

---

**ICANN Transcription**  
**Review of all Rights Protection Mechanisms (RPMs)**  
**Wednesday, 11 September 2019 at 17:00 UTC**

Note: Although the transcription is largely accurate, in some cases it is incomplete or inaccurate due to inaudible passages or transcription errors. It is posted as an aid to understanding the proceedings at the meeting, but should not be treated as an authoritative record.

Attendance and recordings of the call are posted on the agenda wiki page:

<https://community.icann.org/x/KolCBw>

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

<https://gns0.icann.org/en/group-activities/calendar>

**JULIE BISLAND:** Good morning, good afternoon, good evening, everyone. Welcome to the review of all Rights Protection Mechanisms (RPMs) and all gTLD PDP Working Group call on Wednesday, the 11<sup>th</sup> of September 2019.

In the interest of time, there will be no roll call. Attendance will be taken by the Zoom room. If you're only on the audio bridge at this time and haven't been identified yet, would you please let yourselves be known now? Alright. I would like to remind all to please state your name before speaking for transcription purposes, and please keep phones and microphones on mute when not speaking to avoid any background noise. With this, I will turn it back over to Kathy Kleiman. You can begin.

**KATHY KLEIMAN:** Terrific. Thank you so much, Julie. Welcome, everyone, to the RPM Working Group meeting. I'm Kathy Kleiman and I'll be chairing today. Both Phil Corwin and Brian Beckham, the other two co-Chairs are on the call. Let me first check, are there any updates to Statements of Interest? John, go ahead please.

---

*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.*

JOHN MCELWAINE: Thanks. I need to update my Statement of Interest and let everyone know that I was recently elected to be the IPC representative to the GNSO Council that won't start until the end of the Montreal meeting, and I will also be serving as the liaison for this working group to the GNSO Council. Again, that does not officially start until after the Montreal meeting. The handover has already started and I will be working to better understand that role. I'm looking forward to working with this working group and the Chairs, co-Chairs in being a liaison to the Council. Thanks.

KATHY KLEIMAN: Thank you, John. Thank you for taking on this new role as liaison to the Council starting at the Montreal meeting, but really starting now as you work with Paul McGrady on the handoff. And great thanks to Paul who had this role for so many years as our liaison to the Council and has spent so much time and so much effort on it. So, thanks to you both.

Any other updates to Statements of Interest? Looking for hands. I don't see any, so we will go on to the second agenda item, which is determine support for proposals relating to our now two open TMCH Charter Questions. As you remember we were looking at proposals that came in in 2017 but also that we gave the opportunity for these to be updated in light of changes that might have occurred in the last two years. And so, we're seeing both updated proposals and some proposals coming through to try to bridge the gap between different concerns and issues that have

---

been raised in the proposals and in the very active discussions that we've had in the last two meetings.

I actually wanted to recommend that we start with Question #8, and I wanted to see if there was any objection to that. I think there's more agreement on Question #8, and so it might be a good place to start. Question #8 is how are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider? And then with the underlying question, what does the Applicant Guidebook say? Are we happy with that? Is it being followed? Any objections? Let me look before we move on.

BRIAN BECKHAM:

Kathy, this is Brian. I guess it's slightly practical question, which is that we seem to have spent quite a lot of time on the last couple of calls talking more about the question about the types of marks allowed in the Clearinghouse, and I know we have revised proposal from Zak and his e-mails from Lori and others on the list. I just wonder if our attention may be more on that and actually might get a little bit more mileage out of starting with that. Just a question of strong feelings – I just thought that I'd mention that.

KATHY KLEIMAN:

I'm afraid if we start there we might spend the rest of the time there, so in the interest of efficiency, I was trying to think of what we could actually knock out, Brian, that I think we can reach agreement on then spend the rest of the time on Question #7, on

---

the design marks. And you're hearing my mail being delivered, if you just heard a thump in the background.

CLAUDIO DIGANGI: Kathy, it's Claudio. Can I get in the queue?

KATHY KLEIMAN: Sure. You're one of the proposals on Question #8.

CLAUDIO DIGANGI: Yes, exactly. I do agree with Brian just stated and in part because the nature of this issue then the question that you just read out relates to how Deloitte is training GIs, and I think it would benefit us if we had input from Deloitte. I know there is correspondence with Deloitte on the design marks, but if we're going to be answering this question, I think it would really almost be essential for us to – that input from Deloitte on how they are treating GIs. I think we've had a lot of discussion and various [hosts of] interpretations about what they're doing, but I don't think we've heard from them about this. I think that would really be essential first to understand this current state of play and then some of the proposals involve next steps are made before the next round and to get their input on that as well.

Again, any final decisions we're going to have to put stuff out to the list anyway because there's obviously a lot of members who can't be on the call today. So I don't think we could really reach final agreement, maybe something tentative, but for all those reasons, I would support what Brian stated. Thank you.

---

KATHY KLEIMAN: Claudio, what I think you're saying is actually different than what Brian said, which is putting a hold on this question altogether and as I understand it in meetings with co-Chairs, we're supposed to be finalizing our recommendations on these two questions today. So, one way or another, these questions are coming up. But we can talk about reaching out to Deloitte. I wish of course that matter had been raised two meetings ago, but we are now engaged in the discussion of Q8 then. Let me just note that and let's see if there's support for what you're saying, Claudio. In the meantime, Rebecca has her hand raised. Go ahead please.

REBECCA TUSHNET: Rebecca Tushnet, sorry about that. So, I did just put that in chat, we do have Deloitte's answers and they said that they would them under statute or treaty, and that's in the response to follow up questions which was April 2017. I can probably put my copy of it if that would be helpful but let me know. Thank you.

CLAUDIO DIGANGI: Can I respond to that, please, please, Kathy? Claudio. Thank you, Rebecca. I do not know that they sent that over, so that is very helpful. There would just be the other issue that I mentioned and just in terms of implications of rule changes that we might make going forward in terms of if the status quo remains the same that's one thing but if we're changing stuff then I think it would help to have them on the call with us. Thanks.

---

KATHY KLEIMAN: Again, it wasn't my thought as Chair and as part of the group that planned today's call. We hadn't anticipated that one and we are supposed to finalize this, so it raises an issue. We did have a lot of discussion with Deloitte two years ago but that's my personal opinion. Greg, go ahead please.

GREG SHATAN: Thanks. As long as we are discussing this – and thank you, Rebecca, for clarifying that we either had heard and what we had heard, it's very helpful. I think this is – I've said it before – just a clear error on the part of Deloitte and it's one that needs to be rectified, so I don't think we're changing the status quo unless by the status quo one means how changing a mistake or correcting a mistake. Status quo is not supposed to be this, and so I think we do have to have a discussion about what to do about any GIs that are not on trademark registries that have made their way into the Trademark Clearinghouse or whether they should be expunged immediately or whether they should just be allowed to or to continue but not to renew and the like, but I think my basic view is that this just needs to be fix. This was not what was intended by that clause and it's unfortunate that somehow it got misinterpreted, but there you are. We need to fix it. Thanks.

