Categorization of Additional Marketplace RPM Questions by Target Stakeholder/Respondent
Prepared by ICANN staff – updated 4 October 2017

I. Questions for the Working Group:

Question 1[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?*

Staff Note:
The Sub Team identified this question as the overarching issue on the topic of Additional Marketplace RPMs. It is anticipated that the Working Group will deliberate on this question following receipt and review of input on the other questions.

II. Questions directed to Registry Operators:

Question 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)?*

Staff Note:
Existing materials on the current rules for the TMCH and the scope of use of the TMCH services and/or database can provide a useful starting point for answering the first two questions: e.g. the TMCH section of the 2012 New gTLD Program Applicant Guidebook, ICANN's TMCH Operational Guidelines, the TMCH Functional Specification and Deloitte's TMCH Guidelines.

The Sub Team had noted that registry operators are likely able to provide the same or similar services to the Additional Marketplace RPMs without relying on the TMCH; however, the associated costs of doing this will require input from the registry operators concerned.

Question 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)?*
- *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?*
- *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?*

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[1] The numbering of the questions here follow their order as proposed by the Additional Marketplace Sub Team in their list, available at
https://community.icann.org/download/attachments/69283148/CLEAN%20Draft%20Final%20Additional%20Marketplace%20RPM%20Questions%20-%2015%20September%202017.pdf?version=1&modificationDate=1506023484000&api=v2.

- *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?*

Staff Note:
A starting point can be to review the current publicly-available information on the Additional Marketplace RPMs offered by certain registry operators (Donuts, Minds and Machines and Rightside). In particular, the information provided in relation to whether, when and how a block can be overridden by another trademark owner may be useful on the first bullet point, and information regarding eligibility for use of a Protected Marks List based on a valid SMD file issued by the TMCH may be useful on the second bullet point.

At the Working Group's request, staff has prepared a summary of the existing Additional Marketplace RPM offerings based on a review of the registry operator's websites and other publicly-available materials such as industry media sources. Additional or historical information can be sought from each of the registry operators providing the services.

Question 5: *For registry operators that extended the Trademark Claims Service beyond the required 90 days, what has been their experience in terms of exact matches generated beyond the mandatory period? For example, in terms of registration volume and numbers of exact matches?*

Staff Note:
As with the planned survey on Sunrise and Trademark Claims to be sent to trademark owners, this question can be added to the version of that survey that is to be sent to registry operators (especially as this Question 5, unlike Questions 3 and 4, is not limited only to the registry operators who offered Additional Marketplace RPMs).

III. Questions directed to Trademark Owners:

Question 4, first bullet point (rephrased): *Have you been blocked from registering a second level domain name matching your registered trademark in any of the gTLDs launched under the 2012 New gTLD Program?*

Staff Note:
It was suggested that the first bullet point of Question 4, rephrased appropriately, be sent also to trademark owners by adding it to the survey already being planned for Sunrise and Trademark Claims. The question will specifically target those who may have been blocked from registering domain names corresponding to their trademarks. The aim is to obtain information as to whether a trademark registered under one class of goods and services can, by its owner's use of a Protected Marks List service, effectively block another trademark owner holding an identical trademark in a different class of goods or services from registering the domain name across all gTLDs operated by the registry providing that Protected Marks List service.

In adding this question to the planned survey, it may be necessary to provide a link to a list of all the Donuts, Minds + Machines and Rightside gTLDs (possibly including dates if some gTLDs were either subsequently assigned to or obtained from a different registry operator who did not operate a Protected Marks List service).

IV. Questions directed to Registrars:

Question 5: *For registrars who operated an extended Trademark Claims Service (i.e. beyond the required 90 days), what has been their experience in terms of exact matches generated beyond the mandatory period? For example, in terms of registration volume and numbers of exact matches?*

<u>Staff Note</u>:
The Working Group agreed that Question 5 should appropriately also be sent to registrars. As noted above, this question can be added to the survey already being planned for Sunrise and Trademark Claims.

<u>V. Questions directed to the TMCH Providers:</u>

Question 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?*

> **Comment [MW2]:** A suggestion was made on the 28 Sept WG call that this be added to the survey of registrants, possibly broken down further by geographical region and type (e.g. commercial, non-commercial). However, a few other WG members thought this would alter the objective of the question. Staff also noted that expanding the target respondents (especially to a broad global public) would greatly increase the budget needed for a survey.

Question 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?*

<u>Staff Note</u>:
Some of the materials noted above (e.g. the TMCH Guidelines, Requirements and Functional Specifications) may provide information relevant to answering this question. Fuller answers can be obtained through direct outreach to and contact with the TMCH Providers.