

**ICANN
Transcription
Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working
Group call held on Wednesday, 14 December 2016 at 17:00 UTC.**

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Coordinator: The recording has started.

Terri Agnew: Thank you. Good morning, good afternoon and good evening .welcome to the Review of all Rights Protection Mechanisms RPMs in all gTLDs PDP Working Group call held on the 14th of December, 2016.

In the interest of time there will be no roll call as we have quite a few participants. Attendance will be taken via the Adobe Connect room so if you are only on the audio bridge, could you please let yourselves be known now? Hearing no names I would like to remind all to please state your name before speaking for transcription purposes and to please keep your phones and microphones on mute when not speaking to avoid any background noise.

With this I'll turn it over to our co-chair, Kathy Kleiman. Please begin.

Kathy Kleiman: Thank you, Terri. Hello, everyone, this is Kathy Kleiman, one of the co-chairs of this working group. I see Phil Corwin, another co-chair, has joined us, and we are expecting J. Scott Evans, our third co-chair to join us.

Thank you for joining us during this busy holiday season. I know we have a million other things to do, but today's meeting is an important one. Let me pause for a second to see if anybody has an update to their statement of interest? Okay, not hearing any, please feel free to circulate them on the list and of course to post them into the statement of interest that ICANN puts on the Website.

Okay let me give a quick summary for anyone who did not join us at the last meeting. When last we met, we were going over charter questions, a draft of charter questions, a final list of suggested charter questions that had been provided to us by a subgroup that had been working hard over a number of weeks. This was the charter question subgroup.

And it was a group of five or six people who were working pretty hard over the last few weeks to try to bring together a diverse set of questions that came to us from a charter trying to provide some clarity to some of the questions that we found ambiguous and trying to provide some neutrality particularly in cases where questions kind of suggested an answer and there still seemed to be some underlying issues about, you know, what are the facts, what's happening, what's the problem. And then, you know, do we want to get to an answer?

And in some cases there were questions coming in on two different sides trying to push in two different directions for an answer. So again trying to neutralize the question so we can look at both sides of it or see what the evidence provides.

According to our wonderful staff member, Mary Wong, and you guys need - we've lost David Tait now who has gone on to another job in the UK working

on Brexit issues. So according to Mary we were on Category 1, Question 4. Category 1 is the guidance questions, guidance kind of looking at big picture guidance questions for the TMCH providers.

And so we were on the design mark questions. So I'd like to - what I'd like to propose, unless there's any objections, is where - we continue where we left off, try to make it through the entire document and then go back to some of the revisions and questions still raised about the first three questions in Category 1 that we worked on last week.

But again, unless anybody objects I'd like to - I'd recommend we kind of continue through the end of the document, see what we can put to bed and then come back and work on all the questions that still remain. Great, and if we make it through all of this we get to look at some of the data gathering, some of the responses that the Registries provided to some of the questions that we put out for data on the Trademark Clearinghouse and its use.

Okay, so Number 4, is everyone in charge of their own slides, Mary, or are you going to be rotating us through them? It looks like everyone's in charge of their own, good. Okay, so Number 4 is how are design marks currently handled by the provider?

And then there's a note. Note, "The working group is using the more commonly used term, design marks, to refer to what the TMCH guidelines describe as device or image marks or otherwise marks that do not excessively," I believe that word should be "exclusively consist of letters, words, numbers, numerals, special characters," I'm having trouble reading my notes, "special characters, e.g. see the Trademark Clearinghouse guidelines on Page 20."

So this wording and the additions that staff has provided in redline reflect the discussion last week that the Trademark Clearinghouse and the community seemed to use different terms to talk about design marks. And if we rephrase

the question with the clarifying note we've got both sets of descriptions. So let me first - we do have related questions on geographic indicators, designations of origin, etcetera. But let me pause to see if anyone objects to the way the question is currently phrased on design marks.

Great, then we'll go - we'll see if anyone objects on the list but pending that we'll go forward with this as Question 4 with the change from excessively to exclusively.

So now I'd like to ask if any of - if anyone would like to speak to - and I see some of the people had raised questions - issues - related issue to design marks which has been raised by people responding to this question and maybe pointing out that there should be a new question or a related question on geographic indicators, appellations of origin, so and designation of origin.

Would anyone like to speak to that and speak to the concern that they're seeing and perhaps phrase a neutral question on how the working group might look at that? Mathieu and Massimo both submitted comments. I could read them but if they're on the list I think it might be better if they could come on. Massimo, do you have telephone access? Okay. Would anybody like to speak to these?

Let me read what was posted and perhaps people can suggest how we should handle this. So Mathieu Weill, on December 3, apologies if I mispronounced that, had questions about geographic indicators. How would geographic indications and/or appellations, designations of origin handled by the TMCH provider? He'd like to know how many such registrations were submitted and approved.

