTER QUESTIONS	STAFF NOTES	WG DISCUSSION
<b>Category 1: Education</b>		
<p>1. Is the TMCH clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about records in the TMCH?</p>	<p>Criteria are listed in TMCH Guidelines; note that having easily comprehensible and clearly accessible data on the TMCH available to the general public can be useful, so that registrants faced with a Claims Notice are better informed on how to react – different information needed for rights-holders who may use the TMCH, and for the general public (who may only need information about the Claims Notice and what it means)</p> <p><u>Question for the WG</u>: Based on Deloitte’s information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?</p>	
<p>2. Should the TMCH be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the TMCH is not to be responsible, who should be?</p>	<p>Some support for the “hybrid” model (ICANN to develop different sets of materials including for potential registrants and the general public, to be hosted by TMCH and possibly distributed by registrars) – can we close this question?</p>	

<p>3. What information on the following aspects of the operation of the TMCH is available and where can it be found?</p> <p>(a) TMCH services;</p> <p>(b) Contractual relationships between the TMCH providers and private parties; and</p> <p>(c) With whom does the TMCH share data and for what purposes?</p>	<p><u>Question for the WG:</u> Based on Deloitte’s information and materials to date, is there a need to develop additional policy recommendations on this topic (possibly aside from the question of Private Blocking Mechanisms, which is yet to be discussed)? Are there remaining concerns that can be addressed via implementation?</p>	
<p><b>Category 2: Verification &amp; Updating of TMCH Database</b></p>		
<p>4. Should the verification criteria used by the TMCH to determine if a submitted mark meets the eligibility and other requirements of the TMCH be clarified or amended? If so how?</p>	<p><u>Question for the WG:</u> Based on Deloitte’s information and materials to date, is there any need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?</p>	
<p>5. Should there be an additional or a different recourse mechanism to challenge rejected submissions for records in the TMCH?</p>	<p><u>Question for the WG:</u> Based on Deloitte’s information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?</p>	
<p>6. How quickly can and should a cancelled trademark be removed from the TMCH Database?</p>	<p>TMCH users contractually obliged to notify TMCH of cancellations; though no penalties are imposed for failure to notify, there is no evidence to date to indicate that this has been a problem (note that re-verification is done on an annual basis in any event, and that Sunrise and most Claims periods run for a very limited period)</p> <p><u>Question for the WG:</u> Based on Deloitte’s information and materials to date, is there a need to develop additional policy recommendations on this topic? Are there remaining concerns that can be addressed via implementation?</p>	