EN

ICANN Transcription
Review of all Rights Protection Mechanisms (RPMs)
Thursday, 10 October 2019 at 17:00 UTC

Note: Although the transcription is largely accurate, in some cases it is incomplete or inaccurate due to inaudible passages or transcription errors. It is posted as an aid to understanding the proceedings at the meeting, but should not be treated as an authoritative record.
Attendance and recordings of the call are posted on the agenda wiki page:
https://community.icann.org/x/TpYCBw
The recordings and transcriptions of the calls are posted on the GNSO Master Calendar page:
https://gnso.icann.org/en/group-activities/calendar

ANDREA GLANDON: Good morning, good afternoon, good evening. Welcome to the Review of All Rights Protection Mechanisms in All gTLDs Working Group call held on Thursday the 10th of October 2019 at 17:00 UTC.

In the interest of time, there'll be no roll call. Attendance will be taken via the Zoom room. If you're only on the audio bridge, could you please let yourself be known now? I do know that we have Zak Muscovitch and Kathy Keliman who are both on audio only at this time.

I would like to remind all participants 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 Brian Beckham. Please begin.

BRIAN BECKHAM: Thank you, Andrea. Welcome, everyone. I want to star by asking if there are any updates to statements of interest or any comments on the agenda for today.

STEVEN LEVY: I guess this would be an update to the statement of interest. I recently was appointed as a UDRP panelist to the Canadian international Internet Dispute Resolution Center, the CIIDRC. Just want to let everybody know.

BRIAN BECKHAM: Thank you, Steve, and congratulations.

STEVEN LEVY: Thanks.

BRIAN BECKHAM: Alright. Seeing no other updates or questions about the agenda, I believe that takes us to – we have – just in case there are people who haven't been on recent calls, we've been trying to get through question seven and eight. This related to the trademark clearinghouse. The one question was on certain types of design marks and the other was on GIs. We made some good progress and had some false starts, and I think we're sort of at the point where this is our kind of last effort to discuss these, and barring any agreement on a recommendation, then rather than consensus or recommendation from the working group for the initial report, these would be captured in some form as individual proposals in

the initial report. And of course, then there would be opportunities for people to submit public comments on those.

So I'm wondering what's the best way to proceed here. Question seven, there was a proposal from Greg Shatan. I apologize, I'm a little rusty. I've been preparing for an event we're holding coming up in a week or so here and we've just wrapped up our annual assemblies. So I apologize, Greg, if there have been some changes to your proposal. But I wonder if it makes sense to put it on screen and see if Greg wanted to run through it very quickly, see if there were any comments, and barring some progress on that, then I think we just call it a day on that one and agree that it's going in as an individual proposal and not as a big recommendation.

Just looking on the chat if Greg is on the call. I don't see him. Let me scroll down. I don't know in Greg's absence if someone would wish to take this up. I think the gist of it was that Greg was looking to provide some clarity around the text portion of marks. So I'm seeing in the chat from Julie that Greg doesn't appear to be on the call.

And certainly, anyone feel free to jump in, raise your hand, or I'll try to monitor the chat. So let me do this. Let me ask if anyone has any thoughts, comments, questions on Greg's proposal. Otherwise, I think based on our last conversations, it was clear that there wasn't sufficient agreement to put this forward as a recommendation, and it would be included only as an individual proposal. Does anyone disagree with that assessment or have anything to add?

Maybe let me ask if anyone agrees with that assessment, that is, recognizing that there's insufficient agreement for Greg's proposal to be put forward as a recommendation. But would it be included somehow as a proposal in the initial report?

KATHY KLEIMAN: Brian, I don't know if you can hear me.

BRIAN BECKHAM: I can, Kathy. Go ahead.

KATHY KLEIMAN: Okay. I think what we're waiting for is that Greg had revised his proposal, and so far, at the point where we'd gotten to ask him what it is he [inaudible], he submitted no revisions, he hasn't been [here.] So last week and this week. So I think we're still waiting to know what the revisions are, and have, I guess, a brief discussion if it changes the proposal at all. I don't know if anyone had a chance to do a deep dive and check into that. But that's kind of where we were last week, because he joined the call but after we had already talked about question seven last week, so we never got a chance to hear his proposal summary, unless I'm missing something or not remembering something. Thanks, Brian.

BRIAN BECKHAM: Thanks, Kathy, for reminding me, and I apologize. Like I said, I'm a little behind on the e-mails from the group. Ariel, I wondered if it would make sense to put the redline that you mentioned in the

EN

Zoom room if that's possible. And I see that Greg has joined us. Greg, I don't know if you joined us in time to hear Kathy's suggestion that we ask if you wanted to explain the nature of your redlines and see if that couldn't take us towards agreement from the working group. And of course, barring that, then we would include it as an individual proposal in the report. Greg, do you have audio?

GREG SHATAN: Yes, I just have audio. For some reason my Zoom keeps crashing when I try to open it, so I've got to reboot. The general idea of my changes was to create a parallel – a preamble to that that was in the Kathy-Zak proposal which had an introductory element whereas my proposal did not, and reflecting perhaps a different viewpoint as well on the nature and severity of what we see as the issue to be dealt with. So the idea was just to create a more parallel set of recommendations. Thanks.

BRIAN BECKHAM: Okay. Thanks, Greg. I'm just wondering, Ariel, if this is the redline version. I don't see any changes from Greg's prior proposal. Greg, are you able to articulate what the proposed changes were? So in other words, there wasn't agreement on the original proposal, either the Zak-Kathy proposal or your proposal. So if there were changes that you made to try to get us across that line – because I don't see them on the screen unfortunately, would you be able to describe those for us or point those out?

GREG SHATAN: I still don't have a screen in front of me so I can't explicate, but the basic nature was, as I said, to add the preamble. I don't believe that I expanded the proposal as far as I can recall to somehow make it more attractive to those who otherwise would support Zak and Kathy's proposal but not mine. Thanks.

