

**ICANN
Transcription
Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working Group call
Wednesday, 14 September 2016 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. The audio is also available at: <http://audio.icann.org/gnso/gnso-rpm-review-14sep16-en.mp3>

Attendance of the call is posted on agenda wiki page: <https://community.icann.org/x/jBysAw>

The recordings and transcriptions of the calls are posted on the GNSO Master Calendar page <http://gnso.icann.org/en/group-activities/calendar>

Coordinator: The recordings have started.

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

In the interest of time, there will be no roll call as we have quite a few participants. Attendance will be taken via the Adobe Connect room so if you are only on the audio bridge could you please let yourselves be known now? And, Brian, again we have you noted on the audio only.

Vaibhav Aggarwal: This is Vaibhav Aggarwal from New Delhi.

Terri Agnew: Thank you. And we have you noted as well. Hearing no more names, I would like to remind all to please state your name before speaking for transcription purposes. And to please keep your phones and microphones on mute when not speaking to avoid any background noise. With this, I'll turn it back over to Kathy Kleiman. Please begin.

Kathy Kleiman: Hi, everybody. This is Kathy Kleiman. I am chairing today's meeting. And we have regrets from both cochairs, Phil Corwin and J. Scott Evans, so we'll be doing this together and then briefing them about how the meeting goes, but they both send their regrets.

And I want to thank everyone for coming and note that there will be people who we hope will be listening to the recording because there are members, of course, of our working group who are up on - at the US Senate right now listening to perhaps participating in the hearing that's taking place at the US Senate.

So as promised, today begins Section 2 of our work in Phase 1. We're beginning our review of the trademark clearinghouse, the second part of our review on the new gTLD rights protection mechanisms. Now this doesn't mean that our work on the Section 1 on the PDDRP is finished. As you know, we have questions out to PDDRP providers; we have questions out to ICANN Compliance, and to the supporting organizations and advisory committees.

And I'm going to ask if staff for next week, David, if maybe you can provide us with a quick dashboard next week of - where those answers are coming back, who we've gotten answers from and where we can find those easily so that people can remind their SOs and ACs what's going on and of the deadlines and also just give us a sense of when we might be returning to the PDDRP to finish up our discussion.

But for now, we've reached the end of what we can do in the PDDRP until we hear back from those questions. So it seems a good time to go on to the

trademark clearinghouse, actually Terri, let's go back to the initial slide. So what I'm going to do is talk about what we're going to be doing for the next three weeks, which is really - it's really we're trying to set up a methodology and how we're going to approach the next six months because six months is really what we've scheduled for the review that's about to take place of the trademark clearinghouse and the sunrise period and the trademark claims notice process.

And we thought it would make sense to do a more in depth overview than we did when we were starting the working group really looking at the trademark clearinghouse, the sunrise period and the trademark claims notice. And in doing that, we found that there's a lot of material, too much to cover in one hour. So we're dividing it up into three sections over the next three weeks. And at the end of each section you'll see a number of questions.

These questions come from our charter, they come from our outreach section in Helsinki. And one of the key questions for us now going forward is which of these questions can we take on? Which ones make sense? Which ones apply? Are they complete? Do we need more questions? Are they redundant? Can we consolidate them? How do we group them and in what order do we want to address them? We don't have to come up with all those answers today but that's the process in which we're engaged to map out the next six months.

So and I am going to apologize ahead of time. I try not to do most of the talking, but today I've been asked to do the presentation. And so I will be doing a lot of talking. To staff I ask if I don't see a hand, if somebody is trying to break in and I don't see it please let me know. And we can stop wherever people want.

But we'll have about half an hour at the end for discussion. We should have a lot of time at the end to discuss the charter questions and anything else that people want to talk about with the trademark clearinghouse. The other thing

is I want to note that there are people much more expert than I am in our working group in attendance today on the trademark clearinghouse.

So when there are questions that come up if there are substantive questions, please feel free to break in and say, you know, that you'd like to provide that information because there are already people in the working group who have been very helpful to us as we were preparing these slides. So experts, you know, please let us know and please feel free to answer some of the questions that might be raised at the end.

But our goal today is really not to answer but to explore the trademark clearinghouse in the questions we've been given by the community as part of our review process.

So here we have the scope of the presentation. The overview of the trademark clearinghouse. How it works, what it is. And specifically we're going to talk about the verification process. This is the process of Deloitte. We'll talk a little bit about trademark plus 50. And then we're going to talk about not so much our questions, although we can certainly do that, but the charter questions.

So now, excuse me, this is the slide you've seen before. This was in our first overview, which is the slide of the trademark clearinghouse, what it is. Its global database of verified trademark information that supports the services of sunrise registrations and trademark claims and verifies the trademark data received. It does not adjudicate or create trademark rights. And we're going to talk about this in more detail shortly.

And there are some statistics on submissions verified and other details but overall there are 37,000 marks from 121 jurisdictions that have been submitted to the trademark clearinghouse since it opened up.

Now this slide is very important. We're on Slide 4 for whoever is following in a different medium. This is the overview of the trademark clearinghouse functions. Most of which we will not be addressing today. But it's a very important slide because it's really one of the few breakdowns of different types of functions that the cochairs have ever seen. So we're creating it.

