

ICANN Transcription**Review of all Rights Protection Mechanisms (RPMs) Sub Team for Trademark Claims
Data Review****Wednesday 27, March 2019 at 1700 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:

<https://audio.icann.org/gnso/rpm-review-trademark-claims-27mar19-en.mp3>

Adobe Connect Recording: <https://audio.icann.org/gnso/gnso-rpm-review-trademark-claims-27mar19-en.mp3>

Attendance is on the wiki page: <https://community.icann.org/x/oA5IBg>

The recordings and transcriptions of the calls are posted on the GNSO Master Calendar page:

<https://gnso.icann.org/en/group-activities/calendar>

TERRI AGNEW :

Good morning, good afternoon, and good evening. Welcome to the RPM Sub-Team for Trademark Claims taking place on the 27th of March 2019. In the interest of time, there will be no roll call. Attendance will be taken by the Adobe Connect room. If you're only on the telephone, [inaudible] please identify yourself now.

Hearing no one further, I would like to remind all to please state your name before speaking. Please keep your phones and microphones in mute when not speaking to avoid any background noise. With this, I'll turn it back over to Martin Silva. Please begin.

Note: The following is the output resulting from transcribing an audio file into a word/text document. Although the transcription is largely accurate, in some cases may be incomplete or inaccurate due to inaudible passages and grammatical corrections. It is posted as an aid to the original audio file, but should not be treated as an authoritative record.

MARTIN SILVA: Thank you very much, [Terri]. Hi, all. Just to jump right to the issues, today we're going to start on question two, but before that, I would like to open the floor for a few minutes for brief – and when I mean brief, I mean brief – please, brief interventions if there are any other comments you may have on question one, since we're going to go from two sequentially moving forward. I don't want to leave anything behind but someone might have some from the last call. Does anyone have anything to add from the previous call?

Okay, I don't see any hands up. I have Kathy Kleiman.

KATHY KLEIMAN: Yeah. Can you hear me, Martin?

MARTIN SIVLA: Perfect.

KATHY KLEIMAN: Okay, great. I think somebody should talk about the e-mails that are going back and forth in the e-mail stream right now. I think they started, and I could be wrong, with Rebecca Tushnet who was not able to join us in Kobe of posting some new material—

REBECCA TUSHNET: Sorry, Kathy, I'm on. Just audio only. Just so you know.

KATHY KLEIMAN: Oh, okay. Well, why don't I let you summarize, then, because you'll do a much better job. Rebecca, would you like to summarize? I was just going to summarize but I'm sure you'll do a better job.

REBECCA TUSHNET: Sure. I think I put my concerns out pretty clearly. What we have is evidence perhaps that some group of people is being [inaudible]. We don't know what that group is. There are reasons to think it might be disproportionately not problematic for registrations but only [reasons]. I do think the only honest answer is it's possible that it's working. I don't know if [inaudible] is here, but if the working group is not ... I would like to at least be able to present that as an option. Thank you.

MARTIN SILVA: Thank you, Rebecca. Kathy, you have your hand up. I don't know if it's an old hand or a new hand.

KATHY KLEIMAN: New hand. Just to ask, since I know Rebecca is not in the room, Rebecca the only honest answer to what, if I might? And is it question 1A, is the trademark claims service having its intended effect of deterring bad faith registrations? I think that's what you were responding to online.

REBECCA TUSHNET: Yes. Kathy, I'm sorry, I'm in a really noisy place so I'm going to try not to talk. But, yes, thank you.

KATHY KLEIMAN: Okay, great. Thanks. Back to you, Martin.

MARTIN SILVA: Okay. Thank you very much. Rebecca or anyone else that is only on phone, just please jump and interrupt me and you will pop in the queue. Okay. If we are done with anything from last meeting, let's start with question two. That is where we left off.

Question two. If the answers to [inaudible] question A1 is no or 1B is yes, or if it could be better, what about the trademark claims notice and/or the notices of registry names should be adjusted, added, or eliminated in order to reach the [inaudible] under each of the following questions. Of course, we [inaudible] if one is no or [inaudible] is yes. But in any case, what are your thoughts on A? Is the claims [inaudible] extended? If so, for how long [inaudible]? The floor is open. I have George Kirikos first in the queue. Please, George, go.

GEORGE KIRIKOS: Just before I answer this question, I want to clarify, did we want to just do question two sub-part A now or should we do all five sub-parts?

