

CONSOLIDATED TABLE OF PROPOSED REFINEMENTS TO CHARTER QUESTIONS FOR TRADEMARK CLAIMS AND SUGGESTIONS FOR DATA COLLECTION
20 June 2017

	Original Charter Questions	Updated Question	Sub Team Comments/Discussion	Data Available/Collection Needed?
1.	<p>Does a Trademark Claims¹ period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?</p> <p>What is the effect of the 90-day Trademark Claims process?</p> <p>Should the Trademark Claims period be extended beyond ninety (90) days?</p>	<p>1. Is the Trademark Claims service having its intended effect, specifically:</p> <p>a. Is the Trademark Claims service having its intended effect of deterring bad-faith registrations and providing notice to domain name applicants²?</p> <p>b. Is the Trademark Claims service having any unintended consequences, such as deterring good-faith domain name applications?</p>	<p>1a: (KD): Since we don't have a list of marks in the TMCH to compare to the list of URS cases, suggest getting a researcher to review all URS cases to see if the Examiner noted that the brand owner relied on an SMD file. From the Forum's site: There are 698 URS cases and 15 of them contain the term "SMD."</p> <p>(MG): Ask URS filers if their/their client's mark was in the TMCH.</p> <p>1b: (KD): Of those who abandoned: How many thought about it and went back later (that is, it made them think but they made an educated decision)?</p>	<p><u>1 (generally):</u></p> <p>1a: Numbers: URS cases corresponding to marks for which a claims notice was or would have been issued had the registration taken place during the notice period; URS cases not corresponding to such marks (to get a sense of the relative contribution of the marks in the TMCH to the overall set, though this may require further analysis to find non-TMCH marks to compare fairly)</p> <p>1b: Anecdotal data from registrants or domain name applicants who received claims notices. More granular data about the percentage of those who abandoned attempts in response to a notice based on dictionary terms versus those who abandoned attempts in response to distinctive trademarks.</p> <p><u>Others:</u></p>

Commented [MW1]: Rubens, Amadeu: Need to note that there may be other reasons for abandonment, including software defect on registry or registrar side, possible harvesting of Claims Notices, and generally registrar abandonment

Commented [MG(3)]: Use of the original “terms” was quite confusing. I don't think my proposed changes are necessarily much better, but worth considering.

Commented [MG(2)]: I wonder if we need this or if we should leave the question open? If we keep, I would revise as marked.

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¹ The Sub Team agrees that, as used in this list of Charter questions, the phrase “Trademark Claims” covers both the pre-registration Claims Notice that is sent to a domain name applicant who is attempting to register a domain name that matches a trademark label in the TMCH, and the post-registration Notice of Registered Name that is sent to the relevant rights-holder when the registrant proceeds to complete the registration.

² The use of the term “domain name applicant” is not meant to ascribe any intent on the part of the applicant, as intent cannot be confirmed.

				<ul style="list-style-type: none"> • <u>Consumer survey evidence, perhaps via Amazon Turk or online survey group, using existing notice and perhaps other alternatives to test comprehension of the Notice among individuals likely to consider registering a domain name</u> • <u>UDRP/URS case decisions could be conducted via academic participants in the PDP, law firms sponsoring a clerk to collect data or potentially have ICANN commission a study</u> • <u>ICANN monthly registry reports contains data that may be useful – study behavior/ratios of disputes resulting from registrations during the Claims Notice Period vs after the period is over</u> • <u>UDRP/URS providers have search functionality on their websites, which could be used to collect data</u> • <u>Data should include numbers of domain names that were registered and did not result in disputes (UDRP/URS), relative to the total number of domain names registered under any given gTLD</u> <p>Data available in the Analysis Group revised report pertinent to 1a/1b:</p> <ul style="list-style-type: none"> • 125.8 million records of Claims Service downloads between October 4, 2013 and February 24, 2016
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				<ul style="list-style-type: none"> • Unique download³ requests (after excluding duplicative records): 113.2 million • Number of unique verified trademarks in the TMCH downloaded during the Claims Service period (at least once): 26,405 out of a total of 33,523 current and verified records in the TMCH • About 17,500 disputes (UDRP/URS) between January 2014 – December 2015 • 12.9% of disputes matched Claims Service notification (dispute rate of domains that trigger Claims Notice) • Abandonment rate (all downloads of trademarks from IBM that are not associated with a domain name registration): 94%⁴ • Percentage of new gTLD domain name registrations that resulted in Claims Notice generation and subsequent disputes: 0.3% <p>NOTE: The specific rates of Claims Service registration abandonment, completion and disputes (October 2013 - February 2016) and</p>
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Commented [MG(4)]: Are these UDRPs/URSeS of New gTLD DNs?

