

Terri Agnew:Welcome to the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group on Wednesday, 12 April 2017 at 16:00 UTC for 90 minute duration

Terri Agnew:agenda wiki page: [https://urldefense.proofpoint.com/v2/url?u=https-3A\\_community.icann.org\\_x\\_E8zRAw&d=DwlFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpCigmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=e7ZLBbllokCsStKkwQyyQsgaNi3WbizucE4GMfu4F3Q&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_E8zRAw&d=DwlFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpCigmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=e7ZLBbllokCsStKkwQyyQsgaNi3WbizucE4GMfu4F3Q&e=)

George Kirikos:Hi folks.

George Kirikos:bbiab

Martin Silva:Hi all

George Kirikos>Welcome, Martin.

Paul Tattersfield:Hi everyone

Paul Tattersfield:On a mailing list matter before we get started: Would it be possible for the mailing list software to strip of the ATTnnnn.txt files as they don't seem to contain anything useful?

Paul Tattersfield:Seems to be just a bit of repeated text about the mailing list: gnso-rpm-wg mailing list - [gnso-rpm-wg@icann.org](mailto:gnso-rpm-wg@icann.org) - <https://mm.icann.org/mailman/listinfo/gnso-rpm-wg> etc

Paul Tattersfield:If the mailing list software could not add this text to out going emails this would be really helpful as it would make it much easier to spot emails with 'real document attachments'

Paul Tattersfield:Here is a link to the source of an example email [https://urldefense.proofpoint.com/v2/url?u=http-3A\\_www.gpm.info\\_msg.txt&d=DwlFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpCigmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=eviX77twWWJ55bbLJ\\_8xXWCYtwNgFiAINDX90sTrAFI&e=](https://urldefense.proofpoint.com/v2/url?u=http-3A_www.gpm.info_msg.txt&d=DwlFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpCigmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=eviX77twWWJ55bbLJ_8xXWCYtwNgFiAINDX90sTrAFI&e=) if you scroll to the bottom you can see where the problem text is added, which causes [some] email software packages treat as an attachment.

George Kirikos:There had been an .eml attachment forwarded today, too.

Paul Tattersfield:Yes I saw that George I think that is a certificate

George Kirikos:I don't know if ICANN is virus-scanning all the attachments.

George Kirikos:No, the .eml was someone forwarding an actual email.

George Kirikos:I opened it with a text editor, and then copied/pasted the BASE64 text to a website, to read it safely.

George Kirikos:But, the same email turned out to be within the body of the email that Brian sent. So, it was superfluous.

Paul Tattersfield:ah sorry I was thinking of the .p7s that came today too

Philip Corwin:Hello all. We will start in one minute.

Marie Pattullo:Bless you, Phil :-).

Steve Levy:G'day all

Michael R Graham:Attending without audio for a few minutes.

Maxim Alzoba (FAITID):Hello All

Steve Levy:Thank you for reminding us of these critical core principles, Phil. If we cannot achieve consensus on any issues, all of the hours and energy we've spent on this WG will be for naught

Mary Wong:@Phil, yes - please accept our apologies for mistakenly including Question 15 on this agenda and in this document.

George Kirikos:Has Deloitte provided answers to any of the data requests yet?

Mary Wong:@George, we have no further input from Deloitte at this time. Which specific data points were you interested in?

George Kirikos:(e.g. top 500, also how they handle all those marks, e.g. CARS, etc.)

George Kirikos:(the 5 or 6 examples of figurative/stylized marks that Rebecca prepared)

Mary Wong:THanks, George. We have followed up with them and hope to receive some feedback ASAP.

Mary Wong:@Kathy, yes

Mary Wong:We've asked.

George Kirikos:Only standard character claim word marks, yes.

George Kirikos:Proposals only for Q7,8 and 10, though.

Michael R Graham:Do we have a description from TMCH provider answering the charter question?

Mary Wong:@Michael, do you mean these questions? If so, Deloitte has descibed how they deal witht these types of marks when submitted.

J. Scott Evans:I believe that all proposals would be presented equally.

Steve Levy:Perhaps we need a sub-team to try and harmonize the various proposals on a given topic (similar to how it's handled by legislators)?

Michael R Graham:@Mary -- Yes. And thanks. I'll look back in the record for the answer.

J. Scott Evans:The question, however, has been answered by Deloitte.

Greg Shatan:it's a fact question.

Greg Shatan:!"