KATHY KLEIMAN: Greg, before you leave, and for anyone who might not have been on the last two calls, could you very briefly summarize? Because I think you've kind of taken up – unless Paul McGrady is on the call today, I think you've kind of taken up the baton for Paul McGrady's proposal. Could you just very briefly summarize it.

GREG SHATAN: Let's see. I think Paul's proposal was that GIs that are not the subject of an actual trademark registration and currently lodged in the TMCH should not be renewed upon expiration, and that those that are in the TMCH but that are the subject of a national trademark registration that they should be subject to the same use requirements as traditional trademarks as applied to Sunrise registration. That would not I think affect those were that application came in as a trademark registration, but only those came in and the other through the door that wasn't supposed to exist. So, there'd be a chance I guess for GI registrants to show that they have a national trademark registration for that and demonstrate use and use that to retain their Trademark Clearinghouse registration.

KATHY KLEIMAN: So, Greg, if you would, what changes would you – are there specific changes to the wording? We have the wording in the Applicant Guidebook in front of us. Are there specific changes that, with your hat on as Paul McGrady, you might be recommending in case there are people who really support what's being said here?

GREG SHATAN: Sure. I think I wanted clarifying statement in the – not so much changing the wording about statute or treaty but clarifying that what it meant, our statutes or treaties that protect – first that protect trademarks and it protect particular marks e.g. statutes or

---

---

treaties that protect names such as Boy Scouts of America or other such things. So, I don't really have any good wording but that I think it's what we need to clarify was not intended to bring in non-trademarks statutes or treaties and to treat the strings protected there under as trademarks. Thanks.

KATHY KLEIMAN:

Thank you. So, I think this section is – as long as we're diving in and we're looking at this excellent table that staff prepared for us, there's a section 3.2.3, maybe staff can move up the table, and this is where I'm wondering if Greg or others want to speak to what is this. Is Paul's proposal addressing this? And then building on what you said, Greg. So, 3.2.3, any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion.

I'll let Greg and then Rebecca answer. Greg, I think you're recommending a slight change to that, and I apologize if I missed the exact change to the wording that you might be recommending.

GREG SHATAN:

It's okay. I kind of missed it as well. I guess you might say any word mark specifically protected by a statute or treaty, or specifically unexpressed or something along those lines.

KATHY KLEIMAN:

Okay. Thank you. Let me call –



---

GREG SHATAN: Or maybe rather any specific word mark or any word marks specified as protected. Something along those lines. Make it what you will. Thanks.

KATHY KLEIMAN: Okay. Rebecca, any thoughts on this or anything in Q8?

REBECCA TUSHNET: I just want to point out, I did send – I know people will not have had to read it – but I did send around a proposal that actually incorporates that specifically, that language. So, obviously our concern is we want these statute or treaty to enumerate, right? So, we don't want someone to say under 43A in statute, I have a common law protected mark. And I think the current guidelines I think recognize that pretty clearly, but I did send around a proposal I think gets at that, and also gets at the point which I think is completely consistent with this proposal that 3.2.4, other marks that constitute intellectual property, if it means anything, it means a bad thing and we probably don't want that hanging around there to be missed just later. Thank you.

CLAUDIO DIGANGI: Can I get in the queue? Kathy, it's Claudio.

KATHY KLEIMAN: Sorry, having some trouble unmuting. Zoom and I don't always get along. Actually, I want to go back to Rebecca. I apologize. Rebecca, did you have the same question that I asked Greg? Any

---

specific wording changes? Something has been circulated, I haven't seen it, I apologize.

REBECCA TUSHNET: Sorry, I sent it late. The language would be that the current categories to 3.2.3 and 3.2.4 should both be replaced by the single concept of word marks protected as trademarks by statute or treaty specifying the marks that issue. That would clearly encompass things like Olympics symbol and then sort of explaining it, telling Deloitte what to do is Paul McGrady's point about the explanation of what should happen to GI. Thank you.

KATHY KLEIMAN: Okay. Let me repeat that back, 3.2.3 would be revised any word mark protected as a trademark by a statute or treaty. Maybe you can put that language. Maybe you can cut and paste it into the chat so people can see if you have access to that.

And then it sounds like you might be deleting 3.2.4, other marks that constitute intellectual property, which I know came up in our discussion last week and there were some question about what that meant.

So we have Claudio then Greg, and if anyone else is in the queue, you can also type in the chat room that you have a hand up. Claudio, please.

---

CLAUDIO DIGANGI: Yes, thank you. I think actually what Rebecca's suggestion kind of goes to the heart of the issue in terms of what's happened here because the current provisions mainly used in term "word mark" which is not really a legally defined term, and I think what Deloitte did is interpret the protection of GIs as a form of a word mark, and that's why they included it. I think Deloitte was really doing their best to interpret the meaning of that and they brought it in as Rebecca noted earlier under the statute or treaty because they are protecting under statute or treaty.

It's almost there's an argument to say that this would be a change. If there's a validity to Deloitte's interpretation that GIs are form of a mark. I thought it was coming in under the other provision that states any other marks that constitute intellectual property. I think it could fall in under there.

I just think there's room for interpretation. It's not as clear cut as it might seem, perhaps from Greg's perspective in terms of whether they're out of compliance with the current stipulations and this would – there's at least an argument that this would change in status quo by doing that. I'm also curious – did we get formal feedback from Deloitte on the number of GIs that are in the Clearinghouse?

KATHY KLEIMAN: As a few years ago it was about – we didn't not much protected by statute or treaty go about 75 as of two years ago. Someone can correct me if –

---

CLAUDIO DIGANGI: Okay, alright. So, yeah. Just to summarize. If there's an interpretation where they could come in and it will change it that we should consider more broadly what else would follow from changing it, and Greg mentioned there's some talk about the ancillary database, and then I also mentioned the suggestion about the limited registration period which follows the Sunrise period, and some registries that are based in jurisdictions where these are protected forms of intellectual property and they're related to the gTLD like the .wine, .gin gTLD, for example, that the registry wants to protect GIs and what would be the best way of doing that through the TMCH is something that we should consider. Thank you.

KATHY KLEIMAN: Good question. If a registry wants to protect GIs or other types of intellectual property – we talked a long time ago about Gerry's Pizza and a .pizza. It's probably not trademark because it's Gerry's name. Is there a way to protect that in some kind of other realm? But Greg, your hand is up. Let me just ask, is there anyone else in the queue right now because I know we had a number of people on the phone?

JASON SCHAEFFER: Kathy, hi. It's Jason. I'm just on audio so if you could put me in the queue.

---

KATHY KLEIMAN: Absolutely, Jason. Following Greg. Thanks. Greg, go ahead please. Lots of interesting ideas raised, can you bring them altogether for us?