Massimo Vittori submitted on December 13 a question about design marks so data gathering question really, how many design marks and marks protected by statute or treaty have been submitted and validated? And what is your criteria for validating these?

And then he'd like to know, "Under the mark protected by statute or treaty, how many applicants based their requests on titles such as geographical indications, protected designation of origin, and/or appellation of origin?"

Go ahead, Massimo, I'm glad you're in the queue. Thank you.

Terri Agnew: And this is Terri from staff. Your mic is not active so to activate your mic on the top toolbar, select the telephone icon and follow the prompts. Or if you send me a private Adobe Connect chat I'm happy to have the operator dial out to you with the provided phone number.

Kathy Kleiman: Okay, we're still not seeing input, although we are hearing somebody typing. If you're not on mute, if you could please mute? Okay. Kristine Dorrain, please go ahead. And, Massimo, hopefully you'll have audio soon. Kristine, please go ahead.

Kristine Dorrain: Hi, Kristine from Amazon Registry. Thanks, Kathy. I don't want to step all over what Massimo might be planning to say but I'm just looking at - I read the email string and I'm looking at the comments box here on Question 4. And I'm wondering if we want to kind of include geographical indications as something that we investigate. I think it's pretty easily added by saying how are design marks or geographical indications currently handled by the Trademark Clearinghouse provider, because although Massimo asks some very good follow up questions, the follow up questions are along the lines of the types of things that the team will get into, the types of questions that the team had asked.

Having been on the quiet or the smaller TMCH review team, I at that time, you know, we got into those really detailed questions, you know, what did we want to find out, what did we want to know. So I mean, to the extent that geographic indicators are something people want to know about or think that is within the scope of the charter question, I think it's pretty easily added by

just adding the words “geographical indicators” and, you know, going from there.

And, you know, we can mince words over whether geographical indicators is the right word. I’m using this as a, you know, concept. So maybe people could talk a little bit about, you know, just the right wording to include, not the questions and how we’re going to get there. Thanks.

Kathy Kleiman: Thanks, Kristine. Massimo, do we have you?

Massimo Vittori: Yes, can you hear me?

Kathy Kleiman: Yes, very well. Please go ahead. Thank you.

Massimo Vittori: Sorry, first time I take the floor so I was a little bit with technology. I was having some trouble. No, I mean, my point is the following, that we have some of our members of origin, which are geographical indications, owners or beneficiaries, which have submitted requests to be part of the Trademark Clearinghouse basing, you know, their requests on geographical indications title.

But, you know, some - in some jurisdictions these are called appellation of origins, and other designations or origin. So my point was that can we know exactly how many submissions were based on geographical indications, appellation of origins? And I know for sure that one at least was accepted as such according to the review so just to know exactly how many were accepted.

And so I tend to also agree, I mean, we don’t need to give all the details I have put in my proposed questions but the final point would be to know how many people tried to register marks based on treaty and statutes and how many were accepted? And if there were a difference in the way those

applications were managed if some were rejected, for instance, that's my point so.

Kathy Kleiman: Massimo, please don't leave, let me ask you a few questions and see if this would suffice? As Kristine mentioned, it's probably easy to include your question. But I'd recommend perhaps including it as a different question because the design marks do seem to be different than the geographic indicators.

So how would you feel - and then we'll ask the review team - I mean, sorry the working group, about a question that says, "how does the TMCH handle geographic indicators?" and we can say, parentheses, also called appellations of origin and designations of origin. Question mark. And then we can include the data gathering underneath the broader question. I mean, it's kind of implicit that if we're looking into the question we'll be asking for data on it. Like how many registrations...

((Crosstalk))

Massimo Vittori: I totally agree, actually I think the first Mathieu Weill like (unintelligible) to Question 4 and I followed up, you know, and in details into Question 4 but I perfectly understand that would be better to have an independent question only on geographical indications. I agree.

Kathy Kleiman: Fantastic. So let's propose that as a 4A now but ultimately it might become 5. Thank you for the discussion. It looks like Kristine is back in the queue. Kristine, please go ahead.

Kristine Dorrain: Hi thanks. Kristine, Amazon Registry Services. I support the first part of your amendment, Kathy, but I do want to push back a little bit on leaving the itemized question in only because I have a feeling we're going to get into the weeds. If we leave Massimo's wonderful questions in the charter question itself, then there are going to be five people who are going to raise their hand

and want their own questions and their own data gathering activities added into the charter question.

