

**GNSO**  
**Special Trademark Issues : Trademark Clearing House**  
**17 November 2009 at 18:00 UTC**

Note: The following is the output of transcribing from an audio recording of the Special Trademark Issues meeting on Trademark Clearing House held on 17 November 2009 at 18:00 UTC . Although the transcription is largely accurate, in some cases it is incomplete or inaccurate due to inaudible passages or transcription errors. It is posted as an aid to understanding the proceedings at the meeting, but should not be treated as an authoritative record. The audio is also available at:

<http://audio.icann.org/gnso/gnso-sti-tch-20091117.mp3>

On page:

<http://gnso.icann.org/calendar/index.html#nov>

(transcripts and recordings are found on the calendar page)

Davis Maher – Chair

Jeff Neuman

Jeff Eckhaus – Registrar

Paul McGrady - IPC

Zahid Jamil- CBUC

Mike Rodenbaugh - CBUC

Robin Gross- NCSG

Kathy Kleiman - NCSG

Wendy Seltzer –NCSG

Alan Greenberg - At Large

Olivier Crépin-Leblond - At Large alternate

**ICANN Staff in attendance:**

Kurt Pritz

Liz Gasster

Margie Milam

Gisella Gruber-White

Marika Konings

Amy Stathos

Glen de Saint Gery

**Apologies:**

Maimouna Diop – GAC Observer

Mark Partridge – IPC

Konstantinos Komaitis – NCSG

Jon Nevett- Registrar

Coordinator: This is the operator. At this time the call is being recorded. You may begin.

Gisella Gruber-White: Thank you. Good morning, good afternoon to everyone on today's STI Trademark Clearinghouse call. We have Mike Rodenbaugh, Zahid Jamil,

Olivier Crepin-Leblond, Jeff Newman, Wendy Seltzer, Robin Gross, Paul McGrady, David Maher, Jeff Eckhaus, Kathy Kleiman, Alan Greenberg.

From staff we have Amy Stathos, Margie Milam, Liz Gasster, myself, Gisella Gruber-White. And we have apologies from Mark Partridge, Maye Diop, Konstantinos Komaitis And if I could just please remind everyone to state their names when speaking for transcript purposes. Thank you.

David Maher: Okay. Thank you. This is David Maher. Our first topic is the name. And at this point there seems to be consensus on Trademark Clearinghouse. Anyone feel differently about that? Margie.

Margie Milam: Oh I just had just a different point. We did cover it with the schedule. But also too just from - so you know what to expect, we just sent out this trademarks proposal or Jeff sent it out, Trademark Clearinghouse straw man yesterday.

Staff hasn't had a chance yet to evaluate it from an implementation standpoint than and we expect to put something together. Similar to what (Kurt) sent around yesterday kind of thinking through some of these from an implementation standpoint. So just wanted to give you guys a heads up that that's what we'll be doing.

David Maher: Okay. Then there's an issue listed under the ICANN default proposal, two providers each global. One charged with database administration and one with validation. I'm not clear whether this is the discussion of the function of the clearinghouse. In any event, do we have consensus on separate validation from database functions? I believe we do but anyone disagree with that?

Okay. Moving along then the...

Mike Rodenbach: Wait a second David. I'm sorry. Was your question was do we still have an issue with splitting functions?

David Maher: That's right.

Mike Rodenbach: Okay. Sorry. Mike Rodenbach. Yeah I would speak to that for a moment.

David Maher: Okay. Go ahead.

Mike Rodenbach: Just following on what Margie was just saying, I mean, I think generally it sounds wonderful to be splitting up the functions and have more competition and more providers involved, you know, getting a piece of the pie. But my big concern is that there's really not going to be much pie here. That there's just not much of a commercial opportunity for this given the restrictions that folks are putting on the use of this thing.

I just don't feel it's going to be used either by brand owners or particularly by very many registries with the exception of maybe of Sunrise Period, which, as we know, most brand owners are not very interested in.

So I'm wondering, and maybe Margie has an answer here, what effort was made after the IRC report or with any of these proposals since the engaged people that might, you know, bid on these projects; get their views about commercial viability?

David Maher: Margie?

Margie Milam: Yeah. Is (Kurt) still on or is he offline? I know that there may have been some discussions on the services side. Maybe Amy can comment.

Amy Stathos: Yeah this Amy. We have not undertaken any type of analysis on getting and talking to potential providers at this point in time.

Mike Rodenbach: Okay. Well I think that that's something, you know, I hate to make our work even more complex but I feel like we've come too far at this point and we're talking about un-implementable solutions. That's my pretty strong view.