George Kirikos:Yes, 7 and 8 are fact questions.

George Kirikos:10 is more open ended.

George Kirikos:"Should"

bradley silver:+1 @J. Scott

Lori Schulman:Agree with J Scott. A deadline is more fair I think.

Paul McGrady>Hello all. Sorry to be late.

Lori Schulman:We should field all proposals.

Colin O'Brien:All proposals would be better

Paul McGrady:+1 Lori

George Kirikos:I'd like to see all the Deloitte results, to be able to identify problems, before presenting proposed solutions.

Greg Shatan:George, I agree with your reading of the questions.

Kathy Kleiman:+1 J. Scott - Council was quite upset

Georges Nahitchevansky:I agree all proposals shoud be considered at the same time and that we should have teh Deloitte info before proceeding

George Kirikos:@Greg: I agree with your agreement. :-)

J. Scott Evans:agreed.

J. Scott Evans:with Mary

Michael R Graham:Agree with George/Greg/Mary. Very agreeable this morning.

J. Scott Evans:It also needs to be clearly labelled as a proposal for consideration.

Lori Schulman:Yes, all proposals should be marked as proposals and reviewed at once so as to not unduly favor one over the other

Lori Schulman:Although we may all be coming from different viewpoints, we need to be objective and methodically in how we manage proposals and answers to questions that are provided to the group by 3rd parties

Michael R Graham:@Mary: Without looking -- I understand Charter calls for review, identification of issues, and proposals for change consideration. Does Charter also give us the task of proposing specific changes?

George Kirikos:For #10, I've been in favour of allowing "Fuzzy" matching for the ongoing notifications, instead of fees for every variation as per <https://urldefense.proofpoint.com/v2/url?u=http-3A-www.trademark-2Dclearinghouse.com-content-ongoing-2Dnotifications&d=DwIFaQ&c=FmY1u3PJp6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClg>

[mkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk BLj09acfAyTBXXVmW un6ywxjhr4&s=HriQl0AtqhneOCX78ArvY9FhdMtG1Yj49SqcFJNGU4Y&e=](https://www.icann.org/pipermail/gnso-rpm-wg/2017-April/001320.html) . But, not for TM Claims Notices or for Sunrises.

Paul Tattersfield:Agree we should Phil

Mary Wong:@Michael, generally yes as long as the specific policy recommendations don't wander too much into implementation details. For example, a policy recommendation could say "a reasonable time frame" and then it will be for the Implementation Review Team (if the policy is adopted) to work out, operationally and technically, what that time period will be. Does that help?

George Kirikos:Checkmark to agree, hand to queue.

Paul McGrady:Why not do a green check mark instead of raising hands

Michael R Graham:Set deadline for all proposals -- only then discuss towards decision.

Michael R Graham:Paul +1

Lori Schulman:Yes, we should use red and green symbols as provided by Adobe chat

Georges Nahitchevansky:Agree should vote agree or disagree with red and green symbols

George Kirikos:Here's Kathy's proposal, for easy reading outside Adobe:

<http://mm.icann.org/pipermail/gnso-rpm-wg/2017-April/001320.html>

Paul McGrady:@Phil - when will the other positions to Kathy's be available?

Michael R Graham:@Mary -- Okay, so directing specific changes of policy practices are part of Charter. Implementation of policy practice change not part.

Lori Schulman:Yes, clarification on scope is key

Georges Nahitchevansky:Discussing one proposal before seeing the other proposals colors the entire process and starts an initial mental framework, so I urge that a date be set as has been suggested and then all proposals considered

Greg Shatan:Agree with Georges.

Paul McGrady:@Phil - hard to vote without information - when will the other positions to Kathy's be available

Mary Wong:@Paul, the suggested deadline is 7 days from now (19 April)

George Kirikos:We can jump to #3 on our agenda, perhaps?

Paul Tattersfield:I think it would be a helpful guide for others looking to submit a proposal

George Kirikos:CCT-RT

Michael R Graham:Proposal: Hold off discussion of any proposal until after receipt of all proposals with deadline.

Mary Wong:From a quick count, looks almost even on the vote

Mary Wong:Sorry, NOT vote - straw poll!

John McElwaine:@Greg +1

George Kirikos:Let's go for sound marks. :-)

Mary Wong:Staff supports a consistent usage that the Working Group can define or clearly explain, without only relying on one jurisdictional definition.

