

2017-05-17 Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP WG

The call for the Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group is scheduled for Wednesday, 17 May 2017 at 17:00 UTC for 90 minute duration.

10:00 PDT, 13:00 EDT, 18:00 London, 19:00 CET

For other times: <http://tinyurl.com/kb433bb>

Agenda:

1. Roll call (via Adobe Connect and phone bridge only); updates to Statements of Interest
2. Progress reports from the chairs of the Sunrise and Trademark Claims Sub Teams
3. Continue discussion of open TMCH questions:
 - Geographical Indications (with the opportunity for Jonathan Agmon or his designee to present his proposal, being the only proposal that has not yet been presented to the group at a meeting)
 - Expanding the "identical match" test
 - [if time permits Design marks
1. Next steps/next meeting

Please note also that there will not be a Working Group meeting the following Wednesday, 24 May, since many Working Group members will be at the International Trademark Association Annual Meeting.

Documents:

[Mp3](#)

[Adobe Connect recording](#)

[Transcript](#)

[AC Chat](#)

[Attendance](#)

Apologies: Jonathan Agmon, Ivett Paulovics, Massimo Vittori, Paul Keating

Documents/Materials: [Remaining Open TMCH Charter Questions - 17 May 2017](#)

Action Items:

1. Staff to circulate a call for consensus on the Working Group mailing list regarding the Working Group consideration of proposals to include Geographical Indications in the TMCH
2. Staff to consolidate resources of data/work available on consideration of non-exact matches generating Claims Notices, and share with the Working Group
3. Michael Graham to repost his proposal on trademark non-exact matches generating Claims Notices, with refinements based on discussions held to-date
4. Rebecca Tushnet to repost suggestions on data required to evaluate the proposal to extend the match criteria of permissible records in the TMCH
5. Claudio Di Gangi, Jonathan Agmon and Massimo Vittori to consider drafting a proposal for the GNSO Council to consider a PDP on inclusion of Geographical Indications in the TMCH

Follow up notes:

- Claims Sub Team:
 - Claims Sub Team has revised Charter questions to make sure they are not suggestive of specific answers
 - Sub Team is continuing to propose refinements to Charter questions
 - Sub Team beginning to evaluate data available and needed for Working Group to answer Charter questions
 - Sub Team will also attempt to determine how accessible the required data may be
- Sunrise Sub Team:
 - Sub Team has finalized refinement of the Charter questions
 - Sub Team now considering what data is available and/or required to answer the Charter questions
 - Sub Team preparing report for full Working Group, highlighting the work done and rationale in refinement of their assigned Charter questions, as well as data required to answer them
- Proposal by Claudio Di Gangi:
 - Proposal to consider addition of GIs in the TMCH
 - Presence of TMCH records that correspond to GIs should remain or be removed from the TMCH based on the policy recommendations developed by this PDP

- Any recommendations considered regarding records in the TMCH should be applicable to GIs (Records in the TMCH should be consistent, including how they apply to GIs)
- Will GIs that have protection in different jurisdictions be permitted entry in the TMCH regardless of whether they are or are not registered trademarks? Will they be placed in a separate database?
- Protection of GIs normally done via a separate registry than that which contains registered trademarks
- Will the WG plenary deliberate on GIs being placed in the TMCH, or will it be necessary to set up a dedicated group
- GIs currently in the TMCH are included under the category of marks protected by statutes/treaties
- From AC Chat: Should the first question be whether GIs should be included in a RPM, and, if so, whether that should be Sunrise, Claims or both?
- GIs not associated with categories of goods and services, cancellation guidelines due to proof-of-use, similar to registered trademarks
- Is the inclusion of GIs within scope of this PDP, or does it fall outside of the scope of the Review of how RPMs are currently functioning? Should a dedicated GNSO process be launched to consider the inclusion of GIs in the TMCH?
- TMCH is an implementation tool that is meant to function in a manner that is reflective of the applicable policies on RPMs
- There are normally bodies (public or private depending on concerned country) that are responsible for managing protections of GIs - possible to be recipients of Claims Notices
- From AC Chat: Although this may be jumping the gun - staff feels obliged to note that it is open to this WG to recommend that GIs (and possibly other source identifiers that are not also registered TMs) - be considered for rights protection, possibly via a different mechanism TBD.
- Does the WG wish to clarify that marks protected by statutes /treaties are trademarks, or should all marks (such as those that provide indications of source) protected by statutes /treaties be allowed in the TMCH?
- Tentative WG agreement: Consensus that GIs being included in the TMCH should not be considered by the WG
- ACTION ITEM: On-list call for consensus to be circulated by staff regarding WG consideration of GIs being included in the TMCH
- Proposal by Michael Graham on expanding inclusion of non-exact matches of trademarks in the TMCH:
 - Proposal based on observation that disputes arising as a result of domain name registrations of non-exact matches of trademarks are costly and problematic
 - There may be a benefit in expanding the Claims Notice scope to include Notices being sent when domain name registration of non-exact matches are attempted
 - Need for more data on the extent to which this is a problem
 - What would the criteria for what constitutes a non-exact match be, from an implementation perspective?
 - From AC Chat: Also Registries ...are they to pay to ICANN as for claim registrations in those numerous occasions?
 - This proposal is limited to Claims Notices, but may be of benefit to expand to Sunrise registrations
 - From AC Chat: Also, from an implementation basis, beyond my prior comments, one might need to give a *different* TM Claims notice wording for these non-identical matches.
 - Would there be an additional cost to expanding the scope of Claims Notice to non-exact matches? Concern regarding false positives.
 - Should expansion of Claims Notice generation be limited to non-exact matches that include a word descriptive of an associated category of goods and services?
 - Expansion to legacy TLDs is a discussion that might be premature - should address all the RPMs as a package when review of all the RPMs is concluded
 - From AC Chat: If it applied to Legacy, that implies that Claims Notices would be perpetual, instead of 90 days.
 - Refer to work already done on consideration of non-exact matches generating Claims Notices in the AG revised report and staff paper
 - ACTION ITEM: Staff to consolidate resources of data/work available on consideration of non-exact matches generating Claims Notices - share with WG
 - From AC Chat: One more document I forgot to mention - ICANN Explanatory Memorandum from Sept 2012 on this question, noting that it will be important that the TMCH not be asked to exercise subjective judgment (e.g. for the so-called "dumb matches" and false positives Greg, Phil and others mentioned)
 - Identification of additional costs associated with non-exact matches generating Claims Notices might make the proposal less desirable - existing costs are already burdensome
 - Data on curative rights associated with registration of non-exact matching domain names might be helpful in determining the extent to which this proposal has merit
 - TM+50 creates protections for trademarks + associated words provides protections without the problems that might arise from inclusion of non-exact matches
 - Data on the expected increase in number of Claims Notices being generated as a result of inclusion of non-exact matches would be helpful in consideration of this proposal
 - From AC Chat: Would it be worth distinguishing between plurals, typos, mark+keyword and "mark contains"?
 - How would a non-exact matches (specifically, marks containing a trademark) be distinguishable in cases where the trademark exists within a string that does not constitute a confusingly similar match to the trademark (example: GM contained in frogman)
 - ACTION ITEM: Michael Graham to repost his proposal with refinements based on discussions held
- Next steps/next meeting:
 - No meeting next week due to many Working Group members attending the INTA meeting. Next call will be on 31 May, 2017 at 16:00 UTC