Amy Stathos: So Mike to clarify if I might - David, I'm sorry. So the - both proposals are basically two providers at least at a minimum. That would be one to do the database function and one to do validation or authentication or whatever it is that we're calling it at this point.

Mike Rodenbach: Yeah.

((Crosstalk))

Mike Rodenbach: I'm not sure there's a big enough business opportunity even for one business much less splitting it in two. I see absolutely no value to the IP claim service the way that it's being framed just to only end at whenever the registry operator wants, you know, after the first 30 days or 15 days or whatever they want to run for a pre-launch period. After that it's completely meaningless.

The only other value to this clearinghouse is with the Sunrise Period, which again was the whole reason we're talking about rights protection mechanisms because we've had Sunrise Period in the past. Trademark owners aren't too interested in them particularly if we're not going to standardize the processes.

And I guess I'm hearing we're not even talking about standardizing the processes anymore either. So I see no value to this clearinghouse idea as it's being framed right now.

Alan Greenberg: Okay. Yeah. I guess I can't comment on whether there's perceived value or not. I would like to however get out of the business of detailing the implementation and instead stating the principles. You know, whether there are two providers or one, I think we've said that validators must be close to

the source. That is they must be familiar with the laws. They must have the right access. They must have the right language.

And whether that's done with subcontracts or different contracts with ICANN, I don't think we need to specify now. I think we should specify the principles and then let (SAS) come up with something simple and implementable in line with principles. Whether that means - whether that means one or two entities or one clearinghouse and 400 validators, I don't think we need to specify as long as we're clear on what we want the end product.

David Maher: Okay. Paul?

Paul McGrady: Sorry I was on mute. I apologize. But the only thought is if we - if we start busting this - if we start busting up the idea of two providers and again consolidating them into one for purposes of making it more attractive to a potential vendor, you know, our only concern with doing that is that we've not - not everyone's given up on the concept of regional evaluators. And so what we don't want to end up having is a combined operation of database and validation in five or six different regions (unintelligible)...

David Maher: Paul? Hello? Alan?

Alan Greenberg: Yeah. Again I would have thought one of the principles we've all agreed on is one centralized database. So that's dividing up into multiple databases should not be one of the options. We're talking about the structure of the operational part. By the way, there was also a third one we talked about last time and I don't recall how it was resolved. That is who does the trademark owner go to to register a domain name?

You know, what's the entry point? Is that the validator? Is that the database? Is that a third function? I don't remember how we came out with that. But again, I think we need to state the principles and not try to build the entity right now.

David Maher: Yeah. I think that's a very practical suggestion. We're probably getting too deeply into the details here. Unless anyone has something further to say about the function point on our chart, the straw man proposal, I think we might move along to the relationship with ICANN.

The straw man proposal is for a centralized database to have formal contracts including SLAs fulltime, everyday, all year long support data escrow and the one - there is, you know, that's the relationship issue. Any comment on that? If not, I think we have a consensus.

Which brings us to the area where there maybe some discussion I would imagine. The straw man proposal for marks that are eligible for inclusion are those nationally registered marks that no common law rights and no court validated marks. Let's talk about that first. Anyone have a comment on that?

Mike Rodenbach: Okay. Mike Rodenbach.

David Maher: Go ahead.

Mike Rodenbach: Again, you're just further denigrating the value of the whole clearinghouse by not - I don't understand why you (unintelligible) from going in. It's the whole point is to notify people when there's a potential issue. And you want to keep limiting the potential issue that people can notify.

You're - by eliminating common law rights, you're eliminating in particular a lot of celebrities globally who don't have registered marks but clearly have famous names that very well might use the clearinghouse. So again, I just don't really see what the point is of limiting it.

David Maher: Alan?

Alan Greenberg: There are certainly advocates within at large of supporting common law marks. There are some who don't necessarily see the need for it. I would say however that the fees need to be set reasonably based on what the evaluation - what the validation is going to cost. If one includes common law marks where one has to start looking at actual use over the decades or court validations, they're likely to be complex processes and should - and everyone should not have to pay for those. A celebrity's name maybe a simple one to validate.

David Maher: Jeff?

Jeff Newman: Yeah, coming up with the straw man, we tried to do what there was a consensus on in the community and tried to come up with some standard way of doing it. Common law was just too difficult in the sense that not every country recognizes common law rights and that there was no way for a complete validation - standardized validation process to validate those rights.