George Kirikos:\*6 to mute

Lori Schulman:There is no consensus to entertain proposal.

George Kirikos:"private chat is disabled by host"??

George Kirikos:(couldn't reply to a private message)

Kathy Kleiman: In that case, let's use this time on Statute and Treaty marks as well.

Kathy Kleiman:as well.

Mary Wong:@George, that's happened before - normally logging off and on fixes that.

Greg Shatan:I'm on tablet, so when I stop talking it echoes until I turn off the microphone.

Paul Tattersfield:Kathy +1

Paul McGrady:@Kathy, Statute and Treaty marks bleeds into the next question and I don't think it is good to spring that one us.

Paul Keating:Sorry for being late

George Kirikos:Right, the IGO Article 6ter stuff, for example.

David McAuley:also sorry for being late

Kathy Kleiman:We've been in the murky waters!

Colin O'Brien:+1 Paul

Lori Schulman:I think that discussing GI's should have Massimo Vittori on the call.

Kathy Kleiman:Qusetions 7 and 8 are before us!

Lori Schulman:He is part of the working group I believe.

Greg Shatan:Digital archery practice?

Marie Pattullo:+1 to Lori

Greg Shatan:(as a use of our time).

Paul McGrady:@Phil - thanks.

Mary Wong:All, please note that Deloitte has told us how they handle non-word marks (Q7) and "marks protected by statute or treaty" (which may cover Q8). The staff question for the WG after Copenhagen had been, what is the policy intent for the TMCH scope and does what is being accepted now into the TMCH go beyond that? We understood Phil's proposal was to discuss this.

Martin Silva:This is very usefull, since different jurisdiction have different ways of adrassing this

Martin Silva:for what I know, desing marks in the civil law tradition countries are usually called mixed marks

Martin Silva:which are text marks that are represented in an specific figurative way (form+color)

Martin Silva:and are only protected in those desings

Martin Silva:correct me if anyone knows better

Michael R Graham:@Mary: With apologies for being late to the "party" -- can you point me to materials/transcript where Deloitte describes their handling?

Paul McGrady:I would like to speak to the economic efficiency of design marks and the need not to presume that the text portion of a design mark is always indistinct (to the exclusion of smaller businesses).

George Kirikos:I read an article yesterday about China becoming the dominant jurisdiction for IP soon. It'd be interesting to get their perspective, given they accounted for more than 50% of new gTLD registrations.

Michael R Graham:@Martin -- Word and alphanumeric figures contained in mixed marks are also granted protection beyond the stylization unless "disclaimed"

Lori Schulman:Martin: the answer to you questions is "it depends". The words and the stylization are protected.

George Kirikos:<https://techcrunch.com/2017/04/11/the-surprising-rise-of-china-as-ip-powerhouse/>

Lori Schulman:Marks are always looked at on the whole. However some elements dominate others.

Mary Wong:@Michael, I will need to look up the dates of the meetings but will do so.

Mary Wong:Deloitte's TMCH Guidelines describe how they handle marks that are not exclusively comprised of letters, numerals or words.

Paul McGrady:+1 Greg - would be good to develop a definitions list to harmonize all the ways that various trademark offices refer to design marks

Martin Silva:so if I register "Martinish" in a certain font and in red I can exclude other to use "Martinish" regarldes of the desing they are using?

Michael R Graham:@Paul Please do address this point. Most small businesses that develop a logo with words in the US are counseled that registraiton of a design mark/logo containing the words will protect

both the Design Mark and the Words. If the words are not STRONG trademarks on their own, they receive proportional protection.

Paul McGrady:@Phil - the mark may be older

Lori Schulman:Martin, in the US you can.

Martin Silva:@graham

Lori Schulman:as long as Martinish doesn't have any other meaning

Vinzenz Heussler:I may be able to protect a stylised mark but not the letters on its own

Martin Silva:thkns Lori

J. Scott Evans:adias is a bad example. this is usually a problem from small to medium enterprises.

Lori Schulman:or I should says as long as Martinish is distinctive on its own

Paul McGrady:@Phil - the mark may be older

Lori Schulman:if Martinish is a common term that describes your goods or services that is a different story

Rebecca L Tushnet:Are there a lot more small businesses in the TMCH than big ones?

Marina Lewis:@Phil - a lot of brand owners, especially small businesses or individuals, can only budget for one application - and they choose the design form to try to protect both words and design.

George Kirikos:But, the "standard character claim" would be marked "yes" for those, right?