So I do suggest that we not put any of the data gathering questions into the charter question, reserve those for when we get to that action item and then we can add any additional data gathering questions that anybody has. And I do point out that Mary suggested that we had already asked this question of the TMCH, which I thought we had but I wasn't sure.

((Crosstalk))

Kathy Kleiman: Kristine, hold on. I don't think we're in a different place, let me just double check that the question that would be added is, "How does the TMCH handle geographic indicators also called," you know, the other two versions," and then we leave all the data gathering questions as implicit within the question.

Kristine Dorrain: Yes, agreed. Thanks, Kathy.

Kathy Kleiman: Okay terrific. Thank you. Massimo, your hand is still raised, would you like to continue the discussion? Okay, would anyone else like to comment...

Massimo Vittori: No, no...

((Crosstalk))

Massimo Vittori: I will remove my lower hand, here we go. It's okay.

Kathy Kleiman: Okay.

Massimo Vittori: I'm okay with it.

Kathy Kleiman: Okay fantastic. And when we get to this question which again is - and I'm not sure I see it in the notes but the notes are pretty small. How does the - a new

question - How does the TMCH handle geographic indications? When we get there then hopefully you'll work with us on the data gathering questions that would be related to that.

Okay, that covers 4 and 4a unless others have anything to add. Terrific. Then we move along to Question 5. "What information on the following aspects of the operation of the TMCH is available and where can it be found: TMCH services, contractual relationship between the TMCH providers and private parties, and with whom does the TMCH share data and for what purposes?"

And the note from the staff suggests that some of this has to do with the co-chairs' paper on private protection mechanisms which we'll be talking about when - probably next week. But there were a lot of questions raised in the charter and I believe in Helsinki and perhaps in India on how is the TMCH database being used? Do we understand the full scope of the use of this data that ICANN has caused to be collected?

And so when we get - if we get to the Registry responses later today we'll see a number of questions that a different subgroup, the Data Gathering subgroup kind of put out to find on this, but this is the charter question that urges us to kind of - that combines, as you can see, there's a great effort here to combine the number of questions and put them all in one place and look at this all together.

How, you know, what are the TMCH services? What are the contractual relationships and how is the data being used? It seems like a very fair reasonable question. Anybody have any objections or changes? Great, check.

Moving on - again, not accepting it absolutely but accepting it with the 42 participants of the call and we'll put it out to the list in case anyone wants to share anything else.

We now move onto what's tentatively been called Category 2, verification and updating of the TMCH data. And anyone point out - I'm using hard copy notes so if for whatever reason they differ from what Mary has for us please let me know.

Okay, so Category 2, should there be an additional or a different recourse mechanism to challenge rejected trademarks? Now, I urge the sub group to help me with this, the charter question sub group, because I think when we talk about rejected trademarks because there's another question about cancelled trademarks right below, I think what we're talking about here is trademarks rejected by the TMCH provider.

So again, let me read the question as tentative revised. I'm not trying to be biased, I'm just trying to be clear. "Should there be an additional or a different recourse mechanism to challenge trademarks rejected by the TMCH provider?" Of course that would open the questions of what has been rejected? What is the process? And perhaps, should there be some kind of appeals mechanism if we find this to be a problem?

Okay, I see support in the chat room. Can we specify this as rejected for recording in the TMCH? Okay, does anybody object to the wording? So again, trademarks rejected by the TMCH provider. Does anyone want to comment on this question?

Okay then Question 2 of this Category 2, verification and validation of TMCH data, is "How quickly can and should a canceled trademark be removed from the TMCH," that should probably be the TMCH database, "to avoid discouraging or losing domain name registration? Is this satisfactory?"

So the underlying questions, as you can imagine, we're concerned with a trademark that might be cancelled and its underlying trademark - in the trademark office. We've had some famous examples in the United States of this. And so there was - it was posited that the longer a cancelled trademark

was in the TMCH database the longer it might be used in sunrise periods and to stop someone else from having, you know, from being able to record or being able to register a domain name.

Kristine, go ahead.

Kristine Dorrain: Hi, I feel like this is the Kristine and Kathy show today. I just...

((Crosstalk))

Kathy Kleiman: That's a good show, KK, I like it.

Kristine Dorrain: It is. Yes, I agree. Kristine from Amazon. I have just a question on the - this just basically what this is intending to say. I don't understand this concept of losing domain name registrations. I wonder if that's meant to be sort of from the registry perspective and that the registry or the registrar loses out on a registration. Maybe this isn't coming from the perspective of the customer losing a registration. I just maybe wonder if we want to be a little more precise with our language because I'm not entirely sure what this is supposed to say.

Kathy Kleiman: Kristine, do you want to suggest some language? And I don't want to out him, although I might, I know who wrote this language and he is on the list. He's a member of our sub group of course. And so I'm hoping he's going to join the queue and talk about this particularly language, the end of the question that you pointed out.