MARTIN SILVA: No. I think we can go part by part. That would be more clear. We're either discussing about the period or about the [extensions] of [TLDs]. I think this could be ... I mean, you can talk about the period A, B, C or about the [inaudible]. They should be extended, shortened, or mandatory. You can comment on A, B, C if you want.

GEORGE KIRIKOS: Okay. As I already submitted an individual proposal for the elimination of the claim, obviously my answer would be should the claims period be extended, sub-part A, the answer would be no. Should the claims period be shortened? I guess shortened to zero would be yes. Should the claims period be mandatory, part C? My answer would be no and that's based on the ... Well, my interpretation of the data being that the costs of the trademark claims exceeds the benefits that the trademark claims period has. Thank you.

MARTIN SILVA: Thank you, George. Greg, you are next.

GREG SHATAN: Thanks. Can you hear me?

MARTIN SILVA: Perfect.

GREG SHATAN:

Great. On these three questions, I would say that the claims period should be extended at least – or it should be available for extension. I note that right now the TMCH offers an optional service that allows it to be extended for a period of time. I think that should be baked in as a policy concept. Then, to some extent, we should have oversight over that, which we do anyway. It should be codified. So, I would think that it is a valuable service. I think that we're somewhat data poor, so whether we can be [inaudible] conclusive about whether it's working but anecdotally it's working. I don't share George's conclusion that its cost outweighs its benefits. I would say the opposite. But in any case, I would say that there should be extensions available. I don't necessarily think it should be permanent, mandatory forever – at least not at this point. I think that we definitely should be thinking about how to gather better data. Something that actually [inaudible] the name data, as opposed to just being [denoted] as such by us, so that we come back to this question or maybe our successors come back to this question they can work with some real data. But right now I would say extensions should be available. Thanks.

MARTIN SILVA:

Thank you very much. George, I do seem to remember that at some point in the sunrise, you discussed something [inaudible] to these sort of things. Maybe some of those conclusions or ideas could work here, too. I have Kathy Kleiman next in the queue.

KATHY KLEIMAN: Yes. This is Kathy speaking as a member of the sub-team. Just reading the data, I'm in the second column on data previously collected in the summary table which seems to indicate that most of our stakeholders would not support any kind of extension or would not support a policy of general extension. So, registrars and non-trademark registrants that responded to the Analysis Group's questionnaire, [so here's our survey], are opposed to the extension of the claims period. And I'll add the Analysis Group believes that extending the claims period may be a limited benefit to trademark owners and that the associated costs incurred by registries and registrars, as well as potential deterrents to good faith registration, since we are seeing a lot of unintended effects of the trademark claims notice.

I think the evidence doesn't support extensions and I think maybe we should check into why there is an informal policy of the Trademark Clearinghouse to extend claims period services beyond what's required by consensus policy. Thanks.

MARTIN SILVA: Thank you very much, Kathy. I have George Kirikos again in the queue.

GEORGE KIRIKOS: I forgot to mention earlier that I think that if the sub-team does recommend that the claims period be mandatory, i.e. that there's a conclusion that the trademark claims notice is a great thing and it's working – that's not my conclusion, but if the PDP comes to that conclusion, then for consistency, they should also make the claims period be mandatory, permanent for all TLDs, not just new gTLDs

because really I think [inaudible] puts new gTLDs at a severe disadvantage compared to legacy TLDs, like dot-com, net, org, info, biz. So, I think out of consistency ... I don't know if [inaudible] new gTLDs. Obviously, [inaudible] doesn't register any new gTLDs, have no interest in them at all. But I can empathize with the fact that their business model is kind of strangled by compliance costs and that having these mandatory claims period which I think the data shows aren't working. But even if they were working, it puts them at a severe disadvantage.

So, if the conclusion is that they're working, they're a great thing, then I think out of consistency they should be applied universally and not just to new gTLDs. Thank you.

MARTIN SILVA:

Thank you, George. We have Kristine in the queue. Kristine?

KRISTINE DORRAIN:

I think I wanted to just mention I agree with Greg. I wanted to highlight for the group a reminder that when these RPMs were put together, they were designed as sort of a tradeoff already. So, it's not that the people that put together the new gTLD program didn't understand that there would be some people who wouldn't ... The claims notice might affect – it might be a little bit to their detriment. But it was a balance. So, IP owners were going to kind of get the shaft with respect to having to do a lot more IP enforcement. So, the tradeoff was, well, they were going to kind of provide this claims notice.

