
ICANN Transcription
Review of all Rights Protections Mechanisms (RPMs) and all gTLDs Working Group
Wednesday, 28 August 2019 at 17:00 UTC

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ANDREA GLANDON:

Good morning, good afternoon, and good evening. Welcome to the Review of All Rights Protection Mechanisms in All gTLDs PDP Working Group call held on Wednesday, 28 August 2019, at 17:00 UTC.

In the interest of time, there will be no roll call. Attendance will be taken by the Zoom room. If you are only on the audio bridge, could you please let yourselves be made known now? I do show that we have Scott Austin, Steve Levy, and Rebecca Tushnet on the phone. I believe that is everyone that we have on phone only.

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 will turn it over to Philip Corwin. Please begin.

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PHILIP CORWIN:

Thank you, Andrea. Phil Corwin here chairing today's call. Thanks to all who are participating. A fairly decent turnout given it's the week prior to Labor Day, the last week of what we think of as summer though meteorologically it continues until the third week of September.

So let's start. I'll get to the agenda in a second, but any updates to statements of interest? Hearing none, our agenda today is we're going to begin reviewing open questions. These are charter questions for which proposals had been submitted back when we were working on TMCH about a year and a half ago. The co-chairs had a planning call yesterday.

Just to get it out there, if anyone has submitted a proposal in response to a charter question and wants to update it based on work the working group has done since we left off with the Trademark Clearinghouse or new developments that affect the Clearinghouse, we're going to keep that open for a week for people to amend their proposals. If any member of the working group wants to submit a new proposal based on work we've done in the interim or new developments, that also is open until next week. After that – we don't want to keep things open forever – we will focus on the questions that we have and the proposals that we have in their original form or as amended.

The only other thing I'm going to mention before plunging into the questions and relevant proposals is to note that you all should have received copies last week of correspondence between the co-chairs and Council leadership regarding our baseline default starting point on the Clearinghouse and all the RPMs. They clarified that it is indeed the Applicant Guidebook, the final

version. That doesn't mean we can't by consensus recommend going back to an STI recommendation or coming up with a totally new approach if we're not happy with something in guidebook. It just means that's our starting point.

With that, I'm going to ask staff to bring up the Question 7 and the proposals. If the folks who put in those proposals are on the line, we invite them to speak to their proposals.

Question 7 is a very basic question: "How are design marks currently handled by the TMCH provider?" I believe generally we've learned that Deloitte accepts certain types of design marks, and there are different versions, under the statute or treaty exception to the requirement for being a registered trademark. There has been some prior discussion on this issue, quite a lot of discussion. The question for the working group is not how are things being handled but are we happy with that or do we want to see that changed. And if we want to see it changed, can we coalesce with some decent support at this stage, consensus eventually on a proposal to change that practice?

With that, the first proposal in response to that question is from Kathy Kleiman. I see Kathy is on the line in the room, and she has just unmuted. So I'm going to step back and let Kathy speak to that. While we put in the e-mail ten minutes, I'd encourage all the proponents of responses to all the questions to be as succinct as possible so we can get the maximum amount of review done today and set ourselves up to actually discussing the proposals and making decisions starting at our meeting next week. Today is a meeting to refresh our recollections and key things up for substantive work. So with that, Kathy, please go ahead.

KATHY KLEIMAN: Thanks, Phil. Can you hear me?

PHILIP CORWIN: Hear you fine.

KATHY KLEIMAN: Okay, terrific. Of course, part of what we're talking about here in Q7, at least as I understand it and in light of our e-mail from the Council, is not just how are design marks currently being handled by the TMCH provider but what do the rules say about what marks should go into the Trademark Clearinghouse database?

Actually, with this proposal, which as you know is two years old, I found out happily that one of the major cases that I cite here, a WIPO UDRP decision in the case of Marco Rafeal Sanfilippo vs. Estudio Indigo – and apologies for any mispronunciations – was actually handled by a member of the working group. So unless there's any objection, I'd like to ask Zak Muscovitch to talk about the proposal because I think he can provide a lot more information and insight. Thanks.

ZAK MUSCOVITCH: Phil, is it all right if I make some comments on this?

PHILIP CORWIN: Well, just to clarify. Kathy, are you turning over your presentation to Zak? I'm just trying to understand what's....

KATHY KLEIMAN: Yes, I'm turning over the presentation of this proposal to Zak who I think can provide even more insight and details to some of the material.