BRIAN BECKHAM: Okay. Thanks, Greg. So I'm wondering if it's maybe the first two paragraphs in bold that were meant to address the concerns that have been raised. For those that didn't support Greg's proposal – I don't know if others have lost Zoom, I seem to have just lost it – I have a printout of those, I can read those and see if that doesn't get us across the line here. Otherwise, I think it's maybe time to recognize that we didn't have agreement.

So the preamble, as Greg mentioned, was an applicant to the trademark clearinghouse must include in this application a sworn statement that the trademark registration does not include a disclaimer as to any portion of the mark, or if it does, a text portion of the mark is not disclaimed in its entirety. There the text portion of a mark is disclaimed in its entirety, the mark is not eligible for registration in the clearinghouse.

Okay, I'm just sign onscreen, looks like a markup version. Looks a little different than the printout I have. And Greg, you're still on audio only.

GREG SHATAN: Correct, but I'm getting there.

BRIAN BECKHAM: Okay. So it looks like the version in redline is – just reading the beginning – looks like an explanation and it's really the part in bold that I was reading that was the meat of the proposal. So maybe I can just continue with the preamble there.

it says for marks that are text marks that do not exclusively consist of letters, words, numerals, special characters, the recorded name of the trademark will be deemed to be an identical match to a reported name as long as the name of the trademark includes letters, words, numerals, signs, keyboard signs and punctuation marks, and those are defined as characters. And all characters are included in the trademark records submitted to the clearinghouse in the same order they appear in the mark.

So let me ask, for those who did not agree with Greg's initial proposal, does this preamble language that I've just read get us any closer to the goal? I'm trying to remember who would have been some of the people who had –

REBECCA TUSHNET: I'm trying to join, but I'll get on the queue if that's okay.

BRIAN BECKHAM: By all means. Rebecca, and I saw Jason Schaeffer's hand go up and down, and then Phil Corwin. So why don't we start with Rebecca, Jason, and Phil?

REBECCA TUSHNET: I agree with Greg that I don't think the added material changes anything. I think it clarifies the nature of our disagreement, which is fundamentally about whether we should expand the rights that are granted by deeming the mark to be more than it is for purposes of the TMCH. I don't think we should. He thinks it's a reasonable measure to take given the change that there are trademark rights. I had at one point floated the idea on that take a chance theory that notice but not sunrise might be a possible compromise, but there doesn't seem to be much enthusiasm for that. So given that, I think we stay where we were. Greg just put his proposal so it was more in parallel with the competing one. That's my take on it. Thank you.

BRIAN BECKHAM: Okay. Thanks, Rebecca. I see Phil Corwin's hand is still up and James' seems to have gone down. So I'll go to Phil. And Jason, if you did have a comment, just please raise your hand again. Phil.

PHIL CORWIN: Yeah. I just wanted to say it's my understanding that the issue that this addresses, which is design marks, that there's already, I believe, agreement to publish a competing proposal, the Kleiman-Muscovitch proposal for public comment. So my view is that we're not going to get some agreed upon version that combines both. There are principal differences and that we should include both as the authors want them to be published because they raise an important question, and the initial report can set out the issue, set out the differences between the proposals, and that's the best way to get community feedback that may lead hopefully to some final

proposal on the issue that can gain consensus support. Thank you.

BRIAN BECKHAM: Okay. Phil, I think that's a good summary of where we may be headed. I see Kathy and then Greg.

KATHY KLEIMAN: Yeah. Now in the Zoom room. Question for Greg. I thought that text mark was a term of art, and I could be wrong, but when we were doing the SCI, we thought of text mark as a term of art for standard character mark, and specifically said text marks and contrasted it with any kind of design mark or anything that had design elements in addition.

So, I understand what you're trying to do and support it, but do we want to call it text marks if that term already has another meaning? Text marks being both standard character marks and marks with design elements or devices if text mark has kind of another meaning in the legal sense or the legislative sense? But I defer to the experts in the group. Thanks.

BRIAN BECKHAM: Thanks. And I have Greg next.

GREG SHATAN: Thanks. That's not my understanding of the terms of art, which is why I switched it from word mark to text mark thinking that word mark was one that had perhaps the term of art and also that we

kind of moved to a different phrase. But regardless of the definition – why don't we use the term "banana" instead of text marks or word marks – the point is that there is a difference of opinion or recollection that whether only standard character marks were intended to be or should be in the TMCH and that even something as mere as claiming a particular font should knock you out of the TMCH, or according to one compromise proposal, knock you out of sunrise but not claims, whereas the other view is that there is such a significant likelihood that marks that consist of words and other elements are protected beyond just that particular combination, that barring a disclaimer, those marks should be continued to be admitted into the TMCH.

There may be more sophisticated razors that we could use perhaps to carve a little bit back, but then we start empowering the TMCH to start really performing an examination function as opposed to just a use verifying function and a general function of getting stuff validated, and fools rush in where angels fear to tread, so I guess I'm a fool perhaps, but there is a kind of concept of whether the words predominate or the design predominates, which at least in some U.S. cases and circumstances kind of provides a razor between what would be more broadly protected and more narrowly protected.

I'm not sure we want to give that job to the TMCH, trying to decide what predominates, especially since there is, in essence, again at least in the U.S. level, at the USPTO, a jurisprudence and precedence as to where that lien is drawn by that [inaudible] body. But unfortunately, unless there's an office action or some other thing, that line doesn't really get drawn or indicated in any

registration, so there's really no way to capture that concept unless we add essentially a limited examination sort of thing.

And maybe there are other potential cutoffs that we could at least discuss, because there is a spectrum here, as there are in so many places in the trademark world between the standard character mark and the mark where the text is either completely disclaimed and only the designs are claimed or the text is somehow so subsumed to the design that one wouldn't think of any protection given to the text of its own. But now that last one just becomes qualitative. We could look at whether other formations of marks plus some level of something other than standard text is a potential razor. I don't know if we'll get there, especially at this late date, but at least I throw that out there as a possibility for discussion. Thanks.