But, Kristine, do you want to offer kind of where - it sounds like you want to delete some words at the end of the question, so would you like to kind of offer what you'd like to see it as?

Kristine Dorrain: Yes, I guess I was still just trying to understand, so I'm guessing that this is from the perspective of a registrar. So I'm suspecting we need to say how quickly can and should a cancelled trademark be removed from the

Trademark Clearinghouse to avoid discouraging new registrations or preventing - or - yes, I don't even know. Isn't losing a domain name registration the same as preventing it? Because you're not going to lose an already-registered name.

So discouraging or preventing domain name registrations, maybe that's what it's trying to say? Let me see what George is writing. "What might cause the perspective registrant to abandon their shopping cart and thus losing a particular," yes, I think that's right. So...

Kathy Kleiman: So let me read it back to you, Kristine. "How quickly can and should a cancelled trademark be removed from the TMCH database to avoid discouraging or preventing new registrations?" It looks like I see Mary, Kurt and others typing. Okay Mary points out that the question is the same as what was in the charter.

Okay I didn't realize it hadn't been changed by the sub team because we talked about it extensively. She says it was suggested in the comment to the preliminary issues report. So, Mary, would you like to come online and comment from a staff perspective is - to what you think - as to whether you think the change that Kristine offered changes the substance? Because you've dealt with the issues report longer than anyone else. Go ahead, thanks.

Mary Wong: Hi, Kathy, everyone. This is Mary. I'm not sure I can add any more illumination because this question was basically reflecting the suggestion that was made by a commenter to the preliminary issue report. So in that sense it is what it was when it was suggested. And as I pointed out the sub team didn't make any changes to it.

Kathy Kleiman: Oh on further reflection, this is Kathy again of course, losing - if - could that refer - and again bringing the whole working group into trying to decipher the tea leaves of the charter question is what the sub group has been trying to do

for a long time now and now we're all trying to do it. But could losing the domain name registration also refer to the URS since what's in the TMCH database is not - is being used in the URS.

So if you have a canceled trademark it creates - if you have a cancelled trademark that has not been removed from the TMCH database, it both can discourage or prevent new registrations but it might also cause a problem regarding losing a registration that's been challenged in a domain name dispute. Kristine, please go ahead.

Kristine Dorrain: Thanks. Kristine from Amazon. I think that's a fair interpretation actually. I think that's a good catch. And we may just want to clarify it. I mean, simply changing it to how quickly can and should a cancelled trademark be removed from the Trademark Clearinghouse. Now George is suggesting that we really don't even need to have the rest of it we're, at this point, just guessing at the problems if we don't quickly remove a trademark from the Clearinghouse, problems such as discouraging or domain name registrations or losing domain name registrations to URS.

So one option I guess as proposed by George is just to simply leave it at the end of TMCH and be done. Alternatively I think if we leave the losing language I think adding a parenthetical suggesting via URS or something like that would at least clarify so that in a couple of months when we come back to this question in detail at least we'll know what we're talking about.

Kathy Kleiman: Clarifications are always welcome, no question about it. Well let's do a quick straw poll and that way we can move onto the next question. So who's in favor of shortening the question? And I'll read it, and I'm going to add back in the word "database" just because TMCH is so vague, we use it in so many ways.

So, "How quickly can and should a cancelled trademark be removed from the TMCH database?" That's Option 1. And otherwise, "How quickly can and

should a cancelled trademark be removed from the TMCH database to avoid discouraging or losing domain name registrations,” with the parentheses that losing refers to URS and other domain name disputes.

So all in favor of Option 1, the short version, please check or raise your hand. Mary, if you could count? And we'll give everyone a few seconds to look up from other things what they're doing and vote. So Option 1, the short version. Okay, Mary, do you have a count? I have one but I'll trust yours.

Mary Wong: It looks like, yes, it looks like nine but I might need to scroll down again because the checkmarks actually go down the page so I don't know if anyone else has raised their hand since I last counted. But it would be at least - oh I think now more hands have gone up. But you - we're probably at least a quarter of the people who are on the call today.

And, Kathy, if might make the suggestion which is a follow up to Kristine's as well?

Kathy Kleiman: We're voting, Mary, so I'm going to stay with this right now. So Option 1, 1, 2, 3, 4, 5. Okay, if everyone could cancel out? And we'll go on to Option 2. Thanks - and I'll talk for a second as everyone's canceling out. Okay Option 2, the full original question with additional clarifying information about the losing being part of the URS and domain name. “How quickly can and should a canceled trademark be removed from the TMCH database to avoid discouraging or losing domain name registrations?” with the clarifying URS?