PHILIP CORWIN: So you wish to give your time to Zak to speak to your proposal in response to this question?

KATHY KLEIMAN: I do. Thank you.

PHILIP CORWIN: All right, well, sure. Go ahead, Zak.

ZAK MUSCOVITCH: All right, thanks.

PHILIP CORWIN: Again, I'd encourage you to be as succinct as possible so we can get the maximum done today. Thank you.

ZAK MUSCOVITCH: Understood. I'll do my best. I see in the chat just as a preliminary matter there has been a bit of discussion about what's the basis for the introduction of design marks into the Trademark Clearinghouse. Susan Payne, for example, said design marks are

not accepted as statute or treaty pursuant to that section in the Applicant Guidebook ostensibly. And then there's a comment from Mary.

But my assumption is that design marks are being currently admitted into the Trademark Clearinghouse, and I see some problems with that. I do see it as a breach or a violation or at least inconsistent with the current language of the Applicant Guidebook. That Applicant Guidebook speaks of a word mark being the basis for admission.

INTA defines a word mark as the mark includes only common punctuation and diacritical marks and does not include a design element. WIPO defines a word mark as a standard character mark as equivalent in some countries to what is known as a word mark. CIPO, the Canadian Intellectual Property Office, defines a word mark as consisting of words and standard characters without regard to color or font type. The EUIPO defines a word mark as consisting exclusively of words or letters, numerals, and other standard typographical characters or a combination thereof that can be typed.

So if the basis of admission of any kind of graphical marks or figurative marks or mixed marks is the term word mark, I think it's a clear error. I mean, word mark has a well-known meaning as a term of art across the world. It's sometimes referred to as a standard character mark in the U.S. or as a word mark in other places. So if the basis of inclusion is through the word mark category, it's a clear mistake to me. I think the working group should recognize that. It's a mistake if the Trademark

Clearinghouse is defining a word mark to include anything other than a textual mark consisting entirely of text.

In the rationale for Kathy's proposal, she referenced the UDRP case that I was counsel to the registrant on, and it's instructive in a limited way and the way is as follows. The trademark owner had an Argentinian trademark, and the trademark was for the Spanish word *cabañas* meaning roughly a cottage or in Russian a dacha I think, but a cottage.

The trademark was what was considered a mixed mark or a combination mark. It had graphical elements and then it had the word *cabañas* in it. The complainant asserted that it had trademark rights over the word *cabañas* and it was identical or confusingly similar to the corresponding domain name *cabañas.com* with a tilde above the "n" in *cabañas*.

What the panel properly found in that case by reviewing some very basic Argentinian law is that where a mixed or figurative mark contains generic or descriptive terms, the trademark owner under trademark law doesn't have exclusivity over those terms, has no rights in those descriptive or generic terms.

So for our purposes, if the Trademark Clearinghouse is admitting any kind of figurative or combined mark and pulling the words out of it, at least in some jurisdictions – Argentina is definitely one and Canada is another one where unlike the U.S. there's no disclaimer required – a trademark registrant could effectively be getting priority through Sunrise or sending out notices to registrants about their purported trademark over words that they really have no rights to at law.

That's the problem that I see. So if we're leaving it to a firm of essentially accountants at Deloitte to determine what's the predominant element or whether within the particular jurisdiction there are rights in these terms within the composite mark or whether these words are truly descriptive or generic under a particular [national law], I think that's too much for Deloitte to be asked. But in any event, I think that I'd hope and expect that we could agree that currently the terminology is not being followed which requires only word marks to be admitted. Thank you.

PHILIP CORWIN:

Thank you, Zak. I note there were a number of questions raised during your presentation. I think before we proceed to Greg and his proposal and response to this charter question I wonder if you could respond briefly to some of those questions. The first one is from Paul McGrady asking, "What was the case cited, and what is the connection to the Trademark Clearinghouse Applicant Guidebook?" He didn't quite catch the connection. Could you speak briefly to that? Not hearing you, Zak.

ZAK MUSCOVITCH:

Right, mute was on. The case cited is in the rationale under the proposal in the PDF document that was circulated. When I finish speaking, I could also put the actual link to the WIPO case in the text. So that's the first question. And what's its connection to the TMCH? I explain that it's illustrative of how a mark holder, in at least Argentina as an example, could have no rights in the words within a composite mark. And therefore, if Deloitte is pulling out words from a composite mark registered in Argentina that the

registrant has no rights to the constituent words, it would be affording that trademark registrant rights that it doesn't even have in law. That's the explanation.