Again, we're talking about a database validating pieces of paper or entries in a patent and trademark office online database. We're not talking about a validator going in and looking at court documents and trying to decipher court opinion, which God knows how difficult that could be.

The point of including common law rights I think the IRT made a mistake in using the term common law when what we really meant to say was that nationally registered marks and other marks that a registry chose to have validated the clearinghouse should have the ability to validate those, you know, of course for extra fees as Alan said and others, even charged to the registry itself.

So if a registry said look I want - I want to have a Sunrise but I want my Sunrise to include those - I want to run (top pizza) and I want those restaurants that serve pizza to be eligible even though they don't have

registered marks that somehow and someway the clearinghouse in theory could validate that.

But that was at the choice of the registry and not something that was the minimum requirement. So coming up with a minimum requirement it just seemed logical and everyone seems (unintelligible) no disagreement with anyone on the call about nationally registered marks. Seemed to be disagreement on the other two.

David Maher: Okay. Paul.

Paul McGrady: Apologies for my phone dropping the call before. I don't know what happened. But I just - this issue is really not IPC's issue because most of the people who, you know, we are involved with, have trademark registrations.

But I would like just again I guess this is probably a final appeal since we're getting, you know, we're getting to the point where this has been talked about too much.

But if there's anybody on the call that cares about small businesses that they have rights or sole proprietors they don't, college athletes who's names, you know, they're about to become trademarks, I mean, anybody like that that's concerned about those sorts of smaller users, it would be great to hear from somebody that is concerned about those folks and to see if we can find a way to include them.

David Maher: Okay. Thank you. Wendy.

Wendy Seltzer: So obviously we're all concerned about all of the different people who might have claims to domain names or claims to rights to prevent people from registering them. I don't think this database is the place to add the complexity.

David Maher: Thank you. I think we can move along then to the other portion of this topic, the question of identical match. There's quite a long description to domain name consisted complete and identical textual elements and then an explanation of what this includes in spaces, special characters, punctuation, plurals and so on. Does anyone want to speak to this?

Mike Rodenbach: Mike Rodenbach.

David Maher: Go ahead.

Mike Rodenbach: So just to be on the record saying that, you know, I definitely am looking out for the people that you're talking about Paul, small businesses. I think that this provision the way it's worded now actually does that.

It helps the smaller businesses but it really doesn't help well-known brand owners at all because the percentage of cybersquatting domains that would qualify with notification is tiny. There's so many more (unintelligible) word infringements than there are just Yahoo. It's not even funny. I mean it's like one to 100 or something like that at least.

And I'm sure that that's very typical across all brands that get a lot of traffic on the Internet. But don't really, again, see what the harm is of allowing plurals or marks contained, strings to trigger a notice, which is all it is. A notice that can be worded however you want so that it is not so frightening.

But I just think that at minimum brand owners ought to have the option to include plurals and other strings that they've already won in UDRPs for example.

They should also have the right to exclude some strings to deal with the venom versus eNom situation. So that if eNom puts its mark into the database, they could exclude venom so that doesn't trigger a notice if that's

what they'd like to do. You know Yahoo might exclude Ballyhoo because one kept coming up in our searches.

So, you know, there can be more flexibility in how this is used and at minimum registries that want to have that flexibility and use this data in other ways ought to be able to do it.

David Maher: Jeff Newman.

Jeff Newman: Yeah. So I think - Mike I think on your last point, registries that want the flexibility to do it will have that ability. Again it's just not the - it's not the standard clearinghouse service. So that probably means that they're going to have to work something out with the clearinghouse and probably have to pay some of their own fees and other things.

But the standard service should just be again for this type of mark. And we're not just talking about IP claims. We're talking about Sunrise here and these rules that are in the straw man document are the same rules that have been implemented in all of the Sunrise processes. The only one that has additional rules were - was (IDU). But again we're not saying the registry can't have additional marks in there. We're just saying that a registry only has to implement this minimum.

John Rodenbach: So fine but then we agree that the clearinghouse at least could and should be designed so that it can have more flexible uses than what's contained here?

Jeff Newman: Yes. I would agree with that.

David Maher: Okay. Kathy?

Kathy Kleiman: I just wanted to note that the - that the idea of identical matches has significantly expand it from where - from what NCSG was really looking at.

NCSG was supporting an absolute identical match of the textural elements of the mark.

And in extensive discussion with Jeff and others I came - I came to understand better, and have been working with my group on this, that if you have an H&R Block that the ampersand cannot be registered as a character in a domain name so that someone, either the trademark owner or another type of registry, might put a dash there or an underscore there. So what we see here is actually an extensive expansion over what NCSG was looking for and I just wanted to note that.