BRIAN BECKHAM: Okay. Thanks, Greg. Phil, I think that may be an old hand, so let me do this. I haven't noticed any in the chat, but let me ask if there aren't any reactions to Greg's last intervention. Barring that, it looks like we have some differences of opinion on this question. We have two different proposals. So obviously, we'll put those out in some form to a public comment. It would be great if during that public comment or the time between then and us getting back together as a working group to look at those comments that the proponents of these different proposals could work together and maybe even submit a further iteration of a joint proposal through the public comment offering. Otherwise, we will get back to that when we reconvene as a working group to review the public comments.

So I don't see any reaction to Greg's last intervention. I think we're all wrestling with the same question of how to account for nonstandard character parts of marks, but we're just not getting there at the level of [textual] agreement. Mary, please.

MARY WONG: Hi, Brian and everyone. This is just a follow-up from the comment I'd put in chat. To the extent that the working group, whether now or in the future, changes the phrasing, as we know, the last version of the applicant guidebook uses the phrase word marks, and Greg's proposal here uses the phrasing "text marks," and like I said in the chat, that was actually the original phrasing but sometime in 2010 – I want to say between versions four and five of the applicant guidebook – the words "text mark" got changed to "word mark."

So I'm not opining on why or what the difference is, but just to note that whatever the working group decides at the end, that A, some kind of definition or explanation is probably a good idea, and that B, if there is going to be this change, that we document and explain it. Thanks, Brian.

BRIAN BECKHAM: Okay. Thanks, Mary. I think that that probably takes us to an end on this question. I don't see any other hands up, and I don't see any other comments in the chat. Oh, sorry, I see Greg again. Greg?

GREG SHATAN:	Thanks. Mary's remarks and the earlier discussion that ended in the result of "banana" lead me to believe that this proposal could be simplified significantly by removing the word mark/text mark aspects of this proposal and merely defining word marks as defined in 2 A and B, and the language below that. I'm not saying anybody would agree more with that, I just think that there's a tendency when you have an inane aspect of a proposal that really isn't worth commenting on, which would be the text mark/word mark semantics concept, that somehow that will get way too much attention. So I'd like to leave of the group to remove that so the focus can solely be on the substantive aspects of this, which is trying to propose a definition of the term which is now word marks and which continues to be word marks. Thank you.
BRIAN BECKHAM:	Okay. Thanks, Greg. Thanks, Mary. Any comments, any reactions to Mary or Greg's suggestion? Okay. So seeing none, I think – of course, look, if we have a breakthrough, if people want to get together behind the scenes and try to work this out and we have a breakthrough, then of course, feel free to send that through to the full working group list. But it seems for the time being, that we have two slightly different proposals trying to answer the same question, and that's where we are.

So I think that probably takes us to question eight, which is on GIs. And this was subject of a lot of discussion. I saw a few e-mails in the last few hours on this. I didn't have a chance to read them, but I wonder if – and I'm losing Zoom – if Claudio or Rebecca may be able to summarize for us the exchanges that have occurred over the course of today and see if that gets us any |

EN

closer to a resolution on this issue or where we might be on it. So if Rebecca or Claudio could maybe pick up and describe for us the recent [inaudible], that might be a good place to start.

REBECCA TUSHNET: Thank you. I'm fine with Claudio's suggested language, the version of it which is reflected in what is on your screen in terms of additional definitions in 3.2.3.

So the core struggle that we're having over this is the question of what it means to be a trademark. So the proposal here says the word must be a trademark and then propose to define trademarks. So there's also been some discussion on the mailing list about trying to do something else, and the concern is, what about these other things where it doesn't say that there are trademarks in their statute?

And I think to me, this is pretty much a nonissue because the examples that I've seen are actually all also registered trademarks somewhere. So I'm not sure that there's actually somebody that we ought to worry about that's unprotected. If they want to use the TMCH, they'll still be eligible to do so.

So the other proposal on the table seems to be Paul Tattersfield's where he's suggesting let's just say "has to be specified in a statute," which currently seem sot be a big part of the problem that Deloitte seems to think that if there's a statute and it allows the [inaudible] of GIs, then they'll just take in whatever GI happens to be actually then as a factual matter protected, which of course is a bad idea because it means there's no idea what might be getting

in, and there's actually no statutory or treaty determination that that particular mark is protected, which is something that we require when it comes to trademark.

So I actually am open to his other idea. I'm not sure it's necessary given that I don't think that there's some unprotected set of non-GIs, non-trademarks that we need to worry about. The thing that I'm not incredibly clear on – and my research is disclosing sort of a patchwork of laws – I actually think there are a bunch of laws across the world that do specify GIs. Not the majority of them, but I think we should probably decide what we think about that.

So if there is a national law, for example there is one about tequila in Mexico, are we cool with that? It's a GI, it is specified in the law. If we're cool with that, then Paul's alternative [lets some] stuff in, we might be fine with that.

If we think that we really do want to keep a separation between GIs and trademarks, then I think my proposal [with] Claudio's rewording does that. There's also possibility we could do Paul's thing and then say "Notwithstanding that GIs still aren't in." But I think we just have to figure out where we are conceptually and match that up with the implementation. So I think that's an overview of what has occurred during the week, and please let me know if there are questions. Thank you.

CLAUDIO DIGANGI: Brian, can I jump in?

BRIAN BECKHAM: Claudio, please go ahead.

CLAUDIO DIGANGI: Yeah. I think Rebecca did a good job of summarizing what we've been struggling with, which is defining the exact language that will implement the policy rules. So I think we're in agreement on the policy rule. I could of course opine on the latter part of what Rebecca stated there with my personal views, but I think it might just open up a can of worms.

So where we've kind of landed to date is that the policy rule is [inaudible] and claims is limited to trademarks, and then in the applicant guidebook, there are a few provisions describing which marks come in. This is what also was the basis of the design mark discussion that we were just having. So we've been working on the language for 3.2.3, and we weren't, I don't think, able to finalize the exact text there.

We've also done clarified some other elements that relate to this issue, so there's the ability of a registry who's based in a jurisdiction, in a country where GIs are protected, that they could set up an ancillary database, and where I believe Rebecca and I both landed on the same page is that from the administrative level, other registries could tap into that, that you wouldn't have to set up separate databases for each registry and have the same record submitted multiple times over and over again, that they could just all use one ancillary database, unless the registry wants to keep it to its own use. So I think that's a change from the current rules, and so that was something we fleshed out, and I think that's basically [inaudible].