So, I think that there is not sufficient data to establish that the claims notice isn't doing what it's supposed to do and the bar should be pretty high to remove this protection.

I support Greg's suggestion that the claims period should maintain as it's currently implemented because registry operators are all different. I mean, I think we have to be really careful that we don't lump everybody into the same model. So, assuming that all registry operators are simply just trying to sell a domain name at a pretty low cost to third parties so they can set up a website versus build a business model on utilizing a TLD [inaudible] a little bit different story.

So, where a registry operator could take advantage of an extended claims period because it really wants to make sure it puts the public on notice of people who claim to have a [superior right] so that we not write it as in [existence] or is real with respect to that customer, but you do want to let the public know about that claim. I think we should be able to do that.

I don't think the claims period should be shortened. I think 30 days is short enough, or 60 for an [inaudible] sunrise. And I don't think that the evidence shows that there is enough harm – again, going back to what I've been calling the [new man] rule all along is if it's not broken don't fix it, and I don't think the evidence clearly shows that there's a serious break.

So, I think maintaining the status quo in this case is supported by the record, likely to cause the least amount of hassle and disruption. There are some parties who are being affected negatively – maybe a few

claimants are deterred. Maybe some registrars have to do some programming they don't want to do. But by and large it's working. So, I don't think that this is something that we want to disrupt at this point. Thanks.

MARTIN SILVA: Thank you very much, Kristine. Susan, you are next.

SUSAN PAYNE: Yes. Hi. Thanks. Largely, I'm in agreement with what Kristine has said in terms of I think the bar should be high before we start talking about removing something which we believe is having some [deterrents] [inaudible]. I'm bearing in mind that these RPMs were developed as a kind of breach and to work together.

There was a recognition that there is some risk that some people won't be [deterred] even though one would hope they would be. And there is some risk that some people might be [deterred] even though perhaps they didn't need to be. Even if that means they have to go off and do some research and decide whether they continue.

But everyone is ... I feel people have been a bit bogged down with the notion that the Trademark Clearinghouse is running an extended claims and I think it's important to bear in mind that it isn't an extended claims, or at least it's not an extended claims in the form that the 90-day claims service is. But the extended service that is operating is only a notice to the brand owner after the event that a registration has happened. So, it's not the same service at all. And whilst it may or may

not be [inaudible] for it to be codified, it certainly isn't currently something where the TMCH is gone off and operating voluntary perpetual claims.

Having said that, I think that to the extent that we have data, we do have plenty of feedback from trademark owners and brand owners who have expressed the view that they think that that would be beneficial to them and a full permanent claims service rather than a short-term one.

So, I don't think we can say that we don't have data at all, but what we do have is some people who are saying that they think that in order for the claims to really have an impact on cybersquatting and the like that it should continue to be on 90 days.

MARTIN SILVA: Okay. Thank you very much, Susan. Greg, again, you have the floor.

GREG SHATAN: Thanks. First, thank you to Susan for clarifying and correcting the data, the facts about the extended notice such as it is. In that case, I would consider the optional service to extend the notice in its full methodology. But overall, [Newman] rule being what it is, I think that keeping what we have is probably the most responsible course that we have.

I would say that I don't think as ... I think it was Kathy who said that the data shows that most of our stakeholders don't want this – or at least don't want it to be longer. The data that we have here is from just three collections, if you will, of stakeholders and if we're going to read into

the record what some of them said, we should read into the record what all of them said. The trademark owners responding to the user survey of Analysis Group, probably the period should be extended. Interest in extending it for at least one year permanently. Trademark owners believe the period should not be shortened and opinions from others were unclear. Trademark owners believe the claims period should be mandatory. So, just to have a balanced record, to the extent that anybody cares [inaudible] record.

I would agree with George that they should be extended to the remaining legacy TLDs. The DNS should be the DNS, at least as far as gTLDs are concerned. It's really more historical accident that brings us to the split that we have. So, level playing field would be all to the good.

Finally, to the extent that Kristine said things other than agreeing with me, which she did say quite a few things I agree with those things, it would be self-absorbed of me to agree with her agreeing with me, so I'm not going to say that. In any case, thank you.

MARTIN SILVA: Thanks, Greg. Cyntia, you are next.