David Maher: Thank you. Wendy?

Wendy Seltzer: Yes. A question of how this is in scope for what the database contains. I understand that registries can make their own choices about how to match on the strings that are contained in the database after the fact. But why we need to choose when entering into the database; I would think we should enter the mark as registered and let the registry choose whether and how it wants to expand special characters or substitute once it posts the marks out.

David Maher: Okay. Thank you. Jeff do you still have your hand up?

Jeff Newman: Yeah. Well on that -on that point I think Wendy, part of the IRT recommendations were to have a standardized Sunrise process. And I think that was also a bunch of the comments we received from intellectual property owners is that leaving even the standard Sunrise service up to the complete discretion of the registry would cost them - IP owners a lot of money. To at least set these bare minimums of what's required in a Sunrise is a good best practice to recommend to registries.

And even more than best practice, mandatory and if you go to do a Sunrise, you at least need to do these things but you could always add things on top of it. So I think it's very relevant to address the intellectual property owners

concerns, which were we're spending too much money. All the Sunrise processes have different rules. We're not sure how to keep on top of it. And you launch 200 at once, there's no way we're going to be able to do this.

David Maher: Mike Rodenbach.

Mike Rodenbach: (Yeah but no) that's exactly right. There has to be some sort of minimum, bare minimum standards. But again we have to be able to have some flexibility and maybe this is why it's so important to have common law trademark rights included at the brand owner's option. Because, you know, again you're excluding so many common law marks of Yahoo here, Yahoo Sports, Yahoo Mail, blah blah blah, hundreds of them literally because Yahoo could never afford to register all of those marks all over the world.

But there are basically indisputable common law trademark rights under any countries law. So you just - you're doing a real disservice here by making it so narrow. You're doing a disservice to the brand owners. You're doing a disservice to the registrar who could be getting a notice and might avoid a problem.

David Maher: Okay. Alan.

Alan Greenberg: I'm not sure this makes sense or not. But when you factor in the types of things that Mike has said and Jeff's statement that some registries may want a wider range of trademarks that their using for their Sunrise process or their IP claims (per) process, does it make sense to say that this is the minimum that the clearinghouse must use and that every registry who has a Sunrise must adhere to. But the clearinghouse may add - may have provision for other types of trademarks and a registry can opt in or out of using them.

So in that case, the problem with what Jeff said is every registry that comes on would have to negotiate something with the clearinghouse and then all the mark holders would have to go and add the ones that are applicable. So

perhaps the clearinghouse should have the discretion of adding other types of marks and then a registry can opt in or out of using them in any given launch period. I'm not sure that makes sense but as I hear people talking that maybe an answer.

David Maher: Kathy.

Kathy Kleiman: I had thought we have been down this road many, many times before and that we had come to some level of extensive agreement on this. That registries can do whatever they want. If they want to survey pizza restaurants around the world, survey pizza restaurants. Art work, you know, and the titles of art works go ahead and do that but that this ICANN, this contracted ICANN database was - were nationally registered marks and it's an efficiency mechanism for these verified marks so that the trademark owners don't have to put that piece of paper, that trademark in 500 different places.

And that's, I mean, that's where we're coming in at is an agreement - a basic agreement on what this trademark clearinghouse capital T, capital C is and that ICANN will be part, you know, will be - will be basically certifying it. So, again, I thought this was a done deal of that registries can do whatever else they want but not, you know, survey children's names, whatever they want but not - it doesn't belong in this single database. It can go in another database.

David Maher: Jeff.

Jeff Eckhaus: Yeah. I sort of want to maybe, I don't know, maybe just expand on that or what somebody else had mentioned is that, you know, we're starting - part of it was the whole idea is like hey this is going to be the one central place and I know we're still (in) discussions on the mandatory, you know, yes or no. But now it's - we're starting to add in all this flexibility and all these other pieces and so I think we need to just step back and say is it going to be mandatory. Are we going to have the certain rules?

If we are, then we can't start building in all this flexibility of who can use what, how it can be put in. (And) also, to what Kathy's saying, the whole idea was for the efficiency to have this one centralized place versus now it's going to be a whole, you know, a mix of what certain people want, how it's wanted. I think it doesn't jive with the idea of what the clearinghouse is supposed to be.

David Maher: Wendy.