And let me just go through the whole umbrella of the trademark clearinghouse, which is that, you know, there are trademark rights owners, holders, you know, the trademark owners who take their trademarks to Deloitte right now under contract to ICANN, for verification services. And that's what we're going to be talking about today.

Once verified and accepted, they go into the TMCH database and then are used for technical functions currently administered by IBM under contract to ICANN for the sunrise period, for the trademark claims services and then we're calling them private purposes, but like the Donuts protected marks list and other types of protected marks lists that are - there are other types of functions that use the trademark clearinghouse database, and in fact the TMCH subgroup is asking providers more about these services so we can bring more information in. So at least three groupings of technical functions are being - are using the trademark clearinghouse database.

And IBM interacts with the registries and registrars and we'll go into detail about the SMD file, but not today, about the SMD file and technically how that process takes place. So we'll see it from the perspective of the trademark owners, the registries, the registrars and the registrants. But this is - this is, you know, if you were going to take one slide home this would probably be it, the trademark clearinghouse functions. And this overview of the whole process.

Okay so today we're deep-diving into the verification function currently provided by Deloitte. And the idea was, and I'm going to stray from the slide for a second, the idea was that in the pre-new gTLD days as new top level

domains that we called sponsored gTLDs, were opened each registry created their own database for dotInfo, for dotBiz, their own trademark database.

And the thought was that if we were going to open up hundreds of new top level domains that that wasn't very efficient and we should create one place to put verified trademarks. And that's where the idea of the trademark clearinghouse was born.

So Deloitte's job is to verify the correctness and completeness of the trademarks that are submitted to it to see whether they meet the eligibility requirements for entering into the trademark clearinghouse. And in another slide or two we'll see those that do and those that don't as a matter of the rules.

And the trademark clearinghouse provides clearinghouse user interface, they provide education to trademark owners on how to do this. The technical function, which we'll be addressing in the next two weeks, is provided by IBM. And that's how the central database is accessed for the services that are required of it, services that happen in real time as registration is taking place. In many cases, there are some non-real time functions as well.

So back to verification, who can apply to the trademark clearinghouse? And this is a trademark owner who can be an individual or an entity, or a trademark agent. And these are, of course, people who submit and maintain information on behalf of a trademark owner. And they receive the notices. And if you have a trademark agent they're the ones receiving the notices about the sunrise and trademark claims. If the trademark owner is registering directly they'll get the notices. And we'll be talking a lot about those notices in the next two weeks.

What kinds of marks are accepted in the trademark clearinghouse? Now this was the subject of a lot of discussion in 2010, 2011 when we were developing the rules for this. Mostly it is nationally registered trademarks, the primary

register but also regionally registered trademarks as well for countries that have joined together to create a common trademark office.

Protection was also created for marks protected by statute and treaty. And court validated marks, so in countries with common law marks there are proceedings that a common law trademark owner will sue and get a determination that they do have a trademark and then whatever they've sued under for infringement, for example.

Court validated marks are also acceptable for the trademark clearinghouse. And one of the questions we'll be asking the TMCH is how many do they have? How often is this particular process used?

Now the trademark clearinghouse can also collect information, I'm going to read the last line, "Other marks that constitute intellectual property and that meet a registry's individual requirements." The idea here was that if a registry specializes in a certain area there might be an extension of what the trademark clearinghouse should accept just for that registry.

We don't know if this has been used and so this will be part of the questions I - that we might be asking to the provider is, you know, have people been using the trademark clearinghouse for intellectual property beyond trademarks?

Okay next slide, what types of marks are not accepted? Nothing that's pending, no trademark applications are accepted because they're not trademarks yet. I think there's an error in this line of the slide but let me tell you what I think it means.

So well-known or famous trademarks, unless they're already protected by a trademark or unless they're protected not by a - by a statute or treaty or court validated. So but a well-known or famous trademark still needs to have that trademark certification in order to go into the trademark clearinghouse. US

state trademarks are not accepted if it's just accepted in one state but not registered at the federal level. That would not be accepted by the trademark clearinghouse.

And then there's a whole range of international trademarks, of course trademarks that were subject to invalidation, cancellation, opposition. Trademarks that have ICANN or dotICANN. Interesting, any mark protected under statute or treaty starting with or containing a dot unless functioning as a punctuation abbreviation or a figurative part of the mark. So the dot becomes interesting and that's been a subject of controversy in different trademark offices as well.

A mark protected under statute or treaty that does not contain any letters, words, numerals or DNS valid characters would of course not be acceptable in the trademark clearinghouse because it wouldn't work as an identifier in the DNS.

And any mark protected by statute or treaty of which the statute or treaty is only applicable to a certain region, city or state, so if it doesn't have really global application, it wouldn't be accepted under the statute or treat provision.

Next slide, and that is what about device or image marks? So this is interesting and I think we'll be devoting some number of weeks to this. This is where the marks do not exclusively consist of letters, words, numerals or special characters, really where it's not a word mark but it's a design mark.