So this is the original preliminary issues report question, who supports that? And we'll give this a second. Kristine and Lori, do you want to comment on this or - we're going to finish the vote, everybody, and then - 1, 2,...

Kristine Dorrain: No, I'm sorry, that was an old hand.

Kathy Kleiman: Okay. Okay it looks like the shorter version has it. Mary, go ahead and then Lori, I'll call on you and then Phil Corwin.

Mary Wong: Thanks, Kathy. It was really just a note that since we've asked or at least the sub team for data gathering has asked the provider a related question about the process by which they handle these trademarks we can always come back to this question if we need to refine it later on in time. Thanks.

Kathy Kleiman: Phil, go ahead.

Phil Corwin: Yes, thanks, Kathy. Phil for the record. I'm just not clear on why the URS reference is being thrown in? One, if there's possibly a losing it you could lose the - if you register the domain it could be subject to a UDRP or a URS so maybe we should use the, dare I say, generic DRP.

But second, what are the odds of a former trademark owner bringing such an action on the basis of a canceled trademark and if the URS and UDRP are operating properly shouldn't that action just be dismissed if there's no valid trademark?

Kathy Kleiman: Good point, but, Phil, it looks like we've deleted all of that, is that okay with you that the question now is based on the vote, "How quickly can and should a canceled trademark be removed from the TMCH database?"

Phil Corwin: Yes, that's fine, that's fine. I was responding to the comments regarding URS made just two minutes ago.

Kathy Kleiman: Good points. Good points, all. Thank you.

Phil Corwin: Thanks.

Kathy Kleiman: Lori, go ahead.

Lori Schulman: Can you hear me?

Kathy Kleiman: We can hear you now. Thank you.

Lori Schulman: Yes, sorry, I'm on the phone. I couldn't get into the mic on Adobe Connect. I guess I had heard you say something about the use of the TMCH as vague in the question, and that's what I had a confusion about since the TMCH is very clearly the Clearinghouse. So I wasn't sure what made use of the term vague. That's all.

Kathy Kleiman: I'm sorry, Lori, does TMCH database, if we add the word "database" does that help you with that question? Is that - so the question now it looks like, as it's adopted is "How quickly can and should a canceled trademark be removed from the TMCH database?"

Lori Schulman: Yes, I guess it doesn't matter one way or the other I just didn't find it vague the first place so I didn't understand what the vagueness was about because isn't the Clearinghouse, by definition, a database? Is there anything else but the database I guess would be my question.

Kathy Kleiman: There are TMCH providers, there are RPMs, so I don't know.

Lori Schulman: All right. Okay.

((Crosstalk))

Kathy Kleiman: Thanks. Okay it looks like we are now done unless anybody has any other comments. Category 2, verification and updating of TMCH data now has two questions, one about challenging rejected marks and one about canceled trademarks. And absent any other comments we go onto Category 3, balance.

Before I read this question let me just pause and thank the sub group for spending hours, days, trying to gel and distil a number of questions down to what we thought was the essence and presenting it to you. So know that there's a lot of work behind what I'm about to read.

Does - we're on again, Category 3, balance, Number 1, "Does the scope of the TMCH and the protection mechanisms which flow from it reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrants?" And I will pause to see if there's anyone who wants to discuss this, any concerns, any edits or whether the work of the subgroup goes forward. And I'll wait as people are typing into the chat room.

George writes, "Question 3.1 is describing in broad terms our entire charter," with a smiley face. Agreed, George. Okay, we can of course always go back to this in this discussion and our second pass or on the list. But it looks like we're moving onto Category 3, balance, Question 2. And this is of course one that's had a lot of discussion on the list.

"Should the scope of the TMCH be limited to apply only to the categories of goods and services in which the generic terms, with a trademark are protected? If so, how?"

So yesterday a proposal came from the co-chairs, and let me read that. "Should the scope of the TMCH be limited to apply only to the categories of goods and services in which the dictionary term, parentheses S, within a trademark are protected? If so, how? Note, in responding to this question you should note that the original submitters of the related charter question seem to have been particularly concerned about quote, unquote, generic terms representing the common or class name for the goods and services.

And I am going to open this up to Phil, please go ahead.

Phil Corwin: Yes, Kathy, thank you. In the course of some back and forth on the email list yesterday the version of the question - some questions were raised about what the scope of the TMCH mean. And I proposed a clarification of the question - of the co-chairs' suggestion, which seemed to be acceptable to resolve that ambiguity. So let me read that, it's just the first sentence.

And it's, "Should the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary terms within the trademark are protected?" So in other words, that would say if you're - got a mark that's registered for a certain class of goods and services should the - should your right for sunrise registrations be limited solely to those new TLDs that are somehow related to the goods and services and likewise, should claims notices only be generated from some of those.

