

**ICANN
Transcription
Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP
Working Group
Thursday, 27 April 2017 at 03:00 UTC.**

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Coordinator: Good morning, good afternoon and good evening and welcome to the Review of All Rights Protection Mechanisms RPMs in all gTLD PDP Working Group call held on the 27th of April, 2017.

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. If you are only on the audio bridge, could you please let yourselves be known now? Hearing no names I would like to remind all to please state your name before speaking for transcription purposes and to please keep your phones and microphones on mute when not speaking to avoid any background noise.

With this I'll turn it back over to our cochair, Phil Corwin. Please begin.

Phil Corwin: Well good morning, good afternoon and good evening to all of you. Thank you those of you who are participating on tonight's call. I can tell you there's nothing I'd rather be doing at 11:00 pm my time then chairing a 90 minute call of this August group. But we should – it should be a good meeting, we're

going to start off serious discussion of proposals from working group members regarding Trademark Clearinghouse.

But before that I think we've done the roll call and any updates to statements of interest, anyone have any? Okay, well hearing and seeing nothing, with reports of progress and status updates from the cochairs of the sub teams looking at the questions regarding the sunrise and the trademark claims notice.

I see Kristine Dorrain on – she's one of the three people listed so, Kristine, are you in a position to give us an update?

Kristine Dorrain: Yes, I'm sorry. I'm eating dinner. Okay, excuse me...

((Crosstalk))

Phil Corwin: Well finish chewing and swallow and then commence.

Kristine Dorrain: All right, thanks. I am co-chairing the Claims Sub Team. We went through the albeit shorter list of questions that were – charter questions, and we made really good progress in deciding, you know, which questions that kind of bundle together and which questions should be moved to a different sub team.

We are now working on – we have until the end of today to all submit our comments on how we might suggest that the charter question wording be – friendly amendment, if you will, in order to make the charter question wording a little bit more neutral and less suggestive of the answer in some cases.

And we are also in the process of suggesting which charter questions are going to require additional research or additional efforts on the part of either ICANN staff or outside parties to provide some information. So I think we are

on good track there with the Claims Sub Team, and I don't think I missed anything. Thanks.

Phil Corwin: Well thank you very much, Kristine. And feel free to return to your dinner while you're listening to our call here. I don't see Lori Schulman on the call tonight. And I'm not surprised, I believe she's in Europe where it's the middle of the night. And I don't see Michael Graham, so unless anyone else from those sub teams wants to volunteer a report we will move on to Item 3 which is to discuss the consolidated table of proposals received on the Trademark Clearinghouse open Questions 7, 8 and 10.

And let me ask staff for guidance and also solicit any input from the working group. And Paul, I see your hand up, I'll let you talk in just a moment. But are we planning to kind of review all the questions just to note what they are before we get into substance of the first one, or are we going to just plunge into the first one and then get to the others as they come up?

So let me call on Paul first, he had his hand up first, and then Mary. Go ahead, Paul.

Paul McGrady: Thanks. Paul McGrady. So I just had a question for the cochairs or staff, I'm not sure who, I volunteered to be on the team for the Alternative GPML issue, I'm not sure what else to call it. But we've not...

Phil Corwin: Private protections is what we're calling it.

Paul McGrady: Got it, there it is. Do we know when that will kick off?

Phil Corwin: Yes, right now the cochairs are reviewing a revised list of questions proposed by the cochairs subject to further review and modification by the working group members. And we expect to have that out in the next few days so we are working on that, it's just not quite ready to share with the group yet.

Does that answer your question, Paul? Is that satisfactory?

Paul McGrady: Yes, thank you, Phil. Perfect.

Phil Corwin: Okay. Okay, Mary, go ahead.

Mary Wong: Thanks, Phil. And just to add that Kristine in the AC chat has noted that but there was good discussion on the Sunrise Sub Team call as well so for everyone's information, both of the sub teams for sunrise and claims will be having additional meetings this Friday to try to make progress if not wrap up their assignments for now, which is to review and refine if necessary the charter questions and possibly to propose a sort of mini work plan for how and how long it would take to tackle each of them for the full working group.

And as Phil has just noted, for the Private Protection Sub Team, once those questions can be finalized then we expect that third sub team to kick off as well. So, Phil, addressing your question about this table, we note that Michael Graham had said that he might not be able to be on this call tonight, and I don't see him here. So his proposal was for Question 10. But we do have I think two proposals each for Question 7 and Question 8, and I see that Kathy, Greg and Paul are all on the call so from the staff side our suggestion is just to plunge right in, maybe start with Question 7, and if we have time go to Question 8 and see how far we get.

Phil Corwin: Yes, I think that it's unlikely we'll get to Michael's question on – to proposal relating to Question 10 on this particular call. So on Charter question 7 I see we have a proposal from cochair, Kathy Kleiman on the first page here, let me see what else we have on Question 7 if there's – yes, on Page 7 there's another proposal from Kathy on the same question. So, we have two proposals from the same person on trademark charter Question 7 which is, "How are design marks currently handled by the TMCH provider?"

I think the best way to proceed, subject to anyone chiming in, would be to start on the proposal on Page 1 from Kathy to give a – we have everything in writing but to give a succinct five minute summary of the proposal, the rationale for it and what benefits it is supposed to provide and what, if any, cost there might be and why they are worthwhile. And then we can open it up for group discussion. Is that a reasonable way to proceed? If anyone thinks it's not raise your hand now.

Okay so, Kathy, let me – and what happened to Kathy? I saw her on...

Kathy Kleiman: I'm here.

Phil Corwin: Oh you're there.

Kathy Kleiman: Question...

((Crosstalk))

Phil Corwin: Disappeared, oh I see your hand's up.

Kathy Kleiman: I thought Greg had a design mark recommendation as well.

Phil Corwin: Okay, maybe – I thought Mary had said two proposals but let me see what else we have. I'm scrolling through the chart.

Mary Wong: Hi, Phil. This is Mary from staff.

Phil Corwin: Yes. I don't see another one on Question 7.

Mary Wong: I believe we do have – I believe we do have two proposals on Question 7 from Kathy and Greg. What may be kind of cluttering things up in this document is that there is a second table...

((Crosstalk))

Phil Corwin: Oh I see.

Mary Wong: ...where the rationale...

Phil Corwin: Okay.

Mary Wong: ...that was submitted was pasted separately.

Phil Corwin: Okay, so I see the one, now I see the one from Greg that's – I believe that on Page 11, is that correct?

Mary Wong: Hi, Phil. This is Mary from staff again. What we did was to put the actual proposals at the front of this document. So for Question 7 everyone should be seen but to proposals from Kathy and Greg on pages 1 and 2...

Phil Corwin: Oh I see.

Mary Wong: And then subsequently other pages we will see the rationale from both of them for their proposals. And presumably they will speak to this when they make their presentations.

Phil Corwin: Okay, I see that now, Mary. And my mistake was in looking in the left-hand column and assuming when there was a question listed it corresponded to only one proposal regarding it, not two. Greg, I see your hand up, please go ahead.