And the trademark clearinghouse has taken the position that the recorded name of the trademark can be registered into the TMCH database if it's an identical match to the reported name as long as the name of the trademark includes letters, words, numerals, keyboard signs and punctuation marks that are predominant. Clearly separable or distinguishable from the device element and all predominant characters are included in the trademark record submitted to the clearinghouse in the same order they appear in the mark.

I can read - if there's a question Deloitte has an internal team that reviews the design mark and the word mark within it. And again, this is something we're going to be spending some time talking about.

Okay so next slide, other useful notes, the basic fee for registering a trademark in the clearinghouse is \$150 a year, but as we'll see on the next slide you can get multiple year packages at a discount. To be eligible for the sunrise registration, which we'll be talking about next week, you have to submit proof of use. So a signed declaration or sample of use of the trademark. And that will allow you the first come registration that's provided for members of the TMCH in a new top level domain that's just opening up.

Let's see. All trademark comparisons done by the trademark clearinghouse compare the textual elements of a mark with the second level label of the domain name being registered. So we'll see as an example later on there's a Lego issue so it would be comparing Lego to lego.tech or lego.media or lego.lawyer. Obviously that doesn't apply but that's the concept.

And an identical match, and this was also the subject of a great deal of discussion a few years ago and one of the questions is we did it get right, an identical match for the trademark clearinghouse expert - sorry, trademark clearinghouse record, is a domain name that consists of the complete and identical textual elements of the mark but sometimes there are special characters that are not provided for like an ampersand or an at sign that are not part of the - you can't use them in the URL, you can't use them in the domain name registration.

So there is some variation allowed for these special characters. So do you skip them entirely? Or can you - you have a dash, there are different ways to do it. Most of which are accepted by the trademark clearinghouse and we'll be exploring some of that to provide some flexibility for the trademark owners.

So next slide, other useful notes are that other special characters contained with a mark that are unable to be used in the second level can either be omitted or replaced with hyphens. So if you have other characters, smiley faces, other things, you can still register in the trademark clearinghouse.

Plural versions of a mark or domain names containing that mark are not considered to be an identical match. This is really interesting also with the top level domains outside our bailiwick but top level domains where top level domains with S - plurals were allowed as well as the underlying singular.

Multiyear registrations, as I mentioned earlier, are of course allowed. David, do we need to stop for a second? Oh to Kurt Pritz, yes, of course we'll be asking Deloitte to present as well as IBM. It's really important for us to talk to the providers. Okay David says I don't think so.

So trademark plus 50, this is, you know, a newer part of the trademark clearinghouse rules. And it's also called the abused domain name label service. And this allows a trademark already registered in the trademark clearinghouse to be linked to a maximum of 50 variants in the TMCH database provided that each variant of the mark was awarded to the trademark holder in a prior UDRP decision or legal action.

And so we see Yahoo with double zeroes, Adobe with a zero and Lego Box are all examples of variants that are actually in the TMCH database that people who worked with them were kind enough to share with us.

Okay now we begin the deep dive into the questions from the charter just concerning the trademark clearinghouse. Not yet concerning the sunrise period or the trademark claims, although there are lots of questions to follow, you know, preview of coming attractions, lots of questions there too.

So from the charter, staff has extracted the following questions. And I'm going to read most of them because this is kind of the core of the work today.

Should the abused domain name label service be continued? So that's a trademark plus 50. Is protection of the TMCH too broad?

Is the TMCH, kind of I guess a variation or an extension? And quick note for anyone who doesn't know how the charter process works, questions come in from different commenters, different locations, different SOs and ACs.

Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services?

Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs? Next slide. Should further guidance on verification guidelines - I think we're missing - be considered for different categories of marks? Is the - I'll skip this one. Should TM plus 50 be reversed? Again, a question about registrants losing opportunities to register in the new gTLDs.

Should the scope of the TMCH be applied to only the categories of goods and services in which generic terms in a trademark are protected? Should - on the opposite side, should the trademark matching rules be expanded to include plurals, marks that contained, marks plus keyword or common typos - and or common typos?

Next slide. Should there be an additional or a different recourse mechanism to challenge rejected trademarks? We had some discussions here among the cochairs. We think this means trademarks rejected by the TMCH itself.

How quickly can a cancelled trademark be removed from the TMCH because cancellations happen and some of them are getting a lot of publicity. How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies versus what is offered to private

new gTLD registries pursuant to private contracts? So this is that private purposes use of the TMCH database.

Should there be a review on accessibility to TMCH for individuals, private trademark owners and trademark agents in developing countries? You know, are enough people getting the word?

How can the TMCH provide education services not only for trademark owners, but for the registrants and potential registrants who are equally impacted by their services?

On the next slide we are going onto questions from Helsinki. So this was the long and frankly very well attended public outreach session we had in Helsinki Finland. But let me stop. David, is there anything to stop for?

David Tait: Kathy, I don't know if you would like to open the discussion on these questions at this point. But at the moment I don't think there's anything specifically raised in the chat for discussion at the moment.

Kathy Kleiman: I thought maybe we'd read through the next two slides and then go into discussion. Because you're going to see a lot of duplication but not complete duplication. Okay so questions from Helsinki.