GREG SHATAN: No, I can't bring them all together but I'll bring together my ideas perhaps. I think that in terms of 3.2.3, my latest idea of how to amend this is any word mark set forth in a statute or treaty and protected as a trademark by that statute or treaty, that might work and satisfy sundry folk, at least to what was – and I believe that is an accurate statement of what was intended all along. Again, the status quo up to the point where Deloitte drove the golf cart into the water trap was – that water hazard is now being protected by the language. And I actually agree with Rebecca on getting rid of 3.2.4 because unless we can examine the historical record of legislative history, if you will, and to determine what was meant to be said by that as well, that one just seems like another opportunity only for misunderstanding and we might as well clean it up. I'm not somebody who's going to come here and look for any way that could protect a trademark. I'm looking for something that makes sense as policy in 3.2.4 has – I can't make sense of it. So, those to be my two proposals.

As far as ancillary stuff, that's a separate private right that the TMCH has by their contract that they can put together databases of whatever they want and use that as a side hustle to work with registries that want specialized databases that can work within the system of early registration. Thanks.

---

KATHY KLEIMAN:

Thank you, Greg. I actually think you just did it. So, let me summarize. It sounds like there's now two corresponding proposals on the table to embody Paul McGrady's proposal into 3.2.3 as a recommended change that any word mark protected by a statute or treaty and protected as a trademark in effect at the time it's submitted to the Trademark Clearinghouse can go. Sorry, I'm not reading that directly – can go into the Trademark Clearinghouse. So, it's keyword protected as a trademark or protected as trademarks.

And then, now two proposals that 3.2.4, other marks that constitute intellectual property may be too far a field because they're not trademarks per se. So, Paul Tattersfield 3.2.3.4 is very poor. Greg, a plus one on 3.2.3.4 but not 3.2.3.3.

So, Jason, you're in the queue. Go ahead please. And others, let me know that you're in the queue.

JASON SCHAEFFER:

Thank you, Kathy. As Greg just stated, I do agree mostly with what Greg articulated. So let's say this is the TMCH, this is the Trademark Clearinghouse, this is not Trademark Clearinghouse and other things. Ultimately speaking as counsel in UDRP cases and representing registrants and others as well as counsel to registries, I think that the proposal striking and changing this is sensible and within what is expected under the law, whether it's under trademark law, under UDRP precedent even though it's not precedent. It all comports with what we expect. If you have a trademark right then treated it as a trademark, then by all means, it should be in.

---

To Claudio's point, and I think Greg echoed it a bit, is if a registry operator and we would think that in the case of a .wine as he brought as an example, they would be interested in being a good steward of that space and they would want to do something that would benefit those that are seeking to protect those rights because it's in the interest of the registry as well as those parties that might not have pure trademark rights. So, I think that ultimately, part of what we must do is also understand from a registry perspective while not every registry to date operates under what we would like to call best practices. Most business interests require that, right? If you want to succeed and you are specialized in a certain area and then probably in the next round, we will have more specialized results. That registry operator is most likely going to want to work with those parties. So, I think in terms of a harm or a concern, the business case should mitigate that. And as we said, if you have trademark rights, by all means, if the statute treats you as a trademark then you should be in. If it's not, that a whole another story. So, I agree I think largely with what's been proposed. Thank you.

KATHY KLEIMAN:

Terrific, Jason. Thank you. I know like others, you go back to some of the early days of these discussions. Okay. It seems like there's some growing agreement on the wording changes that Greg and Rebecca have suggested for 3.2.3 and some concern about 3.2.4.

Let me read, Mary Wong has posted a question from staff. She says, "It likely makes a difference in scope whether the working group agrees to use the word 'mark' or 'trademark' for what is

---

within the scope of 3.2.3. i.e., all trademarks are likely marks but not all marks are trademarks.” And I think that’s actually run very much to the core of what we’re talking about and some of the wording that people are seeking to add. Mary, did you want to add anything more?

CLAUDIO DIGANGI: Kathy, can I get in the queue after Mary? It’s Claudio.

KATHY KLEIMAN: Sure.

MARY WONG: Hi, Kathy and everyone. It’s Mary from staff. Not really, but thank you for reading it out because given the agreement that we seem to be coming to in this group, staff just thinks that we need to be very precise in terms of the text that you finally agree on because the scope matters as I pointed out in that chat, so thank you.

KATHY KLEIMAN: Great. Thank you, Mary. And I think this is actually the heart of the discussion, marks or trademarks, and that they do appear to have different definitions and we’re trying to put the Trademark Clearinghouse – if I interpret intent into some of the wording that we’re hearing, the proposed wording, we’re trying to put the trademark back into the Trademark Clearinghouse.

Let me go to Claudio and then to Greg. And again, if anyone else has their hand raised, if you’re on audio, shout out, and if you



---

have your hand raised and I'm not seeing it, please type in chat.  
Thanks. Claudio, go ahead.

CLAUDIO DIGANGI:

Thank you, Kathy. I think it's important if we take a step back and look at – Greg mentioned sort of legislative history on how the Clearinghouse came about. It was not in the first version of the Applicant Guidebook, nor were there many RPMs at all, and part of the process was the formation of an Implementation Recommendation Team which the Board adopted by resolution to put together a group of folks to come up with some suggested RPMs. That group, in its final report, referred to this database – the name of the first group, this is where the Clearinghouse came from – referred to it as the IP Clearinghouse. There was discussions on the IRT that some of the points you mentioned, Kathy, and Jason picked up on this too – that we want to be flexible because registries can be in different jurisdictions, there's different laws, and one example that came up during the IRT was that book titles, for example, may not be registerable as trademarks in certain jurisdictions, and if there was a .book registry and they wanted to protect the titles of books that there was no reason why this Clearinghouse could not be used to facilitate that function.

What ultimately happened was staff through public comment and fulfilling its role as staff changed the name to the Trademark Clearinghouse because predominantly that's what are recorded. I think if you mentioned there's 75 GIs, there's almost 50,000 trademark records and we're talking about a extremely tiny minutia percentage-wise of what's in the Clearinghouse. ICANN

---

generally does this, it's a technical organization, and it often boils things down to the base components. This has happened with other RPMs where there was the strawman proposal that was put forward, their names given to certain [other] protections, and ICANN staff changed them, simplified them, kind of boiling them down to their root proposal.

That I think is separate from – in other words, I don't think that should be the definitive guideline or guidepost. If there was language that said this is only for trademarks and GIs and other forms of intellectual property or not to be included in this Clearinghouse, we would have a different situation. But there is specifically the provision that states other marks that constitute intellectual property. So, there's specifically a provision that refers to other forms and intellectual property, notwithstanding the fact that it's called the Trademark Clearinghouse. So, I just want that to be able to inform our understanding of how we got to the current state of where things are and that separately we should consider the implications of the rules that we're proposing and there's a lot of moving parts and if we change a rule or change the wording, and I think the clarifications go to the intent of the proponents of Paul's proposal. I think they do clarify it.