So I think we'll have to just decide as a group, do we want to continue working on the language for 3.2.3 or maybe put something up for public comment on it, or ask staff to help us or take some other approach on that particular issue?

BRIAN BECKHAM: Okay. Thank you, Claudio. I think that one way to tackle this maybe – it feels to me that we've sort of landed in agreement and it might be that seeing it in the initial report will affirm that for us, but let me turn to Greg and then Rebecca.

GREG SHATAN: Thanks. Listening to both Rebecca and Claudio, my personal thoughts are that I've come around to the point where I believe 3.24 is probably more trouble than it's worth and we haven't quite figured out positively what's supposed to be under that, because the TMCH operators don't need any definition of the AGB, I believe, to operate ancillary databases. So I'm wondering if we wouldn't just be better off without 3.2.4 unless [somebody's identified a clear] reason why trademarks – and that's what I think is meant by marks, since people often use [that word,] marks, to avoid the idea that some people think that service marks aren't included in the word "trademark."

So I see Paul Tattersfield says 3.2.4 is needed, but again, for what? What are we adding that is a mark that doesn't fit into any of the prior categories, and that yet is a trademark? This could be including all common law marks. Do we want to bring in common law marks? I actually think that's kind of a great idea. But any

mark that isn't part of the RPM. So I guess then we're saying that this is the definition of not what should be included in the clearinghouse but what should be excluded, or what should be included in the ancillary database, and I go back to the point that TMCH-operated ancillary databases I don't believe need any specific permission and they don't have to be limited to marks that constitute intellectual property. They could pretty much run their side hustle as they want and compete with others in that space.

The other thing is that for 3.2.3, I agree with Rebecca that what seems to have happened is that – and the way I look at it – any statutes that seem to create a right that protect a word in some fashion – other than copyright – seems to have been their reading of what 3.2.3 was supposed to include. So bringing in whole new neighboring rights, if you will.

And it's my recollection that was never the intention, it was to deal with a very narrow class of marks which perhaps again more trouble than it's worth, marks that became marks because they were specifically raised in a statute or treaty that gave them that protection, and it may be a very narrow group that doesn't also have trademark protection somewhere in that same area, but again, my primary example is big brothers, big sisters of America, and I believe that's protected by statute, and then within the trademark office, it's more of the kind of negative right, just a warning to trademark examiners not to accept anything that would conflict with this, but that does not actually make it a mark protected by the USPTO, rather, it's by the statute. So that's the example that I was trying to give for that.

EN

So both of these are kind of edge cases. I think 3.2.4 is an off the edge case or over the edge case, and 3.2.3 is not meant to bring in all sorts of things that aren't really marks but that somehow can be protected in some way by something that may look like a mark. We're just getting too expansive here. Thank you.

CLAUDIO DIGANGI: Brian, can I get in the queue at some point?

BRIAN BECKHAM: Yeah. Claudio, I have Rebecca before you, and then you're next.

REBECCA TUSHNET: Just briefly, this wasn't actually discussed over the week, which is why I didn't include it in my summary, but I just want to draw your attention to the fact that current 4.1 of the AGB appears to require that anything run by the TMCH be nonexclusive. And I actually have no particular commitments about that, but I think part of the issue we're facing here is that a lot of this was done in the hypothetical by people who were not – so provisions seem to have gotten scattered around in ways.

And just to be clear, we could leave that alone, we could require all such services to be nonexclusive, we could allow waiver of that. Just so you know what's going on and people can form their own opinions. Thank you.

BRIAN BECKHAM: Thanks, Rebecca. Any other comments? Please, Claudio.

CLAUDIO DIGANGI: Just o respond briefly to Greg's question. I think he answered the question as part of his comments for 3.2.4 with [inaudible] common law marks. So how I understand what 3.2.4 does is that it allows things like common law marks that are not generally – there's a separate provision for marks that are common law marks [validated] by court decision. So if you have a common law mark that's validated by a court decision, you're eligible for sunrise and claims in every new gTLD.

3.2.4 is registry-specific as far as I understand [inaudible] works. So it's not mandatory in sunrise and claims, but if a registry wanted to allow the protection of common law marks, they can under the registry agreement, and they could be recorded in the TMCH under 3.2.4 and then they could be registered, and that registry sunrise period [or claims] notification service. That's what I understand how 3.2.4 works. It's basically a [inaudible] registry-specific RPMs that go beyond the general categories of trademarks to include things like common law marks that are not verified by court decisions. Thank you.

BRIAN BECKHAM: Right. Thanks, Claudio. Just before Jason, if I may, I think that we've all sort of agreed on this, and I'm wondering if maybe one of the things that's sort of holding us back is simply seeing these things grouped together. In other words, if it was clear that – let's pretend that they weren't called 3.2.1 and so on, but if you saw, let's say, bucket A, this is stuff that gets in the clearinghouse and gets access to a sunrise and a claim, bucket B – and this is the

stuff we're talking about now – gets in the clearinghouse because some registries might want to have a specific registration period or they have specific requirements, or what have you, then those don't get access to sunrise and claims.

I wonder if that might help us break through this a little bit, because I think we're all sort of seeing the same thing and possibly just seeing these all kind of grouped together, is kind of holding us back a little bit. Just an idea. Jason?

JASON SCHAEFFER: Thanks, Brian. I think I agree with how you reframed the issue, and that does make some sense and it might be helpful. The other point I want to echo is it seems like we're getting bogged down on this, and the fundamental problem that we have as a group is that there is an issue with how Deloitte is handling the TMCH to begin with, and I don't want to lose sight of that. And we need to really figure out whether they are or not operating within the proper mandate, and I think that there's agreement that they are doing things that are beyond what were intended, but we're struggling on how to deal with that. So when we talk about this policy and this proposal, and now we're talking about expanding further and creating these ancillary options that registries may or may not use, I think we still need to get a handle on how deep the issue is with Deloitte.