Does the trademark clearinghouse provide avenues that are procedurally and substantively fair? So again balancing the question of balancing the rights of rights holders versus normal Internet users? Does the trademark clearinghouse create a tendency to perpetuate the status quo? That's a question for example, that I'd love more detail on so if there's someone who understood what they're trying to get at or maybe help craft that question that would be great to understand in more detail about what's being sought.

How accessible is the TMCH to reviewing accessibility for trademark agents in developing countries? What is the effect of the 90-day Trademark Claims

process? So that's the first time we're seeing the trademark claims and the time period being asked about. Should the TMCH remain a single provider or should we open it to different providers, of course with a central database that should be accessed by the different providers? That's going to be a question I think we're going to spend some serious time on.

Are the costs of the TMCH, for rights holders, for ICANN, for the community proportionate to the benefits it provides? How do we determine what is "good chilling effect" and "bad chilling effect" in relation to rights protection mechanisms? That's an interesting question.

And then last page of questions, I promise, except for the questions we're asking you. Are the Providers' procedures fair and equitable for all stakeholders and participants? Here the providers are of course Deloitte and IBM.

Are the Providers consulting with all stakeholders and participants in the evaluation, adoption and review of these new procedures? Are they training both the Complainants and the Respondents, and their communities and representatives, fairly and equally in these new procedures?

Are they exceeding the scope of their authority in any of the procedures they are adopting? Is ICANN - now switching from providers' obligations to ICANN's responsibilities - is ICANN reaching out properly and sufficiently to the multi-stakeholder community when such procedures are being evaluated by ICANN at the Providers' request? Is it an open and transparent process expeditiously and fairly created?

What changes need to be made to ensure that procedures adopted by providers are consistent with the ICANN policies and are fair and balanced? Okay so next slide.

Now I turn it over to you. Questions and discussions. So a lot of material has just been presented and glad to see hands already being raised.

What would you - in terms of questions what would you add? What's duplicative? What can be grouped together? What should we examine first? And also general questions about the trademark clearinghouse and again asking the experts who live and breathe the trademark clearinghouse every day to be on deck to help me answer the questions.

I turned it over. Go ahead. Mr. Aggarwal. Could you go ahead with your question or comment?

Vaibhav Aggarwal: Yes, hi, this is Vaibhav Aggarwal for the record. Thank you. Kathy, my compliments to you on running us through the presentation first. And to add on to the talks here after looking at the presentation and going through a lot of study material and understanding, I feel TMCH is not right on two points, so far and that's what also should be included in the correction format.

Now first, TMCH is deep-diving too much into the legality of the trademarks, which I don't think it is the responsibility of TMCH. It is the responsibility of the trademark owners and their respective attorneys. That is one part of it.

And leading - and taking a cue from this part, I would say here that TMCH should just add as a noted authority or an agency and not a statutory agency to monitor and decide which trademarks to go through and which not. It's a disputed - it should be left to a group of attorneys or a legal group or something or just said no. You know? There should be clear line of distinction between acceptable and not acceptable. And that should not be from a legal standpoint.

So for example if Yahoo is with a triple zero or a triple O it is not TMCH's responsibility to decide whether it's right or wrong. I feel it should just be limited to the (unintelligible) trademark either by the common name, common

law, or by the word (unintelligible) registration and that's it. If it's there, great; if it's not there sorry, bad luck. It should be sent back to the applicant. And that's my thought process so far.

Kathy Kleiman: So you think there should be clearer lines so that there shouldn't be any discretion, is that what you're saying, that you should know ahead of time what goes in and what comes out?

((Crosstalk))

Vaibhav Aggarwal: Absolutely.

Kathy Kleiman: Okay.

Vaibhav Aggarwal: Because TMCH cannot be a legal authority. TMCH cannot be a legal agency to decide which trademarks should exist and which does not, which trademark because today on one of the calls a few weeks back I was also a very vocal advocate of saying that every digital property today is an asset to organizations. Okay? And those assets cannot be verified, decided upon, etcetera, etcetera, by an agency like TMCH for that there are attorneys, there are legal counselors, there are government arbitration centers, there are so many agencies for that.

So I think there should be a clear line of distinction on the way TMCH needs to function, if it needs to function and it needs to function under these guidelines, these are the time periods, and it is a clear line of decision that TMCH needs to come up with.

Kathy Kleiman: Thank you for your comment and for the passion behind it, appreciate it.

Vaibhav Aggarwal: Thank you.

Kathy Kleiman: And looking forward to your participating actively in the discussions to come. It's an important point that you're making. Susan, are you making a new issue or responding? Actually you can do either one. Go ahead.

Susan Payne: Well kind of responding, I guess it's a question. If Vaibhav, if you could - if you have a particular experience and it sounds as though you have, it might be really useful for us to kind of - for you to share that because I'm struggling to understand what your concern is and particular in relation to your concern about the TMCH making decisions about what is or isn't a trademark.

I mean, my perception of the TMCH is that it's got a...

((Crosstalk))

Susan Payne: ...your mark goes in and if you don't fit within the rules your mark doesn't go in. And so to me it seems pretty clear. And we may disagree amongst this working group about what those rules should be and the extent to which you should or shouldn't be able to put a mark in and the extent to which you can then rely on it to match for a sunrise or a claim. But it seems to me that the rules are pretty clear about what can or can't go in. So could I...