Another way of clarifying that could just say "trademark." You don't need to use the word "word mark." It can simply just say trademark if that is what the intent is there. But I just think that's separate from what is currently allowed under the current rules, but there's room for other marks or signs that are not trademarks to come in, and if we don't want them registered during the Sunrise period, you could just simply state that and there will be

---

no interference with the trademark protection rules whatsoever, and to me that seems like the simplest approach to proceed. And that's why I put forward that suggestion. Thank you.

KATHY KLEIMAN: Claudio, don't get off yet. Are you saying – I know you can't see it but in 3.2.3, that is saying any word mark protected by statute or treaty, any trademark protected by statute or treaty?

CLAUDIO DIGANGI: Correct. I think any time word mark is used, it could be substituted. I mean according to this interpretation of Paul's proposal, if you only want trademarks in the database then just use the word trademark, and you don't need to further delineate what type of word mark because those words don't have legal definitions.

KATHY KLEIMAN: Okay. Thank you.

CLAUDIO DIGANGI: So, that would be that, but again I don't – I have a separate view on allowing them to be protected after the Sunrise period, for those registries that choose to do that. Thank you.

KATHY KLEIMAN: Great. Thanks, Claudio. Thanks for the clarification. We've got Greg and Rebecca right behind you to comment on what you said,

---

I assume, and a path going forward. Are we reaching some kind of convergence? Greg, go ahead please.

GREG SHATAN:

Thanks. I take the trademark versus mark discussion and Mary's remarks to refer to the issue of whether trademarks embrace service marks or not, and that the word mark was chosen here to avoid the confusion that might arise from the word trademark being used and some people thinking that that excludes service marks. I don't think we were trying to do anything more than that, and so I think that probably where Mary was going with that – I don't mean to be presumptuous – and that therefore the language that I proposed should say as a mark rather than as a trademark in 3.2.3, unless we want to change the whole way we're dealing with the word trademark then we do refer to trademark registration in 3.2.5, but that's because I don't think anybody ever says mark registrations. So, the alternative is to footnote the first time the word trademark is used that this includes service marks or all marks on trademark database, or something along those lines.

As much as I like the expansion of this discussion, to take the words word mark out, I think that actually goes to the other topic of today and I think it's probably kind of over, over, overdoing this proposal to weigh it down with the issue of what is meant by a word mark, what is meant potentially by a design mark. I think is just a discussion about clearing up the non-marks that ended up in the Clearinghouse. Thanks.

---

KATHY KLEIMAN: So, Greg, are you still with the language that you said any word mark protected as a trademark by statute or treaty, or have you changed that?

GREG SHATAN: I'm not sure that we need to say as protected as a trademark. I'm trying to think of a statute or treaty that would expressly set forth something – and we do start with a trademark or any word mark set forth in a statute or treaty and protected in that statute or treaty. It might actually cause some mischief to say protected as a trademark and because we already have that as a word mark. So if we left that in, I would say protected as a mark or protected as a trademark or service mark or certification mark or other such thing overall trademarks.

KATHY KLEIMAN: Okay. Put it into the chat room if you would. Thanks.

CLAUDIO DIGANGI: Kathy, can I –

KATHY KLEIMAN: Claudio, Rebecca's been on the queue for a long time.

GREG SHATAN: Just my point that the trademarks – I'm seeing what Rebecca just wrote. That's why we need to say that it's expressly the word mark is set forth expressly in the statute or treaty, that these statute or

---

treaty has the words that we're talking about in it. You can say here's my registration for Boy Scouts of America or for Academy Frances and it comes in a statute. We're not talking about statutes that protect types of intellectual property. Not at all. Thanks.

KATHY KLEIMAN: Oh, that's a pretty sophisticated – wow, okay. Kind of a whole new layer here. Rebecca, and then I believe, Claudio. Let me check. Yes. Rebecca then Claudio. Rebecca, go ahead please.

REBECCA TUSHNET: Thank you. Basically, I agree with the first half of what Greg said. Whatever word does or doesn't mean we're either going to [hash] out or not, retaining its current indeterminacy or what some people see as indeterminacy really doesn't have any bearing on this. My proposed solution to the extent we're worried about it is an early footnote saying, look, when we say trademark we mean trademark, service mark, certification mark, collective mark as found in trademark databases worldwide. I think that's pretty clear.

The other questions that have arisen are things like protecting book titles. I don't know why we want to protect book titles if you don't have a registration or a court decision confirming it or, frankly, national legislation. I believe Peter Pan actually has that protection in the UK, if I'm not mistaken. So, why shouldn't you have to show up with that if you want into the TMCH and want those Sunrise and notice? If there is some other system people want to implement, I agree. It's totally fine to develop it but we

---

shouldn't be blessing it in this and creating this pool, which is as far as I can tell, the current status that we have. Thank you.

KATHY KLEIMAN: Sorry. Rebecca, before you leave, trademark, service mark, certification mark – do they get that?

REBECCA TUSHNET: Collective mark.

KATHY KLEIMAN: Collective marks. Okay. So, kind of defining what a word mark means in a statute or treaty because there seems to have been some question about that. Okay, did we capture that? Great. I'll pause if you have any further comment.

REBECCA TUSHNET: Actually, yes. Sorry, this just came up in the staff comment #2: "Concerned about specifying that the actual statute or treaty must either name the marks or contain a list." Yeah. That's actually what the statute or treaty should do. That's what we require with a registration. That's what we require with court decision. It's not enough to come in with a court decision saying, "In general, marks that are distinctive are protected." You've got to show that your mark is the one that's covered.

So I would strongly oppose that comment from staff and say that just puts the statute or treaty marks on parity with everything else that is legitimately in the TMCH. Thank you.

---

KATHY KLEIMAN:

Okay. Thank you very much. Moving to a definition, a closure, a tighter definition here of what would go into the Trademark Clearinghouse, from statute or treaties. By the way, I think some kings' names are protected by statute or treaty in certain countries. There's a wide variety of things that are protected by statute or treaty as I understand it in different countries, and then going further this question of classification and categorization where some statute or treaties are very broad, embracing say GIs but without listing them individually. So, lots of really good questions coming up. Caludio, back to you.

CLAUDIO DIGANGI:

Yes, thank you. A response to Rebecca's question and a point that Greg made. I think as a starting principle, what's helpful is if we use language that is legally recognized language. Greg brought up the service mark distinction. I think to address that, it could say trademarks and service marks, so that issue goes away.

On a broader level, what these words are, are identifiers or source identifiers. They identify to the consumer the source of a particular product or service, and in a manner that is distinctive and distinguishes the symbol or the word or the phrase from other symbols, words or phrases.

