

DRAFT QUESTIONS FOR ADDITIONAL MARKETPLACE RPMs SUB TEAM

24 JULY 2017

Preliminary Note from the Co-Chairs:

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.

Overall, ICANN-mandated RPMs **should** be considered in combination with additional marketplace offerings to fully understand the RPM ecosystem available to trademark holders.

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

From the TMCH review (Category 1, Question 3):

1. What information on the following aspects of the operation of the TMCH is available and where can it be found?

- a) **Ancillary services offered by the TMCH which are not mandated by the ICANN RPMs, including but not limited to:**
 - i. **the post-90 days’ ongoing notification service; and**
 - ii. **other services in support of registry-specific offerings**
- b) **With whom and under what arrangements does the TMCH share data, and for what non-mandated RPMs purposes?**

In considering this Question (1) the WG should take into account and avoid duplicating other work undertaken by the Working Group in reviewing the TMCH. The WG should also distinguish between services related to the TMCH database and those provided by the TMCH validator.

2. **[PROPOSAL TO DELETE]** 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.,

¹ **Additional Marketplace RPMs are mechanisms offered by registry operators independent of the TMCH and not the same as “ancillary services” that may be offered by the TMCH provider. Ancillary services may be offered by the TMCH provider (see Section 1.4 of the TMCH description in Module 5 of the Applicant Guidebook (June 2012): “Trademark Clearinghouse Service Provider may provide ancillary services, as long as those services and any data used for those services are kept separate from the Clearinghouse database”); however, under Deloitte’s contract with ICANN any such “ancillary services” require ICANN’s consent. To date, only the provision of the post-90 days’ ongoing notification service has been approved by ICANN (for a description of this service, see <http://www.trademark-clearinghouse.com/content/ongoing-notifications>).**

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Deleted: 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. ... [1]

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Deleted: are subject to ICANN approval as per the gTLD applicant guidebook, while Additional Marketplace RPMs offered by registry operators are not. From the gTLD Applicant Guidebook: “The Clearinghouse database will be a repository of authenticated information and disseminator of the information to a limited number of recipients. Its 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.”

private protections using the Trademark Clearinghouse database and special webinars about these private services? What changes might provide a clearer line?

3. [\[PROPOSAL TO DELETE²\]](#) Could registries provide the same or similar services without the use of the TMCH?

Other questions proposed for consideration by the Working Group co-chairs:

4. 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)?
5. 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?
6. How does use of the blocking services affect the utilization of other RPMs, especially Sunrise registrations?
7. [\[PROPOSAL TO DELETE\]](#) 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).
8. 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?
9. 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?

Comment [SP1]: I would suggest this is a separate question

² [Reasons cited for deletion: \(1\) Since registry specific RPMs are voluntary they clearly make their own choice whether to utilize the TMCH to operate them or not; \(2\) To the extent that they do utilize the TMCH, then they impact on a review of the TMCH. If they do not use the TMCH, then they do not impact on a review of the TMCH. The voluntary measures themselves could still be relevant to a review generally of the RPM ecosystem, but not whether they might be offered in another way; \(3\) The question formerly-numbered 7 covers this anyway.](#)

10. 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?

Comment [SP2]: The trademark holder is the party who seeks the DPML so what is the relevance of asking whether their proprietary data is used for the purpose? Could whoever drafted this question please clarify what relevance it has to our work.

11. **[PROPOSAL TO DELETE]** 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:

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

13. What role does the TMCH Provider (front-end) play in “servicing” the private services? For example:

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- 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?

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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.

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Mary Wong

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including:

The post 90-days ongoing notifications service;

Services in support of registry-specific offerings; and

Other services, if anyContractual relationships between the TMCH providers and private parties;

and

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With whom does the TMCH share data and for what purposes?

^{b)}