((Crosstalk))

Susan Payne: ...could we understand what your experience is that's leading you to raise this issue?

Vaibhav Aggarwal: Yes. This is Vaibhav for the record. Thank you, Susan. I think it's a very valid point. I do not have the details on the experience that I have so it would be unjustified for me to share it right here. But I'd like to take your attention back to Slide Number 13 taking a cue from the charter questions. There are a few questions saying are legitimate noncommercial, commercial and individual registrants losing the legitimate opportunity to register domain names in the new gTLDs.

This question cannot exist here if there is a clear line of sight in terms of the role of TMCH because TMCH is no one or shouldn't be anyone to decide whether the opportunity is legitimate or not. Then - or on the same slide we could take Point Number 1, should further guidance on verification guidelines, position categories of marks be considered? There aren't needed any. Why? Because it's just (unintelligible) validation of the documents submitted by the registrant.

So validation by the - since it's validation document by the registrant a lot of countries, including the emerging markets, or the developing countries today are (unintelligible). And one can just go ahead and simply validate it and (unintelligible) the entire time period on the validation.

Kathy Kleiman: Thank you.

Vaibhav Aggarwal: I can share more details on the list if need be.

Kathy Kleiman: I think that would be very valuable as well as perhaps some of the questions you're getting at kind of the duplicative use of certain words. I know when the rules were begin designed Apple was talked about extensively of course as a computer company, as a record label, and as a fruit. And there are other uses as well. So that's may be one of the issues that some of the questions are getting at and that you may be getting at as well. Thank you. Thank you for introducing the topic.

((Crosstalk))

Kathy Kleiman: Is there anything else you wanted to add?

Vaibhav Aggarwal: No, I'm good. I think that should just start the debate. I see the chat pod and Steve has a point, if I can take an opportunity to respond to Steve's point?

Kathy Kleiman: Sure. Please go ahead.

Vaibhav Aggarwal: Okay. So, Steve, good evening. Now (unintelligible) rights but in case TMCH (unintelligible) with doing the sunrise period since that period was reserved for the trademark holder it's just the trademark holders right?

Kathy Kleiman: Yes.

((Crosstalk))

Vaibhav Aggarwal: Just a response (unintelligible).

Steve Levy: This is Steve Levy for the record. I'm sorry, was there a specific question there? I was having trouble hearing you.

Vaibhav Aggarwal: Oh. No, there wasn't a question.

Steve Levy: I see.

Vaibhav Aggarwal: I was just saying that since the sunrise period and it's reserved for the trademark holders so TMCH is not about granting rights there, it's in response to what you (unintelligible) rightly. So it's, you know, if the paperwork is there it's got to be the trademark holder, otherwise it's not there, it's like that.

Kathy Kleiman: Steve, feel free to come back online if you want to respond or engage.

Steve Levy: Well then my - again, this is Steve Levy. My main response is simply that, you know, the trademark clearinghouse does not grant trademark rights. The gaming of the system to the extent it occurs, really results in unnecessary costs to brand owners by having to pursue legal claims against a domain which may have been improperly acquired during a sunrise period. So that

part I completely understand. And that's why I think - yes, so but it doesn't create any trademark rights itself. I was basically just supporting Kristine Dorrain's point.

Kathy Kleiman: Great, thank you, Steve. To David Tait, in the notes section can - Susan made the interesting point that maybe we can globalize. I know she made it, you know, for the discussion. But to the extent people have details, it would be great if they could, you know, share them, detailed experiences with the TMCH or related to some of the questions that we'll be bringing forward or addressing.

So I'm going to be taking a look at the chat but in the meantime would anybody - who else would like to comment on the types of questions we're looking at from the charter, maybe the order that we should take the questions, whether they're fully inclusive? Is there anything you would add or take out from the list of questions both from the charter and from our outreach session in Helsinki?

George, do you want to come online? Kristine? I see a lot of people typing. Feel free to come on the phone. Caroline, please go ahead.

Caroline Chicoine: Hi there. Sorry, I had to unmute. I guess I just have more - maybe a question and/or comment about the cost because I always see them throw around the \$150 number. And, you know, my understanding and I, you know, our firm does not provide that service so to the extent we do assist clients it's through a third party.

And our costs aren't \$150 for our clients because of course there's, you know, they kind of add value that they provide for providing the service. And if trademark owners, if I remember right, way in the beginning you have to put I don't know if was \$10,000 or \$15,000 deposit which I understand that you get back but that's an initial cost that your company has to be willing to make.

And if you're a small company that maybe has only one market of real importance, you know, that's a big commitment. So I guess I - and that's kind of a question or comment, I've seen this number thrown around and I don't know if it clearly represents, you know, the true cost to trademark owners even though that may be kind of the base number that gets thrown out there.

Kathy Kleiman: Caroline, before you - before you get off, would this be a valid rephrasing or a valid way to put it into the notes that David is taking that questions have been raised about TMCH agents and other issues that might be, you know, other costs that might be associated with registering in the TMCH database aside from the TMCH costs themselves and that you'd like to explore that further?