Generally, there's a common term which we refer to as a sign that these are signs. There are various forms of signs, GIs being included as a sign that identifies source, or a trademark as a sign that identifies source. That's the broader term, but I think from a



---

more legally definitional perspective, we should use words that have legal definition broadly across jurisdictions. Now is the challenge with the book titles issue, Rebecca, which was that they're treated differently in certain jurisdictions. In certain jurisdictions, you could register the book title as a trademark. But the law in another jurisdiction might not treat them that way. And since they're identifying the source of the product, they represent a form of intellectual property from that perspective.

So the idea was to have an inclusive system from the very start. That was what the genesis of the IP Clearinghouse was. I just think we're somewhat skipping over that. I haven't heard a response to that particular point by anyone which was that was the genesis of this Clearinghouse. The name of it got changed but it was born in the spirit of protecting source identifiers, whether they'd be trademarks or other forms of intellectual property. We could then come up with rules where we could say trademarks have priority and they can register during the Sunrise period, and other identifiers get registered during the limited registration period which is already part of the system, it's already set up, and I know registries have had all challenges. I'm not sure if there's any registries on the call today with getting their launch plans put into place. That's my concern with the ancillary database. I would think it would've been created by now because registries have gone down this road already and there isn't an ancillary database. So I'm just trying to work off of what's in the current system. Thank you.

---

REBECCA TUSHNET: This is Rebecca Tushnet. Can I get on the queue? I'm sorry. I'm out of my computer.

KATHY KLEIMAN: Greg, is that an old hand or a new hand? Okay, Greg's hand is down. Rebecca, you're going to be next. I just wanted to summarize that as for 3.2.3, I think I am hearing agreement that there is an interest of speaking in more clearly defining that it applies to trademark service marks, certification marks, collective marks, and that we should be using more precise language here. Rebecca, go ahead please.

REBECCA TUSHNET: I apologize for the background noise you're now going to hear. Now that I understand Claudio's suggestion more firmly, I think I'm more convinced that things like book lists are inappropriate for the TMCH. So, it is true the United States does have a rule that says a single book title can't serve as source identifier because it's the name of the thing. That's a national rule and it contains some evidentiary presumptions. There are some other systems that have different kinds of evidentiary presumptions in the U.S.

I don't [inaudible]. Sorry about that. We are supposed to be overriding national law or creating new rights. If you're in a jurisdiction where you can't register a trademark for a particular thing then you're in a jurisdiction where you can't register trademark for this particular thing. And there's no reason that the TMCH should be reaching out to hold your hand and give you something you can't get under national law. Nor do I think we

---

should accept the WGA registry so you can register titles there. I don't think that's an appropriate use of the TMCH either. So if there are these informal things out there, so what? They're beyond the scope of the TMCH or even the MCH because the issue is, we have some reason to think they actually are working as marks, and national registration, court confirmation, more specific identification, and statute or treaty seems to be a good line to draw. Thank you.

KATHY KLEIMAN: Great. Thank you, Rebecca. You're talking as you're moving.

JASON SCHAEFFER: Kathy, Jason here, if I can get in?

KATHY KLEIMAN: Okay. I just wanted to distinguish everybody because we haven't from this 3.2.3 and 3.2.4. We have what appears to be agreement on 3.2.3 adding some specific language. Again, tying that to – and part of the reason we're repeating this again is just to see if there's any objection or concern, tying it to trademark, service mark, certification mark, and collective marks. 3.2.4 then remains a different question, which Rebecca and Claudio just spoke to about this kind of broad category or the marks that constitute intellectual property. Jason, go ahead please.

---

JASON SCHAEFFER: Thank you, Kathy. Again, forgive me, but, Claudio, maybe give some clarification. I'm not sure if I'm hearing this correctly. I think the point is it should be discussed and clarified. The way I'm hearing this is that Claudio has some thoughts and concerns about specific registries, specific uses of an ancillary database. We were talking about .book, so let's just play with that. Are you saying that in the case of a .book – and I do agree with Rebecca's point on the lack of trademark rights there and that is a concern that we have – but are you suggesting, Claudio, that the idea is that it allows for these ancillary databases to be created and utilized ... Is it something that would be in connection with the registry? If the registry operator for .book said, "Really our purpose is to make sure that the universe of authors and writers are protected, we want to utilize this database," is that something that you envision or is it something that's imposed externally upon that registry? I'm not sure which way you're going with this. So if you could clarify that, that would be helpful for the discussion, but then I do agree with what Rebecca says. I think we do need to be very precise in our language so we avoid this problem in the future. Thank you.

CLAUDIO DIGANGI: Sure, Jason. Thank you for the opportunity to clarify because I did want to try to clarify it. I think what a lot of this come down to is the idea of what's mandatory and what a registry must do and what a registry is allowed to do under the contract. This, in part, was to Rebecca's point about the book titles.

I'm not suggesting that this would be a mandatory rule. It's born from the idea – and Jason said this earlier – that the registry

---

having a safe space, the registry doesn't want to have abusive registrations in their TLD. They want a TLD to be reflective of their intended purpose for the domain. So they want the registrations to correspond to the semantic meaning and the reason they applied for the name. So the idea was to allow registries the flexibility to do that and permit them to protect different forms of source identifiers or signs or, generally, intellectual property if they chose to do that.

I think really all we're debating here is how that would go about happening. I'm not suggesting that the GIs should be protected mandatorily. It simply came up in the Sunset in certain jurisdictions. Those identifiers, that's the legal form of protection that they have. So if the registry is in that jurisdiction, they might want to protect that form of intellectual property. The ancillary database I guess could be another way of going about accomplishing that and I just thought we haven't seen one created yet and we've heard difficulties from registries about getting things approved, that there would be a simpler way of doing that by just saying it's already baked in that they could have a limited registration period after the Sunrise period to register these different intellectual property.

So what we could say to Deloitte is those can't be registered during the Sunrise period. It's okay if you keep them in the database. I'm not conceptually seeing really the big benefit of having a separate database. As long as those names aren't registered during the Sunrise period, then they could sit in the same database as far as I understand. I hope that clarifies, Jason. Thank you.

---

KATHY KLEIMAN: Thank you, Claudio. I'm going to recognize Mary next.

REBECCA TUSHNET: Can I get on the queue?

KATHY KLEIMAN: Sure. I did want to add, it does seem that we have some agreement on 3.2.3. As we look at 3.2.4 – and I'd urge Paul Tattersfield to join us if you can, join by audio. I want to add a factual account. The Trademark Clearinghouse term was created by the STI. This was a group that was kind of like an expedited PDP that was created by the GNSO Council to rapidly review what the Intellectual Property Constituencies IRT put together, and it was the STI by unanimous consent that limited the Trademark Clearinghouse to trademarks and service marks. Mary, go ahead please.