Now, there was a comment, I don't know if he wants to comment orally, but Greg Shatan just a little while ago on email said that he was fine with that clarification but he thought now the question should be in a different place, in a different category. So I don't know if Greg wants to speak to that. But I did want to read out the latest version of that which had circulated on the list yesterday.

Kathy Kleiman: Phil, before you leave the call, and as you know, I've been traveling a lot lately, let me ask you a question, because if this question is modified the way you suggest then it will probably move to the future charter questions that we'll be reviewing for the sunrise period and trademark claims. But could it be not - could it be limiting too limiting? Would it really - is there anything within the scope of the TMCH database that is not within the scope of the RPMs? And here I'm thinking private purposes as well.

So could there be implications of something being in the - uses - could there be reasons to keep it at this level rather than - as well as pushing it down to

the rights protection mechanisms rather than keeping it here as well as keeping in the sunrise?

Phil Corwin: Kathy, I'll leave that to the rest of the working group to decide. All I'm saying, and I think it's a valid concern, that the phrase, "scope of the TMCH" without some additional words doesn't really - is not really very clear. The TMCH doesn't have a scope, you're either meet the criteria and you're registered in it or you're not. What has scope is the range of the protections, which flow from TMCH registration.

So it's an attempt to get at the effect of, you know, some special treatment for dictionary words and their generic meaning. So I'll stop there and let - this was a topic of great interest so let's see if others have something to say about it.

Kathy Kleiman: It was indeed. Thank you. And thank you for all the revisions that you and so many others on the group have been working on. Mary, it looks like your hand is raised.

Mary Wong: Yes, Kathy. I just wanted to draw the group's attention especially for folks on the bridge to some discussion that's going on in the Adobe chat. There's actually two discussions. One goes back to the earlier question so maybe I'll park that for now, Kathy, while we talk about this question 2. But on this specific question I believe there was a question from Beth that asked about Phil's reformulation concerning the use of the word "related" as in what that means and who's going to determine what that means.

And there is a suggestion from Paul Tattersfield that we should change the phrase "dictionary term" simply to the word "words." Kathy, I don't know if you can see that in chat but those are the two comments I picked up including the discussion that's going on about the previous question about the word "legitimate."

Kathy Kleiman: Mary, could you go back to the first comment about the word “relating” and which version of the question does that go to?

Mary Wong: Sure. It refers to the reformulation by Phil. And I see that Beth has her hand up so maybe, Beth, would you like to explain your question and comment?

((Crosstalk))

Beth Allegritti: Yes. Beth Allegritti. So the comment was that registrations be limited to the goods or services that are related to the gTLD, if I understood that correctly. And I’m just wondering who would make that determination because it’s kind of subjective. So I just wanted to throw that out there.

Kathy Kleiman: I think that would be part of the evaluation that would be done - as part of the evaluation of this question of the working group. But the question from the charter was pretty clear which is, you know, is - are trademarks being protected outside the categories of goods and services in which the trademark gives them protection? So, Beth, I agree, it’s a hard call, but the evaluation seems like a fair question to ask and we were certainly asked it numerous times in the charter.

Who would like to actually join the discussion and raise some of the edits? It’s much easier to talk about edits if someone comes onto the call rather than trying to negotiate with the chat room. So let me read the version from Phil and, Mary, go ahead.

Mary Wong: Sorry, Kathy. There was the other comment by Paul Tattersfield, I believe, I don’t know if, Paul, you want to speak to it. But his suggestion on the edited question is not to use the phrase “dictionary term.” And there’s a bit of a discussion as to what should replace it in the Adobe.

Kathy Kleiman: Again, I’m going to urge - I actually have a hard time reading the small print in the chat room, guys. I’m going to urge people to come onto the call and talk

about this because dictionary term was heavily negotiated. That was, you know, people are concerned about these kind of basic words, generic terms, dictionary terms that are trademarked in some uses. But as Phil pointed out in some of the descriptive emails over the last few days, not trademarked and, you know, heavily used dictionary terms and others like apple.

So let me read the version that Phil circulated and, "Should the scope of the RPMs associated with the TMCH be limited to apply only to TLDs that are related to the categories of goods and services in which the dictionary term or terms within a trademark are protected?"

Lots of discussion in the chat room. Come onto the call. Okay Phil, go ahead.

Phil Corwin: Yes, given the surprising silence on this, I think we should take silence as consent if no one's going to be really objecting to the current formulation because people are going to give whatever answers they want to give anyway no matter how precisely we try to formulate the question.