Caroline Chicoine: Yes, I would because I think that even though the trademark owner maybe has the wherewithal to put that kind of deposit down, you know, that's an initial cost that comes - it actually has to be made, it's not just something that's done in gesture. And so it's an initial cost that goes on. I'm registering some renewals for clients and they said it's not \$150 when I go through an agent.

So, yes, I just think it's - I just want to be sure we're comparing apples and apples because I know in the other report that the Analysis Group did they talk a lot about costs, they reference, you know, to the extent that there's registrar and registry costs also, but I just want to be sure that we're comparing apples and apples with what - to the costs on one end versus the other.

Kathy Kleiman: I think that's a really good point. David, if you could also add something - a placeholder about deposits because Caroline's mentioned that twice. So that would be interesting as well what deposits that have to go in in order to become an agent. Thank you. Anything else you wanted to add, Caroline?

Caroline Chicoine: No, I think, you know, my comments really were in looking - I tried to review that (unintelligible) report before the call. You know, and it just seems like

there's a lot of unknowns where I think sometimes they don't - they aren't comfortable coming down one way or the other based on maybe, you know, certain things that have happened. So, you know, they'll say that well, you know, in the trademark clearinghouse that the fact that a lot of these aren't necessarily disputed.

And, you know, but there's no follow up to say well, okay but, you know, how many of those domain names were associated with websites that had true content? Because as we all know, given the proliferation of gTLDs, trademark owners have limited budgets and so the fact that they may not then pursue a dispute after the fact the implication is, is maybe that's not really an issue as opposed to well, you know, we have bigger fish to fry right now. So I just think that I don't necessarily like the conclusion that they're coming to based on, again, just the numbers that they're looking at in terms of, you know, things that go into a dispute.

Kathy Kleiman: Interesting. So I don't think we have any questions on this. How would you - could you maybe rephrase that because that was a lot of material, which is great. Rephrase that as kind of an area of inquiry.

Caroline Chicoine: Yes, you know, I mean, what I could probably do best is I'll just kind of put together - I just did some scribbles, like I said, because I wanted to read this thing before the call but I'll just put some scribbles to give to the staff that they can then put in the notes. But just like something that I noticed in reading the report is that sometimes I was disappointed that they sometimes, you know, said well we didn't have that data or - and I thought well then why didn't you get it.

But, then like I said, I think they made some, you know, implications or conclusions that I don't necessarily think are valid given they don't have all the information or facts. So I'll go ahead and prepare a little blurb and shoot it off to you guys.

Kathy Kleiman: That would be great if you could send that to the list, that would be great. And if other people have thoughts and questions it's an important area of inquiry of ideas after you get off the call please send it to the list in the next week. That would be great. George, you're on decks. Actually you're up.

George Kirikos: George Kirikos for the transcript. And making sure I'm not on mute. Yes, I have opinions on all these questions obviously but I think the overriding thing we have to look at is, you know, how are names going to be allocated, you know, whether trademark owners and I've talked in the chat room about how are there are, you know, strong trademarks and then there is, you know, de minimis weak trademarks that don't necessarily deserve the same kind of protection that strong trademarks do.

Whether those - that should be, you know, a concern about how domains are allocated, and so the sunrise period is, you know, very subject to gaming. And so if people are told that they, you know, if you have this piece of paper you can priority access to the best domain names, then people will go out and get this little piece of paper from, you know, either, you know, the Benelux trademark office or other trademark offices that aren't very - they don't scrutinize their trademark applications very carefully.

The thing is, even if you eliminated the trademark clearinghouse you're not necessarily better off there because the registry operators can put the domain names on a premium list and charge accordingly. So if you think about it, you know, 40,000 feet perspective what you have is you have some very valuable domain names within each top level domain name and some lesser domain names.

And so the demand is really for those premium domain names and so how the pie is cut, you know, you want trademark holders that have - that want to get access to those first but given their trademarks you have registries wanting to maximize their profits, you have other domain name registrants who are, you know, some cybersquatters that want to get those domain

names to resell them. And then you have, you know, common words that, you know, by definition are valuable just because they're generic that, you know, the public en masse wants them.

And so who deserves to get that domain name is the key question. And so we're going to need a lot more data to decide this thing. But that's really that is it is from, you know, 40,000 feet, how these domain names should be allocated and that's kind of a fairness question so we need to get that data.

((Crosstalk))

Kathy Kleiman: So, George, based on what you've been saying - oh okay, go ahead.

George Kirikos: That - the prime benefit of the trademark clearinghouse as I see it is that priority registration on new gTLDs, if that was eliminated, you know, a lot of the concerns about gaming would disappear with these, you know, weak trademarks for lack of a better term. And we see that, for example, in many of the TLDs - new gTLDs have kind of failed, you know, a couple thousand registrations which is a lot less than the total number of marks that are in the trademark clearinghouse.

So I don't think that people were deterred from registering those strings in those TLDs, it's just that they're very low value and, you know, no specially value, no demand for those terms. And so you could see that the trademark clearinghouse isn't necessarily preventing people from registering those names because they weren't registered in the sunrise period, they weren't registered after the 90-day period.