PHILIP CORWIN:

Okay, thanks, Zak. Greg made a comment that word mark doesn't mean plain text. I'm not going to call on you for that because Greg's about to speak after we finish this. Michael Graham asked, "If we accept that design and stylized trademarks are outside the scope of the Clearinghouse registration under the Applicant Guidebook, can we then open discussion of whether and how such trademarks should be included in the scope and how can we do so?"

Michael, next week when we get to debating what we should do about the apparent situation where Deloitte is accepting marks beyond what is permitted in the guidebook, of course we can discuss whether that's proper and whether we should change the guidebook to explicitly permit it or whether we should push back and tell Deloitte to stop doing that. So that will be in order when we get to substantive discussion of the charter question and how to respond to it.

Another comment from Greg. I'm going to let him speak to that in a minute when he speaks. Another one from Paul McGrady. I think you already covered that, Zak, but were you counsel in that UDRP, that WIPO case?

ZAK MUSCOVITCH: Yes. I believe I said in my remarks that I was counsel to the registrant.

PHILIP CORWIN: Okay. So let me see. I'm just reading the other comments. All right, a lot of comments here. That's good. Everyone is engaged.

ZAK MUSCOVITCH: It's a fun topic.

PHILIP CORWIN: Yes. Yes, it's a relative cottage industry apparently or a dacha industry. And with that, I'm going to thank Zak for his comments and ask Greg Shatan to take himself off mute and speak to his proposed response to the charter question and what we found out about Deloitte's current practice in their operation of the Trademark Clearinghouse. Greg, I still see you on mute. Can you unmute and speak succinctly to your proposal?

ANDREA GLANDON: Phil, I'll note that Susan Payne has had her hand up for a bit. And also, I think Greg had indicated he might not be able to go on audio at this moment. But there is a hand up from Susan.

PHILIP CORWIN: Okay, yeah, Susan, go ahead. But I just want to make clear that we're not going to be really [debating]. We want to tee up these charter question proposals today. We don't want to get into a

substantive debate about what to do because we want to cover as many questions and proposals as possible. So with that caveat, please go ahead.

SUSAN PAYNE:

Yes, thanks, Phil. Actually, it's not really on the particular proposal, per se. It's just a slight feeling of caution about treating the Applicant Guidebook as the be all and end all. The Applicant Guidebook was developed, as we all know, over a series of public comments and so on. But I don't think you can entirely view it as the end of the line.

There were certain – I believe there were further developments after that. So for example, if you look in the Applicant Guidebook, you don't see some of the RPMs that were introduced referred to at all, but they were developed subsequently and adopted after community input, input from the GAC.

So, for example, something like the PLUS-50, there's not a reference to the trademark PLUS-50 as far as I know in the Applicant Guidebook. But I don't think we're suggesting that was not something that was properly adopted. So I don't know what the legislative history was on this particular provision relating to what was finally adopted by the Trademark Clearinghouse for acceptance in the TMCH, so I just wanted to express a note of caution about us assuming that the final word is the AGB and that nothing happened thereafter.

PHILIP CORWIN: Yeah, thank you for that comment, Susan. I saw that comment also raised by your colleague, Jeff Neuman. I am aware there are certain things that both new TLD operators and ICANN contractors have to abide by that were developed after the final language of the guidebook. I don't want to get into a deep discussion of that now other than acknowledging that. But do you know of anything in that category applicable to the Clearinghouse operation generally and design marks specifically? Since that's the subject we're discussing right now.

SUSAN PAYNE: No. I think that's what I'm saying. I'm not aware. I don't know if there is or there isn't. So I'm just expressing a note of caution that this assumption that if something isn't exactly as people think it should be as per written in the AGB, that wasn't because of later development, I think perhaps we need a bit more clarity on that.

PHILIP CORWIN: Okay, well, thank you. Certainly, if we find something relevant to the Clearinghouse that's beyond the guidebook that happened subsequently, we'll take notice of that and decide what to do with it. But we don't know of anything on this question right now, the design mark question.

What is – I'm not seeing any other hands up. Is Greg able to speak at this point? I'm assuming not because I'm not hearing Greg and I still see his microphone muted. So, Greg, if at any point during this call you're able to speak to your proposal, we certainly will yield the floor to you. If not, we can hear from you

hopefully next week when we get into substantive discussion of this charter question and proposed responses. I see Mary's hand up. Go ahead, Mary.