³ Unique downloads are defined as the unique combination of trademark string, downloading registrar ID, and download time stamp (NOTE FROM MG: I think we should ask AG to change both the definition and the resulting figures. I think “unique downloads” should be defined not as comprising all three qualities but must be the unique trademark string and either the registrar ID or the download time stamp. Otherwise, the same registrar could download at two different times the same string and still be considered unique.)

⁴ Due to limitations of the data, the Analysis Group analyses of the data required an assumption that each download is associated with a registration attempt (and was not downloaded by a registrar for a purpose unrelated to domain name registrations). If this assumption is incorrect, then their results will exaggerate the size of any observable registration-deterrent Claims Service effect.

				<p>reported by the Analysis Group were as follows:</p> <ul style="list-style-type: none"> • 1,696,862 out of 1,810,546 attempted registrations generated Claims Notices and were abandoned (93.7%) • 113,338 out of 1,810,546 attempted registrations generated Claims Notices, were not abandoned, and were not subsequently disputed (6.3%) • 346 out of 1,810,546 attempted registrations generated Claims Notices, were not abandoned, and were subsequently disputed (0.0%) • The registrations in the Claims Service data account for approximately 5% of 2.2 million registrations made in new gTLDs during Claims Service periods that occurred between October 2013 and February 2016 (i.e., the time period covered by the Claims Service data) <p>Discussion on data (from registrars) concerning the abandonment rate:</p> <ul style="list-style-type: none"> • What is the abandonment rate associated with reasons other than a Claims notice being triggered? what is the difference between abandonment rates of applications that trigger Claims Notices, and those that don't? • Analysis Group did reach out to registrars and registries, but was not able to acquire
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Commented [MW5]: Brian Beckham: Registrars may have additional data/input on abandonment outside the Claims context. It may be difficult to get data that links abandonment to a Claims Notice in any event.

				<p>data on an abandonment rate of domain name registrations that did not trigger a Claims Notice</p> <ul style="list-style-type: none"> • Registrars may not be agreeable to providing data on abandonment rate not associated with a Claims Notice - may involve competitive issues • A high-level set of data concerning abandonment rate of domain name registrations that did not trigger a Claims Notice might be obtainable from registrars, but need to first determine to what extent this would be helpful in providing/influencing direction to the PDP WG • Would registrars be willing and able to share anecdotal data on why potential registrants did not complete registrations – was abandonment the result of a Claims Notice being presented, or was it due to other reasons? • At what point in the registration process is a trademark record downloaded? Does this happen when domain names are placed in carts, or does it happen when payment/attempted registrations are done later in the process? • Many registrars take orders for domain names before general availability –
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Commented [MG(6)]: We should ask for the data.

				<p>preorders do not normally result in Claims notices being presented until within 48 hours of general availability – how does this contribute to the abandonment rate?</p> <ul style="list-style-type: none"> • An overview of how the general registrar processes leading up to Claims Notices and checkout processes work (during pre-order, general availability, after Claims period has expired) might be helpful, and possibly obtainable • Would registrants be willing to participate in surveys during the next round of new gTLDs – for anecdotal evidence on why registrations are being abandoned? • There is a process by which GNSO WG's can acquire data either internal or external to ICANN (possibly via third-parties), if the data is substantively helpful in answering PDP Charter questions - this data can be anonymized • Not all registrars keep records of when and why abandonment takes place – might be more achievable to keep records on this in future rounds, than rely on past data • Can the Analysis Group provide anonymized data (percentages, not raw numbers) on specific registrars that downloaded trademark records, without providing registration services during the
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Commented [MG(7)]:

Commented [MG(8R7)]: Would we not analyze a) the number of pre-orders, (b) the number of notices that issue to pre-ordered domains, and compare?