And I think I'm happy to let this go to public comment, let's move on, let's get this out there, let's have a robust debate around it. But whether this is a good idea or not is something that should also be viewed in light of whether or not we want Deloitte to have a

monopoly on this, whether or not it's appropriate. These hypotheticals that registries may or may not use something in the future, I'm happy to take offline and talk to Claudio about this more at length, because I am curious to see where this is coming from.

But I think we'll address this issue later when we get to the issue of transparency with respect to Deloitte, because again, everything that we're talking about on all of these questions is we really don't have clear insight into how deep and how much Deloitte is doing, whether it be design marks or whether it be GIs, or whether it be these other issues. So I think it's time to move on, but let's get to the bottom of this. Thank you.

CLAUDIO DIGANGI: Brian, can I respond very briefly?

BRIAN BECKHAM: Sure, Claudio, and then I have Greg and Kathy.

CLAUDIO DIGANGI: I understand what Jason's saying, the lack of data has been this longstanding challenge for working groups as a whole. So I don't think this is a unique case for this particular issue that we're addressing. But just in terms of the way things have been operating, I think Deloitte said that for the statute or treaty provision, they allowed 79 or so records in the database, and they did not parse out whether any of those were GIs or regular trademarks.

EN

But at the 79 point level, I did a calculation and I think it's 0.001% of all the records in the clearinghouse. And that doesn't even mean any of those records were used to register a domain during sunrise. Presumably, they were. But we're talking about really extreme miniscule number of cases, and we don't know whether any GIs – because they said they didn't parse it out, so we don't know whether any were accepted. If you look at their website, it says that they may be submitted and it doesn't clearly say that they will be accepted.

So I just wanted to mention that, that I just think we're really talking about a tiny number of cases, and we don't even know what that is. And then just with the other point that Jason touched upon, the voluntary RPMs have already been part of the process so far, for example Google runs a permanent claims notice period with I believe most all of their new TLDs. So that's always been there, and there's provisions in there now concerning that. What I was just looking to do was to provide more transparency on how those things work and if there's any barriers that are unintended or don't really serve a purpose that we could clarify those, which Rebecca and I did in our proposals.

And again, these are just voluntary things that registries can choose to do, because they may be based in a country where the laws are different than they are in the States, or they may just want to have less registration abuse in their TLD, and these are words that are abusively registered. And they're not subject to the UDRP currently, so someone would have to go [to national] court over one domain name.

So there's a purpose for having that ability for the registry to do that. So I just wanted to mention that. There's a problem in terms of abusive registration, [these] different terms. Thank you.

BRIAN BECKHAM:

Thank you, Claudio. I have Greg and then Kathy, and I want to just maybe ask if Greg and Kathy and others, if the idea of moving the 3.2.4 to a different section and leaving it to the drafting of the initial report, it seems we're all sort of landing in the same area, so I just want to mention that as a possible way forward. Greg, and then Kathy, please.

GREG SHATAN:

Thanks. While I'm not wildly enthusiastic about kind of expanding the reference to ancillary databases in the AGB, it's something I can live with under the circumstances that you described, Brian, which is that it should be clearly separated, both in drafting and in organization from the TMCH and from the definitions of "marks" that go into the TMCH. It should clearly be a completely separate section so that we avoid the confusion here. That's something I'm willing to live with. I don't think we need to – and I think that if we do say that, we need to indicate that this is not an exclusive right of the TMCH, and others could compete in the same marketplace.

And lastly, I think that we'd need to make sure that we do clarify that GIs do not go into the TMCH as GIs. If they are trademark registration, that's another thing and then they go in just like every other trademark registration that is eligible to go in.

And lastly, while I would love – in a certain trademark maximalist sense – to get common law marks into the TMCH, I don't think that was ever our intention, which is why we're so careful about defining both registered marks from registries as well as other ways of creating registered marks. So not really being a trademark maximalist, I don't want to leave that door open for yet another new and exciting misinterpretation of the breadth of the TMCH. Thanks.

BRIAN BECKHAM: Thanks, Greg. Kathy?

KATHY KLEIMAN: Hi. I think I'm in agreement with Greg, but let me try it with my phrasing and see what happens. TMCH is an ambiguous term. Trademark clearinghouse. It is both a service provider and a database. And here I think we're largely talking about the database, criteria for trademark inclusion in clearinghouse, main clearinghouse database.

And we're technical enough to know the difference, so what goes into that main database that is used by the trademark clearinghouse service provider for providing trademark claims notices as well as sunrise period.

And it seems to me what we're doing here is very important, we're clarifying that trademarks go into the main trademark clearinghouse databases, other things go into ancillary databases that can be provided by the TMCH service provider, or that can be

provided by competitive providers, whether it's the registry providing it for themselves or going to another service provider.

So I think we've done a lot of good things today and a lot of important clarifications. So thank you. And thanks to everyone who did so much work over the last two weeks on this, and before that.

BRIAN BECKHAM: Thanks, Kathy. I'm not seeing any other hands and I wasn't sensing a massive disagreement. In fact I think I saw some agreement with the idea of clarifying this at a textual, structural level. So unless there is some disagreement with that idea of moving this forward for purpose of the initial report, then it seems like we've made a little bit of progress on this topic.

Any last thoughts, questions, comments, concerns before we move on to some of the questions that we had parked some time ago that we agreed to come back to? Okay, seeing none, I think I jotted down earlier that the first was – it had to do with questions 12 and 13. Trying to find those quickly here. Let's see.

So Question 12, are there concerns about operational considerations such as costs, reliability, global reach, service diversity and consistency due to the TMCH database being provided by a single provider? If so, how may they be addressed? And Ariel has put in the chat for everyone's benefit a link to the document of all the TMCH charter questions.

So the recommendation from the past was that the only recommended path forward was to narrow this question to cost.

So let me see if there are any – I saw a hand go up and go down. Kathy, please.

KATHY KLEIMAN: Is Maxim on the call? If not, he sent me some material that I just posted before the call, so let me read to you, Brian, if I might. It's a very short e-mail.