MARY WONG:

Thank you, Phil. I did put a comment in the chat from the staff that responded to Susan's comment which, as you acknowledge, is a more general one. It simply says that our understanding from the Council leadership is that in their response to the co-chairs of this group they were answering the baseline question which is what is the starting point. They did not mean to exclude subsequent implementation steps in terms of what this group should be considering.

In terms of your specific question, Phil, as to the relationship to design marks, staff is trying to track down the exact chronology of the changes, but we believe that the change from the language that in earlier versions of the AGB was text mark to become word marks happened around late 2010 or early 2011. So we can continue to look for any further explanations, comments, and analyses around that, but in terms of when that happened that would be the timeframe. Thank you.

PHILIP CORWIN:

Okay, thank you for those further clarifications, Mary. I'm noting that in the chat – and everyone can read these – there are comments from George N. (I'm cautious about trying to read your full last name and mangling it) and Brian Beckham. I think those comments are more in the – George suggests a limited exception

that would allow some design marks, word text portion with designs in. Brian is saying that he thinks Deloitte's interpretation was reasonable. I think those go to substantive debate on the question, and again we're going to get into that on the next call.

Paul McGrady is noting that he has to drop off at this point and now that he's liaison he doesn't feel comfortable advocating for his proposal but hopes that another working group member might take up the baton and speak in favor of it. Rebecca also has a response to Brian.

I'm going to hold all that debate for next week. Right now we're just reviewing the charter questions and what proposals we've seen on them, and we're going to get into what's clearly going to be a lively and well-informed debate on the next call as to whether Deloitte is in the wrong, whether we should accommodate what they're doing, or whether we should push back and enforce the current rule if that's the view of what it means and/or change the rule in some other direction.

So with Greg unable to speak to his proposal on Question 7, I think that would bring us to Question 8 where we have proposals from Paul McGrady who has just dropped off but hopes someone else can speak to his proposal, and one from Kathy, one from Jonathan Agmon (I'm not sure if he's with us today), and one by Claudio di Gangi. Is Claudio with us on the phone today?

ANDREA GLANDON: No, Claudio is not on the line.

PHILIP CORWIN:

Okay, so we've got Kathy here. Maybe someone will speak in favor of Paul's proposal. Question 8 is on the ever controversial topic of geographic indicators: "How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?" I think this is the subject I misspoke on in the prior, and this is the one the statute or treaty exception comes into play.

But with that, the question is, what is Deloitte doing with geographical indications? I believe they're – what are they doing here? Okay, so Deloitte is – the guidelines at least say if it's a registered trademark, it gets in. If it's a court validated mark, it gets in. And if it's a mark protected by statute or treaty, it gets in if the statute or treaty is in effect at the time the GI is submitted to the Clearinghouse.

We do have Paul's proposal on this. I'm going to read it out, summarize it briefly. Paul's view is: "Unless a GI is the subject of a national trademark registration, it should not be in the future, and should not have been in the past, included in the TMCH. For any GIs that are not the subject of a national trademark registration which are currently lodged in the TMCH, such GIs should not be renewed in the TMCH upon expiration. For any GIs that are currently in the TMCH that are the subject of a national trademark registration, such GIs should be subject to the same use requirements as traditional trademarks as applied to Sunrise registrations." He thinks if anybody wants to go beyond his proposal, that should be looked at separately from the work of this working group.

I'm not being a proponent of Paul's, but in fairness and in respect to his expertise, I've now gone through it. Did anyone else want to speak briefly in favor of Paul's proposal before I call on Kathy to discuss her proposal? I see Greg's hand up. Greg, does that mean you're now able to speak?

GREG SHATAN: I'm now able to speak. The gag has been taken off. Or rather I should say the other call I was on has now ended. I wanted to speak to Paul's proposal first, and then we can let that discussion complete and then with can come back to my proposal.

PHILIP CORWIN: Yeah, that's a good approach, Greg. We'll dispose of Question 8 and then circle back to your proposal on 7. So go ahead and speak to both.

GREG SHATAN: I support Paul's proposal. I was involved in the drafting of the language that ultimately led to the TMCH, and the language that has – it's a clear case of misinterpretation of the statute or treaty language that has somehow allowed GIs not registered as marks to be admitted to TMCH. This was really intended to address an entirely different scenario of marks that literally the mark itself is protected by statute such as Big Brothers is protected by a Congressional statute and then recognized after that by the USPTO. That was what this was intended to be.