				<p>Claims Period?</p> <p>Suggested questions for registrars:</p> <ul style="list-style-type: none"> • What is the abandonment rate associated with reasons other than only a Claims notice being triggered? what is the difference between abandonment rates between those that trigger Claims Notices, and those that don't? • Is there anecdotal data explaining why potential registrants did not complete registrations? • At what point in the registration process is a trademark record downloaded? Does this happen when domain names are placed in carts, or does it happen when payment/attempted registrations are done later in the process? • Many registrars take orders for domain names before general availability – pre-orders do not normally result in Claims notices being presented until within 48 hours of general availability – does this contribute to the abandonment rate? If so, to what extent are pre-ordered domain name registrations abandoned? • Would it be feasible for registrars to run surveys of domain name applicants during subsequent rounds of new gTLDs for
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				anecdotal evidence on why registrations are being abandoned? Is this something ICANN should mandate?
2.	Should the Trademark Claims period continue to apply to all new gTLDs?	<p>2. If the answers to 1.a. is “no” or 1.b. is “yes”, or if it could be better: What about the Trademark Claims service should be adjusted, added or eliminated in order for it to have its intended effect?</p> <p>a. Should the Claims period be extended - if so, for how long (up to permanently)?</p> <p>b. Should the Claims period be shortened?</p> <p>c. Should the Claims period be mandatory?</p> <p>d. Should any TLDs be exempt from the Claims RPM and if so, which ones and why?</p>	Ideal research (because data doesn't yet exist in aggregated form): List of new gTLD domains subject to URS (and UDRP?) between 2013-present and note their registration date as compared to the end of claims period.	<p>2 (generally):</p> <p>2a: Is there a spike in registrations that are ultimately subject to the URS after the Claims period ends?</p> <p>Data available in the Analysis Group revised report pertinent to 2a/2b:</p> <ul style="list-style-type: none"> Dispute rate for exact-match strings registered during Claims Service period/Number of exact-match registrations in the same period (October 2013 - February 2016): 323/136,732 (0.24%) Dispute rate for exact-match strings registered within 90 days after the Claims Service period/Number of exact-match registrations in the same period (October 2013 - February 2016): 62/47,606 (0.13%) Exact-match registrations during and after Claims Service period by non-trademark holders/Month from the beginning of the Claims Service period (estimated numbers – <i>please refer to Figure 1 on page 20 of the AG revised report</i>):

Commented [AE9]: Comment from WG F2F meeting at ICANN 59 included that questions 2 through 5 might benefit from requiring separate answers to Claims Notifications sent to domain name applicants and those sent to brand owners.

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Commented [MW12]: George Kirikos: this should be viewed as a relative rather than absolute number of domains. Also, this data question should be asked in relation to all four sub questions, not just 2(a)

Commented [MW10]: Jon Nevett: each of the following bulleted questions should be asked separately for the Claims Notice and then the Notice of Registered Name

Commented [MW11]: Suggested additional question from Paul Tattersfield: “Should the proof of use requirements for sunrise names be extended to all TMCH names i.e. for the issuance of TMCH notices?”

Commented [MW13]: FROM KD: why limit to URS, which is used rarely? Is it because there is too much UDRP data?

Commented [14]: I think this is misleading because URS/UDRP cases are often not filed until there is a use made of the domain name, which can be some time after it's registered.

Commented [MW15R14]: NOTE FROM STAFF: This was pointed out by AG as a potential limitation in their study, i.e. that disputes may have been filed after February 2016.

				<p>→ Beginning of Claims Service Period Month 0: 59,000 Month 1: 35,000 Month 2: 19,000</p> <p>→ End of Claims Service Period Month 3: 17,000 Month 4: 14,000 Month 5: 14,000 Month 6: 10,000 Month 7: 10,000 Month 8: 9,000 Month 9: 9,000 Month 10: 9,000 Month 11: 11,000</p> <ul style="list-style-type: none"> • TMCH users enrolled in ongoing notifications service/not enrolled: <ol style="list-style-type: none"> Agent: 142/31 (82.1% of total) Trademark holder: 673/833 (44.7% of total) Total: 815/864 (48.5% of total) <p>2c: _____</p> <p>2d: _____</p> <p>Others: _____</p>
		3. Does the Trademark Claims Notice to domain name applicants meet its intended purpose?		<p>3 (generally): See Notes on Q1</p> <p>3a: _____</p>

Commented [16]: 2c and 2d: Request for data from ROs where Claims was irrelevant and unnecessary. Ask TM holders if there are some RO business models that make claims a hassle. Consider if there should be a mechanism to skip.

See also Q5.

Commented [17]: All of 3: Ideally, we present the claims notice to average internet users and get their opinion (i.e. a survey). To address 3c, we should include people from other regions, using the TMCH's translations.