But the thrust of the question is simply - let me give a, you know, a well-known example that's used all the time. Apple, it's the name - it's the dictionary name of a fruit, nobody has the right to call themselves - nobody who raises the fruit, apple, has the right to trademark we are the apple company for apples because it's generic term.

But there's this well-known company named Apple which makes all kinds of electronics. So the question is really if Apple registers Apple in the Trademark Clearinghouse should it have the right for sunrise registrations in every new TLD or only in the ones that are related to the goods and services for which Apple is registered? And should potential registrants only get trademark claims notices from TLDs that are related to those goods and services or from every TLD?

And I already put in my opinion yesterday that I'm probably going to ask this question no for two reasons. One, it'd be a very difficult task for the Trademark Clearinghouse to - someone is going to have to decide for each registered mark - it's going to have to look at his goods and services, which may be categorized in different jurisdictions in which the mark is registered, they use different words for it and different languages. Which TLDs relate to those goods and services, which is a subjective judgment.

And second, there could be, if there's a TLD, and I don't remember all the TLDs, if there's a TLD.computer, there could be a valid registration by someone who's not associated with Apple Corporation of Apple.computer if the purpose is for fair use commentary on the features and pluses and minuses of Apple products. And someone could register an infringing domain related to electronic goods at some other TLD that's not related to Apple goods and services and then drive traffic to it through various search engine optimization techniques.

So that would be my answer but I hope it's clear what the question is getting at is right now every TLD - if someone tries to register a exact match of a registered TMCH registered mark generates a claims notice and the rights holder has sunrise registration rights in every TLD. The question is really saying should that be narrowed?

Kathy Kleiman: Thank you for the clarification, Phil. I'm seeing agreement with you in the chat room.

Phil Corwin: Okay.

Kathy Kleiman: Thanks. Bradley Silver is next in the queue.

Bradley Silver: Thanks, Kathy. This is Bradley. I, you know, I had a little bit of a different question - actually are we talking about, sorry, before I go, are we talking

about 3.1 or 3.2 before I weight in? Because there's activity in the chat room about both.

Kathy Kleiman: We are talking about 3.2 and we're in the third column under - at the very bottom of the third column, it's a long column, Phil Corwin, 13 December, "Should the scope of the RPMs associated with the TMCH be limited to apply only to the TLDs that are related to the categories of goods and services in which the dictionary terms within the trademark are protected."

Bradley Silver: All right, I'm going to put my hand down for now then. If we come back to 3.1 and there's discussion about how to tweak that I will weigh in then.

Kathy Kleiman: Okay.

((Crosstalk))

Bradley Silver: ...disturb the flow on 3.2.

Kathy Kleiman: Great. I am going to actually - can we cue up - let's - I'll make a note about 3.1. But 3.2 I'm going to go with Phil's suggestion that silence is probably a good sign. And that we will - that it looks like the group is accepting the second version that he sent around, the version I just read in the third column of 3.2 that he sent late yesterday, the one I've read several times.

Mary, can we take that as the current version now of 3.2? And my thought would be to keep plowing through and go back to 3.1 later but it looks like there is discussion now so let me reopen 3.1 and I'll read it again. So we're in Category 3, balance, we're going back to the prior question that we were discussing, "Does the scope of the TMCH and the protection mechanisms which flow from it reflect the appropriate balance between the rights of trademark holders and the legitimate rights of non-trademark registrants?"

Actually it has a lot to do with the question 3.2 as well. Bradley, go ahead.

Bradley Silver: Thanks. So, you know, I think there might be two points here. I raised the point about what legitimate means and others in the chat room raised the point about well what rights are we talking about when we make reference to non-trademark registrants? You know, back to what Phil was saying about 3.2, we are not necessarily being, you know, need to be completely precise, we're trying to elicit answers and information. So my suggestion for 3.1 is that I don't know if it's going to be necessary to describe in great detail about exactly what rights we're talking about when we make reference to non-trademark registrants.

I was just wondering about why we make the distinction between rights of trademark owners on the one hand and legitimate rights of non-trademark registrants on the other. And maybe we should just refer to rights and let folks respond in, you know, how they, you know, in a manner that supports their answer.

Kathy Kleiman: Bradley, can you hold on a second? Let me share some of the sub group discussion as well as some of the charter and see if that makes a difference, because there is - we had questions coming in both in the charter and in Helsinki where there were multiple sides that feel that their concerns and issues should be reviewed as part of this review process.

Trademark owners are one. But also the domain name registrants are the other. And so rather than coming up with a series of questions of one set for trademark owners and one set for, you know, current and future and potential registrants, we combined it to show, you know, to come up with the balance question. And so that was the illustration of rights on both sides.

And as Phil was talking about, that could include the ability to use apple to critique and discuss Apple, kind of some of the fair use issues. So this was the most neutral wording the sub group could come up with.