In some cases, those are not actually registered in the PTO. They exist as creatures of statute. But this was not intended to take any statute that would protect something that looks like a word and make it a trademark statute. So the substantive issue whether GIs should be protected is an entirely separate issue from what was intended with regard to marks protected by statute or treaty, what that meant for GIs. And to my mind, it's stunningly clear that this was not intended to be there. This is just a complete mistake. Thanks.

PHILIP CORWIN:

Thank you, Greg. To summarize, your view is that Deloitte has gone too far and we need to be clearer in somewhat restricting their current practice.

GREG SHATAN:

I would not say that they went too far. I would say that they completely opened up a line of interpretation that was completely not intended. This is not a matter of degree; it's a matter of kind. This is just a complete – it never should have started. They should not have gone one nano millimeter or whatever the heck the thing would be really small on this path. It was misbegotten from the second it started. If there are GIs that are protected as trademarks, they're trademarks. Otherwise, they're not and they should get the heck out of the TMCH. Thanks.

PHILIP CORWIN: Okay, that's a very clear view, Greg. Now, we're going to move on and I'm going to call on Kathy to discuss her proposal and response to this charter question.

KATHY KLEIMAN: Yes, can you hear me, Phil?

PHILIP CORWIN: Yes, we can.

KATHY KLEIMAN: Terrific. Hi, everybody. Of course, these proposals were submitted about two years ago, and I want to follow up. This is a point of rare and valuable agreement. I want to support what Greg said that the Trademark Clearinghouse was not intended to have non-trademark marks in it.

To that end, I quote – and I know it's persuasive – but I quote the special trademark issues review team and the agreement, unanimous consensus across all the stakeholders that were involved in 1.1 under Trademark Clearinghouse the name of the rights protection mechanism should be the “Trademark Clearinghouse” to signify that only trademarks are to be included in the database. So I'm in great agreement with Paul's proposal.

What I wanted to point out also is that this has led to confusion. My proposal shares that everyone seems to interpret differently what's allowed into the Applicant Guidebook. Are these marks expressly protected by treaty like the Olympics? Or are they

categories or organizations like International Governmental Organizations? Or are they geographical indications which are expressly not trademarks generally?

So unfortunately, Deloitte will not explain to us how they interpret this section. And what they are accepting into the Trademark Clearinghouse database, of course, we can't see it. So I would second what Greg just said that the acceptance of marks protected by statute or treaty appears to be a direct violation of what we the GNSO intended to have in the Trademark Clearinghouse. Thank you.

PHILIP CORWIN:

Thank you, Kathy. I'm just going to ask one question. I'm not advocating, but I note when you quote from the STI the STI said by these adopted rules anything that is not a trademark cannot be entered into the main TMCH database but may be segregated into another "ancillary database." Given that GIs are not viewed favorably in some corners of the world and are viewed very favorably and given protection in other parts of the world, do you have a personal view on whether we should consider such an ancillary database for their protection? Or do you think that's a territory we shouldn't get into?

KATHY KLEIMAN:

That's a good question. The ancillary database is I think, and maybe Greg can help me if I'm wrong, we did say and I don't know if they're doing this that "The TC service provider" – which we now call the TMCH service provider – "should be required to

maintain a separate” – sorry, I’m thinking out loud as I read this – “TC database, and may not store any data in the [main] TC database related to its provision of ancillary services, if any.”

If I remember correctly, what this was about was if you were going to have a .pizza and you wanted to ask the Trademark Clearinghouse voluntarily just like in the old days pre the first round when every applicant, every new registry could collect trademarks on their own but they could collect other marks too.

So if you’re Joe’s Pizza or Jerry’s Pizza, you may not qualify for a trademark if Joe or Jerry. But still .pizza may want to put you in an ancillary database and protect you in some kind of special Sunrise plus round. I don’t know if that makes sense, but the ancillary databases were thought of at the time if I remember correctly for specific registries that wanted to provide additional protections in other types of Sunrise type periods for local trademark holders or for special trademark holders or for special mark holders. Thank you.

PHILIP CORWIN: Okay, thank you, Kathy. I see hands up from Greg and Martin. I’m going to call on Greg first and then Martin. Greg?

GREG SHATAN: Just briefly, I agree with Kathy’s recollection here. With regard to GIs, I think that’s a whole separate discussion that needs to start from ground zero. I’m not ruling it out entirely, but it’s hardly an appendage or an implementation technicality of the TMCH. It’s a completely new line of inquiry. Thanks.