Michael R Graham:@Marina -- Exactly.

Lori Schulman:Even big trademark owners may opt to register distinctive words with designs if they are registering in mutliple jurisdictions or multiple classes to reduce cost

Marina Lewis:@Rebecca - the TMCH was designed to protect all businesses, not just large ones.

Mary Wong:@Rebecca, there is no way to tell even if you saw all the TM records in the TMCH.

Marina Lewis:@Rebecca - not sure why that question is relevant?

Greg Shatan:I have certainly put smaller clients' marks in the TMCH.

Greg Shatan:Not that the question is relevant....

Greg Shatan:But nothing wrong with being informative.

Lori Schulman:I represented a small business that had several TMCH filings

Lori Schulman:Charities also use the TMCH

Lori Schulman:it depends on the reach of the market and the challenge a particular business or charity has with squatting

Michael R Graham:@Rebecca: Would it matter whether there were more small businesses or large in the TMCH? Across the board, smaller businesses that wish to protect their trademarks have a higher proportional cost than large companies. But consumers need to be protected regardless.

Mary Wong:Is there agreement that a mark comprised of text (words, letters, numerals, punctuation, keyboard signs) may be a mark, but is not a "design mark" even if it is a stylized version of the word?

Paul McGrady:+1 J Scott. We need to have clear definitions.

Michael R Graham:@Mary: I would agree with you. My practice is even to refer to them as "WORD and Design" marks.

George Kirikos:We want to protect the Stronger marks. But, we don't have a clear definition of "strong" marks (and some want to squeak weak marks into the database).

Marie Pattullo:Thanks for this Michael - "Across the board, smaller businesses that wish to protect their trademarks have a higher proportional cost than large companies. But consumers need to be protected regardless". + as many 1s as permitted.

Martin Silva:I think we deffintly need deloiite deffinition on this, we can't really discuss if each one has a different understanding. I donOt care which is the meaanaing as log as we all know what it is.

Michael R Graham:@Martin -- +1

Martin Silva:is not bad faith

Martin Silva:on the contrary, I am traying to build good faith!

Paul McGrady:"Stylized" is being conflated with "Design" Its not the same

Kathy Kleiman:Tx you, J. Scott. History and background are important.

Lori Schulman:Correct Phil. Words are protected.

Marina Lewis:+1 Paul

Monica Mitchell:sorry

Terri Agnew:@Monica, I don't see your mic active or on the telephone

Mary Wong:@Paul, yes, it is not the same thing as we (staff) understood this discussion. A stylized word is still a text mark - I think that's what Deloitte goes by as well. By "design mark" they/we mean devices and logos and the like (not stylized text).

Terri Agnew:to activate your mic, top tool bar select the telephone icon and follow the prompts. To join on the telephone let me know if a dial out is needed

Monica Mitchell:just found the answer ... sorry

Amr Elsadr:@Martin: Deloitte's TMCH Guidelines can be found here:

[https://urldefense.proofpoint.com/v2/url?u=http-3A\\_www.trademark-2Dclearinghouse.com\\_sites\\_default\\_files\\_files\\_downloads\\_TMCH-2520guidelines-2520v1.0-2520-5F1.pdf&d=DwIFaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=L03PIKl0v4RIDkfiHtVioSvnyGThtArdMePuLxSzamc&e=](https://urldefense.proofpoint.com/v2/url?u=http-3A_www.trademark-2Dclearinghouse.com_sites_default_files_files_downloads_TMCH-2520guidelines-2520v1.0-2520-5F1.pdf&d=DwIFaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=L03PIKl0v4RIDkfiHtVioSvnyGThtArdMePuLxSzamc&e=)

Susan Payne:apologies for joining late - overrunning prior meeting

Michael R Graham:One of the most important things the Policy & Implementation Working Group did to aid its deliberations -- and it carried through to our proposals -- was to identify TERMS we were using in our discussion and the develop and agree to specific DEFINITIONS that we stuck to in our discussions and proposals.

George Kirikos:<https://www.uspto.gov/trademarks-getting-started/trademark-basics/representation-mark>

Michael R Graham:Can I propose that we establish a continuing working team to do that for this PDP going forward?

Marie Pattullo:Fully support Paul's comments re SMEs.

Martin Silva:thnks Amr

Martin Silva:!

