DRAFT QUESTIONS FOR PRIVATE PROTECTIONS SUB TEAM
28 May 2017

<u>Preliminary Note from the Co-Chairs:</u>

Given this Working Group's responsibility to consider the interplay between the RPMs, their collective fulfillment of their intended purpose, and their aggregate sufficiency, it is the view of the Co-Chairs that the WG should undertake some notice and understanding of the blocking mechanisms, and any other additional RPMs that are being offered by registries or the TMCH as additions to the mandatory ICANN RPMs. We believe that market offerings provide additional information about the benefits and limitations of the RPMs, and that viewing the market holistically may spur better informed policy discussion within the WG.

The WG inquiry may also consider whether, and to what extent, additional protective services should be consistent with either policy decisions reflected in the shaping of the ICANN-required RPMs (noting that it may have always been contemplated that such RPMs could constitute a "floor" and not an overall limitation on additional market-provided protections) or with the recognized scope of trademark law.

Overall, ICANN-mandated RPMs must be considered in combination with additional marketplace offerings to fully understand the RPM ecosystem available to trademark holders. On one hand, the availability of additional protections may provide trademark protections in a more cost-effective manner than the alternatives of sunrise registrations and the potential filing of a UDRP or a URS action. On the other hand, TM owners are presented with an RPM landscape in which additional protections of varying scope and cost are available from some but not all registry operators.

What we want to make clear at this time, and initiate discussion upon, is our collective determination that knowledgably answering the key Charter questions relating to the mandatory RPMs requires some understanding and appraisal of the additional RPMs that have been made available in the marketplace.

<u>From the TMCH review (Category 1, Question 3):</u>

1. What information on the following aspects of the operation of the TMCH is available and where can it be found?
    (a) TMCH services, especially the post-90 days Ongoing Notifications service;
    (b) Contractual relationships between the TMCH providers and private parties; and
    (c) With whom does the TMCH share data and for what purposes?

2. How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies and what services Deloitte and IBM provide to registries via private contract? Correspondingly, how can the Working Group and the public better understand what services Deloitte and IBM are offering to registries via private contract, e.g., private protections using the Trademark Clearinghouse database and special webinars about these private services? What changes might provide a clearer line?

<u>Other questions proposed for consideration by the Working Group co-chairs:</u>

3. What are each registry operator's rules for each type of private offering (noting that some new gTLD registry operators offer more than one version of a DPML service)? How many registry operators

extend the Trademark Claims service beyond the required 90 days, and what has their experience been in terms of exact matches generated beyond that mandatory period?

4. How does use of the blocking services affect the utilization of other RPMs, especially Sunrise registrations?

5. What approval process (if any) from ICANN is required to offer these services; RSEP, other or none?
   - Initial review of RSEP requests indicates that some DPML services were submitted for and received RSEP approval, while others did not request approval – what explains this difference?) (Informational Note: Section 2.1 of the standard new gTLD registry agreement permits a registry operator to offer Registry Service that is an Approved Service, but requires it to request approval under the Registry Services Evaluation Policy (RSEP) if it wishes to offer any service that is not an Approved Service or is a material modification of an Approved Services. It is important for the WG to understand whether registry-offered RPMs, especially those based upon TMCH mark registrations, have been subject to any such approval review and, if so, what criteria were utilized in their evaluation).

6. Where a rights-holder uses a blocking service for one class of goods or services, are they able to block another rights-holder who holds the same trademark, but for a different class(es) of goods or services?

7. Do all registry operators use the Valid SMD File contained in the TMCH Database as a condition of using DPML services? How would registry operators verify trademarks to provide these services if they did not use the TMCH Database?

8. How much and what manner of use does each DPML-offering registry operator make of proprietary data, whether derived from the TMCH or the trademark holder?

9. 9. Given the decision that ICANN should not provide a Globally Protected Marks List as a mandatory RPM, should the offering of private DPML services be viewed as inconsistent with that decision, or as an expected and beneficial marketplace supplement? What options for the WG might exist and how might they be pursued?

About the role of the TMCH Providers:

10. What roles do the TMCH Providers play in the provision of private services: both the front-end (Deloitte) and the back end (IBM)?

11. Per the "transparency" question (#2 above), what role does the TMCH Provider (front-end) play in "servicing" the private services? For example:

   a. What website and webinar services is the TMCH Provider providing?
   b. What support to TM Owners and Registrants is the TMCH Providing?
   c. Are these services separated from the ICANN-mandated and supported services, and if so, how?
   d. Are these services supported by the ICANN contract and fees?