Greg Shatan: This is great. I think I've been overtaken by events. I just wanted to point out that I did in fact have a proposal on 7 so that's been discovered by others here as well.

Phil Corwin: Okay. And, staff, are those two proposals on Page 1 and 2 from Kathy and Greg, are they grouped together, because they address the same issue in a different way? Yes, Mary.

Mary Wong: Hi, Phil and everyone. This is Mary from staff. We had grouped the proposals according to either how they were submitted and titled or how they were I guess phrased by the submitters. And that's why for Question 7 for design marks, we have Kathy's and Greg's, and for Question 8, geographical indications, we have Paul's and Kathy's.

Phil Corwin: Okay, so I'm going to propose that we let Kathy present her proposal regarding design marks, that we then let Greg propose in the same, about 5 minutes, his proposal regarding design marks, and then that we open it up to group discussion on that subject. And again, if anyone think that's a bad way to proceed please raise your hand now, otherwise we will proceed in that manner.

So okay, see no hands up and hearing no one Kathy, go ahead and educate us on your proposal and then we will let Greg present to us as well, and then we can open discussion.

Kathy Kleiman: Sure, although I'm happy to let Greg go first if he wants to.

Phil Corwin: I'll let you and Greg work that out. Greg, did you want to go first or would you prefer that Kathy go first?

Greg Shatan: I was expecting we would just go in the order of the document.

Phil Corwin: Okay, so Kathy, why don't you go ahead?

((Crosstalk))

Kathy Kleiman: Sure...

Phil Corwin: ...collectively anyway.

Kathy Kleiman: And, Phil, you were right, I did have two recommendations in for Question Number 7 involving design marks. I have the one that went into weeks ago which I withdrew after our discussion, and then there is a new one there so that is – let me clarify that for everyone.

Phil Corwin: Okay so one of the ones that's listed here is outdated?

Kathy Kleiman: I don't think...

((Crosstalk))

Phil Corwin: ...on this document.

Kathy Kleiman: Mary used the most recent one, but I think she separated out what she deemed to be kind of proposal terms versus the rationale.

Phil Corwin: Okay.

Kathy Kleiman: I think she just put parts of it in different places.

Phil Corwin: Okay, so well which one – is the one on page 1 the one you want to present now?

Kathy Kleiman: Yes.

Phil Corwin: Okay, go ahead.

Kathy Kleiman: Okay, and I'm going to present it in a different order, I'm going to start with the expanded discussion because what's really there is 1-5 is the conclusions.

Phil Corwin: Okay.

Kathy Kleiman: Because that's the action items. Okay, so let's start with the expanded discussion, which is that we've done – and here I'm not just going to follow the text but kind of talk as well, which is we have this question here, both Question 7 and Question 16, and Question 7 is, "How are design marks currently handled by the TMCH provider?" and Question 16 says, "Does the scope of the TMCH and the protection mechanisms which flow from it, reflect the appropriate balance between the rights of trademark holders and the rights of non trademark registrants?"

And my recommendation is designed to address both. And what we found in researching the Trademark Clearinghouse is that the Trademark Clearinghouse is accepting a lot of materials. And I'd like to ask Mary Wong, not immediately but within, you know, by tomorrow, to recirculate the answers we got from Deloitte to Appendix A which was a group of great examples put together by Rebecca Tushnet and George Kirikos about some really kind of funky situations in terms of marks and styles and composite marks and mixed marks to see just how much Deloitte was going in and extracting words, letters, and terms.

And I think the answers, because we had waited so long for the answers to Deloitte, I think they got – it was past our discussion time, I think the answers got buried. And so I think we should review them, and everyone should take a look at them again.

But what we know is that the rules that were adopted by the GNSO Council and the ICANN Board say, and here I'll just read what's there, "4.1, national and multinational registered marks. The Trademark Clearinghouse," it actually says the TC but, "...the Trademark Clearinghouse database should be required to include nationally or multinationally registered, quote, text

marks, close quote, trademarks from all jurisdictions including countries where there is no substantive review.”

And then immediately adds, and puts it into the rules themselves, the trademarks to be included in the Trademark Clearinghouse are text marks because quote, design marks provide protection for letters and words only within the context of their design or logo, and the STI was under a mandate not to expand existing trademark rights.

And so nonetheless and kind of counter to these express rules, Deloitte is accepting into the Trademark Clearinghouse database words and letters it has extracted from – and pick your favorite word because we found that there are a number of different ways of phrasing this across the world. But we are global so we’ve got composite marks, figurative marks, stylized marks, mixed marks if the Argentinean term.

What we know is Deloitte is removing words and letters from designs, patterns, specialized letters, colors and logos. And this goes – and this is even when they are integral and integrated into the mark, and in fact too integral to be disclaimed. So what’s the harm? The harm is that first, this violates the rules adopted by the community.

You’re not, you know, sorry, I used to be a data security auditor and I think we all worked in compliance, the rules are the rules. A contractor doesn’t get to choose their own rules. And Deloitte seems to be operating under a different set of rules than we created, under its own authority, not that of ICANN or the ICANN community, and that’s not – that gives too much power to Deloitte.

But it also creates – it goes beyond the rules that were specially balanced to protect text marks but not to protect anything in a design or a logo or stylized. And that was the deal, that was the balance that was created by the

community when we created the rules that created the Trademark Clearinghouse.

So if we wanted to – and there's a lot more here, there is examples of cases that are drawn both globally and in the US. But this just gives too much discretion to Deloitte. It goes beyond the rules that we adopted together. And if we want to change the rules, that's fine, but this isn't the rules we adopted. And it was good that we found that out while we were doing our due diligence, and while we were doing our review. I'm happy to – again, delve more deeply but that's pretty much it that as part of our review we should call on Deloitte. We have no choice but to call on Deloitte to follow the rules as they were passed or to modify the rules by consensus.

Thanks, Phil.

Phil Corwin: Okay, so Kathy just to quickly summarize, you believe Deloitte is in violation of the rules adopted for design marks and that they should either be brought to heel or that we should modify the rules to encompass their current practice. Greg, can hold one second, Mary's had her hand up for quite a while so I just want to hear from Mary...

((Crosstalk))

Phil Corwin: Yes, Kathy?

Kathy Kleiman: Can I just respond?

((Crosstalk))

Kathy Kleiman: ...breach, and I just wanted to clarify that as well since we are dealing with the convergence of both legal terms and technical terms. I was using it in a technical sense which is a breach is a break in a set of agreements so it's a term we used all the time in auditing. It's not meant to be a moral judgment,

it's meant to be just an actual review. It's just a break in the agreement, so thanks.

Phil Corwin: Okay, thanks for that further explanation, Kathy. Mary, why don't you go ahead and speak up and then we will turn to Greg to present his proposal.

Mary Wong: Sure. Thanks Phil, and thanks everyone for this time. So actually from the staff perspective we just wanted to highlight some of the background information that we had tried to provide on the list and to note that the following the IRT worked initially and then the STI recommendations, which has Kathy noted, was approved by the GNSO Council and supported by the ICANN Board, those then made its way into the Applicant Guidebook.