CYNTIA KING: Hi. This is Cyntia. I read George's information this morning and tried to keep an open mind about all of it, but I'm afraid that the information, the data, to me was missed. I don't think we can rely on it wholeheartedly, although certainly it's valuable anecdotally.

But I think that it is very important that the data sets be equal if we're going to use them. The Analysis Group's data sets lack certain areas that were really required to be true and meaningful. Not their fault but just didn't have the information. But it does appear that the claims notices are working. It's unclear to what degree.

To me, the key issue is the notice itself because we've already discussed at great length that the notice itself isn't great and I think improving the notice will change the data quite substantially without changing the length of time, the length of period.

I don't support removing the time period. I don't support shortening. I don't necessarily support extending it either, although I think it should be – the registries should be able to extend it if it makes sense for that particular registry. Then I think they should be able to do it.

I think the policy should be mandatory, consistent across all gTLDs, and then allow a certain amount of flexibility for the registrars to create a business model that makes sense for them.

So, I agree with George, Greg, and Kristine, and Kathy. Thank you.

MARTIN SILVA: Thank you very much, Cyntia. Kathy, last one with you.

KATHY KLEIMAN: Okay. I think we may be reaching some kind of midpoint. I did, per Greg, fill in the record concept which was fine. I did dive a little deeper into some of our data gathering and I just want to add the registries and

registrars, according to the Analysis Group survey, want the claims period to be shortened or eliminated entirely due to some of the negative impacts that they've experienced with it, so at least we have some [inaudible] responses on that from registries and registrars when we dive more deeply into our data.

Also, it's not a historical accident. If we want to talk about legacy, we may be here a while because, of course, it's not a historical accident what happened in 2009 and the rules that were negotiated for new gTLDs. It was felt that the introduction of – we thought maybe 500 new gTLDs. It turned out to be 1300 new gTLDs might create some real confusion. And for trademark owners, it took steps to try to minimize that. That doesn't apply to the legacies as has been said in the chatroom because we don't have the general availability issue. And the unrolling of new gTLDs.

So, a question for the working group – for the sub-team, sorry, as well as for our chair – how much time do we want to spend debating on some of these issues or moving forward if this seems to be general agreement in the middle? Thanks.

MARTIN SILVA: Thank you very much, Kathy. Cyntia, you have an old hand, I guess. We have George next.

GEORGE KIRIKOS: Yeah. I just want to point out a couple of things. In the individual proposal that I sent out, I did point back to the congressional testimony

in the US Senate back when these issues were debated. Some people would call it a compromise, but I think there were a lot of expectations that cybersquatting would be a lot higher than it actually turned out to be. I think people were predicting billions and billions of dollars in damage, if you read the initial proposal. Just do control+F and search for the “billion”. It’s funny how so many predictions were made that there would be massive cybersquatting. It’s also funny that I think a registry was present at the [inaudible]. They thought their company was going to be worth billions of dollars. There were wrong predictions from I think many in the community, not just trademark holders, registry operators.

I think we’ve seen from the data that the actual experience was exaggerated and there wasn’t the actual level of cybersquatting that people anticipated.

Just on a broader note, the people who have spoken so far have basically been myself, Kathy, and then several members of the IP Constituency. I don’t know how we’re going to come to agreement on things when we have such a very small sample – an unrepresented example – compared to the broader working group and the community at-large. It would be nice to hear from Zak still, Martin, Lori – well, Lori probably [inaudible] with the IP point of view – and Rebecca to see what their answers are. Thank you.

MARTIN SILVA:

Thank you very much, George. Regarding to myself, as I stated before, being a chair for me in this, [inaudible] of course I won’t put my own

suggestive opinion. But when I get back to the old group, then I will probably have an opportunity to fully express myself. I have Greg. You also have probably the last word on this so we can move on.

GREG SHATAN:

Thank you. First, on the very last point, for unrelated reasons I went and looked at the list of participants in the entire working group as well as the participants in each of the two subgroups and the amount of missing in action and absent without leave and deserters and recovering working group members far outweighs those who are still here. That's a problem due to the length of this. And perhaps the fact that we keep sharpening the pencil all the way down to the eraser. But there's nothing we can do about that, other than try to engage and to try to move forward with recommendations. And if we have divergence, we have divergence and that leaves us with the status quo.