Wendy Seltzer: Yeah. I think we are mixing too many different issues in here at once to be able to talk effectively. Since we haven't reached consensus on whether this is mandatory, whether registries have to use it in a uniform way, it then becomes difficult for us to talk about what's contained in it because we each have different notions of how those pieces of contained data will be used. I'm not sure how to resolve that question though.

David Maher: Okay. Thank you. Jeff.

Jeff Newman: Well (so) I agree with Wendy that we're mixing up a bunch of issues. We're mixing up the collection versus the use issue. I was not aware that there was any dispute that if a registry implements a Sunrise or an IP claim that it had to use this clearinghouse. Is that still up in the air? I thought that was resolved. I thought there was consensus on that point.

Mike Rodenbach: I think there is and now, it's Mike. But now that we're talking about is what sort of flexibility this clearinghouse has and the trademark owners have to put data in which would trigger a match. And then of course we started this by talking about what exactly would trigger a match.

Jeff Newman: Right. So on that the IRT recommended that - just like Mike was initially saying, the IRT recommended that there's a bare minimum of data that it collects. And that that's going to be the - and then on the other side there was a bare minimum of what a registry needed to do if it implements a Sunrise.

But then there is a flexibility to have additional data elements in there and I actually don't see an issue with that. In fact I think it's best for - I think that is in the interest of both commercial and non-commercial communities in the sense where if I'm a dot shoes and I want to limit my registry to only those registrations that are in a certain class of goods and services, I should have the flexibility to do that

But so I'm not sure why we're confusing these. But I do want the first question answered. I thought it was mandatory in the sense that - first of all it's mandatory that a registry - that if a registry does a Sunrise or IP claims that they have to use the clearinghouse. I think we need to answer that one. I think it should be.

David Maher: Jeff Eckhaus.

Jeff Eckhaus: Yeah. So Jeff I agree with you. I think that we did come to agreement that it should be mandatory to use it. I guess my point was then we're saying I do have to - if I'm the registry, then I'm saying that I do have to use the clearinghouse but then it's up to me to decide how to use it and which terms.

So if I'm using dot shoe then I don't have to put in, you know, Yahoo Sports you're saying into it. I get to choose which of the terms I want to put in or could I exclude Yahoo in general? I mean that's the question I have is if it is mandatory, then do I get to pick and choose how I use it and which terms get put in?

Jeff Newman: So to answer that from the IRT standpoint, if you wanted to do shoes and you wanted to exclude Yahoo completely because they don't have any registrations in any of those categories, then the answer would be according to the IRT report yes, you could exclude Yahoo completely.

Jeff Eckhaus: Okay. So yes, so that was, I guess, my point was that yes so it is mandatory which I think we're all in agreement with. But then the registry can pick and choose which of the terms from the clearinghouse or how it decides to use the clearinghouse. There's no mandate on how it's used; just that it has to be - that they have to use it.

David Maher: Paul.

Paul McGrady: Yeah. This is, yeah this is Paul. I'm trying to understand this conversation and I apologize. What we're saying - is the question essentially that a trademark right could exist within the clearinghouse that a registry could choose to do a Sunrise. However that registry can choose to exclude certain marks or certain international classes of goods and services or other things for purposes of their registry?

Jeff Newman: So to answer that I think the answer is yes but would have to be - I mean, I would argue that there has to be some explanation as to why the registry is excluding those marks.

So if you are literally a dot shoes and in your application you talk about I'm limiting my domain registration to only those companies, shoe companies that could show that they are a shoe company, then I think they would absolutely be justified in not necessarily doing a Sunrise that's open to all trademark owners no matter what class of goods and services.

But I think that was always kind of the understanding of - at least in the IRT that was the understanding. But again it shouldn't be, you know, I'm doing a dot Web and I only want - I only want to accept trademark registrations from shoe owners, right. There should be some explanation in the - or acceptable explanation in the application as to why you'd be limiting the Sunrise.

Paul McGrady: Yeah. I've got serious concerns about that and I think that's something I'm going to have to take back to the IPC and make sure that they also view that

the same way Jeff as the way you set forth because, I mean, what about maybe you don't make shoes. What if they make belts and purses or what if they make coats?

You know, what if its of a nature that, you know, are we also saying that if we're only going to consider trademarks related to shoes of this, you know, at this point that the registry also has an obligation to only - to make sure that only shoe related content is expressed in conjunction with the main needs of the second level?

You know, to me this - that opens up a can of worms. I think that the clearinghouse should be the clearinghouse and the marks that are in there should be notified to the potential registrant so they can make, you know, a good decision. You know, if they get a claims notice for example they can make a good decision about whether or not they want to register the domain name.