Kristine Dorrain - Amazon Registry Services:Lots of active participation this week. I have to drop for a conflict but will pick up on the rest of the call later. See you all next week.

Mary Wong:The TMCH Guidelines specifically address the topic of a mark that is not entirely text. Deloitte's rule is that it is considered identical to the TM record if the words/numerals/letters/signs are predominant in the mark AND are clearly separable and distinguishable from the design element.

Martin Silva:doesn't that gives too much power to deloitte?

Greg Shatan:Thanks, Mary. That seems appropriate.

Georges Nahitchevansky:Here is USPTO link on standard, stylized and design marks:

[https://urldefense.proofpoint.com/v2/url?u=https-3A\\_www.uspto.gov\\_trademarks-2Dgetting-2Dstarted\\_trademark-2Dbasics\\_representation-2Dmark&d=DwIFaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=-Di6r8jig1apTU-VL70XJqzNWmaKog0cyWoLCgw37Lw&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_www.uspto.gov_trademarks-2Dgetting-2Dstarted_trademark-2Dbasics_representation-2Dmark&d=DwIFaQ&c=FmY1u3PjP6wrcrwlI3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0AIGN-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=-Di6r8jig1apTU-VL70XJqzNWmaKog0cyWoLCgw37Lw&e=)

Martin Silva:it might create broader domain name protectio that ana trademark gives

J. Scott Evans:Agree Paul.

Paul Keating:That exact problem arises often in a UDRP context.

Lori Schulman:Martin: It shouldn't.

Susan Payne: There has also been at least one UK TM decision which said you must register in the form that you use - ie not as plain text. Further, the advice I routinely received from Chinese TM attorneys is that this is a requirement in China. So we must acknowledge the fact that not every country's law and practice is the same as that of the US. Something which is perpetually forgotten in ICANN land

Greg Shatan: Martin, I think that treatment is consistent with the current state of TM protection. (Putting aside the disclaimer issue.)

Lori Schulman: In a UDRP, the panelist will review the TM registration or the common law claim and make a determination based on the totality of the circumstances

Kathy Kleiman: With great respect, I don't agree Paul.

George Kirikos: TMCH costs \$120/yr. Over 10 years, that's \$1200. So, it's NOT small businesses signing up for the TMCH, given they paid less than that at the USPTO.

Michael R Graham: @Mary -- Useful, but the wording "if the words/numerals/letters/signs are predominant in the mark AND are clearly separable and distinguishable from the design element." needs to be clarified I think.

Marina Lewis: I think the key point is whether a trademark includes "literal elements", regardless of font, stylization, color, or additional design. ("Literal elements" is the term employed by the USPTO in this context.) Since the TMCH is designed to match to a literal element, this would seem to be where I focus should lie.

Kathy Kleiman: Small businesses, and especially entrepreneurs, will be hurt.

Lori Schulman: Excellent Points from Susan Payne.

Greg Shatan: With great respect, I agree with Paul.

George Kirikos: USPTO TM Fees: [https://urldefense.proofpoint.com/v2/url?u=https-3A\\_www.uspto.gov\\_learning-2Dand-2Dresources\\_fees-2Dand-2Dpayment\\_uspto-2Dfee-2Dschedule-23Trademark&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLi09acfAyTBXXVmW\\_un6ywxjhr4&s=SrXvKJ\\_c6ROp4rH4-yjojeN1hxZIQPHpplvkAUx6j4I&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_www.uspto.gov_learning-2Dand-2Dresources_fees-2Dand-2Dpayment_uspto-2Dfee-2Dschedule-23Trademark&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk_BLi09acfAyTBXXVmW_un6ywxjhr4&s=SrXvKJ_c6ROp4rH4-yjojeN1hxZIQPHpplvkAUx6j4I&e=) Fees

Mary Wong: Thanks for reading that into the record, Phil. Staff hopes that's a helpful guide to this discussion.

Michael R Graham: @Phil/Mary -- Problem for me is what is "predominant"?

Steve Levy: Sorry but I've got to jump onto the audio-only line for the remainder of this call

Paul McGrady: @Michael G - agree - sounds like Deloitte is re-examining marks. Yikes

Michael R Graham: @Marina -- Good point. Would be useful to check INTA or other Global Rules listings to see what variants there may be.

Greg Shatan: There are a vast number of USPTO TM registrations owned by SMBs and individuals.

Greg Shatan: Yes, "predominant" could be a fuzzy concept.