Kathy Kleiman: George, a lot of - thanks to you a lot of people have entered the queue, which is great because I thought this meeting was going to end early. But I don't think it is now.

((Crosstalk))

Kathy Kleiman: Is there a particular question you'd like to phrase maybe that has to do with the differentiation of strong and weak marks? Or other things that you've said, do you want to type that into the chat room and David will add it to the right hand side of our notes?

George Kirikos: Okay.

Kathy Kleiman: Thank you. And thanks for the discussion. I know you've been watching this very closely. Kristine, go ahead.

Kristine Dorrain: Hi, this is Kristine from Amazon. And I'm chuckling that you think that this conversation could be ending early, Kathy. Anyway, anyway I have two sort of side comments in relation I guess responses to George's comments. First one I would say, you know, this idea that people have gone out and registered, you know, Benelux trademarks or whatever, in order to game the process, I think we absolutely need to add that as a question. I could go back, I think we've kind of sort of asked that question but I think we definitely need to go back and get some information about that.

Because what we're here to do of course is to determine the effectiveness of the RPMs and the RPMs are here to protect trademark rights, the rights protection mechanisms are here to protect trademark rights. So first we need to see if it's doing that but we also want to know if it's permitting abuses, which would be an ineffective RPM, right? So I think we definitely need to gain that data.

But to George's point that this seems to be some sort of a prolific gaming adventure, I mean, I heard you say that the, you know, there's a lot of sunrise registration - or a lot of the marks in the trademark clearinghouse that never translate into sunrise registrations.

So it seems to me that most people putting trademarks in the trademark clearinghouse are mostly doing it for defensive purposes and are not doing it to game the system. And there may be a few people doing that and we absolutely want to stop that, but I think to the point that people are purposely trying to abuse the trademark clearinghouse I think your own data that indicates that there are fewer sunrise registrations and trademarks in the clearinghouse is definitely, you know, it's a little bit confusing to me.

And secondly, it would be very hard, I think, to gain a portfolio of generics using the trademark clearinghouse. I mean, I could go get one or five or maybe 10 generic words entered into the trademark clearinghouse but I think it would be hard for anybody to justify, you know, getting 1000 generic words as trademarks and dumping them all in the trademark clearinghouse.

So I just want to talk - I guess I just want to think a little bit about the scope of any possible gaming, you know, certainly we want to prevent some instances. But I'm not entirely sure the scope is there.

Kathy Kleiman: Okay so, Kristine, both evidence and scope of gaming to the extent it exists so that's a really good point, thank you for responding to George. Greg, go ahead. And if you want to give us a summary of what happened at the end of the hearing I'd be interested in that too. Just kidding. Greg Shatan, are you with us? Greg, if you're talking I can't hear you, you may still be on mute. Okay, it looks like someone else just had their hand up and took it down. If you want to go ahead we'll - more than welcome to come back while Greg is talking. It looks like Greg has just taken his hand down.

I'm going to wait another minute or two, to see if Greg wants to raise his hand again, see if anyone else wants to comment. I'm glad we've added to the scope of our charter questions and review. There's certainly much more information than we had years ago, you know, when we were designing this from whole cloth. That was one thing. But now there's evidence of its actual use and that's really where the working group comes in is working with what's

actually happened with these mechanisms since their creation. Jeff, go ahead.

Jeff Neuman: Thanks. Can you guys hear me okay?

Kathy Kleiman: Yes.

Jeff Neuman: Okay good. Just to kind of a word of caution. I think we should be careful in how we phrase things. I don't think we should phrase questions as strong or weak marks. I think what everyone's getting at, you know, is whether the marks have undergone substantive review versus those jurisdictions that don't have substantive review. I think that's the way ICANN has referred to in the past. So we should be careful on that.

And perhaps the question that we need to look at is, you know, were there any negative effects from the decision ICANN made to allow marks to be submitted from those jurisdictions that do not conduct a substantive review? I think that's the question in a more politically sensitive way. Thanks.

Kathy Kleiman: But, Jeff, I mean, it's a very important question and I'll call on Craig. But George I think is making a different question - is asking a different question, which is in addition to the question of substantive review or not there is a question of a differentiation, a protection of marks he pointed out Exxon and Verizon, both coined and fanciful terms, versus the generic words that we're hearing talked about in a number of questions.

So before...

((Crosstalk))

Kathy Kleiman: ...we exclude that I would argue a number of people have asked about generic and descriptive dictionary words in the questions so I think that's in the scope of our inquiry.

Jeff Neuman: Well it's just - but just to be clear, and just to respond to that, you know, a trademark is a trademark is a trademark. You know, whether someone believes it's a dictionary word or if someone else believes that it's fanciful, you know, they still undergo similar analysis under let's say infringement law in the US, you know, so if you have a registration in the US that, you know, George may consider strong, it still undergoes the same analysis as to whether if George views it as weak or a dictionary term. You still look at things like prior use and you still look at the goods and services by which they're associated with.

So I just think you - we need to - we are not a legal authority and we should not get into distinctions as to whether we believe a mark is strong or weak for sunrise purposes, right? That's all we're talking about is for sunrise and claims I guess and maybe if we added any other RPMs. But we're not talking about infringement law in general. We're not even talking about UDRPs...