So Maxim was the one who raised the issue of operational concerns, and if I remember correctly, what he said was – and he was very urgent in saying it, is that at times, the trademark clearinghouse database has not been available it sounds like at critical periods during sunrise in particular but maybe also during general availability during those first 90 days for trademark claims notices.

But my sense was sunrise hasn't been available during some critical times where some active registration was going on. So he thought about it. He said he'd still like to have some results from staff or from ICANN about availability, about performance of the TMCH in providing that main TMCH database. But he said, "I came to the conclusion that another option is for the single TMCH operator to have a better design of the system which effectively creates two virtual TMCH operators (with the synchronization and proper redundancy.)"

So with my former IT hat on, I think what he's saying is some better design to make sure that there's redundancy in the system so that if the main TMCH database is unavailable from, say, Geneva or wherever Deloitte is operating it from, then a backup

version could be available from Buenos Aires. Same database but it's kind of how you make systems available, especially in the age of DDoS.

I have no objections to that. I think it's frankly a good idea. Julie, I've put this in the chat as well, that main piece just now. And I asked Maxim to post it. So that idea that operational availability, that we should check on it, that we should ensure that it's available during these kind of critical short periods sounds good to me, but it's more implementation detail, I would think. Back to you, Brian. Thanks.

BRIAN BECKHAM: Yeah, thanks, Kathy, for relaying that from Maxim. I think what you said at the end is mostly right. It sounds more of an implementation detail. Frankly, it sounds like it has more to do with the sort of SLAs that would be expected of a provider like a Deloitte or IBM, I don't know to what extent this implicates either of them or the interplay, but it feels to me this is straying a little bit outside policy. The policy is that there should be a trademark clearinghouse that should be accessible for purposes of a sunrise period and so on, and of course, we would normally expect that things would work on an operational front.

It's not immediately clear to me how we would address that at a policy level if there happens to be kind of a momentary breakdown of a service. Certainly, we could opine that for example let's suppose that the trademark clearinghouse- went dark for 24 hours, then you could extend the sunrise periods. But it seems to

me this is less of a policy question, more of an operations and business-oriented question.

So I guess that's my loopy way of saying I'm not sure exactly what we should do. I don't know if there's a specific proposal from Maxim except that the trademark clearinghouse should work. I think it's in that entity's own interest that their services are working. So I don't really know what to do with that in terms of a policy recommendation. And I see Julie's hand coming up in the chat. Maybe she can help us a little bit. Julie.

JULIE HEDLUND: Hi. Thanks, Brian. Just as I noted in the chat, as we requested from everyone with respect to these charter questions, we asked if they had proposals to send these proposals to the list. So we would recommend that Maxim do the same just so that we have it in list archive and in the record, and so it can be captured appropriately with respect to the deliberations on this question. Thank you.

BRIAN BECKHAM: Yeah. Thanks, Julie. That's a very good point. Certainly, people are free to have private conversations, but it's important that we're all in the loop if we're meant to be discussing these questions together.

Kathy, I think you had a new hand.

KATHY KLEIMAN: Yeah, I do, Brian. I don't know why Maxim sent it to me. I did urge him to send it to the list, and I assume when he's available – some of this in the interest of speed. These are busy weeks for everyone. But Brian, to the question that's before us, Q12, I'm not sure – it is a policy question per se. Forgive me, but are there concerns about operational considerations such as cost, reliability, etc. due to the TMCH database being provided by a single provider?

And I think the answer that Maxim shared, not just in the e-mail he sent me but also on the call last week, is that, yes, there are some concerns about the operational considerations about this database that we've created for policy purposes and its availability. So I think we should answer that, yes, and then ask Maxim and any other registries and registrars or anyone with information to fill it in a little more and let Maxim take it from there. But I think the pending answer right now is, yes, there are some issues that have been raised on operational considerations. Thanks.

BRIAN BECKHAM: Okay. Thanks, Kathy. And like you allude to, certainly if people are raising concerns, then it's incumbent on them to also propose solutions, and I understand that Maxim had an idea that you read for us, so maybe we can make sur that this gets on to the list so that everyone, including those working group members that aren't on the call, have a chance to see the concern being raised and the proposal, and we can take it from there.

So that takes us to, I believe, question 13 was the next outstanding question, which is related to this one. It's, are the costs and benefits of the TMCH reasonably proportionate amongst rights holders, registries, registrars, registrants, other members of the community and ICANN? And the early recommendation was to table this question and return to it at the end of the RPM discussion, which is where we find ourselves.

I don't know – apologies to the genesis of this question, but are there any thoughts on the question of the proportionality of the cost of the TMCH between the different participants in the ICANN ecosystem? Claudio, go ahead.

CLAUDIO DIGANGI: I think that if I had to just take a stab at answering, I would probably say the costs are generally distributed in a way that's fair. I remember the registries at one point had a concern that they had to pay a fee – I think it was $5000 – to connect to the TMCH for each registry they operated. And that got resolved, so if there's a portfolio applicant or somebody who had multiple new gTLDs, they didn't have to pay that fee for each different top-level domain that they were operating.

From the IP perspective, I think a lot of the concerns with costs had been around the cost of some of the sunrise services. I'm not sure if there was anything from the INTA study about cost relating to just recording marks in the TMCH as being a huge concern.

So that's just my take on it. I think that with the update that the registries got, the cost allocations might be fine. Thank you.

EN

BRIAN BECKHAM: Thanks, Claudio. Anyone else? I'm just looking at the notes and there was a note about possibly combining this with question 16. I'm just flipping over to see what that is. And it's, again, about the appropriate balance between rights holders and registrants.

Any comments, questions on this? I don't know that we have a concrete proposal. We had agreed earlier to come back to this. I think basically what Claudio was saying is that all the kind of different actors in the chain have some cost involved with this, whether it's linking into the TMCH, whether it's paying to get in, paying for a sunrise.

So no one seems to be off the hook in terms of fees, if you will, and since there was no specific proposal, I think this is one where probably different people have different views on what the costs for them or others should be. Probably it's safe to say that people would like whatever costs there have to be to be less than they are, but frankly, I don't know how we would go about answering this question knowing that all the different actors in the chain do have some costs associated, but that seems to be just sort of par for the course.