And I think in an email to the list we had noted that much of the amendments and updates occurred around mid to late 2010, and that's where we saw the three categories of trademarks that were acceptable and accepted into the Trademark Clearinghouse.

So one of the things that we wanted to highlight was the use of terms such as text marks and word marks. And if you look at the red lines from those times those were usages that changed, and I believe that the most recent formulation might be word mark. So our suggestion to this working group was and is twofold. One is maybe to clarify what specific category or categories of marks are we talking about in the Question 7?

So for example, when we say design marks as pointed out before, that may be considered a figurative mark in the EU and with some other terminology elsewhere. I think the categorization we have are things like pure text marks, stylized text marks without a graphical element and a mark that has both a graphical element as well as a word or text or character element.

So that's one thing that I think some folks on the working group list have also noted and that's the first suggestion we would make to clarify the terminology

that we are using here because it may be that for each of these categories of marks that they may be different justifiable treatments.

And then secondly, going back again to something that we sent to the list, in terms of Deloitte's treatment it may go back to first of all the wording in the Applicant Guidebook, and secondly the intent around that wording to community consultation as and whether that is in fact what Deloitte is doing or are they going beyond. So our second suggestion is to really go back and look at the intent as encapsulated in the STI recommendations as well as all the community consultations with the Applicant Guidebook. Thanks, Phil.

Phil Corwin: Okay, thank you for that, very useful input, Mary. And now I'm going to turn to Greg, and Greg please go ahead and present your proposal regarding design marks.

Greg Shatan: Thank you. Greg Shatan for the record. First, by way of background, that GNSO Council back in 2009 took on the STI final report and pass that on to ICANN Board as a recommendation. And, you know, made reference to including nationally or multinationally registered text marks, which was not further defined in that STI report, although that there was a note that the trademarks to be included in the TCR text marks because quote unquote design marks provide protection for letters and words only within the context of their design or logo. So that is a key perhaps to distinguishing the types of marks that were not intended to go in to the Trademark Clearinghouse.

The ICANN Board took a rather interesting approach in dealing with debt STI paper. It did not approve the paper or adopt the paper in full, rather it stated that it supported the substantive content of the proposals which seems to be, you know, a way to distance themselves from what from the actual text, so it's really more of a conceptual support than that was passed on to the ICANN staff to analyze public comments and develop a final version of the Clearinghouse proposal, and also the URS proposal for version 4 of the AGB.

The AGB has the wording that we know is there that just says nationally or registered word marks from all jurisdictions. And then the Trademark Clearinghouse guidelines, as we know, have ways of dealing both with Mark that consists solely of letters, words, numerals and special characters and those that don't.

Interestingly, the guidelines provide examples of both the – a word mark and a non word only mark. The word mark that they have as an example is the mark Deal Safe and they have two registrations in the guidebook for that. Both are the EU one identifies the type of mark as figurative whereas – and the US registration identifies it as words, letters, numbers and stylized form. It is a rather boring font, it might be Times New Roman or something, but it is nonetheless what would be called a stylized mark, not a standard form registration.

So even the word Deal Safe bet given as an example of a word mark is not a text only without any claim as to font type of registration. So I've noted that there are – there is really a whole spectrum of marks, mark type going from so-called standard form, where there is no claim that the font or color, those where there are claims to a font, those where there is stylized vision that goes beyond a mere font or it has been drawn rather than, you know, just taken from using a different, a particular font, color claims, words that may have small non-textual details such as a trefoil instead of the dot over the l.

Text with a design element where it is predominant, text where it is her dominant but not clearly separable or distinguishable from the device element and onto those where the text is not predominant but is separable and distinguishable from the device element, and those where it's neither. And then there's even design marks of course that don't contain any text element. And that puts aside three-dimensional marks found, color and other nontraditional marks.

So it's my view that taking the language about marks solely, letters that provide protection for letters and words only in the context of the design or logo leads to a conclusion that a disclaimer, a mark where the text is disclaimed in its entirety would be such a mark as well as of course designs without any text at all, and that there are rights asserted when there is not a disclaimed component, there are rights in the words and those words are protected beyond the context of their design and logo.

So the proposal then is to modify the Trademark Clearinghouse guidelines so that any statement, any application to register in the Clearinghouse a mark where the text was disclaimed in its entirety should be – should not be allowed in. However, anything where there is not a disclaimer and there is text should be allowed in even where it is not predominate or separable as these would be protected in addition to only being protected, they're not only protected in context of the registration with the design but the protection goes beyond that. So I think that in a nutshell is the proposal.

And it still draws the line where pure design marks are kept out, but marks where there is text that is used as a trademark, that is used as a source identifier and that is used to protect consumers is in fact registered in the Trademark Clearinghouse allowing the essential function of enhancing trust in the Internet to go forward. Thanks.

Phil Corwin: Yes, thank you very much, Greg. And I'm going to sum up just as I understand it. You want to propose some additional – two additional concrete pieces of guidance to the Clearinghouse. And I note that in your rationale that on Page 16 at Point 9 you note that the Trademark Clearinghouse is currently both under and over inclusive, so you seem to believe there are some deviation from what should be the proper practice going on right now by that Clearinghouse.

So while you and Kathy may not agree precisely on the exact details or degree of the deviation, you both think there is something that needs to be

constrained to some degree. So I think, and I'll hear you out in a second, Greg, but after you speak I think it might be best to have a discussion ensue as to whether members of the working group on this call believes that that Clearinghouse is doing something right now in their practice that falls outside the letter and intent of the rules for the Clearinghouse.

And if we can get some agreement on that we can discuss what if anything should be done to deal with that either to advise them to change their practice somewhat or to codify their practice through a modification of the rules. Yes, Greg, go ahead.

Greg Shatan: Thanks. Just to follow on to your remarks, and, you know, Item 9, the reason that I felt that the TMCH was being over inclusive is that we found that they were allowing marks where all of the text is disclaimed to be registered in the Trademark Clearinghouse, and I believe that's the sole example of over inclusiveness as well. And since there was no guidance given about whether marks were predominant or separable for any design elements that was a distinction that Deloitte took upon itself to make, that should be removed because that was not the intent.

And finally just to mention those two work tracks, because I think that as part of the overall proposal is that we do need to make proof of use requirements for purposes of sunrise eligibility and putting aside the question of whether we should extend these requirements to claims or not, does proof of use requirements should be more rigorous so that we keep out folks who are registering trademarks for the sole purpose of getting into the sunrise rather than registering trademarks for the purpose of running a business and identifying the source of their goods and services and incidentally are seeking to enter marks into the sunrise.

Finally, the other point is to require that the sunrise dispute resolution provisions, policies rather, contain a provision that any successful complainant can have the – register the registration transferred to them,

because we discussed earlier the fact that there was no real incentive to enter into a sunrise DRP, so that they would be rewarded either the cancellation and right of first refusal to register the domain name itself, or a transfer of the domain name, that was challenged and that will I think have more appropriate incentives for SDRPs to take place.

And obviously those are very short form proposals and can be more detailed as we move on. Thank you.