David Maher: Okay. Kathy.

Kathy Kleiman: I just wanted to share that the understanding shared by the two Jeffs was the understanding that I had that the registries would have a great deal of choice in tailoring the use of the trademark clearinghouse to whatever the launch was of the new gTLD.

And the dot shoe, you know, probably should go far beyond shoes to related goods as well. I would think belts wouldn't be unusual to include in that as well. But Kraft foods might not be something where you get an IP claims notice in dot shoe for Kraft. So at least I had understood it the way the Jeffs explained it.

But let me throw out another whole set of new gTLDs which might not be applicable for use in the clearinghouses at all, for use of the clearinghouse at

all. Anything commercial dot Web, dot travel makes sense to me that this is used and that it be required to be using this clearinghouse.

But dot advocacy, dot criticism, dot sucks, we may have new gTLDs that are specifically non commercial and I would think that the registry would only well documented and for very, very good reason choose not to use the clearinghouse. But I would think that it would have to be very well documented on their part.

David Maher: Jeff Eckhaus.

Jeff Eckhaus: Yeah. So I just wanted to now kind of bring back full circle to what my original point. One of the points of my argument here was that is if you're going to allow not exact matches and other common law trademarks then we - then the registry should have some flexibility. But if we're back - but that's the whole point because then it just opens (up).

But if we have I guess you could say just the exact matches and the small - and it's more narrowly defined, then I think people would be more - okay with having mandatory for all terms for the clearinghouse.

But if you open it up and then you allow so many different marks and, you know, some kid who's in high school who may become a football player and his name becomes a trademark, I think then you start - then you might want to give the registry some flexibility because you would kind of shut out almost everyone. Because, you know, I think my kids are going to be superstars so you can't get their names, you know, that sort of, I mean, you've just got to put a limit on where we draw the line (and sort of) where the trademarks are.

David Maher: Paul.

Paul McGrady: I want to ask a follow up question. Are we - in terms of the narrow - the narrowing of the uses of the clearinghouse, are we making a distinction

between narrowing those uses for the purposes of a Sunrise and narrowing the purposes - narrowing the uses for purposes of an IT claims because that may make a difference?

I mean I understand the notion that if I'm launching dot shoes, I only want a Sunrise for people who have registrations in a certain international class because I've written my restrictions in a way that only the people who sell shoes are allowed to be registrars in the first place, that doesn't bother me. What bothers me is the notion that it would be narrowed for the purposes of the IP claims service. Jeff, can you speak to that or somebody else?

Jeff Newman: Yeah. So I mean I suppose they could be differences between the two although it was envisioned that a registry would either do a Sunrise or an IP claims and what you're saying is that in some cases they may be required to do both which is not something I've thought about or the registries have thought about.

But there certainly could be a difference in that if you wanted to do a little bit broader of for IP claims. I guess then the question would be to Kathy and others is a chilling effect. If you're giving out notices or in a dot shoes by Kraft and the notice basically says you may be subject to challenge, is that - is that - would that be to much of a chilling affect? And so I would kind of throw back to the non-commercials.

David Maher: Okay. Alan.

Alan Greenberg: Yeah. I'm getting a little bit confused. Maybe I'm not the only one. We're talking about the clearinghouse being mandatory but the registries may pick and choose which types of marks they use in any given case which would sound like they also have the ability of not using any of them which makes it not mandatory. So I seem to think we're talking mixed metaphors here. That's one point.

The other point I wonder is to what extent, if we really believe a clearinghouse is needed, are we sure that given that it will only be used pre-launch and we don't know what rate new gTLDs are going to be launched two years from now or three years from now, do we need to even consider whether this is a viable business model and whether it's going to be sustainable? Because if we believe if necessary, we maybe end up in a situation where there's no one who wants to offer it.

David Maher: (Thanks). Wendy.

Wendy Seltzer: Just re-raising the question of where the consensus is around - on mandated use. I'm hearing some around if a registry chooses to use a list of trademarks this is where it should draw that list at least the core of its list to which it may choose to add or subtract. But I have not heard a consensus that a registry launching new domains much do anything with list of trademarks.

((Crosstalk))

Mike Rodenbach: ...Sunrise or IP claims service. That's what you're asking?

Wendy Seltzer: That's right. Do we have a consensus that they must have anything at all?

Mike Rodenbach: I thought that we did and had since the IRT report but I may have missed it if we don't. But perhaps couldn't it be - couldn't it be addressed - following up on what Kathy was saying earlier, now if the - if the registry operator had some really good documentation as to why not, then perhaps ICANN grant an exception.