I'm not seeing any hands raised, and I'm not aware of any proposals being put forth on the list, so I think probably, this was coming from our charter so this is something that in some fashion will be included in the initial report by way of seeking public comments.

So I think we can probably move on to question 15 which was about the TMCH database confidentiality. And I believe there was a proposal from Michael Karanicolas on this. I understand there were some technical difficulties earlier but it looks like we're back with the Zoom function and I'm assuming that we're pulling up Michael's proposal.

Michael, I think I saw you in the chat earlier. Are you still on the call?

MICHAEL KARANICOLAS: I am here.

BRIAN BECKHAM: Michael, would it make sense – do you want to sort of refresh our memory on what your proposal was? And we can take a queue from there.

MICHAEL KARANICOLAS: Sure. So the proposal is fairly straight forward. I think it doesn't have as many bits and pieces as a lot of the others that we've been talking about, and we had a good kind of introductory discussion on this last week, which was good to hear so much support.

So essentially, it's transitioning the TMCH from a closed database to an open and searchable database in line with the way that trademark databases are handled in the vast majority of

jurisdictions and in line with the basic publicity aspects that are inherent to trademark law.

Again, I think that a lot of this stuff was discussed last week in terms of the basic public interest. I think we got a pretty good reminder just in the last discussion where people were again going back and forth about what is or is not in the trademark clearinghouse, and difficulty in policymaking and oversight that flows from that, just black box and not knowing what's inside of it.

So in addition to those foundational principles to trademark law, as well as ICANN's own inherent interest in promoting transparency, I think it would do a lot to support effective oversight for future processes if there was a clear idea of what's inside it.

As I said, it's a fairly straightforward proposal, so I don't see a huge need to run over all the different aspects of the argument again, but would be happy to chat further. Thanks.

BRIAN BECKHAM: I do see the comment now from Marie. She says, "I went back to check with my members. they still oppose it being open as their choice of what trademarks to put, not put into the TMCH is part of their commercial and/or enforcement strategy."

Michael, I don't know if you wanted to respond to that. I don't see anyone else in the queue. I'm not sure where that leaves us. I think our general kind of way of working was that we wanted to find agreement for recommendations, and if there was disagreement, then those would be more for the initial report.

So I don't know if anyone has any thoughts on the comment from Marie about her members, and I don't know, Michael, if you have any reactions to that.

MICHAEL KARANICOLAS: Yeah. Marie just put in the chat that we went around this a lot last week, and I basically agree with that. I think that we went back and forth a lot. I think that the question then becomes with regards to levels of support to have a recommendation. I don't think that unanimity is necessarily the requirement, so I obviously understand that we're not unanimous, but I heard a lot of support last week, so would be in favor of taking this forward.

BRIAN BECKHAM: Okay. Thanks, Michael. I think this is something that we'll need to discuss with the staff and liaison, how to go about sizing this up. I know there's, as you rightly say, in the ICANN GNSO world, then it's consensus in the GAC for example for consensus advice that's actually unanimity or the lack of objection, the sort of UN definition of consensus.

I do know that there's a designation, strong support with significant opposition. So I guess the test before us is to understand the level of opposition from Marie and her members.

I'm seeing still Greg and Kathy. Maybe before I call on them, I just want to mention we have 14 minutes left on our allotted time, and we did want to reserve a bit of time at the end to talk about the possibility of a survey for the URS and think about the best way forward with everyone on the call here today. So maybe if I could

call on Phil, Greg and Kathy, if I could – sorry to do this – ask you to keep it relatively brief so that we have some time to talk about the URS. Phil?

CLAUDIO DIGANGI: Brian, can I very briefly get in the queue at the very end?

BRIAN BECKHAM: Of course. Phil?

PHIL CORWIN: I'll be brief because I do want the working group to have a chance to talk about the URS individual proposal survey. On this one, we had a good robust discussion last week. I don't know if it narrowed the differences at all. I think it's a legitimate proposal on transparency, but the reasons for opposing it seem legitimate as well. I don't know whether making the database public can ever achieve the level of consensus required for this to be a working group recommendation for the final report, but taking off my co-chair hat, personally I wouldn't oppose putting out this question with proper framing in the initial report to lay out both sides of the argument to get feedback from the community. There may be a way not for complete transparency but for a way to get some reveal when there's a reason for that, which maybe with community feedback we can achieve that. Thank you.

BRIAN BECKHAM: Okay. Thanks, Phil. So that's one idea for a way forward, which is to capture the proposal and then capture the specific concerns or objections around that. Greg, Kathy, and Claudio.

GREG SHATAN: Thanks. Just briefly, I missed last week's call for business reasons. I'm still not in support of this proposal, given it some thought as others have, but at this point, I'm not. And I don't think we can characterize this – actually, [I'll say this rather than do what others may have done, I'll] leave the responsibility to the co-chairs where it lies to determine what the level of support is and then we can challenge that if we disagree with them. But I think the idea of putting it out there with pros and cons may be the way to go. Thank you. Pros and cons of no endorsement.

BRIAN BECKHAM: Okay. That's well noted, Greg. Kathy, please.

KATHY KLEIMAN: Thanks. Very briefly, just that it was a fascinating – and I thought insightful – discussion last week, and it was very interesting cross-community support. What Greg said, what others have said about putting it out there with the pros and cons sounds like a great idea. And I know we need to save time for our next discussion point, so thanks, Brian.

BRIAN BECKHAM: Thanks, Kathy. Claudio?

CLAUDIO DIGANGI: Yeah, so in terms of the level of support, I think that it might be similar – although I'm speculating – to the design mark issue where we're split because I believe all of the members of the working group who are in IPC would not support it. And there's other constituencies that don't as well, such as Marie's.

I would be willing to work with Michael on perhaps finding an alternative solution to get to the heart of it, or at least to maybe get to something that he finds of value as opposed to a result where the status quo remains.

So if Michael's interested in doing that, I would be happy to correspond with him and put forward ideas that might he able to get to the concern that he's trying to address through the proposal.