Mary Wong: @Michael, if it helps, Deloitte has a Dispute Resolution Process where incorrect acceptances into the TMCH can be challenged: [https://urldefense.proofpoint.com/v2/url?u=http-3A\\_www.trademark-2Dclearinghouse.com\\_dispute&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLi09acfAyTBXXVmW\\_un6ywxjhr4&s=SHzgbgUvCEUwXsHtiBlv815XK16Xd9v2QSsxf6vuSDg&e=](https://urldefense.proofpoint.com/v2/url?u=http-3A_www.trademark-2Dclearinghouse.com_dispute&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk_BLi09acfAyTBXXVmW_un6ywxjhr4&s=SHzgbgUvCEUwXsHtiBlv815XK16Xd9v2QSsxf6vuSDg&e=)

Michael R Graham: @Paul -- That's my concern as well -- my understanding is that Deloitte wanted rules that avoided it examining these.

J. Scott Evans: Have we asked Deloitte if any challenges have been filed? And, if so, how many?

Martin Silva: 4.2 in the Deloitte Guidelines

Mary Wong:@J Scott, if I recall correctly, Deloitte's written response to the WG's initial questions was no. As of Jan 2017, the only disputes they had received was about TM owners not agreeing with Deloitte's verification.

Michael R Graham:@Mary -- I presume our goal in this regard would be to ensure that challenges are the exception since the rules are appropriate to "real world" practice.

J. Scott Evans:Kathy. You need to review Susan Payne's email.

J. Scott Evans:Kathy. That is a huge assumption.

Paul McGrady:@Kathy - we do a lot of pro bono work for non-profits and small entrepreneurs who will not be able to get coverage for their designs if they have to choose to spend their money on text alone marks in order to be allowed to participate in ICANN

J. Scott Evans:I practiced for 13 years and routinely advised clients that were cost-conscious to file one application for a design or composite mark.

Greg Shatan:I'm with J Scott. That is not the advice that I have learned to give in 30 years of trademark practice.

Mary Wong:So it seems that 2 basic questions for the Working Group are: (1) is a mark comprised entirely of stylized text considered a word mark? (2) does the concept of "word mark only" exclude all marks that are device/logo plus text (even where the text part is disclaimed)?

George Kirikos:You can pick "Clear Status" to remove the hand/checkmark.

Maxim Alzoba (FAITID):colours ... are used sometimes (in case of Russia, few Telcos from one holding registered same image with different colours as different trademarks, for example), but I wonder how it should be reflected in TMCH ?

Paul McGrady:@Rebecca - the same thing was happening to me. I think we have to "clear status" first to get rid of the green checkmark and then the hand being raised will work

John McElwaine:Many countries apparently require "a depiction" of the mark with no distinction between text, stylization or included designs. I repeat that we are being too U.S. centric in this analysis.

George Kirikos:+1 Rebecca

Martin Silva:exactly!

J. Scott Evans:@rebecca. that is not true. You are misstating the law in the US at least.

George Kirikos:This is basic stuff.

Maxim Alzoba (FAITID):how to reflect RGB palette in TMCH?

Martin Silva:+1

Maxim Alzoba (FAITID):to properly reflect the colour?

Michael R Graham:@Rebecca -- Please provide cases supporting "weaker" protection statement for stylized word registered marks. I'll take a look for protection of both in the US.

George Kirikos:@Maxim: combine it with the TLD, e.g. mark.red, mark.black, etc. :-)

Mary Wong:What if the registered trademark is "logo plus word" and the word is not disclaimed, i.e. it is protected as part of the whole mark? Should that be accepted or rejected by the TMCH?

Georges Nahitchevansky:Rebecca you are wrong on the scope of protection afforded in the US on stylized marks

J. Scott Evans:@rebecca. Second, also. The same argument can be made to small or medium enterprises or civil libertarians. Go get a cheap trademark and register it in the clearinghouse.

George Kirikos:(Afilias has a bunch of colour TLDs)

John McElwaine:@mary good point

Greg Shatan:Rebecca, that's wrong about PARENTS unless the word has been disclaimed (which in that case, it was).'

J. Scott Evans:Trademarks are communicated by word of mouth. So, sound alike is very important -- even in design marks and stylized marks.



Maxim Alzoba (FAITID):@George ... the worst thing is green ... most browsers use green when proper TLS, SSL used .. so all owners of proper certificates will be violate it ... :)

Maxim Alzoba (FAITID):\*worst

Michael R Graham:@Phil -- Good point as to different jurisdictional practices.