David Maher: Jeff Newman.

Jeff Newman: Yeah. I think - I think that was the point that it should be mandatory that an IT claims or Sunrise and - but the IRT did have a sentence in there saying basically that there maybe limited circumstances in which doesn't make

sense in which case the registry should have to explain that to ICANN and that it has to be vetted and acceptable.

So for example a dot IBM - if IBM wants to operate a dot IBM and only have employees register that address there's really no need to have a Sunrise or an IP claims. But all of that should be explained in their application. And it should be acceptable to the - to ICANN in order to do that.

David Maher: Okay. Wendy.

Wendy Seltzer: Okay. I'm still questioning whether we have a consensus or whether we just have various expressions of interest around the idea of it being mandatory? I've - if it is still an open question, I don't agree it should be mandatory.

Mike Rodenbach: Even with an exception process as we just discussed?

Wendy Seltzer: Even with an exception process as we've just discussed?

Wendy Seltzer: Even with an exception process.

David Maher: Kathy.

Kathy Kleiman: A question. Does any - does the DAG speak to this? Is there a required IP claims or Sunrise as part of the application process for new gTLD?

((Crosstalk))

Jeff Newman: Just to clarify, the DAG - none of this is in the DAG because the DAG specifically chose not to put this in. It's a separate explanatory memo. So there's nothing in the DAG.

Kathy Kleiman: Okay.

Mike Rodenbach: I mean - it's Mike Rodenbach. Is there a queue? I'm sorry. I'm not in the (data) room right now.

David Maher: Go ahead.

Mike Rodenbach: So Wendy, if it's not mandatory, you know, with a limited exception process I can agree with that. But if it's not mandatory, what is the incentive to use it? Why would any registry use it?

David Maher: Isn't the answer to that that it's the question of convenience. Instead of getting involved with unknown areas, you have some certainty that there's been some validation process.

Jeff Newman: Can I ask a question? This is Jeff. Does anyone...

David Maher: (Yeah). Go ahead.

Jeff Newman: ...does anyone - let me ask it the other way. Does anyone think that - and Wendy, are you saying even for something like a dot Web that's open and generic for the entire world no restrictions, you still believe that it should not be mandatory? I believe it should be.

And if we could start from that standpoint, then maybe I think we're making some progress. But I want to hear from you whether you believe even in that case where it's completely open you do not believe it should be mandatory.

Wendy Seltzer: I would - I would start by allowing the applicant to specify something that might be different.

David Maher: Okay. Well I think we may have - I'm not sure there's consensus but I also not sure that we're making any progress on this. Perhaps we really ought to move along unless anyone has something to add beyond the positions already expressed.

Liz Gasster: So this is Liz. I'm just trying to take notes. Wendy, can you just identify the concern and I'll capture it here.

Wendy Seltzer: It's just I would like a bullet point in our list of is this mandatory for registries to use in the launch of a new gTLD and some discussion or notation...

Liz Gasster: But why wouldn't it be? So why shouldn't it be?

Wendy Seltzer: Because I think that there are alternate ways from checking anything against the list for registries to assure that trademark holders have the opportunity to protect their marks. If we have narrowed the opportunities from our protection to checking a list, then I'm agreed that this list is the place that they should check. And I'm really asking a procedural question of if there was a consensus here and I missed it, fine. I'm out of turn. But let's please document that consensus.

David Maher: Okay. I think we better move along. The next issue is the duration of required use, if it is required, of the trademark clearinghouse and the straw man proposal is - it's to support the pre-launch of a registry either for Sunrise or an IP claims service and potentially pre-registration process for the URS but no post launch IP claims. Mike.

Mike Rodenbach: Just to clarify, no post launch IP claims are required but still could be used by the registry if they choose, correct? Do we have - do we have consensus on that point or does anyone...

David Maher: I believe we do that as an optional resource that will be available.

Mike Rodenbach: Then how about putting some sort of minimum period on those so-called pre-launch whether they choose a Sunrise or an IP claim because otherwise they can choose a one day period or the one hour period and so I guess that would satisfy the rule as it is now which is they either have to have one or the

other. So I think we need to put some sort of more limits on at least the minimum duration of these functions. Otherwise again they can be entirely meaningless.

David Maher: Well I think that maybe somewhat outside the scope of this proceeding. I agree with you that a ridiculously short Sunrise but I think - I would assume that ICANN would catch that in the application process if there's an elusory claim of rights protection of - ICANN's application process should pick that up.