BRIAN BECKHAM: Okay. Thank you, Claudio. I'm not seeing any other comments or questions on this. We wanted to see what was the best way forward on the URS. And I'm going to see if my co-chairs, Phil or Kathy, or staff, please feel free to jump in here, but just to sort of briefly recap, I think there were 30-odd proposals around the URS, we had a few – I think there were four, maybe five working group sessions devoted to those. They didn't really advance our discussions for purposes of finding agreement on those proposals, so we effectively decided to park those and now we've got the question in front of us whether it's realistic to put out that number of proposals in the initial reports, noting that they didn't have agreement.

EN

So the question was whether we wanted to survey the working group with sort of a thumbs up or thumbs down approach to see if there aren't proposals that we have some chance of coming to agreement for purposes of a recommendation. Otherwise, those would not be in the initial report as a recommendation, they would be somehow captured very succinctly for purposes of public comment. Phil, please.

PHIL CORWIN:

Thank you, Brian. I'll speak to this briefly. All the members of the working group received an e-mail on this a few days ago laying out the co-chairs' ideas on this topic and linking to the survey that staff have prepared. I want to emphasize what we're proposing is a survey, not a poll. There's no predetermined standard for that if a proposal gets X number of objections or X number of support, that is either going to be kept out or put in the initial report.

It really deals with the reality that we've got 31 individual proposals, we decided in Barcelona to put them all in the initial report. In my personal view -and I'd be surprised if there's strong objections – no more than probably a handful of them have any chance of achieving consensus support and making it into the final report.

So the purpose of the survey, we would put it out for a week, give everyone a week to go through it and indicate their support or objection to each of the 31 proposals would be one to refamiliarize the working group members with these 31 proposals, what they're about, because I'm sure few – if any – have looked at them since Barcelona, and second, to kind of take the temperature of the

room and give the working group as a whole some idea of the level of overall support or opposition to any of them, and then be up to the working group whether to stick with its original decision to include all 31 or based upon reviewing and refamiliarizing themselves with the proposals and seeing how their other fellow working group members felt about them to engage in some degree of editing down and putting out a fewer number in the initial report, which in my personal view would have the virtue of putting less of a burden on the community and giving the community more opportunity for more focused comments on the proposals that have a better chance in the long run of making it to the final report.

But the one last thing I'd say is that for this working group, at some point, whether it's now or if we decide to put all 31 out in the official report and ask the community to give serious comments on all 31 – which is quite a large number – at some point, whether it's now or later, we're going to have to take these 31 and say which, if any, have consensus support and can be working group proposals included in the final report. So that work needs to be done whether it's now or later, and I'll be quiet now and turn the floor over to others. Thank you.

BRIAN BECKHAM: Thanks, Phil. I have Rebecca.

REBECCA TUSHNET: Thank you. I really strongly oppose this. I think that a survey is not a discussion. We've seen proposals get refined in discussion and

sometimes closer to agreement. A number of these proposals actually did benefit from some discussion in the past, although it is receding into the waters of memory, I agree.

But I actually think it's fairly unfair to raise this again. We did make a decision. I don't think we should keep a bunch of proposals from the public using a procedure that's very different from the procedure used for other proposals, including individual proposals like the ones that we've discussed here. I think this is a bad way to do things. People can decide what they want to give feedback to. That in and of itself will be a pretty clear message. And I think we will all be able to tell when comments relate to more than one proposal, because at this point, I think we're pretty good at it. Thank you.

BRIAN BECKHAM: Okay. Thanks, Rebecca. Sorry I have to do this, but just to clarify that in fact, it's the very reason you mentioned, which is why we're suggesting that switch, is that the way that we went through the process of reviewing the proposals was, as you say, very different. So that's why they never actually got a full airing and a chance for kind of compromise and agreement. We just sort of all had enough in Barcelona, so unlike some of the TMCH questions, these didn't get to kind of the full benefit of discussion. So that's why we're here.

Michael, please.

MICHAEL KARANICOLAS: Hi. Yeah. I agree with Rebecca, and I think this whole approach is wrong headed. It sounds to me like what we're trying to do is to essentially overturn previous decisions, previous consensus of the working group, and in my mind, in order to –

BRIAN BECKHAM: Okay. Michael, we've been down this – Okay, thank you.

MICHAEL KARANICOLAS: Yes. Thank you. No, we haven't been down this, because I think that it requires strong consensus in the other direction, which does not exist. So I don't think this working group should be pushed down this path without that consensus, and I think this is not a direction that we have agreement on. So I'm not sure why this idea is going forward.

BRIAN BECKHAM: Okay. I think, Michael, Phil articulated the reasons why, because whether we make an effort to refine some of these now or look at them down the road, that's a task that's in front of us as a working group. And just to be clear, the reason we're here again is not because there was consensus to take this approach, it was because there was no decision. So I think we need to just understand the context here. It's not that a decision was taken to throw all these in. A decision was taken not to do any work.

Okay, so Phil has his hand up, then Kathy. I think probably – so I'm sorry, Rebecca, to disagree with the comment in the chat, the survey is not intended to substitute for working group discussion.

It's precisely the opposite. It's to see if there are proposals that people feel there's an appetite to discuss with a view towards an agreed recommendation.

So maybe I can turn over to Phil and Kathy, and it feels like we probably have to pick up this conversation either over the working group e-mail list or on another call. Okay, we're at the top of the hour. I see Rebecca, Kathy and Phil. Let me ask if people want to stay on for a few minutes and discuss this or maybe we park it and discuss it either over e-mail or during another call. I see Kathy's putting next week in the chat. That's fine, that gives us a little bit of time maybe to discuss this with the staff and the council liaison.

So why don't we do that? I think we have to put a pin in this for today. We'll come back to it and see if we have a survey or not. Okay. With that, I think we can call it a day here duly. Ariel, I think we can probably end the call and pick this up next time.

JULIE HEDLUND: Thank you very much, Brian. We will adjourn the call. Thank you all for joining. I hope you have a good morning, afternoon or evening.

ANDREA GLANDON: Thank you. This concludes today's conference. Please remember to disconnect all lines and have a wonderful rest of your day.

EN

[END OF TRANSCRIPTION]