Phil Corwin: Okay. Yes, Greg, just to clarify that proposal for a proof of use requirement for sunrise, that's not part of the current proposal we're looking at, is it? Is that something that you've offered for this round or that's going to be offered when we get to sunrise just for clarification.

Greg Shatan: I mean, in here it's not fully fleshed out but given that it is really part of – in a sense it's part of the problem of this chicken and egg situation we have which is that the proof of use requirements are really part of the TMCH's job, and would be part of the TMCH but they also, you know, go specifically to the sunrise RPM. So whether we review them now or review them later when we are talking about sunrise, but then clearly have to apply them to the TMCH because that's where the proof of uses validated, you know, doesn't so much matter to me.

But I think the important thing is we've been talking about so-called gaming quite a bit, and I think there's a huge difference in what certain people define as gaming versus what other people define as gaming. In my view it's basically bad-faith trademark registrations being used for purposes of gaming a non-bona fide but still available opportunity to get into the Trademark Clearinghouse. And so that I think in terms of making the Trademark Clearinghouse a better database is something we need to deal with and probably better to deal with it now than later. Thanks.

Phil Corwin: Okay. Thanks Greg. What I'm going to do now is noting that on Page 2 you clearly state that the mark shouldn't be eligible for registration in that Clearinghouse where the text portion is disclaimed in its entirety. That seems to be kind to the limit of what you view as the lack of compliance by that Clearinghouse right now.

I'm going to ask just Kathy to come back in and explain in what instances beyond what you believe the Clearinghouse is doing wrong, she believes they're getting it wrong. But then when we kick off the discussion I think we need a discussion which is both on the subject of whether the Clearinghouse is violating the letter and spirit of its current rules but also as we do that, be aware of the fact that, you know, we now have some more time and some more experience to come back to this issue.

And we are not bound to the original rules, we are free to recommend policy modifications to those rules if we think I'm either legal or operational grounds they are justified now that we've seen that Clearinghouse in operation. So, Kathy, could you just come back and briefly explain to what extent beyond what Greg has identified you think the Clearinghouse is in noncompliance with the letter and spirit, and then we can open it up for group discussion on the subject. Thank you. Kathy.

Kathy Kleiman: Sure. Sure, thanks Phil. And I just wanted to clarify since there is a discussion of this in the chat room that we haven't really gone into the history of the IRT and the STI, but the STI was created when there wasn't a PDP process or outside of it because it had to be. We were given – we, the GNSO community was told we had to create teams that would come together from every stakeholder group to review the IRT report, because so many concerns had been raised to make it balanced from the perspective of all the stakeholder groups and to submit it and that is what would be reviewed by the GNSO Council and by the ICANN Board. And that was what happened and that was what was approved.

And since I was on that committee, and frankly since Konstantinos Komaitis, after Konstantinos Komaitis and I spent hours, days on this section, we know what was drafted and we know what was intended, which is that design marks would not be included. Now of course design marks could be pure design, that's what we are talking about, we are talking about the integration of words and letters.

I totally agree with Greg, if it's disclaimed, that's part of the problem is that if you have something in that is dialyzed and they disclaim the word, probably because it is generic to the industry like parents, for Parent Magazine, then of course it doesn't belong in the Trademark Clearinghouse, that was the essence of the balance we were trying to get to.

But if you go into a composite mark where the words are so integrated into the design or the logo or the style, they may not need to be disclaimed because the trademark office, the US Trademark Office, for example, considers them, considers the letters and words to be so integrated into the design that they wouldn't be protected outside of it otherwise.

So the idea of Deloitte going in and then extracting from that design one that goes so far into the design that it wouldn't even need to be disclaimed even if it was generic, seems to be a contradiction in terms, seems to be again, outside – way outside of what we want to be letting in. If it's disclaimed, great, but if it goes beyond that and it's too stylized so that it doesn't need to be disclaimed, that certainly wouldn't belong in the Trademark Clearinghouse and the question is, how to integrate that concept and then how to take care of countries where you would have these very, very detailed patterns, but there is no process of disclaimer.

What Greg proposes is very US-centric model, but how do we globalize that for the same level of protection and what the STI found and, again, what the GNSO Council and Board approved was the easiest way to do it, the way to take discretion out of the Trademark Clearinghouse, out from who is now

Deloitte, the provider that is now Deloitte, was to say text marks, we are going with the text, we are going with the stray characters. And that's where the largest protection under trademark law is, outside of logos and styles.

So I don't know how we fully extend that protection to what was intended under the rules and what creates really fair balance. Thanks, Phil.

Phil Corwin: Okay, thanks Kathy. I'm just going to say at this point, as I think about this, as the discussion proceeds, I'm actually thinking that rather than, you know, anyone could feel free to discuss – to what if any extent they think Deloitte is not properly following the letter intent of what was the forth in the rules for the Clearinghouse, but really I think the more productive question for us is, now that we've got the benefit of experience and we have the time to give all of this a second look given the somewhat, the very convoluted history of how we got to this point, is I think the task before us just to clarify how Deloitte should be handling, how the Clearinghouse should be handling design marks going forward regardless of what the past history and practice has been.

So that's probably the more positive and productive questions look at. And let me call on Jeff Neuman to expound on this question. Thank you Jeff, go ahead.

Jeff Neuman: Thanks, Phil, and you've actually said a lot of what I was going to say. I think we spent a lot of time both in emails and on calls talking about what the STI meant or didn't mean, and I was on that group as well and I was on the IRT before that. And, you know, going back through emails, we didn't do such a great job in the STI of documenting rationale behind what we did so it's really difficult to go back and remember all the stuff.

And I think in fact, that what you said, the much more productive discussion is what do we think should be the rules going forward. And I think in the last explanation I think Kathy started to really get that as to her belief as to what we should do. And I'm sure Paul and Greg have their views as well coming

out. I agree with you, Phil, we should focus exclusively on what we think should be going forward and not necessarily worry about what's happened in the past. Thanks.

Phil Corwin: Okay, thank you Jeff. Paul McGrady, please go ahead.

Paul McGrady: Thanks. Paul McGrady for the record. So I agree with Jeff, I think that – and Phil on this – I think that referring back to early-stage documents, no matter how much we might like them and certainly I was on, you know, being a member of the STI, you know, think favorably of all of our hard work together on that, doesn't really advance the ball. The bottom line here is that the Guidebook is the Guidebook and the program is the program. And, you know, anybody – I guess if we claim STI and we should be able to claim back to IRT and there's all kinds of stuff missing in the Guidebook from that.

So I think we should just sort of move forward. I do think however, to get anywhere with moving forward we need to get back to some pretty clear definitions because I don't think that lumping a stylized marks in with design marks is, you know, I don't think that's productive because if we do that then that leaves some of us in the awkward position who would otherwise say, you know, essentially have a very dim view of composite marks, if they're being lumped in with stylized marks, which may be quite distinct and are just written in cursive instead of in Times New Roman, that sort of backs us into the corner, to have to defend the collective definition as opposed to really parsing it out and having the conversations about each kind of mark.