PHILIP CORWIN: Thank you, Greg. Martin, please go ahead.

MARTIN SILVA: Can you hear me, guys?

PHILIP CORWIN: Yes, we can.

MARTIN SILVA: Thank you very much. Just to point out what I said in the chat. I think in this discussion a lot of the things can be solved just by having the manager of the Trademark Clearinghouse having a correct assessment of the right that it's accepting. It's obvious that we're going to have different jurisdictions with different grades and colors of whether a trademark is protected and how and what documents does it present, etc. I think that's the real place where you can make the difference.

It is the manager that is responsible to give no further protection than the one with the right gives. If you just have the rights for the word, that's good. If you just have the rights for the design which means that in your jurisdiction, the text, the word as a concept is not protected, then it says, I'm sorry, your trademark is not good enough for a string protection. So I think part of this debate goes to that. What is a manager accepting? I think the rules are clear. They cannot accept something that is not protected. Thanks.

PHILIP CORWIN:

Okay, thank you, Martin. I see a comment from Susan Payne directed to Kathy. In the interest of time, I'm going to invite Kathy to respond in the chat right now to that rather than taking time for a verbal response.

I'm going to just note that we have two other proposals on this. The proponents are not on today's call. I'm going to briefly speak to them. Jonathan Agmon said that GIs when registered serve as collective trademarks. I don't know if he means registered in a trademark registration or some other GI registration. He refers in the next sentence to both possibilities. But he's saying that if it's registered in a GI database in a national GI registration, it should be included in the TMCH. But if it's not registered either as a trademark or a GI, it wouldn't be eligible. Of course, if it's not registered in something, I don't know what legal effect it would have anyway. But that's the sum of his proposal. He would allow in apparently GIs that are in the nation in which they're registered or accepted as a geographic indication registration.

Claudio who is usually with us and hopefully will be on the next call said that we should consider this in our Sunrise and claims services. Well, we've been through that. I don't think it came up I think in that phase. We said we'll deal with it when we get to the TMCH. And then withhold final consideration of the current Trademark Clearinghouse proposals until we conclude the policy review of the new gTLD RPMs. I'm not sure what Claudio meant by that. We've concluded our review of all the other RPMs other than the TMCH at this point, and that is our Phase 1 work. So I'm going to just bookmark that one, and hopefully Claudio will be with

us on a future call when we're still discussing this subject and can speak to his proposal.

Let me just check the chat here and hands. Martin, is that an old hand? Is that your old hand from the comment you just made? If it is....

MARTIN SILVA: It was an old hand. I can quickly respond [inaudible].

PHILIP CORWIN: Yeah, go ahead.

MARTIN SILVA: Basically saying that it's not that we are here [inaudible] consumer protection. That's why maybe we want to give a valid privilege to designs because people could also associate a logo that doesn't have a right for the word but people associate that word with the trademark. We are protecting consumers by protecting trademarks, and we have to really stay in that realm of trademarks. The Trademark Clearinghouse cannot give privileges to people that don't have a trademark that allows that privilege. Thanks.

PHILIP CORWIN: Okay, thank you, Martin. Just quickly reviewing the chat. Rebecca was wondering if we have GI proponents here. I'm not sure if we do or not. We certainly have broad membership, but I know it's a controversial issue. It sparked debates in the GAC in the past.

Mary has noted that when we previously polled the group in 2017 on this, there was a little support within the working group for including GIs as eligible for registration in the Clearinghouse. Mary suggested an approach in the chat which I think is a positive one. What's the correct scope of the current rule? Should this be continued, limited, or expanded for the next round? If expanded, should it include geographic indicators as GIs? Which I assume means GIs that are not registered trademarks. That's the debate we'll get into when we return to this question for substantive debate.

Martin, I think that's an old hand now for sure, so please put it down so I don't get confused. We're going to move on to Question 10. I note we're about halfway through our time for today, so we're well on the way to revealing a lot of these questions and the relevant proposals. Question 10, now this is a big one and one that I'm sure there will be some controversy about, which is: "Should the TMCH matching rules be retained, modified, or expanded, e.g., to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?"

I think we touched on this question somewhat, and staff can maybe fill in on this, in particular when we considered generation of trademark claims and we agreed that for trademark claims they should only be generated by exact matches to a registered mark and not to variations. But this is a somewhat different question as to whether anything other than the exact trademark should be permitted to be registered in the Clearinghouse as I interpret it.