I do think that cybersquatting is a big problem in the new gTLDs. The fact is, overall, there were many fewer registrations than expected in the new gTLDs, much to the [inaudible] of some of the registry operators. So, qualitatively, the problem is real, the problem is significant, the problem also relates to far more than just simple trademark infringement cybersquatting as a [inaudible] of phishing and farming and malware and [inaudible] fraud and all sorts of other fun things.

So, I don't think we can dismiss the problem because, overall, orders of magnitude may or may not be the same. In any case, we don't have data really that goes to what the downstream costs of all this are. It may

even be [billings]. I wouldn't bank on it, to be honest. But it's significant to companies and to consumers, etc. So, I think we need to keep in mind where we're going.

And the last thing, an exhortation to myself and everybody else, in addition to being individual stakeholders, we're all common stakeholders in a larger effort and the point is we should try to get out of our own heads and try to think about what's best for the Internet as a whole. I'm not saying I know what's best for the Internet as a whole, but all of us need to watch out for being so deep in our corners. I'll leave it with that. Thanks.

MARTIN SILVA: Thank you, Greg. I have two more people now in the queue. Philip, you have the floor.

PHILIP CORWIN: Yeah. I want to make a couple of quick points. The first is that the co-chairs of the full working group had a meeting with the leadership of council the last day in Kobe. Council leadership made it clear to us that they want us ... They sent a very strong message to us they want us to stay on timetable and not have further slippage unless it's completely unavoidable.

What this sub-team does is going to be reported back to the full working group and then we're going to get community comments, whatever comments out of that. So, regardless ... And we have a good number of

people on the call today. We need to keep pressing forward and not delaying.

Second, in my personal view, as we consider proposals, in the end we have to think about what is really going to have a chance at getting consensus from the full working group at the end and make it into a final report after we consider community comment. We haven't received that comment yet but I think we all have a pretty good idea that on a lot of these subjects, changes which are incremental may get consensus, and I believe on claims, there's already probably an emerging consensus that the language of the notice needs to be altered to make it more understandable and less scary for folks who have non-infringing intent when they go to register a domain while still [communicating] strongly to those with infringing intent. But we need to keep that consensus bar in mind as we consider this.

Finally, on extension of any of these RPMs to legacy TLDs, my colleague at Verisign, David McAuley, has proposed, and it was adopted I believe, that in the initial report, we should ask the community's opinion, whether URS should become a consensus policy. My company has not taken a position on that but we do want to make sure there's community feedback on that.

On trademark claims for reserved legacy TLDs, I don't want to get deep in the weeds on that, but the board did decide what the procedure for releasing o.com would be. They approved that in Kobe and it's expected that will be auctioned off. I think it will be auctioned off. It's expected the auction will yield several million dollars to be put toward Internet non-profit causes and Verisign's take on that would be \$7.85. It's

extremely unlikely that any bidder expending millions of dollars for the use of a single-character dot-com is going to infringe someone else's trademark with it, but if they do, that can be subject to UDRP or the trademark infringement suit. That's all I have right now. Thank you very much.

MARTIN SILVA: Thank you very much, Philip. Lori?

LORI SCHULMAN: Yes, hi. I wanted just to comment on a generality about whether or not [inaudible] cybersquatting as requested. I think what we've seen, and should note, is that there's some new [extensions] where we've seen more cybersquatting than in others. But we can't necessarily target a particular [extension]. Therefore, when we're thinking about what [rules] to cover, let's think about ... We're talking about worst-case scenarios, not best-case scenarios, and I think it's important to keep that perspective as we move on in this conversation. Thank you.

MARTIN SILVA: Thank you very much, Lori. We have to stop talking about question number two because we also have D and E. Question 2D is should any TLDs be exempt from the claims RPMs? And if so, which ones and why? Does anyone have a comment specifically towards this one, thought or recommendation you may have? Kathy?

KATHY KLEIMAN:

So, it's interesting that the questions for the sunrise period and the trademark claims aren't parallel on this, which is the idea that should registry – and [inaudible] sub-teams. So, certainly the sunrise sub-team is talking about [inaudible] the registries, TLDs, be exempt from the sunrise period. But they're also talking a lot about the choice of either/or. Should a registry be allowed to choose which mechanisms work better for them?

The sunrise period, of course, we know that geos have had [similar] problems, but are there TLDs that should be exempt from the claims period? Certainly, anything that ... Let me throw it out. Non-commercial. If it's largely non-commercial, should it have a trademark claims period? Does that make as much sense if the whole goal is to dedicate it to non-commercial speech and not non-commercial speech and not general protection?