Kathy Kleiman: No we're certainly not...

((Crosstalk))

Kathy Kleiman: ...and there's no basis...

Jeff Neuman: Right.

Kathy Kleiman: ...there's no opportunity to do the kind of infringement evaluation that you're talking about.

Jeff Neuman: So the only question is, in my mind, is to whether we continue to accept trademark registrations into the clearinghouse from jurisdictions that do not perform a substantive review of the mark. I don't think we should get ourselves in any kind of distinction of whether a mark is perceived to be strong or weak. Thanks.

Kathy Kleiman: Cool, thank you for your comment. Greg, I'm glad you're back. Go ahead.

Greg Shatan: Thanks...

Kathy Kleiman: And then we'll wrap up with Susan probably.

Greg Shatan: Just engaging in some multitasking. I think we have - there are a lot of dangers here in throwing around terms plucked from trademark law without really appreciating and understanding what they mean in the law and while obviously trademark law is, you know, distinguished by jurisdiction there are both by treaty and custom a lot more in common than different overall.

So both a so-called strong mark and a so-called weak mark are both valid marks what that often has to do with are not issues of the strength of the mark as a source indicator but maybe with the ability to enforce against uses that are relatively far removed from uses of that - that are being made by the trademark owner.

A weak - a so-called weak mark may be just as valid - these are broad classifications. And if we want to get into what's a strong mark, on the spectrum of trademarks that we all who learn about trademark law learn about, the next strongest mark after a fanciful mark, a made-up word, is what's called an arbitrary mark, which means a dictionary term, so called, a word, a word that is being used in a way that has no connection even a suggestion with the goods or services that are being offered.

So for instance, with apologies to J. Scott Evans, Adobe is an arbitrary mark. So if we're going to talk about strong marks, which I don't think we should actually, but if we are then there goes the dictionary with regard to arbitrary marks. And if we are not going to get into analyzing the relative strength and weakness of a particular term as it's used, because that also requires us to look at the goods or services for which it is used.

You know, a generic term is apple for apples. Apple for computers is arbitrary. That's strong. In between there's suggestive and descriptive and we don't really need to talk about all of the stuff that goes there because frankly I think, you know, if we're going to get into kind of trying to parse trademarks and trademark law we're going to be here for a very long time and not accomplish anything. Thanks.

Kathy Kleiman: Thanks, Greg. One question I'll throw out to the non-lawyers in the group or non-trademark lawyers is whether we need to talk about - whether we should be giving a briefing on these areas as well and whether they might be - that's important or not important because certainly a lot of people in this group are well versed on what Greg just said, and a lot of people aren't. Greg, is your hand still up?

Okay. Let's see, we have two minutes left and thank you to everyone for engaging in this discussion. We have some new questions, we have concerns about scope that have been raised, all good. Let's continue the discussion on the list. And next week will be our deep dive into the sunrise period which is a very important part of our work in understanding the scope and the use of the TMCH database.

And one thing I did not ask earlier was if anyone had any updates to their statements of interest. So let me pause for a second see if anybody wants to update their SOI. In that case, David, do you happen to know what time our meeting is next week? David Tait.

Terri Agnew: Hi, Kathy, it's Terri. Our meeting next week is Wednesday the 21st of September at 2100 UTC for 60 minutes. And I'll quickly put that in the chat as well.

Kathy Kleiman: Terrific. Thank you very much. And thanks to everybody for joining us. That'll be our late meeting next week. Any final comments before we go? Appreciate

the dynamic discussion. The beginning of six months is now on its way. And a quick note that soon we'll be also talking to the trademark clearinghouse subgroup that has been diligently working every Friday to try to gather data for us.

Vaibhav, do you want to have the last word? We are at time so I'd urge you to...

Vaibhav Agarwal: Yes, can you hear me?

Kathy Kleiman: Sure, go ahead. Quick comment please.

Vaibhav Agarwal: Just to offer comment since we're all here trying to understand a little bit non-lawyers, lawyers, (unintelligible) Greg's comment was lovely. I think it throws a lot of light on the way we are (unintelligible) going forward. I would highly recommend all of us trying to read a book by Professor of Law at UC Davis (unintelligible) that talks about a whole lot of IPR issues in trademarks and competition that they bring together from across the world. And his views, his experiences, all these years and in that book. So, yes, that is one point.

Kathy Kleiman: Could I ask you a huge favor since we're about to log off and leave the chat room also, could you post the book and the author in the working group list so that everyone has...

((Crosstalk))

Vaibhav Agarwal: Yes, I can.

Kathy Kleiman: ...and your recommendations.

Vaibhav Agarwal: I can.

Kathy Kleiman: Thank you. That's great. McCarthy on trademarks, Greg, definitely that's the one of the bibles. If you could post that to the working group as well. Everyone, have a good week and thank you very much for the discussion today. Take care. Bye-bye.

Petter Rindforth: Bye-bye.

Terri Agnew: Once again the meeting has been adjourned. Operator, (Louie), if you could please stop all the recordings. To everyone else, please remember to disconnect all remaining lines and have a wonderful rest of your day.

END