We have a proposal from Michael Graham in response to this question, and Michael is on our call today. So I will invite Michael

to tee up and present his proposal. Again, we're not going to get into full-fledged debate on this now. We're going to tee it up and then return to it within the next few weeks and have a good lively debate on this important question. Michael, were you ready to speak to your proposal?

MICHAEL GRAHAM:

I can speak briefly. I think it is clear in its terms as it's expressed here. The intent of this is to enable both trademark owners and more importantly applicants for new domain names the ability to be aware of the potential for conflict when the domain name that they are applying for contains both the exact registered trademark and some additional term. That's really the general intent of this.

I know that in discussions that we've had previously, the really focus has been on the possibility of the rule subsuming the limitation. That is, a single or a dual letter trademark or say a trademark that The Ohio State University if they were allowed to register "The" (which is doubtful) would then be able to – that would then show up whenever anyone applied for a mark not only that had the word "the" in it but that had a construction of that like "theater" and such.

So it may not be a perfect proposal, but it addresses the fact that a majority of domain names that are challenged are either typo squats or are combinations of exact trademark plus something. From my experience, knowing that there is a potential for a conflict or for a challenge down the pike would prevent an applicant for a domain name from going too far in their planning or in their

application without knowing that and being able to figure that in to whether or not they wanted to continue.

PHILIP CORWIN: Okay, thank you, Michael. I'm going to comment in a moment, but Ariel has her hand up so I'm going to call on Ariel.

ARIEL LIANG: Thanks, Phil. Staff just wants to remind the working group that the working group recently accepted the Sunrise and Trademark Claims sub team's recommendation that the current identical match and exact match requirements for Sunrise registration and trademark claims service be retained. So staff is wondering whether there's any further need to discuss this topic and also the proposal. Whether the status quo recommendation from these two sub teams override this discussion. So we just want to refresh the working group's memory on this.

PHILIP CORWIN: Yeah, thank you, Ariel. Yeah, I was in fact going to comment that I was wondering whether the precise proposal Michael had put here which is that the rule should be revise to require claims notices to be issued not only as an exact string match but also for any domains that include anywhere in the string the exact match to the trademark, I'm not sure that's still germane.

But as I said at the beginning of the call, we are based upon developments since these proposals were submitted a year and a half ago allowing until next week proponents to revise it. So in this

chair's view, speaking only for myself, Michael, if you wanted to revise it to propose some ability to register things other than exact matches, that would seem to be in order. Then the exact match to what had been registered would be what was generating the claims notice.

As to your second proposal that the claims service and registration program should apply to legacy TLDs, that is in order under our general charter mandate to recommend whether we thought any of the RPMs should become consensus policy applicable to legacy TLDs. Of course, the generation of claims notice is something that's only required for a limited time at the opening of general availability for a new TLD. So if we were going to consider it becoming a consensus policy, it seems to me at least we'd have to change that part as well. So those are my comments on your proposal, Michael.

I think that, okay, that wraps up discussion of proposals. But we're going to come back to Greg in a minute and let him speak to his Question 7 proposal. But before then, there are hands up from Martin and Rebecca. I'm not sure if that's an old hand from Martin or a new one. I'm going to call on Rebecca first. She hasn't spoken yet. Martin's hand just disappeared. Rebecca, please go ahead.

REBECCA TUSHNET:

So I appreciate staff's and your comments, Phil, because it sounds a lot like something we've actually thought about to death. I appreciate the idea of proposing something new. I just anticipate that the exact same problems are going to come up again if

something is not in trademark PLUS-50, which is of course already part of the system. So I just hope that any proposals will actually be new matter rather than something we've been through a bunch. Thank you.

PHILIP CORWIN: You're welcome, Rebecca. I already made clear that if Michael wants to revise his proposals somewhat, to take into consideration the decisions we made on trademark claims. That's within his rights, within the rights of all the proponents to revise their proposals if they want to get something in by next week. And if any other working group member wants to submit a proposal on these questions based upon developments since we closed out our prior TMCH discussion, that is also in order for the coming week.

With that, Greg, are you now in position to speak to your proposal on Question 7, which is the design marks question?

GREG SHATAN: I am, thank you.

PHILIP CORWIN: Go ahead.

GREG SHATAN: First, I'd like to say that I don't think it's correct to refer to this as a design mark question because I think that a lot of what is being discussed here are not design marks as such. Stylized word

marks where there is a font or a color used in connection with text, I do not consider that to be a design mark.