I'm not sure how far we want to go down. I really wanted to raise again the question of the optional, the either/or, because I'm not sure we're saying that TLDs should be exempt from all RPMs, but should the registries be allowed a choice might be another way of rephrasing that. Thanks.

MARTIN SILVA:

Thank you, Kathy. I have George next in the queue.

GEORGE KIRIKOS:

For part D, should any TLDs be exempt from the claims RPM, to be consistent, my answer would be yes to all of them because I don't want the ... I don't think the claims period should be mandatory.

As for the proof of use, I think we already have statistics in the Analysis Group report thing that I think was upwards of 80%. It may be 90% are already sunrise eligible. So, making it 100% wouldn't be a big leap, so I would support if the trademark claims persists, that the proof of use should be extended.

However, the proof of use requirements right now are very low in terms of the actual test that Deloitte is appearing to use. It doesn't really measure [token use] and other [de minimis] use and non-use. So, I think there's some changes that can be made in that regard and I put individual proposals on that separately which I won't go into now. Thank you.

Oh, as far as the point about optional which does appear in the sunrise [charter] questions but not [abuse charter] questions, there definitely should be some coordination between the two sub-teams to jointly answer that question. I think there's an overlap of membership of [both the] sub-teams, so we probably want to talk about that in the sunrise call. Thanks.

MARTIN SILVA:

Thank you, George. Cyntia, the floor is yours.

CYNTIA KING:

So, I'm hearing what Kathy is saying, and George, I understand your position. I do think that consistency with the RPMs is going to be key to minimizing user confusion. We rolled out a huge amount of TLDs and I think that part of the reason that it's difficult to get information from users – good actual information – is that there was a lot of confusion and confusion is because we rolled out a whole lot of information. Consistency on a minimum standard for the RPMs I believe will be key to users understanding what their rights and responsibilities are.

I do support allowing registries the ability to extend certain of these, of the RPMs, if it makes sense for them to do so. For example, someone that I worked with was trying to develop a registry that was specific to trademark brand owners [inaudible] real brand listing here on their registrar. In that case, they might want to have a very tough and tight RPM rollout for sunrise and that kind of thing, but other registries may not need that. I support allowing registrars to extend the protections to a certain degree, but I think we need to have a minimum set of standards.

And just very quickly, George, what you said kind of brings up some questions for me about the standards to be used for trademark use and so forth, because as I read an article recently, it seems like Canada might be eliminating a lot of the requirements for use in terms of the trademarks that they're going to be issuing in the future. So, I'm not sure how far ICANN can go in determining standards for use and stuff like that when right now it seems like several major countries, the way that they give trademarks is going to change. I'm not sure how far we can go in making those rules. Thank you.

MARTIN SILVA: Thank you very much. Kristine, you're next.

KRISTINE DORRAIN: Hi, thanks. So, I think a lot of the reason we ended up with this question here was that we were actually fishing for using stories to see if there were any exemptions. I don't think any of us had any reason in mind why we should do this, but we were looking for stories about where people might have had hardships and what might be a reason to exempt them.

One thing I think I should throw out is I know we've talked about doing something similar to what the SubPro PDP did, which was in a few instances putting questions as part of the public comment. We've got to have a list of recommendations. But is there a rule here for some questions and would this be the type of question we would want to put to the public?

So, for instance, I'm hearing people talk about consistency. I think that's perfect and we definitely want consistency. On the other hand, one of the problems we see when we talked a little bit about ... And when we get to the sunrise, we'll talk more about it. But this idea of some types of TLDs ran into problems with their startups because of the sunrise. Specifically, I think we were talking about city TLDs.

So, here, with claims, what I think we were saying, as anybody experiencing some sort of an analogous situation where they struggled to operate under the way that they were intending to operate because

of this sort of ICANN imposed limitation that we should be mindful of? Are there alternatives.

I'm thinking about what if the TLD has outreached to a specific community – and maybe to use Kathy's point of maybe it's non-commercial speech. If there's a public interest commitment to the public in a written PIC as part of the registry agreement that this is the purpose for the TLD and this is the only purpose of the TLD, such that that PIC is enforceable under the ICANN contract, maybe it doesn't make sense to have a claims notice. I don't know. I'm not even supporting that.

