FINAL QUESTIONS FOR ADDITIONAL MARKETPLACE RPMS
Report from the Sub Team (15 September 2017)

Preliminary Note:

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 Working Group Co-Chairs that the Working Group should undertake some notice and understanding of the additional marketplace 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 Working Group.

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 knowledgably 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.

The original set of questions proposed by the Co-Chairs included several questions that have since been deleted following deliberations and agreement by the Sub Team. For completeness and for the information of the Working Group, all these deleted questions have been compiled and archived on the Working Group wiki space at https://community.icann.org/x/_ywhB).

THE SUB TEAM'S AGREED LIST OF SUGGESTED QUESTIONS FOR THE WORKING GROUP TO REVIEW:

1. How, and to what extent, does use of Protected Marks Lists (e.g. blocking services) affect the utilization of other RPMs, especially Sunrise registrations? (NOTE: The Sub Team considers this the overarching issue on the topic of Additional Marketplace RPMs)

2. 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[1]?

   In considering this Question (2) the Working Group should take into account and avoid duplicating other work undertaken by the Working Group in reviewing the TMCH. The Working Group should

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[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).

also distinguish between services related to the TMCH database and those provided by the TMCH validator.

3. ** Are registry operators relying on the results of the TMCH validation services, or accessing the TMCH database, to provide Additional Marketplace RPMs, and, if so, in what ways? Is there language in the current adopted TMCH policy or related documents that expressly permits, prohibits or otherwise addresses such use by registry operators? Are registry operators able to provide the same or similar Additional Marketplace RPMs without relying on the TMCH validation services or access to the TMCH database? Will there be an increase in costs? If so, what will this be to stakeholders along the value chain (i.e. brand owners, registries, registrars, other registrants)?

   ** SUB TEAM EXPLANATORY NOTE ON QUESTION 3:

   The Sub Team's discussion of this question resulted in agreement amongst most Sub Team members that the answer to the question as to whether, and how, some registry operators are relying on the TMCH validation services and/or accessing the TMCH database in order to provide Additional Marketplace RPMs is "Yes". This is based on information provided by some registry operator members of the Sub Team as well as registry responses to a poll conducted by the Working Group in December 2016. The poll questions included the following: (1) Are you accessing data and records in the TMCH for purposes other than obtaining information necessary for the provision of Sunrise and Claims services in accordance with ICANN's user manuals and technical requirements; and (2) Are you using any capabilities of the TMCH other than for Sunrise Periods and TM Claims Notices? Two registries (PIR and Afnic) responded "no" to both questions, while Donuts responded "Yes" to both (for (1), it was to verify Domains Protected Marks List (DPML) block requests, and for (2), it was to leverage SMD files as qualifiers for the DPML service[2]).

   Similarly, the Sub Team came to a similar conclusion in relation to the question about cost increases where a registry operator provides Additional Marketplace RPMs without relying on the TMCH's validation services or accessing the TMCH database.

   The Sub Team believes that even if the answer to these initial questions are "Yes", the information and any additional input that may be provided as part of the responses will be useful to the Working Group.

4. What are each registry operator's rules for each type of Additional Marketplace RPM it offers (noting that some new gTLD registry operators offer more than one version of a Protected Marks List service)[3]?
   - Where a trademark holder uses a Protected Marks List service (e.g. 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?

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[2] The questions and full results of the poll can be found on the Working Group wiki space here: https://community.icann.org/download/attachments/61606228/Registry%20Responses%20to%20TMCH%20Data%20Sub%20Team%20-%2013%20Dec.pdf?version=1&modificationDate=1484721921000&api=v2.

[3] The Sub Team notes that this question is intended to allow for a compilation of all the various Additional Marketplace RPMs that have been offered in the 2012 New gTLD Program round.

- What do registry operators impose as a condition for using Protected Marks List (e.g. blocking) services? For example, do they all use the valid SMD File contained in the TMCH database?
- How much and what manner of use does each registry operator make of data from the TMCH [or the trademark holder] in providing its Additional Marketplace RPMs?

5. For registry operators that extended the Trademark Claims Service beyond the required 90 days, and for registrars who operated the extended service, what has been their experience in terms of exact matches generated beyond the mandatory period[4]? For example, in terms of registration volume and numbers of exact matches?

6. What role does the TMCH Provider (front-end) play in "servicing" the Additional Marketplace RPMs? For example:

- What services do you provide to ICANN Registry Operators?
- Does the TMCH use any data from the Clearinghouse to provide these services? If so, please explain.
- How are you compensated for the provision of these services?

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[4] The Sub Team notes that the previous formulation of this question asked about the number of registry operators that extended the Trademark Claims Service. The Sub Team believes that the data collection exercise that will be conducted as part of the Working Group's review of the Trademark Claims Service will provide the relevant data in answer to this query.