So hopefully we can parse it out, that way we don't have to get backed into a corner and inadvertently, you know, go overboard trying to defend one kind just because it's lumped in with another. Thanks.

Phil Corwin: Okay. Thank you for those thoughts, Paul. And I see Greg's hand up again, go ahead Greg.

Greg Shatan: Thanks. I think Paul, you know, pretty much made the point, one of the points I was going to make. The other point I was going to make of course is that the – characterizing the STI reports as being the thing that is being breached because the Board somehow, you know, made it its document I think is incorrect reading of the status of the STI.

And I do agree that moving forward and trying to figure out what should be done, which is where I think my proposal largely goes, whether we adopt a proposal exactly as put is better off rather than treating this as some sort of a star chamber inquisition of the Trademark Clearinghouse, which I assume believe it was proceeding in good faith. You know, we may need to look at how the Trademark Clearinghouse works with ICANN and the community over time since nobody seems to have noticed this for years and so we did this review, which kind of points to some issues and how they should all be dealt with on an ongoing basis.

But, you know, I think, you know, looking at this as a past performance problem probably puts us in exactly the wrong place. Thanks.

Phil Corwin: Yes, thank you, Greg. And before I call on Kathy again I just want to observe I'm noting some discussion going on in the chat room. And my only comment would be there are some specific references to US PTO practice. I just remind everyone that we are dealing with a system that's got to have I guess what I would call some looseness in the joints because different national trademark regimes have somewhat different approaches to all of this. And we are trying to create a global system for the DNS that's compatible to as best possible with all those varying regimes.

So, Kathy, go ahead.

Kathy Kleiman: Hi. Yes, it's going to be interesting when we get to the UDRP whether we can take it as loosely as we are taking other policies that have been adopted by

the GNSO Council. That will be interesting. But I want to drill down on Greg's talk a little bit. And I did post something from the US PTO.

One is, you know, obviously if every word were disclaimed that would solve the problem, but that's not what's happening. In many countries you don't have disclaimers so how do we handle those? And also even within the United States you can have a word that is so integrated into the design that the words themselves are construed to be un-registerable and so they don't need to be disclaimed.

And yet that appears to be what Deloitte is extracting from designs based on the examples that we gave them. So based on the reasoning of the original STI, that would go beyond the balance of protecting trademarks but yet also protecting the rights of others because you would wind up protecting generic words that might be disclaimed if the design work so extensive or might be disclaimed if it was in another country but yet is generic or very highly descriptive to the term.

And we would normally not consider excluding, the reason it's in the design is because probably it couldn't be registered as a text marked because you don't want to exclude competitors from using a term basic or highly descriptive to their industry. That was the balance back to STI was thinking of. How do we protect that balance and what we are doing here. Thanks.

Phil Corwin: Okay, thank you, Kathy, for those further thoughts. Alright we've had a good – I don't see any other hands up right now. We've had a good discussion of both whether Deloitte in operating the Clearinghouse is adhering properly to the Guidebook. And there seems to be some consensus that some guidance, further guidance to Deloitte based on experience and based on further thoughts of what the proper policy should be would be advisable.

There's not agreement yet on what precisely that guidance should be to Deloitte. So I'm going to suggest that, given that we have a limited number of

participants on this call, and we are not going to be able to decide anything tonight, that we give other working group members the opportunity to review our discussion and the extent to which it was explored this question, and maybe rather than trying to go further on it tonight, given that we have about 35 minutes left, maybe get some presentations on the two proposals relating to Question 8 on geographic indications, protected designations of origin and protected appellations of origin, let them at least be presented tonight and initiate a discussion on that.

And then we can give working group members the opportunity to review those discussions and come back at the next meeting to try to go further on discussing consensus responses on those issues.

Mary, I see your hand up, go ahead please.

Mary Wong: Thanks, Phil. Sales staff just had a question that in terms of going forward recommendation from this working group and guidance to Deloitte, would it be helpful to try to get working group agreement on the various types of marks that could be called a design marks writ large? And we ask that because of two things.

One is, you know, that the principle of non-differentiation that was adopted for the RPMs, but secondly and perhaps more importantly it may be that the working group will ultimately agree that certain guidance that's applicable to a certain kind of so-called design marks may be different for another kind. So for example, a mark that's all text but stylized may be treated differently from a mark that's got text integrated with a graphical representation.

So we are just wondering if that is a worthwhile inquiry to try to get some sense of definitional clarity. And if so one thing that we could do, as has been done in other working groups, is to set up a survey or a poll to try to get working group members views on that bearing in mind, as you noted that we

don't have many working group members on this call and we don't always have working group members on all calls.

Phil Corwin: Okay. Yes, Mary, my personal reaction to that, and I solicit feedback from other working group members, is that a good suggestion? I would welcome staff preparing a draft document to go out to working group members as a survey giving a little bit of background, explaining that there does seem to be consensus that some additional guidance to the Clearinghouse on this design mark issue would be desirable.

And asking working group members whether they think for various categories of marks, such guidance would be advisable. I think we should give them the option to say yes, no, or not sure because this is a very complex area, and I think working group members might want to discuss things more before rendering a final opinion.

And if staff could prepare that I think the cochairs could review it very quickly and get it out to the working group to kind of get a sense of where the working group is on those various categories.

And with that I'm going to be quiet and call on Mr. McGrady, his hand is been up for about a minute.

Paul McGrady: Thanks, Phil. Paul McGrady here. I don't have any problem with the idea of another round of surveys to find out whether or not people, you know, think – we're getting some background noise. I'm not sure whose line that is. I'll wait. Oh there it goes. I have no problems putting out another survey to find out whether or not people think that we need to make changes to the way that Deloitte has been doing things and even, you know, asking opinions about whether or not the way Deloitte has been doing things is consistent with the Applicant Guidebook.

But I do have very strong concerns with an idea that Mary put forward which was that we would collect all these different kinds of marks and write large called them design marks and then again after we make that language then parse it out again and call them what they really are in real life. We don't need a survey to go out there and create new language for categories which are already well defined categories in trademark law.

There are text marks were word marks, sometimes they're called, there are stylized marks, there are composite marks which are text marks and a design element together, and there are design marks which are just designs. And so we don't need to re-create the wheel and re-create brand-new language so that we can get nice and confused and end up with a work product that nobody knows what it means.

We should stick with words that have a current meaning already and they go ahead and have that survey but not get bogged down in attempting to create a new language for this and then go back and try to apply that new language to the Applicant Guidebook and to what Deloitte is doing, it will be meaningless because Deloitte is supposed to be operating under the Applicant Guidebook and its contract with ICANN both of which preexist any new made-up language that we might create tonight. Thanks.

Phil Corwin: Okay, yes, thanks for that, Paul. And I note in the chat room Jeff Neuman has inquired whether we can create a glossary of these terms. Mary has agreed that we need to get consensus on the terminology. So I think the question we need to address and give working group members the option of saying hey, I don't even think this falls within the category, but we will try to work out a questionnaire that doesn't stray too far and is very clear on what it's referring to with these different categories because if we can't agree exactly on what we're talking about it's going to be very hard to find any kind of consensus. So I think those are all good suggestions.