MARY WONG: Thank you, Kathy. I'll keep this brief because I know that you all have a lot to discuss. But since there's a few group members who are on audio only, stuff that we might just want to summarize some of the comments in the chat especially some that went by earlier.

On 3.2.3, the marks protected by statute or treaty, the examples that we gave in the chat that occurred to us at the top of our head really go to the earlier comment we had about whether you're

---

going to be saying “mark” or “trademark” in 3.2.3. Thank you for inviting Paul Tattersfield to participate if he can because staff just wanted to clarify what the scope there is. If we’re going with trademarks, so for example, Rebecca’s suggestion of statute of treaty that lists and specifies what the trademark is that would likely exclude some of the examples, including examples given by Paul Tattersfield.

Then in respect of 3.2.4, other marks that constitute intellectual property, we just wanted to remind the group that while this may be somewhat broadly phrased, the intention and the practice in the AGB NS implemented by Deloitte was really about marks whereby arrangement with the registry operator in accordance with an individual registry operator’s own requirements, those marks are put in the trademarks database with respect to that registry, that gTLD, and not with respect to the full-on Sunrise or Claims services for other registries. So we hope that clarifies. Thank you.

KATHY KLEIMAN:

Mary, do you know about since Greg mentions ancillary database with a concept created by the STI on that very concept that if there were individual registries who wanted to go farther, such words should, by definition, not trademarks or service marks. So it should not go into the main Trademark Clearinghouse, it should not be used for Sunrise, and should not be used for Trademark Claims. So do we have a convergence of staff recollection and of maybe partial working group agreement that these belong someplace else but not in the main Trademark Clearinghouse?

---

These being other marks that constitute intellectual property.  
Thanks, Mary.

MARY WONG: No worries. I don't have a specific answer right now. We can go back and check to the extent that we have the information. But as of 2017, when this group last engaged with Deloitte, they told the group that at that time, no registry operator had engaged with Deloitte on this specific provision 3.2.4.

KATHY KLEIMAN: Mary, before you leave, does that mean that we can move towards – forgive me, we're not going to have the exact wording yet, we'll have to come back to working group next week – but conceptually, that 3.2.4, other marks that constitute intellectual property can be added to ancillary databases maintained by the TMCH but do not go into the main Trademark Clearinghouse database. Is that a reflection, Mary, of what you were saying, was the intent? Let me just start with that question.

MARY WONG: Thanks, Kathy. I was not speaking about either a main database or an ancillary database because I do not personally know and I don't know if any of my colleagues on this call know how the database has been built and structured by Deloitte and IBM, with respect to where and how they house each category of marks. So, I'm afraid I can't answer that direct question. It's just that we wanted to clarify that for 3.2.4, under the AGB, is not meant to be a broad category of anything else that could be a mark. It really is



---

... tied to an individual registry operators, requirements, and arrangements.

KATHY KLEIMAN: So if we clarify that individual registry operators and their arrangements –

CLAUDIO DIGANGI: Kathy, can I get in the queue?

KATHY KLEIMAN: Yeah. John McElwaine has said in chat, “Just because a mark is in the Trademark Clearinghouse, I do not believe that means that the mark is entitled to a Sunrise or Claims Notice.” But, John, if I might, that’s what the Trademark Clearinghouse is for, so interesting.

Claudio, go ahead but very, very briefly please. We really need to go on to design marks.

CLAUDIO DIGANGI: No, absolutely. I somewhat lost my train of thought. One point was that that’s helpful input from Mary because that would mean each individual registry would have to create its own ancillary database as opposed to having one way of having them entered into the Clearinghouse and then used across registries that [inaudible] accept those forms of IT. I think it would help – again I said this at the earlier part of the call – to have Deloitte’s input. And now I remember my main point, Kathy, and I appreciate you trying to

---

help us reach consensus, but we need to put obviously everything out to the west. I have spoken to other working group members who were supporting the position I put forward. None of them are on the call today, and the agreement is very tentative at this point.

KATHY KLEIMAN: Agreed. Absolutely agree. John, and then I think we're going to try to wrap this up because it sounds like –

REBECCA TUSHNET: Sorry, Kathy.

KATHY KLEIMAN: Don't apologize. You [waited] a long time. I apologize. Rebecca then John. I apologize.

REBECCA TUSHNET: I'll try and be super quick. First of all, I think now this discussion demonstrates just how incoherent the current situation is. Right now we have a system that is designed to produce Claims Notices and Sunrise registrations, and as far as we can tell, we don't know for sure because it's not transparent, anything dumped into the TMCH gets Sunrise and Claims period. That's a bad idea for the reason to be discussed extensively. To the extent that that your provision about other IP is designed to allow other business models, first of all, it's leading Deloitte to engage in false advertising. If you look at what they say, they clearly indicate that

---

if you get in through other IP, you get everything else that is in the TMCH.

So I don't really think we should be in the business of creating provisions for something that apparently there's no market demand for yet, and to the extent that we decide to allow for it, it should be clear that this optional, not that it's part of the same program that's part of everything that everyone else has to sign on to. So, yeah. I'm increasingly convinced we need to separate this out. Thank you.

KATHY KLEIMAN:

Thank you, Rebecca. And again, apologies for forgetting the proper queue. If people could speak briefly as to language because I believe there's some agreement in convergence that what was intended may not be what the wording is and that we can probably get there. And if that means that the co-Chairs and staff go back and work through the chat and the transcript of this discussion and try to come up with some wording that reflects where the general agreement is, we can do that.

But, John, let me pass it over to you. Also I'm going to put on notice everybody on Question #7. We're going back to design marks. John, go ahead please.

JOHN MCELWAIN:

I think Paul Tattersfield and I are saying the same thing, which is you have to look to section 7 of the Applicant Guidebook 7.1, 7.2 as to what registrations in the Trademark Clearinghouse provide what rights, whether Claims service or the Sunrise service. I think

---

everyone's really maybe talking about best practices. You know you can get other marks that are considered intellectual property into the Trademark Clearinghouse that Rebecca has said may be a good idea for us to suggest that those marks follow 1.4, which says that any marks that are being used for ancillary services, since there wouldn't be any services in 7.1 and 2, need to be kept in a separate database. Does that make sense? Thanks.

KATHY KLEIMAN:

I'm going to ask staff to transcribe exactly what John had said so that we have that. It looks like a way forward. John, thank you for that. I think you may have given us a path forward in this issue.

For Claudio's suggestion, I think we should go back and rework on some wording, staff and [inaudible] and then send this out. Could somebody mute please? Send this out to the working group – a nice summary of this discussion, how it affects 3.2.3 and 3.2.4, along with what John McElwaine just said about 1.4 and in reference to section 7. It's a lot of material and it's not in front of us, so we need to give everybody the chance to go back to the Applicant Guidebook, look at the Trademark Clearinghouse section, which is a PDF by the way, and look at these other sections. But I think we've made some progress here, and I think we're converging. Thank you.