My point is there may be a story that we're missing here and I think that that's why that question is here. So, I'm proposing that we think about including this on our list of questions if people actually think that we can come up with a use case. If nobody thinks that we can come up with a use case, if we're all thinking there's just no reason to not make it consistent, that's just going to be a headache for everybody, then I say we leave the question out. But just for discussion purposes. Thanks.

MARTIN SILVA: Thank you, Kristine. Greg, you're next.

GREG SHATAN: Thanks. I think, first, it's interesting question whether there should be some exemptions. I think where Kristine is going in terms of further fact-finding, it would be useful. I think in the case where a restricted TLD where they would perhaps bar any commercial use and the terms of use

or acceptable use policy would bar any commercial use of the domain might be worth looking at exemptions but we have to consider whether there is literally no chance. Keeping in mind, again, that this is a claims notice and I think we all agree the claims notice needs to be redrafted and needs to be more clear, so that if in fact a good faith user could have a good idea of what they're looking at, if there is a chance of cybersquatting, of infringement, of abuse then the exemption can't hold.

And so far, there have been relatively few highly restricted TLDs – not none, of course. There might be more the second time around. Who knows? But overall I think that we might be missing the right user story or the right combination of characteristics. At that point, that's something I wouldn't count out without looking at it further. But overall, I don't see the likelihood that exemptions would be broadly granted. We'd obviously have to consider a rubric for doing that which would be a lot of fun. Thanks. Bye.

MARTIN SILVA:

Thank you very much, Greg. Susan, you're next.

SUSAN PAYNE:

Yes, thanks. I don't think we do have any user stories or particular types of TLDs where because of the particular nature of their TLD that they should be exempt from the claims. But also I'm not sure that we asked any questions that would have elicited that. And I don't recall in detail. Maybe we did, but I don't think we did. We certainly didn't ask questions of dot-brand because, to a large part, [inaudible] not very

relevant to dot-brand. But of course they are [inaudible] to had we asked them a question about this would have answered, "No. Of course the claims didn't apply to dot-brand. It's crazy. Why on Earth do we have to do a claims [inaudible]?"

So, that is a [class] of registries where it would be entirely appropriate for us to say there's no need for this. But, it's a 90-day claims process. [inaudible] dot-brand has just gone, "Oh, what the hell, we'll do it anyway. It's only 90 days. So be it." But I don't think we ever asked for those user stories, so no, we don't have them. But I would say dot-brand is one of the ones that there's just no purpose to the claims notice whatsoever.

MARTIN SILVA: Thank you, Susan. George, you are next.

GEORGE KIRIKOS: Yeah. I was just going to say what Susan just said, that I think the motivation for question 2D was the dot-brand scenario, companies that have already been vetted by ICANN, are not cybersquatters typically. Dot-brand will typically be doing trademark searches anyway before we do any sub-domain registration on our own behalf. I think that was the motivation for part D.

But I think if people are going to be consistent, we can't say, "Well, we're the good guys. There should be one set of rules that applies to us, but everybody else is the bad guy and we have a different set of rules for them." [inaudible] in this case for dot-brand, but it could also be for

if we want public WHOIS but we don't want the public TMCH. It needs to be some consistency [inaudible] all these questions and answers. Thank you.

MARTIN SILVA: Thank you, George. Susan?

SUSAN PAYNE: Thanks for that. George, my point wasn't really about the consistency, or rather that we're the good guys and therefore we don't need it. Or that wasn't my intent. It was more just that the nature of the claims notice in the context of the dot-brand registry doesn't really [inaudible].

If you had a scenario where a brand owner within their dot-brand registered, I don't know, someone else's brand, it's highly unlikely that at the point where they're doing that, that if they've got a claims notice that they wouldn't proceed because they would have already considered whether it was appropriate for them to register that brand or not, one would hope. Or they haven't considered it, in which case, getting a claims notice, they're not going to change their [inaudible].

But if a brand owner had an issue with it, their [inaudible] is with the registry itself, if you know what I mean, rather than the registrant because the registrant is the registry.

So, if I were brand Y and I had a problem with something that was happening in [dot-brand X], I'd be going direct to the registry operator. I wouldn't be worrying about whether they had a claims notice. I

wouldn't be worrying about whether I should bring a UDRP. I would be taking it up direct. That was really my point.