All right, it's now –we're at the one-hour mark, we have 30 minutes left. Did anyone have anything further to say on the design mark issue? If not I would hope we could get presentations on the two proposals regarding geographic and related indicators to at least start teeing up those proposals, and then on the next call we can get into more discussion on those. Is that acceptable way to proceed, anyone object to that please speak up or raise your hands now.

I see one affirmative checkmark. Okay so I note on Page 3 the question is, how would geographical indications, protected designations of origin and protected appellations of origin currently handled by the TMCH provider, and the first proposal is from the esteemed Mr. McGrady, so Paul, if you could go ahead and present your proposal and the rationale and then Kathy has a proposal on that and we can let her go ahead after you. And then we can start our discussion on that in our remaining time tonight. So go ahead, Paul.

Paul McGrady: Sure, thanks Phil. So my proposal is somewhat straightforward, and I think to a certain extent contains its own rationale but I'm happy to answer questions about it. And I guess I'll just read it into the record. I apologize. I know it's out there for everyone to see.

But here goes. GIs or geographic indications are not always trademarks. The Trademark Clearinghouse is a place to lodge trademarks. 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 Trademark Clearinghouse. For any GIs that are not the subject of a national registration which are currently lodged in the Trademark Clearinghouse, such GIs should not be renewed in the Trademark Clearinghouse upon expiration.

For any GIs that are currently in the Trademark Clearinghouse 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. To the extent that there is interest in finding a mechanism to

lodge GIs that are not the subject of national trademark registration for use in as yet unidentified RPMs, study of the concept should be split off from this work and given its own study and thought.

So, what I'm trying to do here is just present in extremely straightforward, it doesn't accuse Deloitte of any wrongdoing. It doesn't, you know, bring in unnecessary factors. I just think it's straightforward. You know, GIs, unless they are registered trademarks shouldn't be in there. And frankly the issue of GIs and their existence at law, is not universal across all countries; it's quite a complex discussion.

You know, they may serve some source indication in relationship to regions or places or the kind of grape or something but, you know, they're not trademarks in the sense of, you know, I know precisely which producer made the thing I just consumed. So they are very, very different in some very important respects from trademarks, unless of course they're registered trademarks.

In which case, we would then know who is claiming that GI and could in theory, you're looking at their licensing relationships, figure out who is actually using the mark. So kind of a bright line rule. You know, it's not terribly nuanced, folks, but there is. Thanks.

Phil Corwin: Thank you, Paul. And I welcome your statement that the Trademark Clearinghouse is a place to lodge trademarks. I may bring that up at some future discussions. But I appreciate the explanation, and I'm in general agreement with the thrust of your proposal. And now let's hear from Kathy on her related proposal.

Kathy Kleiman: Terrific, Phil, thank you. And I find myself in a very comfortable position...

((Crosstalk))

Phil Corwin: Oh, Kathy, could you hold one second? I see Jonathan Agmon has his hand up, if we could just hear from him...

Kathy Kleiman: I will save my compliments for Paul McGrady's proposal for another minute or two. Thanks.

Phil Corwin: Jonathan, please go ahead.

Jonathan Agmon: Yes, I just wanted to say we've been I think discussing the issue of GIs in the group, via emails, and I don't find the proposal to be very comfortable. I think that from a US perspective it may be that the practice that GIs maybe should even be excluded from the trademark system. But I think that there is a lack of balance in the group when it comes to US perspective, and I wouldn't say more foreign perspective. So I think if you take the European perspective they don't think that GIs are something that should be excluded or that there are sometimes or maybe trademarks, I think that their view is completely different than the view that Paul was presenting.

So I tried to present a different view, right now I understand that the current view is Paul's, but I think that this discussion maybe should be extended and be further discussed especially with the European counterparts because as far as they are concerned that GIs are very very important and they are like any other mark. If I take it from the top a way I see it is that when you say that GIs may not be or may be trademarks it's like saying that marks may be trademarks or may not be trademarks. It really depends whether it is registered or not.

I do agree that for them to be inside the TMCH they have to be registered. From my perspective I would take – even take out the first sentence and the second suggestion that I would basically do is say that if they are registered, if GIs are registered because ordinarily in other countries they would be registered in GI registries, which are within the trademark offices. And if that

is the case I should argue that these registered GIs should be included in the TMCH.

Phil Corwin: Okay. Yes, thank you, Jonathan. You know, as I commented a little while ago we are trying to create a global DNS facing system that is in rough compliance with various approaches in different national trademark regimes, and they're sometimes not in alignment. But, I'll just say on behalf of Paul's proposal that under his proposal it if a geographic indicator was given a trademark registration in a nation that did that it would be I believe under his proposal, allowed to be in the Clearinghouse.

And I see Paul has his hand up so I'm going to call on him and then call on Mary. And I apologize to Kathy but I want to let this discussion play out before we get to the presentation of her proposal, related proposal. So Paul, please respond if you can and then we will turn to Mary.

Paul McGrady: Sure, thanks Phil. Just to say that obviously where Jonathan is coming from is very different from where I'm coming from on this. But I know that, you know, he on the list has been very thoughtful. And I don't think that we should stick to an arbitrary deadline on proposals. And I think if the wants to enter a counter proposal for us to think about in the next call I would have no objection to that. I think that the more the merrier. Thanks.

Phil Corwin: Yes, that's fine with me, Paul. And regardless of whether someone submits a counter proposal, any proposal before us is subject to extensive amendments through consensus of the group, so I view these proposals as starting points for discussion rather than, you know, a fixed proposal that we have to either accept or reject in their entirety. Mary, please go ahead.

Mary Wong: Thanks, Phil. So on this question of geographical indications, and more broadly because the Applicant Guidebook doesn't actually speak to GIs but it talks about a mark protected by statute or treaty, and that was part of the

discussion that we had with Deloitte as to what extent this category or mark protected by statute or treaty also includes GIs.

So it seems that the key here for this category is what is a mark? And I guess I would have hung up on us. So what staff did is we went back and looked at the various iterations of the AGB. We looked at a number of the public comments and the staff analyses of those comments in the various iterations of that AGB to try to figure out some of the context and evolution of this category as it relates to GIs.

So one thing that may be of interest to the group is that there were public comments submitted as to marks protected by statute or treaty including from the International Olympic Committee. And the just of those comments seem to be that where you have marks that are protected by statute or treaties, those can also function as source indicators.

So given that the word "mark" doesn't actually have a technical definition, our interpretation is that because of those public comments and the fact that we are looking at marks as source indicators, that maybe how this category of marks got into the Clearinghouse.

But bearing in mind what we agreed earlier that, you know, it's not so much looking to the past but to see what should be done going forward the other observation we would make as staff is that the status of protection for GIs, while very similar to trademark, is not necessarily the same. Under current international law norms, I think the protections kind of divide along either a sui generis type of protection, whether under statute or some other form of protection, or using collective marks or certification marks depending on what jurisdiction you are in and what language you use, and that's more akin to what you have under trademark law.