John, is that a new hand? Great. So, thank you. I think we should wrap up the GI question and move back to Question #7. And thanks for an excellent discussion.

---

Okay, Question #7. How are design marks currently handled by the TMCH provider? And with the background questions as our – table shows us in column 3 and 4 what does the Applicant Guidebook say about it, and also what is Deloitte doing.

This is a work in progress. Even though it says, “Proposal submitted by Kathy Kleiman,” this has been now supplemented or supplanted, really, by material submitted by Zak Muscovitch. My understanding is that there are several proposals in play. One is this design mark proposal now in front of us, one is Greg Shatan’s proposal about disclaimers, and one is a compromised proposal that was shared among, I believe, several of the proposers as had been requested by Phil Corwin when he was chairing last time – so by the co-Chairs – that to see people could come together. So, Zak, let me hand it over to you to see where you’d like to start.

ZAK MUSCOVITCH:

I see that there’s almost 20 minutes left, and I know everyone is going to be disappointed that they won’t have as much fun as we originally anticipated given the time constraint. What I first want to say is thank you to the IPC and Deloitte for having some communications with me about trying to find a compromise solution since the last call. There wasn’t a lot of time in between this call and the previous week’s call, but at least we managed to have some communications. Although there hasn’t been a compromise found, at least we can say that the two particular interests understand at least what each other’s position is. So we’re not talking past each other, it’s just a genuine disagreement it seems to me. Originally, in the proposal two weeks ago that Kathy originally introduced and which I revised, that took the

---

position that essentially word marks ... A word mark is a term of art and the Applicant Guidebook only permitted word marks to enter. There's some corroboration from that from the previous STI, which talked about text marks, and so I'm convinced and remain convinced that word marks mean exactly what I think it is, which is, it's a term of art referring to a mark composed of words. But the other perspective is that whether or not Deloitte has misinterpreted, the fact is that we can allow in other marks that have words in them.

So the concern from my perspective with that is that when it comes to – and I'll use the term “design mark” to encompass any mark that is composed of anything other than words in this context. So when I say “design mark” that's what I'm referring to now. The concern was that design marks can be admitted into a Trademark Clearinghouse as they have been wholesaled by Deloitte, notwithstanding that under trademark law in various countries, the mark holder doesn't necessarily have rights in those constituent words. You've heard me speak about this last week and the week before.

The other side of it is that the person who has the word mark or the design mark may very well have rights in the constituent words. So essentially, at the risk of oversimplifying it, what it boils down to is that one side of the argument we characterize as wanting to err on the side of admitting design marks even at the risk of some rights or some trademark orders not having the complete rights in the words. The other side wants to err on the side of not letting in design marks so as to avoid any chance of

---

someone getting into TMCH that doesn't have rights in the constituent words.

KATHY KLEIMAN:  
was?

Zak, can you briefly summarize maybe where that middle ground

ZAK MUSCOVITCH:

It's middle ground as far as I'm concerned, but not as far as other people concerned, and I respect that, but the middle ground that I saw was that we could harness Greg's proposal of disallowing design marks that have complete disclaimers and allowing marks into Trademark Clearinghouse that have partial disclaimers. But when it comes to what rights getting into Trademark Clearinghouse entails, the design mark holders would get the right to have a Claims Notice issued that would say something to the effect that the trademark owner may have rights in the words within the design mark. Otherwise, they shouldn't be able to jump the queue and harness a design mark for the purposes of Sunrise.

This was intended as a compromise, but really the position that I prefer is the one that I took two weeks ago that followed Kathy's initial proposal which is that design marks should be prohibited – period. If the compromised proposal that I put forth has attracted any new supporters, that's great. I'd love to hear from you in the chat or on this call. But otherwise, it would seem to me that the original two positions remain entrenched, so I'll leave it at that. Thank you.

---

KATHY KLEIMAN: Okay. Zak, thank you for trying to come to a middle ground and for presenting it. Let me ask, Lori Schulman, do you have audio, and do you want to comment briefly on this because you also posted to the working group on this kind of compromise or middle ground proposal?

LORI SCHULMAN: Hi, can you hear me?

KATHY KLEIMAN: Yes. Thank you.

LORI SCHULMAN: Okay. I've been following. Yes, Zak and I had some offline conversation where we thought there could be a path. I appreciate other IPC members to step in, but I want to say this. We recognize and appreciate that it was acceptance of Greg's solutions in terms of the one to choose. Of course we would support it.

I think 3 is interesting and it's why I agreed to surface it to the IPC that if there were some clearer way to maybe in cases of doubt, give a right to Claims but maybe not a right to Sunrise. That may be a path to go. But there was a lot of concern on the part of the IPC membership about where you draw that line, how that line would actually work. It goes back to this whole issue of what is or isn't a design mark, whether words dominate or should dominate in terms of the domain system itself, and there was definitely a consensus about having words dominate in terms of how we



---

would draw a line if we were to draw a line. That's in terms of 3. In terms of 4, there was a feeling that –

KATHY KLEIMAN: Lori, [inaudible] second. Everyone, the version we're looking at says 1, 1, 1, and 1.

LORI SCHULMAN: Yeah. But I'm just superimposing what are logical – 1, 2, 3, 4, 5 if you count them.

KATHY KLEIMAN: You'll also see the number. Somehow we lost the number. We'll see it in the working group. In the list it has the correct number. Sorry, back to you, Lori.

LORI SCHULMAN: Right. In terms of 3, 3 was interesting. But I don't think there was enough there for us to come out and fully support it because there's still this risk of losing what other [rights] be right through this RPM. That's problematic for us.

In terms of 4, we agree that this is something we could talk about. We don't agree that we go back to zero on this, that we all agree that the Claims Notice needs revision, that the Claims Notice should not be scaring away legitimate registrants – absolutely. But at the same time, with this particular iteration, we were thinking about maybe there could be some compromised language, but we also didn't want to go down the rabbit hole of providing legal

---

advice in a notice. So, I think something is [4] that we could talk about and perhaps come up with a creative solution.

In terms of 5, my personal feeling about this is it's an edge case. It's a small problem but we had many members in our group who believe that these are trademark registrations with trademark rights that should be respected inside the Clearinghouse, and that maybe at some future point, this might be something you might discuss or move on but not until the other questions in terms of 3 and 4 were answered.

So I think that pretty much reflects what the group was discussing, but I would love my IPC colleagues to chime in here. As I said, this was something Zak and I – I was just offline asking him for the redline last week. I was a little concerned about having it and we were both discussing how I really felt that a lot of these issues could potentially be solved with revisions to the Claims Notice itself. Registrants are really clear what things mean and don't mean when they get a notice. I think that's something that the group has agreed to all along. It's just how we get there has been the issue. Zak very kindly came back with the proposal that he did, and it was fully discussed. I would hate to go back to the corners and say, "We are where we are," and I understand Zak's perspective that perhaps this didn't move things as forward as much as he would have liked. But I think they actually have because there is the opportunity here to talk about 4 and maybe even 5. So I'm going to leave it right there.