Paul McGrady:@Rebecca - I didn't understand your comment about needing to file all over the world. Even filing in 1 jurisdiction for multiple marks can be daunting to a small business or non-profit

Kathy Kleiman:@Phil, we have seen no examples of this issue. It would be good to do so.

George Kirikos:Otherwise, there's massive jurisdiction shopping.

Maxim Alzoba (FAITID):@George +1 ...

George Kirikos:Google with their Tonga TM, to get priority date for "Alphabet", so even the big companies do it.

Rebecca L Tushnet:PARENTS--the word was not in fact disclaimed.

George Kirikos:(Instafire jurisdictions)

Rebecca L Tushnet:Because disclaimer is optional.

J. Scott Evans:@Rebecca. I agree with your earlier comment that disclaimer practice is inconsistent. Sometimes it is optional, but not always. Making an absolute statement is incorrect.

Maxim Alzoba (FAITID):@Mary Is it possible not to use small size of the chat history?

Paul Tattersfield:Given domains are worldwide should there be a requirement for TM registrations in a minimum number of different jurisdictions to gain entry into the TMCH?

Rebecca L Tushnet:In re National Data Corp. United States Court of Appeals, Federal Circuit. January 30, 1985 753 F.2d 1056 The absence of a disclaimer does not, however, mean that a word or phrase in a registration is, or has become, distinctive in the registered mark, so that that part of the mark must be treated the same as an arbitrary feature. The power of the PTO to accept or require disclaimers is discretionary under the statute, supra note 5, and its practice over the years has been far from consistent.

Michael R Graham:Words subject to disclaimer in Stylized or Design marks should not be registrable in TMCH -- Agree.

Marina Lewis:@Rebecca - I don't understand your comments on disclaimers being optional. Yes, an applicant has the option of proactively entering a disclaimer before being required to do so during examination - but once an Examining Attorney refuses registration unless a term is disclaimed, that would seem to eliminate the "optional" aspect of disclaimer practice. Can you please clarify?

George Kirikos:Cross-talk.

Terri Agnew:finding the line

Rebecca L Tushnet:Optional for the PTO, you're right, not for the registrant when demanded by the PTO if not argued out of it.

J. Scott Evans:I don't see why we talking about disclaimers since the EUTM doesn't use them and many other jurisdictions do not.

Mary Wong:Again, if staff may summarize, perhaps where there IS a disclaimer for the text part of a device mark then that text/word shouldn't go into the TMCH (per Susan Payne), but we cannot draw the same conclusion the other way when there is no disclaimer?

George Kirikos:Perhaps instead of a black/white binary 0-1, there needs to be a scoring system from 0-100, e.g. 100 equals Verizon, Exxon, 0 = figurative mark for "CARS", and develop a points system.

George Kirikos:Kind of like the Canadian immigration points system. :-)

Lori Schulman:How do you make the "score" objective?

Michael R Graham:@Mary -- I would agree with your distinction.

George Kirikos:(or the points system for Community Applications for new gTLDs, as a precedent)

Maxim Alzoba (FAITID):fruit companies might object

George Kirikos:@Lori: right, it'd be a tough job, but avoid the "binary" choices.

George Kirikos:Just thinking out loud, outside the box.

Lori Schulman:that seems like re-examination to me but I get your point George.

Maxim Alzoba (FAITID):unfortunately community evaluation failed ... only rich communities prevailed :)

Paul Tattersfield:only a re-examination in some jurisdictions

George Kirikos:It'd need to be mechanical, some robotic algorithm. (that would also lower the cost).  
Feed it into an AI system. :-)

Greg Shatan:A valid mark is a valid mark, so strength is not particularly germane in our discussions.

Lori Schulman:+1 Greg

Marina Lewis:+1 Greg

Mary Wong:Public comments to the CCT Review Team Draft Report closes on 27 April:

[https://urldefense.proofpoint.com/v2/url?u=https-3A\\_www.icann.org\\_public-2Dcomments\\_cct-2Drt-2Ddraft-2Dreport-2D2017-2D03-2D07-2Den&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=Z3SGcjmQeXCcjlUa5nlqx78HFdxWLxx9sqrbQYysyQ&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_www.icann.org_public-2Dcomments_cct-2Drt-2Ddraft-2Dreport-2D2017-2D03-2D07-2Den&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=Z3SGcjmQeXCcjlUa5nlqx78HFdxWLxx9sqrbQYysyQ&e=)

Paul McGrady:Thanks Phil!