And there is a couple of other schemes for protection. So ultimately again, you know, the question is for this working group to decide whether in terms of

the scope of the TMCH GIs, as such, and also other marks that may not be GIs but that are protected by statute or treaty, are they or are they not properly within the scope of the TMCH? Thanks, Phil.

Phil Corwin: Well thank you, Mary. And to paraphrase President Trump, I had no idea design marks were this complicated but I'm being educated. I see a lot of good discussion going on in the chat on this subject, a lot of good observations. I don't see any other hands up right now so I'm going to invite Kathy, we've got 18 minutes left on this call to present or related proposal regarding design marks, and then we will see if we have time to start a discussion on these proposals. So go ahead Kathy.

Kathy Kleiman: Great. Thanks, Phil. I did want to say that that I'm in the comfortable ground that I was in for such a long time of agreeing completely with Paul McGrady on his proposal because I think it is consistent. But my proposal is...

Phil Corwin: I want to make note of this moment because it may not occur again soon.

Kathy Kleiman: It is a valuable and important moment. And what I wanted to say is that the question, Number 8, deals with geographic indications. What we found out is that much more appears to be going into the Trademark Clearinghouse database. And we don't know what that is. So let me talk about the problem, which also a source of confusion, what the rules we adopted said and what the harm is in the direction we're going.

So I'm going to call my proposal the what do we do about the black hole? And that's because we don't know what the term "marks protected by statute or treaty" means. Some think – and I surveyed people – some think it means solely marks protected, expressly protected by treaty like Olympics and Red Cross. Others believe it protects geographical indications so categories created under certain laws and treaties. Others frankly, including people who were very instrumental in creating these roles, do think it involves the 6ters, and that involves protections for categories of organizations like the IGOs.

So again let me call this the black hole because we don't know what it means. What's really interesting is we didn't pass the rules either, you know, they got put into the Applicant Guidebook but they weren't passed by the GNSO Council. And that's because what was passed was that the names of the rights protection mechanism, the name of the rights protection mechanisms should be the Trademark Clearinghouse to signify that only trademarks are to be included in the database. That's a direct quote from Section 1.1 of the Trademark Clearinghouse rules.

And then it says, anything that is not a trademark is going to be under – it has to be segregated into ancillary database, again a direct quote. The Trademark Clearinghouse service provider should be required to maintain a separate Trademark Clearinghouse database and may not store any data in that Trademark Clearinghouse database related to its provision of insular services if any. The Trademark Clearinghouse is for trademarks.

Yet when we saw the Applicant Guidebook, we saw this very vague sentence about marks protected by statute or treaty. We know that at least 75 of these marks have been approved by Deloitte, that's what they shared with us in Copenhagen, and we appreciate them sharing that with us. But it doesn't comport with the balance that we are looking for or certainly the balance that the STI and the GNSO Council had when they said the Trademark Clearinghouse is for trademarks. Certainly there were a lot of other things people wanted to put in that, but that was rejected.

And the reason why is for everything you put in the Trademark Clearinghouse, you are creating rights through the sunrise period, through the trademark claims, through perhaps private protections, that then exclude other people from doing other things or eliminate certain possibilities that they might have.

So the idea is to know exactly what goes into the Trademark Clearinghouse and to provide the appropriate protection for those trademarks, and then select everyone else register the new gTLDs, we created the new gTLDs for new space, for new companies, new goods and services, new speech, new research, new education, websites and domain name registrations.

And so it really hurts the balance when we create a black hole, which we don't know marks, protected by statute or treaty. If we want to reinterpret that as trademarks protected by statute or treaty that makes more sense to me and that seems to comply with the rules as created. But a Trademark Clearinghouse that has a whole bunch of other stuff in it is a black hole. Thanks.

Phil Corwin: Okay. Thank you, Kathy. Just reflecting on what you just said, it seems to me that the fact that the Clearinghouse rules provide for the possibility of registration of marks protected by treaty or statute that's evidence that there was a desire to let something other than registered trademarks in, but it's not very precise as to exactly what that should be and there are the various interpretations of what marks protected by statute or treaty means.

So I think our task is to bring some clarity to that vagueness as we go forward looking toward a future round of new TLDs with rules for these RPMs that are more clear based on experience and the ability to think about these – some of these policy issues more than was originally done.

So with that, who wants to speak in regard to these proposals on geographic indications? Surely there's someone on this call who wants to add their thoughts on this. Anyone? Well, the group is either in complete agreement with what's been said or they're starting to fall asleep, I'm not sure which is.

But wait, I see two hands up. Okay, George Kirikos and then Greg. Go ahead, George.

George Kirikos: George Kirikos...

Phil Corwin: George, can you hold one second? I see Mary has her hand up. I just want to see what she has to say before we launch into this. Go ahead, Mary.

Mary Wong: Hi, Phil. Yes, so actually I was just going to follow up on some discussion in the chat and noting that the category under which GIs go into the TMCH is the category of mark protected by statute or treaty. So I was just wondering if it would be helpful for the working group to agree on what the mark means.

From our perspective, you know, we've been looking at it as something broader than a trademark as a mark that is something that denotes source or origin or something like that. So from that perspective, one can perhaps see why a mark protected by statute or treaty might include a GI or a designation of origin.

From a different perspective however, if a market is to be equated as a trademark, then obviously the scope of the TMCH would be narrower. So we just want to raise that as a possible point of discussion. Thanks, Phil.

Phil Corwin: Okay thank you for that suggestion, Mary. Okay, George, go ahead and then Greg. I know we have 10 minutes left so if anyone else wants to queue up we might have time for one or two more comments after the two folks who have their hands up and then we are going to get a couple of final items and adjourn the call for now. So go ahead George.

George Kirikos: Thanks, Phil. It's George Kirikos for the transcript. For these GIs, I was thinking that perhaps I don't know if this is something that the Registrars could do, but I think the holders of those GI, not to use the word marks but terms, want to be able to protect their marks I guess or their terms in their territories.

So for example the term champagne obviously have protection in France. I don't know if there would be a way for the Registrars to show the claims noticed only to prospective registrants from France instead of showing it worldwide. So for example, if you're using the OVH Registrar in France, and your person in France, you know, you would be shown the claims notice in the event you tried to register champagne.web or something. But if you're an American living in – if you're an American, you know, living in the United States and try to register at Network Solutions or Go Daddy you wouldn't see that claims notice so just thinking out loud but that might be a way to kind of handle the situation to give them the limited recognition that they deserve, but not give them overly broad expansion of the actual rights that they do have.

This might actually be something that could be done for even the regular claims notice if you have a registered trademark in Belgium perhaps that Americans shouldn't see that claims notice if they weren't planning to use the commercial term in Belgium. But at least for the GIs it would make a lot more sense to have kind of like a more territorial claims notice. Thank you.

((Crosstalk))

Phil Corwin: Yes, thanks, George.

George Kirikos: One more point.

Phil Corwin: Just thinking about that, that would require both the Clearinghouse marking in some way a GI as a GI and deserving of different treatment than the trademark, and then somehow the registrar who is the contact point with the potential registrant somehow identifying where there from before actually getting their application for the domain because the potential registrant gets that claims notice before they complete the registration and submit all of their identification information.