Jeff Newman, go ahead.

Jeff Newman: Yeah. I think - I think - I don't think we set a minimum days but I think we can - we should document Mike's concern in our report and basically say, you know, a reasonable time period to achieve the goal, right. And so I mean we could spell it out but - so I agree we can't really specify an amount of days but we should - the concept should be in there.

David Maher: Okay.

((Crosstalk))

Mike Rodenbach: (Unintelligible) just clarify - this is Mike. I'm not in agreement with the straw man. You know, I think that the IP claims need to be mandatory for all look-ups. I haven't heard any good reason why it shouldn't be.

David Maher: Which...

Alan Greenberg: Mike, are you saying post launch also? Is that - is that the gist of what you're saying?

Mike Rodenbach: Correct. In my mind the IP claims service - okay just looking at that alone right now. If you allowed - the registry is allowed to just offer it for 30 days or

90 days, what is the point? Obviously no infringer is going to register during that time period. They'll just wait until the launch. So it is entirely meaningless if it's limited to so-called pre-launch.

David Maher: I - well I think you have a minority view there.

Mike Rodenbach: Explain to me the benefit?

David Maher: Well, it's not a question of the benefit. I and perhaps someone else -Jeff Newman, do you want to speak to this?

Jeff Newman: I could certainly speak to the harms. And I could explain how the costs would out ride the benefits. And I think we've done that on the last few calls. And I think I put some of it in the explanation in the common grounds paper.

You might not think it's good Mike, but I guess that's your subjective opinion on that. I'm not sure what to do. We've kind of been through this and around and around and you don't agree with it and that's fine I think that should be documented but I'm not sure what else to say on the subject.

David Maher: Yeah. I think we have - there's disagreement. There's no question about that. So we move along to the required elements of the notice, which is the next topic. The straw man proposal, a clear notice that the registrant may proceed to register if it does not believe it will infringe or plans to use for a non commercial or (unintelligible).

There has to be a clear description of the goods and services, the jurisdictions, registration numbers, date of (unintelligible), date of registration and provide either actual clearinghouse data in the notice or feasible link to the data and the applicable database. And finally indicates that the registrant should consider consulting an attorney to register to understand his rights.

Any comment on that? Paul. Paul, are you available? Well. Go ahead - go ahead Alan. Alan?

Alan Greenberg: ...muted. I'll make my standard comment that we need to put a reference in that statement regarding language.

David Maher: Okay.

Paul McGrady: I'm sorry. This is - this is Paul McGrady trying again. And I keep forgetting to un-mute the phone. I think that this, you know, that there's general - I believe that this statement captures what needs to be there. I very early this morning and Kathy's not had a chance to look at it.

I sent Kathy a draft proposed notice. She and I are working on making sure that the notice is useful to the end user. And hopefully she and I will have a chance to sort of go back and forth over the next little bit and the we'll be able to produce a draft notice how we think it should look in the field to the group in the next day or so.

David Maher: Okay. Thank you. Kathy.

Kathy Kleiman: That's what I was just going to say. Thank you Paul.

David Maher: Very good. Okay then I think we can move to our final point, which is the effect of filing. We clearly stated in the mandate of the database that simply inclusion of a reviewed mark is not proof of any right nor does this infer any legal rights on the rights owner. That's - I think we do have consensus on that unless anyone feels differently.

Man: I don't think you should give people the opportunity now.

David Maher: I'm...

Man: But you have to be a fair chair.

David Maher: Yeah. God knows. Thank you. Well we've run through about an hour. We can extend this call but we've come to the end of this straw man proposal. I'm perfectly willing to say that we've completed our work for this morning or the afternoon wherever you may be. Does anyone have anything to add at this point or shall we adjourn until next week sometime?

Alan Greenberg: It's Alan. When we started this discussion, I was saying that on the issue of separation of database versus validators and such we should try to document the principles. I'll volunteer to try and put something out on a list in the next day or so of what I think the principles that we've all agreed on are.

David Maher: Good. Thank you. That would be much appreciated. Okay. If not, thank you all for participating. I think we've made some very good progress. And we'll talk next week sometime.

((Crosstalk))

Alan Greenberg: ...and thank you for the 25-minute break before my next call.

Man: Okay.

Kathy Kleiman: Thank you David. Thanks everybody.

Man: Good night.

Man: Bye bye.

((Crosstalk))

Gisella Gruber-White: Thank you (Shirley).

Coordinator: Thank you. Have a nice day.

END