Lori Schulman:Yes, INTA has completed the study and is compiling the data now.

George Kirikos:For CCT-RT #10, a simple/obvious solution would be to charge less (say 50% off registry fees) if the domain name is registered, but has no nameservers. Defensive domains could then be removed from the zone file, not resolving. This should apply to all (including .com, legacy TLDs).

Mary Wong:Column 1 is the recommendation, Column 2 the rationale provided by the CCT-RT

George Kirikos:But, not just for "large brandowners" -- do it for everyone.

George Kirikos:But, if the name resolves (e.g. wwwbrand.com redirects to [www.brand.com](http://www.brand.com)), that is in the zone file, and would be charged a normal price.

George Kirikos:(its defensive, but delivering value to the owner)

Mary Wong:So next WG meeting will be 26 April; no meeting on 19 April

J. Scott Evans:I am going to need to jump soon. Thanks to everyone for their great participation today.

George Kirikos:If we can get Deloitte's answers before the 19th, it'll inform our proposals.

Marie Pattullo:Would still advocate any proposal being sent to the full list, please.

George Kirikos:Not sure what to propose, until seeing that.

J. Scott Evans:@Paul. We have co-chairs call on 4/21 and that should result in an agenda for the WG by the end of that day for our 4/26 call.

Amr Elsadr:UTC 14:00 for sunrise and UTC 16:00 for claims.

Greg Shatan:Do we have lists of who is in both sub teams (or all 3)?

Paul McGrady:Could we all get calendar invites for all of these subgroups? It would be good to know who is meeting when.

Amr Elsadr:@Greg: yes, they've been posted on the wiki pages for the Sub Teams. Please check the 3 pages. Links coming up.

Mary Wong:Thursday 27 April 0300 UTC (Weds night for North America)

Amr Elsadr:Members of Sunrise ST: [https://urldefense.proofpoint.com/v2/url?u=https-3A\\_community.icann.org\\_x\\_nMrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=L9vPjMKkLkI0Uhu9qQjMYRgG0BFuenqmsn5J2sGolxs&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_nMrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Algn-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=L9vPjMKkLkI0Uhu9qQjMYRgG0BFuenqmsn5J2sGolxs&e=)

George Kirikos:Bye folks.

Amr Elsadr:Members of Claims ST: [https://urldefense.proofpoint.com/v2/url?u=https-3A\\_community.icann.org\\_x\\_qMrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5c](https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_qMrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5c)

[M&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Aign-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=Y5sH1sJZJBxLu30Wly4PJDTLKMJoR\\_KHfmG3RjlfCf8&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_tcrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Aign-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=Y5sH1sJZJBxLu30Wly4PJDTLKMJoR_KHfmG3RjlfCf8&e=)

Paul Tattersfield:howmany APAC people responded to the poll?

Paul McGrady:Thanks all! Great call.

Greg Shatan:Bye all!

J. Scott Evans:ciao

Mary Wong:@Paul T, I can't recall off hand but there were a few

Maxim Alzoba (FAITID):bye all

Elizabeth Featherman:Thank you!

Amr Elsadr:Members of AVPMs: [https://urldefense.proofpoint.com/v2/url?u=https-3A\\_community.icann.org\\_x\\_tcrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Aign-H4xR2EBk&m=4TB9lvO5J7iGvk\\_BLj09acfAyTBXXVmW\\_un6ywxjhr4&s=sb6befKntFNKHDoH3NozTJ\\_qXAmalFhThD9KsBY5\\_m4&e=](https://urldefense.proofpoint.com/v2/url?u=https-3A_community.icann.org_x_tcrRAw&d=DwIFaQ&c=FmY1u3PJP6wrcrwl3mSVzgfkbPSS6sJms7xcl4I5cM&r=DRa2dXAvSFpClgmkXhFzL7ar9Qfqa0Aign-H4xR2EBk&m=4TB9lvO5J7iGvk_BLj09acfAyTBXXVmW_un6ywxjhr4&s=sb6befKntFNKHDoH3NozTJ_qXAmalFhThD9KsBY5_m4&e=)

Michael R Graham:Thanks@

Paul Tattersfield:thnaks Mary, bye all

Amr Elsadr:Thanks all. Bye.

Monica Mitchell:thank you