		<p>6. If not, is it intimidating, hard to understand, or otherwise inadequate?</p> <ul style="list-style-type: none"> • If inadequate, how can it be improved? <p>7. Does it inform domain name applicants of the scope and limitations of trademark holders' rights?</p> <ul style="list-style-type: none"> • If not, how can it be improved? <p>8. Are translations of the Trademark Claims Notice effective in informing domain name applicants of the scope and limitation of trademark holders' rights?</p>		<p>What is the correlation between domain names that were registered during the Claims Period, and subsequently subject to a UDRP/URS? Objective is to determine if the registrant was on notice when the domain was registered, then subsequently resulted in a UDRP/URS filed</p> <p>How many of the disputes filed in response to registrations during the Claims Notice Period were found to be in favor of the complainant?</p> <p>Survey brand owners and/or registrants regarding cease and desist letters sent/received.</p> <p>Others:</p>
		<p>4. Does the exact match criteria for Trademark Claims Notices limit its usefulness?</p> <p>a. What is the evidence of harm under the existing system?</p>	<p>KD: 4.d.i. Depends on the scope of the changes.</p>	<p>4(a)(i) Obtain research help to identify studies, reports or articles discussing the harm of typosquatting and other forms of non-exact-match cybersquatting, including⁵ all forms of consumer harm, not just traffic redirection?</p> <p>4(a)(i) Survey to determine actual experience of brand owners</p>

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Commented [MW18]: Kurt Pritz, Wendy Seltzer: suggest rephrasing the question to be more balanced (Wendy: "is the exact match criteria for trademark claims notices appropriate?")

⁵ Based on our discussions, the subteam recommends that the WG not limit the harm investigated to just harm against a brand's reputation, but advises the WG that this investigation has a strong potential to get out of scope quickly, so care should be taken to stay in scope during the data gathering phase.

		<p>b. Should the matching criteria for Notices be expanded?</p> <p>I. i. Should the marks in the TMCH be the basis for an expansion of matches for the purpose of providing a broader range of claims notices?</p> <p>II.</p> <p>III. ii. What results (including unintended consequences) might each suggested form of expansion of matching criteria have?</p> <p>IV.</p> <p>V. iii. What balance should be adhered to in striving to deter bad-faith registrations but not good-faith domain name applications?</p> <p>VI.</p> <p>VII. iv. What is the resulting list of non-</p>		<p>4(a)(i) Include questions for a proposed UDRP/URS study. Ask: What are the limitations of relying on UDRP/URS studies?</p> <p>4(a)(i) Open question to WG: What other sources of information should be used to explore the level of harm?</p> <p>4(b) Review Graham/Shatan/Winterfeldt proposal⁶</p> <p>4(c) What are the technological options for creating a non-exact match system, what would it cost, and who should pay (and at what point(s))? [Subteam notes that the selection of a provider would likely be through an RFP process, but the WG should obtain minimal feasibility data before making its recommendation.]</p> <p>Re-test claims notice language with relevant criteria.</p>
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Commented [MW19]: Amadeu: Consider expansion only for the Notice of Registered Name, not the Claims Notice.

Commented [MW20]: Amadeu: Note that IDN variants are not necessarily accepted at the moment so this should be factored into the analysis.

Commented [MW21]: Maxim: Suggest getting a third party to translate the ideas into semantics of programming language and then test the historical data versus these semantics so we see how many claims would it generate and are able to evaluate the presence of the registrations without claims.

Wendy: add consideration of financial and technical costs for registrars (Maxim: and also for registries).

Commented [MW22]: FROM KD: Graham/Shatan/Winterfeldt proposals. Data would likely best be found in an analysis of UDRP/URS cases. If we're going to commission a study, it needs to be well-designed and comprehensive and include information for the whole PDP.

⁶ This reference is to the proposals submitted by Working Group members Michael Graham, Greg Shatan and Brian Winterfeldt in relation to exact/non-exact matches. The consolidated proposals can be reviewed here: <https://community.icann.org/download/attachments/66080938/PROPOSALS%20ON%20NONEXACT%20MATCHES%20%E2%80%93%208%20JUN%202017.docx?version=1&modificationDate=1498049562691&api=v2>.

		<p>exact match criteria recommended by the WG, if any?</p> <p>c. What is the <u>feasibility of implementation</u> for each form of expanded matches?</p> <p>d. If an expansion of matches solution were to be implemented:</p> <p>i. Should the existing TM Claims Notice be amended? If so, how?</p> <p>ii. Should the Claim period differ for exact matches versus non-exact matches?</p>		
		<p>5. Should the Trademark Claims period continue to be uniform for all types of gTLDs in subsequent rounds?</p>	<p>KD: we could solicit feedback from ROs about if they think something about their business model should exempt them from claims and why.</p>	
		<p><u>6. Should Claims Notifications only be sent to registrants who complete domain name registrations, as opposed to those who are attempting to register domain names that</u></p>		

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		are matches to entries in the TMCH?		
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