But in any case, the proposal here is to try to memorialize I think what has been discussed in a number of ways which is that if there is not in fact any right to the protection of the words, that this provides a path forward or at least it provides the ability to state that a mark that there is protection attached to the words in the mark.

So that the proposal itself was that any applicant would need to include a sworn statement that the trademark registration doesn't include a disclaimer as to any portion of the mark or if there's any kind of disclaimer – it could be a disclaimer as to color – that the text portion of the mark is not disclaimed in its entirety. Of course, there are times when various words are disclaimed, but the mark as a whole is fully protected.

If the text mark is fully disclaimed, then that mark – if you want to call it that – is not eligible for registration in the Clearinghouse. Where there 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 the recorded name as long as the name of the trademark includes characters and the characters are included in the same order in which they appear in the mark.

So this gets to issues of the transliteration if you will between marks and strings. I know transliteration is not quite the right word, and another group wasted about three weeks talking about that. But in any case, I think the idea is to try to disprove or to more

clearly mark the boundary between protectable and nonprotected matter.

Now I see 2 and 3 up here. Were these also part of my proposal? It has been so long. I'll take that as a yes.

PHILIP CORWIN: Yes, sorry, Greg, but they do appear to be part of your proposal. Refreshing your memory.

GREG SHATAN: Yes, indeed. Refreshing perhaps. So again here, this is kind of a statement of how the guidelines themselves should be revised. What previously was expressed was more the rationale, and so this is just a statement that marks where all textual elements are disclaimed and as such are only protectable as part of the entire composite mark should not be included in the TMCH and that new grounds to the challenge procedure be added to determine whether the underlying trademark registration was obtained in bad faith as a pretext solely to obtain a Sunrise registration.

That's kind of off on a completely different tangent, but it goes to a lot of the issues of what we're talking about in terms of gaming and what appear to be some fairly naked schemes to obtain marks solely for that purpose. So that's also an attempt to try to close the gaming gap more specifically without throwing an entire load of babies out with the bathwater. Thank you.

PHILIP CORWIN:

Thank you, Greg, for taking us through that. Let me say now I don't see any hands up. Let me just review the text. We're now at about the one-hour mark. We have another 30 minutes or so if we want to use it. So let me just ask the group for a quick survey. We have teed up the three open questions and reviewed the proposals relevant to them. We could stop now and start debate next week, or we could actually start substantive discussion on Question 7 for the next 30 minutes.

Could I ask folks to either by the yes or no buttons to indicate whether you'd want. Yes would be let's start having substantive discussion on Question 7 on the remaining time on this call. No would be let's defer it and start that next week. Can I see some indication from the group what your preference is?

All right, so far I'm seeing mostly – to the extent I'm seeing marks, I'm seeing noes. Seeing now one yes. I'm going to give this another 30 seconds for people to indicate their preference. If there continues to be a predominance of noes, we're going to give you back 30 minutes of your life and start substantive discussion on Question 7 next week. Greg indicates he has to go. So far, I'm seeing two yeses and quite a few noes. Julie says 11 noes and 2 yeses, and a lot of people abstaining.

LORI SCHULMAN:

Phil, I don't have a hand but I'm a no vote. I apologize for interrupting.

PHILIP CORWIN:

Okay, Lori. Yeah, so I think in view of the view of the group and in view of the fact that we're going to give proponents of proposals until the next call to revise them if they wish to or for other folks to submit proposals on these questions if they believe there's been something we've unearthed in the last year and a half or some new development that is a basis for doing so, probably the best thing to do is to say we've had a good background discussion of the questions that are open on the Trademark Clearinghouse and the proposals that will be the starting point for debate, emphasizing that where we wind up in terms of whether we can agree with wide support to some answer to these questions that would alter the Applicant Guidebook and the current rules remains to be seen. We're not locked into the proposals. The working group as a whole can go in any direction it wants where there's broad support.

We're going to thank everyone for their participation today. And for those in the U.S., have a very restful Labor Day weekend and get the rest you need to return to this discussion with full focus and energy one week from today when we're going to get into substantive discussion and decision-making on these open charter questions relating to the Clearinghouse.

With that, I'm going to thank everyone for their participation and end the call. Anything further from staff before I end the call? Okay, so we're on next Wednesday, same time. And staff will send out a notice to remind you with the agenda which will be I believe we're going to start with Question 7 and go through the questions in order for substantive debate.

Thanks again. Have a great weekend. Bye now.

[END OF TRANSCRIPTION]