I think that would probably be pretty challenging to do, that's my initial reaction to that.

George Kirikos: Yes, I agree. It's definitely harder than what's being done at present.

Phil Corwin: Yes.

George Kirikos: And some of the other people are mentioning that in the term. But this is just a thought I put out there.

Phil Corwin: Yes, while I appreciate the thought. And again, you know, we're trying to accommodate different treatments of these GIs in different trademark regimes. Yes, Greg, go ahead.

Greg Shatan: Thanks. Greg Shatan for the record. A couple of different points. First with regard to marks protected as statute or treaty, the phrase, I think this is one place where we do need to look backwards a bit and try to figure out how this language came to be and whether there was any basis for using it for GIs or whether this was just an error on the part of the TMCH, again clearly an error that hung out there for quite a while before anybody really stood up and took notice.

But I think we kind of – I don't think so much a black hole or it's a hole into which no light has been shone, shone, not shown. And so I think just trying to – but that's the backwards looking half. The forward-looking half is should GIs be protected? I think arguing about whether GIs are trademarks, first might view is that empathically the answer is no unless, you know, there is a GI that may also function as a trademark is a certification mark. But that's not all GIs, and it's not all certification marks.

But I think we are also putting the cart before the horse, as I said in the chat. The TMCH is just a tool that exists to facilitate the substantive RPMs of sunrise and claims. So unless we are going to have a GI sunrise or GI claims

notices, then, you know, there's no reason to create a GI Clearinghouse. And again I think mixing GIs and trademarks in the same clearinghouse is dead wrong on the law. Not saying that there shouldn't be sui generis protection for the sui generis GIs.

Lastly I'll note that the Trademark Clearinghouse guidelines allow the Trademark Clearinghouse, or rather the AGB section on the Trademark Clearinghouse, allows the Trademark Clearinghouse to create other databases for use by particular registries as long as they keep those segregated from the Trademark Clearinghouse database. So if any particular registry wanted to take upon itself to have a GI sunrise or qualified launch program or whatever it might be, the Trademark Clearinghouse might not be the low bidder, but they are certainly, or they might be, but they are certainly capable of doing that.

If we are going to go back and talk about creating new or additional rights for other types of IP, I think we should go back to the IRT report and to the concept of an ICPH, which may be in multiple sections, to avoid friction, but that's kind of where I think a discussion of GIs belongs. Thanks.

Phil Corwin: Okay. Thanks, Greg. And by the way, again while we are not bound by past decisions it's useful to know how we got to this point. So I like your suggestion and would hope that staff could provide us with a little background on how that term, protected by treaty or statute, came to being, what if any dictate areas in the history that indicates what it was meant to denote.

And I'm going to take a very quick comment from Jonathan and then I'm going to end the queue because we are three minutes from the conclusion of the call. So this'll be the last comment, and then we will briefly hit some logistical items and ended the call. So, Jonathan, go ahead.

Jonathan Agmon: I will be very very brief. I think that my problem is not whether we create GI Clearinghouse, it's the fact that we shouldn't take a position about what GIs

are. While Greg may argue that GIs are not trademarks, I actually think the opposite, I think that GIs are a type of the trademark. I actually think contrary to what has been said in the chat room that there are numerous laws around the world that are very very similar or usually they're in affinity with the local trademark laws that actually assign protection to GIs and they're a trademark umbrella.

And, I mean, I can go on and on about this, but I don't think that it's going to be very beneficial right now because I have the two minutes. My only suggestion would be, first, not to characterize GIs in a way that would actually maybe be harmful to certain systems of law that are different to the US. And the second thing was to consider whether registration of GIs as, I would say, a form of trademarks in other national – by other national laws, should also be included.

I understand that in the US GIs, when registered are registered as trademarks in the US PTO but there are quite a lot of different countries which basically have a different, I would say, registry that is usually within the trademark office and protects GIs when they are registered. And I'm stressing when they are registered as GIs, whether this should also be included in the TMCH once a person actually showed that he has that kind of registration. Thank you.

Phil Corwin: Okay well thank you very much. And we're now one minute before our closing time. Item 4 is the notice of deadline for further follow up questions to the Analysis Group. I'm going to – Mary, can I call on you to give a 30-second explanation of that and to note what the deadline is?

Mary Wong: Sure, Phil. Happy to. So basically the long and the short of it is that the Analysis Group was contracted by ICANN to do the TMCH review, which they've pretty much done. So to the extent that our working group has sent them follow-up questions based on the data and findings that they've had,

that has been something they've been able to write answers for and they've been happy to do that.

To the extent that we are asking them to do additional work beyond what data and findings they are to have, that's more difficult. The GDD staff have kindly extended the statement of work for the Analysis Group to address the questions that we have sent them so far.

So the request of this working group is that if there are additional questions that we want to ask of the Analysis Group about their TMCH review paper, A, we would need to ask that before mid-May; and B, if it goes beyond the scope of work it will be very difficult to actually get that through because it will mean a new contract or at least a substantive extension of the existing contract and therefore budgetary impact that we did not allocate for.

So the long and the short of it, Phil, is that if we have follow-up we should get that follow-up to them sooner rather than later and definitely before mid-May.

Phil Corwin: Okay, and, Mary, have we put out a notice to working group members yet of this pending deadline? If not I think we should as soon as possible to give everyone opportunity to formulate any further questions before the deadline, some conspicuous notice going out to the working group would be advisable.

Mary Wong: Phil, and we have not. We will do so after the call. And to George's question in the chat, no, I don't think you need to resubmit the questions; we have noted the questions that we have actually sent the questions that were raised from the last call to the Analysis Group, so we are good there. It's just a question of what if any new questions there are and when those need to be sent in.

Phil Corwin: Okay. Thanks. And finally, our next meeting is I believe one week from today. I don't have my calendar in front of me. Staff, just can you tell us, confirmed the date and time of the next meeting? I believe it's May 3, is that correct?

Mary Wong: It is the next Wednesday. And Terri has just put the date and the time in the chat. We are reverting – because of the rotation –two 1600 UTC. So the only thing I would add to that, Phil, is that we have a meeting next week 3 May, but we will not be having a meeting the following week, the 10th of May, because of the GDD Summit.

Phil Corwin: Right, and then we'll probably have won the following week, the 17th, and then I suspect we will be having a meeting the week after that on the 24th because so many of the members of this working group will be at the INTA meeting in – the INTA annual meeting in Barcelona. So we need to be as productive as possible on these calls due to that.

I think we made good progress tonight. I think we clearly have consensus in regard to both design marks and marks protected by treaty or statute that we need to provide some additional guidance to the operator of the Clearinghouse. We don't have consensus yet on what that guidance should be. Hopefully we will make progress with that on those questions on next week's call. And we will also hopefully get a presentation of the proposals relating to Question 10.

So I want to thank everyone for being on this call and for having such a productive discussion. And for those of you in the North America and South America, I will wish you good night, and for those on other continents hope you have a good day. And with that I will close out. Good bye, all.

END