But I did also say what we've been saying from the outset, that this really is a new relevant process for dot-brand. As I said, most dot-brands operate [inaudible] they've just gone, "Oh, what the hell, it's 90 days in claims notices. We'll just run it."

MARTIN SILVA: Thank you very much, Susan. George, you're again.

GEORGE KIRIKOS: Just a follow-up. Look, there's some interaction between these things because if the claims period becomes mandatory then it will have an affect on dot-brand and other types of TLDs. If it becomes mandatory and permanent, in other words. So, they can no longer say, "The hell with it. It's 90 days." Now they'll know that it's permanent and it will have a much bigger impact that they'll get [inaudible] built into their interface for registration systems [inaudible] claims notice and so on. That's where the compliance costs can mount.

So, I think if we did make the decision that claims are permanent, extended beyond the 90 days, then the [answer] [inaudible] [questionable change]. Thank you.

MARTIN SILVA: Thank you very much, George. Greg, you're next.

GREG SHATAN:

Thanks. Just briefly on an earlier point that was raised as to whether the proof of use is too low, too easy, whatever it may be. Based on my personal experience – of course, that's anecdotal, but it is an experience – I would say that it's not. As a matter of fact, for one of my clients, the TMCH rejected the use [inaudible] that had been accepted by the PTO, by the United States Patent and Trademark Office, which I thought looked like a perfectly valid proof of use but there were some things that they didn't like about it, so we got a new proof of use and submitted it. But it's clear that they are not just rubber-stamping these. At the same time, they're not playing detective and we're not asking them to undertake investigations of use or claims of use when people submit something saying that the mark is in use. But at least from my experience, it's a substantial requirement. Thanks.

MARTIN SILVA:

Thank you, Greg. Kathy?

KATHY KLEIMAN:

So, I guess we've moved on to 2E. I have to say, Greg, that your story which you [inaudible] a while ago, was interesting. I found it useful because it shows the TMCH really is taking the proof of use seriously. Even anecdotal, it's a good story.

The question is slightly different. Should the proof of use requirements for sunrise be extended to include the issuance of TMCH notices? And I know this is going to question ... We're not going to resolve this today.

But if people are using design marks, if they are using geographical indications, should there be some proof of use not just for sunrise but for the issuance of trademark claims notices, especially with the deterrent effects that we know about and the use of these very common words now as some of the top ten – as many of the top ten – trademark claims notice are being generated on common words. Should we make proof of use just a requirement across the board for TMCH registrations? And why wouldn't we?

So, I think probably more of a question for next week. Thanks very much.

MARTIN SILVA: Thank you, Kathy. Cyntia? This is one of the last interventions.

CYNTIA KING: Thank you. As I mentioned, of course I'm not a trademark attorney. That's why I don't know that this is written in stone. But I just read something that Canada was going to be issuing trademarks as proof of current use. I'm not sure who then becomes the arbiter of what is an effective or enforceable trademark? The TMCH or the Trademark Office of Canada? I'm not sure how far down the road of determining what's valid and what isn't that ICANN wants to go. Just throwing that out there. Thank you.

MARTIN SILVA: Okay. Thank you, Cyntia. We should be wrapping now, so Greg, this is the last comment. You get the last word.

GREG SHATAN: Thanks. I am a trademark attorney but not a trademark attorney in Canada, so this is not in any way definitive, but [inaudible] do some quick looking at that. It appears that what has been eliminated as a proof of use in Canada – and not necessarily eliminated, but made optional – is that you can rely on foreign use in registration in order to support registration in Canada and that's a requirement of Madrid, the Madrid protocol. So that's really harmonizing with other trademark regimes around the world which Canada has been an outlier from the Madrid protocol among more developed nations for quite a long time. Thanks.

MARTIN SILVA: Thank you, Greg, for that piece of information. I think we have run out of time. We have to run to another meeting. So, [inaudible], if you want to wrap up.

UNIDENTIFIED FEMALE: Yes. Thanks, everyone, and we'll give you [inaudible] and we will start the next call at five minutes after the hour. So, thank you all for joining and we'll look forward to talking to some of you very shortly and some of you next week at the same time. Bye-bye.

MARTIN SILVA: Bye-bye, all.

EN

Sub Team for Trademark Claims Data Review_Mar27

TERRI AGNEW:

Thank you, everyone. The meeting has been adjourned. Please remember to disconnect all remaining lines and have a wonderful rest of your day.

[END OF TRANSCRIPTION]