Bradley Silver: Yes, I don't have an issue with what combining the question, I'm just wondering what the word "legitimate" means when we're talking about the rights of non-trademark registrants. I just, you know, we want to get answers that aren't in the form of questions and some might say well, you know, I'm not sure if I'm answering the question because I'm not sure what the rights I'm talking about is legitimate.

So either are we talk about interests because that's, you know, I suppose the sort of formulation I've seen most often in talking about the rights of IP owners versus the interest of users, or we talk about the rights of trademark holders and the rights of non-trademark registrants and not editorialize, you know, any sort of sub category of rights like only those which are considered to be legitimate.

Kathy Kleiman: So the proposal is to delete the word "legitimate" so that the question reads about the appropriate balance between the rights of trademark holders and the rights of non-trademark registrants.

Bradley Silver: Yes, or I think an equivalent suggestion is one that's in the notes which is replacing it with legitimate interests, which I think just is more cogent because we're not talking about rights on the one hand versus legitimate rights on the other hand. I think legitimate interests is a more understandable term when you talk about the interests of non-registrant - of non-trademark registrants. So I think either would be fine.

Kathy Kleiman: Okay. My guess is we're going to be talking about legitimate interests for a long time. Would anybody object to just making the language parallel, deleting "legitimate" because we haven't set the legitimate rights of trademark holders. So again, let me read the question as revised. "Does the scope of the TMCH and the protection mechanisms which flow from it reflect the appropriate balance between the rights of trademark holders and the rights" - deleting the word "legitimate" - "and the rights of non-trademark registrants?"

Okay, looks like there's agreement. Bradley, your hand is still up. So I'll pause and see if that's an old hand. People are typing so I'll wait a second. Kiran agrees. Beth agrees. Phil Marano agrees. Jon agrees.

Okay, terrific, 3.1 done. We'll parallel the language on both sides. So delete the word "legitimate" so one and - 3.1 and 3.2 now done. Let's go onto 3.3. Here are two questions - actually 3.3 and 3.4 have to do with some of the matching rules and variation rules.

So 3 was a very clear question coming in from the charter, "Should the TM+50 be retained or removed?" and then there's a note, because we found that some people didn't know what the TM+50 was so we asked staff to clarify. So the footnote says, "Trademark owners can add up to 50 variations that are similar to each valid submission in the TMCH within the notification process provided that the variant to the mark was awarded to the trademark holder in a prior UDRP case."

So up to 50 variations if you can show that the UDRP case involved those variations and that you won. So Kurt is proposing, "Should the TMCH+50 be retained as is, amended or removed?" So adding the words "retained as-is, amended or removed?"

We've got three more minutes so, Phil, go ahead, please.

Phil Corwin: Thanks. Phil for the record. I'm fine with the question as posed or with Kurt's revision. I'm just wondering shouldn't we also be asking how many marks that are not registered trademarks but were registered under TM+50 are in the Clearinghouse? Wouldn't that be useful information? I'm not sure if we're asking that elsewhere but if not I think we should be asking it here as part of this...

((Crosstalk))

Kathy Kleiman: Phil, hold on a second. Would you - would that be a data gathering question that would be kind of implicit under this question? So once this question goes out would then kind of a follow up be to ask the Trademark Clearinghouse about the use of the TM+50?

Phil Corwin: That's fine, I just want to make sure that at some point we actually know, yes, I don't know whether there's been no marks or 1000 marks and they're put in the Clearinghouse under TM+50, this working group ought to have that data at some point.

Kathy Kleiman: Absolutely. And I think this question will lead to that kind of information gathering but very good point. Okay so Phil is ready to accept it as amended by Kurt Pritz or as-is. Any thoughts? I'm going to check the chat room on this. Let me ask for any objections to Kurt's revision. And let me read it again. And he's just putting in more variations which is what the sub group did - Kurt was on the sub group team and we just tried to make sure everything was as neutral as possible. "Should the TM+50 be retained as-is, amended or removed?"

I think that's a fair expansion. Let's put that in, Mary, and it looks like there's some support here. Mary, let's put that in as a redline so people can see it. And I think that wraps up our work for today. I'll pause for any other comments that people have. Thank you for running through so many comments and thank you for the robust discussion on the list this week in preparation for today's call.

I know this is hard work but these will be the questions that we'll be working on for the next three, four, maybe more months so really appreciate everyone's time and laying them out. So barring any comments, Terri Agnew writes, that our next meeting is 2200 UTC on Wednesday the 21st of December unless anyone has any objection to holding it that close to the holiday.

So thank you very much and we'll see you next week. Appreciate it. Have a good week, everyone.

END