---

KATHY KLEIMAN: Okay. I'm going to – with our last 10 minutes left – ask anyone who's taking a look at this. I think Zak raised the question, is there anyone in support of this middle ground. So let me [inaudible] as well.

REBECCA TUSHNET: Can I get on the queue?

JASON SCHAEFFER: Hey, Kathy, it's Jason. If you could put me on the queue please?

KATHY KLEIMAN: Did I hear Rebecca and Jason? And we've got Greg. Okay, Greg, go ahead please. And I'm going to [inaudible] we're doing this next week. Sorry about that but clearly we are. Go ahead.

GREG SHATAN: Thanks. Unfortunately, I can't support this proposal, or at least not number 3. Basically, I think that the idea of the design mark, word mark binary, it's kind of a false binary. If, for instance, logo marks or FedEx in two colors is not a word mark if Coca-Cola in script is not a word mark, and yes, I know those companies are probably big enough to have text-only registrations as well but gee, I'm just thinking of famous trademarks at the moment. I'll try to think of some obscure ones. Michael Stevens was a client of mine. Handbag manufacturer, didn't have a lot of money. They registered only the stylized version of their logo, which was the word "Michael Stevens" and the font with some extra attention

---

paid to the M and the S to make them a little more fancier. If that's not a word mark then I'm against it. If we can draw the line somewhere where a bush is a design mark, and a bush that says "Michael Stevens" on it is not a design mark, then we have something to talk about. Thanks.

KATHY KLEIMAN: Great. Thank you, Greg. Rebecca, please. Rebecca and Jason will probably take us to the bottom of the hour.

REBECCA TUSHNET: Look, Zak did numerous original [inaudible] thinks that there's such a thing as a word mark. It's hard not to see this insistence on the incredible complexity of the system as being somewhat [inaudible] in nature. But here's the thing. We now have an opportunity for some compromise on this. If we can talk about splitting Sunrise and Claims like the best argument for letting stuff in for Claims purposes is maybe there's a problem, and the person who gets the notice should have a chance to evaluate. That's just not true with Sunrise, which is a preemptive right that excludes other people from the market. And we already have a system under Sunrise where Deloitte is examining for proof of use. So, we can leverage that.

If we can reach some conclusion about how to deal with it then we can say, "Deloitte, make sure it's a text mark." Or if you want to, there's even some room, "Deloitte, make sure that the textual elements are dominant," if that's what the concern is. We have some freedom now because it's possible for Sunrise to do some

---

more specific examination, which is already taking place. So, let's leverage that. Thank you.

KATHY KLEIMAN:

Thank you, Rebecca. And thank you to Lori and Zak for giving us the space to leverage a further discussion. Thank you for pointing out what possibilities this gives us, Rebecca. Jason, you're taking us to the end of the discussion. Go ahead please.

JASON SCHAEFFER:

Okay. Thank you, Kathy. Just hearing Greg's concern and statement earlier, I don't think we're that far apart. In Greg's example, I think it's Michael Steven, if it's a clear situation – and I know that's debatable – but if we're talking about situational, predominantly the mark is contained of words and it's not a bush as we said, I don't think we are that far apart. The concern is that – I don't think anyone on the call wants to expand rights beyond what they're given under the law. So if you have a disclaimer – and I think that's where we're getting hung up – if the words are disclaimed or partially disclaimed, we have to treat it differently.

I can tell you from the Claims Notice perspective, it's a problem. I'd like to think that I'm pretty savvy person in the world when it comes to this because all of us on the call are probably the elite when it comes to domain registration and understanding this. I got a Claims Notice once when I was trying to register something and I knew exactly what it meant and it's like, "Wow. This is intimidating." I was thinking, gee, if I had no idea what I was doing here, the registration, the rights, it would probably be very chilling

---

to the registrant. So I think we have to be aware of that, the practical impact in effect is that a novice, someone who had no clue what this is about, getting that notice can be very intimidating. It would likely cause the registrant to think twice.

Again, on the edge cases of a cybersquatter who's coming in to really do something improper, the notice doesn't matter anyway. They're going to do what they're going to do. But the party that's not a bad actor and may have a good purpose and a proper use of the name could be intimidated, so I think we have to be very careful with the Claims Notice point.

Forgive me, I'm on audio only so I don't know the numbers offhand, but I'll just speak more generally. To the point of Sunrise, giving that preemptive right is, again, I think something that is expansive in the case where you do not have a word mark. If you do not have those clear rights, I don't agree that we should give you the right to preempt everyone, jump the queue, and preclude others from registering. Everyone has a right to certain registrations and I think we have to just take a measured approach here and look at – if Greg's concern is Michael Stevens, I don't think we'll disagree with that. But I think we probably could get into an area of disagreement if it's just the stylized heavy, heavy design mark. Heavy – it weighs more in terms of design than the word. I think that's a concern that's legitimate and an issue that we should focus on. I do believe the compromise is here and I hope that we can continue to have the dialogue because that's the only way forward. If we're talking then we're making progress, and I don't think we're that far apart. Thank you.

---

KATHY KLEIMAN: Thank you, Jason. Let me read that briefly because I know we have so many people who are on audio.

From Michael Graham to Rebecca: “Agree with explanation of divergent rights of Claims and Sunrise, and with considering different status of Design/Logo marks.”

Scott Austin to Rebecca: “Agree with dominant text in design marks accepted into TMCH.”

I think Paul may still be on Question 8.

Michael Graham pointing out, “Problem with dominant text is who and how to determine weight of textual element in relation to design or stylization?”

Paul Tattersfield: “Demonstration of use for notices would mitigate the concerns perhaps?”

So that brings us to the bottom of the call. We’ve explored for Question #7 the design marks. There are now various new options and ideas on the table. So let’s continue the online and offline discussion that’s taking place and see with great appreciation – because it takes a lot of time to do that – but let’s continue that discussion and see if there are ways of building on the ideas that have been brought forward today for Question #7, and again we’ll circulate something [inaudible] for Question #8. Any last words?

CLAUDIO DIGANGI: Kathy, I’m just going to say I think the same should apply –

---

KATHY KLEIMAN: Very briefly.

CLAUDIO DIGANGI: Yes, very briefly. It's just that the same should apply to Question 8. We should continue discussion on the list. I just want to put a request to the co-Chairs to consider inviting Deloitte to the next call. Thank you.

KATHY KLEIMAN: Okay. Thank you very much. Thanks to everyone for a robust discussion today. Thank you and have a good rest of the week. Take care. Bye-bye.

JULIE BISLAND: Thank you, Kathy. Thanks, everyone. Have a good rest of your day or night. This meeting is adjourned.

**[END OF TRANSCRIPTION]**