

New gTLD Trademark Clearinghouse Sunrise and Trademark Claims Processes Summary of Input from the Implementation Assistance Group

Introduction

ICANN formed an Implementation Recommendation Team (IRT) in March 2009 to develop and propose rights protection mechanisms for the new gTLD program. The IRT, consisting of 18 geographically diverse subject matter experts from the intellectual property arena, made several specific recommendations to enhance trademark protection. One recommendation was the establishment of a Trademark Clearinghouse (see <http://www.icann.org/en/topics/new-gtlds/trademark-clearinghouse-clean-19sep11-en.pdf>) to provide certain services during new gTLD startup processes. As a result, ICANN has specified in the Applicant Guidebook (AGB) that all new gTLD registry operators will offer a Sunrise period and a Trademark Claims service, supported by use of a Trademark Clearinghouse.

In an effort to capture the business requirements for implementing these processes, ICANN received input from the Implementation Assistance Group (IAG)¹ convened to provide advice on these issues from November 2011 to March 2012.

The IAG provided feedback on targeted issues identified and prioritized by staff based upon input received from the ICANN community.² Each priority's position in the Clearinghouse operating process flow is indicated in the appendices, which depict the issues in a process-logic order for Sunrise and Trademark Claims.

This Report describes the information received from the IAG on each of the following topics and provides the background for the draft implementation model of the Trademark Clearinghouse published by ICANN for discussion purposes.

¹ For additional information on the IAG, please refer to the Community Wiki at: <https://community.icann.org/display/cctrdmrkclrnghsiag/Home>, where membership information, mailing list archives, and recordings of meetings are posted.

² Input received from the ICANN community at sessions in Dakar and Singapore can be viewed at: <http://dakar42.icann.org/node/26961> and <http://singapore41.icann.org/node/24629>

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Topics and Issues Discussed

Topic	Issue
P1- Sunrise	Domain Registration Authorization
P2- TM Claims	Responsibility for Registrant Claims Notices
P3- TM Claims	Responsibility for Trademark Holder Registration Notice
P4- Sunrise	Audit/Logging/Compliance Requirements
P5- TM Claims	Responsibility to Perform Trademark Claims Checks
T1- TM Claims	Implementation: Data Locations
T2- TM Claims	Implementation: Data Access
T3- Tech Implementation	Communications Protocols
N1- Authentication/Validation	Authentication Standards
N2- Authentication/Validation	Validation Standard for Proof-of-Use
N3- Dispute Resolution	SDRP Administration
N4- Data Maintenance	Information Accuracy & Update
N5- IDNs	String Comparison and Matching

TMCH Terminology

Authentication: Establishing that trademark information is genuine and that the trademark belongs to the mark holder. All information in the TMCH will be authenticated.

Validation: Establishing proof of use or where the rights are based on statute/treaty or court proceeding. Not all information in the TMCH is expected to be validated. Validation does not occur in every case.

Recording: the process for putting data in the TMCH. The procedure is to add information to the repository.

Authcode: specific term used in inter-registrar transfers. IAG members recommended that if a similar code is used for sunrise processes, that a different term be adopted.

Clearinghouse “registrant” is the trademark rights holder.

Match: Determining whether a particular string is identical or triggers some process to be treated as identical to a mark registered in the TMCH.

Priority: P1 (see Appendix 1)
Issue: Sunrise Domain Registration Authorization

Description: Sunrise eligibility requirements must be met for any domain name registered in the sunrise period. Confirmation that eligibility requirements have been met is called “authorization.” The Sunrise Process should identify where in the process the authorization check(s) will occur.

Business Requirements:

- (1) Maximize efficiency of customer registration experience
- (2) Ensure the process accommodates the use of authorized agents during Sunrise to register new domains
- (3) Minimize impact on registration process flows

Approach	Advantages	Disadvantages
<p>(1) Registrant provides a pre-issued code to evidence authorization</p> <p>The registrant would be provided with an authorization code (“authcode”) as part of the process of registering their trademarks with the clearinghouse and/or confirming sunrise eligibility. The registrant would obtain this authcode in advance from the TMCH. The code is then offered to a registrar by the registrant for validation by the registry or the registrar as part of the sunrise domain registration process.</p> <p>The authcode will be verified as authentic and valid by either the registry or registrar.</p>	<ul style="list-style-type: none"> ▪ Simplifies the domain registration process by reducing the number of queries ▪ Facilitates the ability to use agents to manage domain registration ▪ Accommodates diverse design approaches for location and access to clearinghouse data ▪ Reduces need to transmit live data 	<ul style="list-style-type: none"> ▪ Registrant must keep track of auth codes ▪ Creates risk of authcode forgery, theft, or misappropriation ▪ Authcodes may create a new sunrise challenge stemming from erroneous acceptance or rejection. ▪ There is a cost to the clearinghouse associated with the systems and processes for authcode repudiation and re-issue
<p>(2) Registrar queries the clearinghouse to verify authorization</p> <p>The sunrise registrar(s) would query against the clearinghouse as part of the processing of the registrant’s request and would confirm authorization at that time</p>	<ul style="list-style-type: none"> ▪ Simplifies the registrant experience ▪ Effectively no change of behavior required for registrants 	<ul style="list-style-type: none"> ▪ Requires every participating registrar to implement clearinghouse subsystems ▪ Requires registrars to have query access or a local cache of clearinghouse data and more complicated queries against that data ▪ May not accommodate agent use scenarios where the agent differs from the clearinghouse registration record
<p>(3) Registry queries the clearinghouse to verify authorization</p>	<ul style="list-style-type: none"> ▪ Simplifies the registrant experience ▪ Fewer players impacted: While 	<ul style="list-style-type: none"> ▪ Requires registries to have query access or a local cache of clearinghouse data and more

<p>The registry would query against the clearinghouse as part of the processing the registrar's request to register a domain.</p>	<p>registries must implement changes, avoids technical implementations in large number of registrars</p>	<p>complicated queries against that data</p> <ul style="list-style-type: none">▪ May not accommodate agent use scenarios where the agent differs from the clearinghouse registration record
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IAG P1 Comments

Issuance of a Unique Code

The IAG supported the proposal that the TMCH should use a code to confirm eligibility of a mark holder to participate in sunrise period. This code should be issued by the TMCH.

One Code or Two

The IAG took differing views on whether the code should be unique to each mark or to each mark holder. Some members held the view that adopting a different code for each mark could be burdensome to mark holders. Those with this view suggested that the TMCH issue a unique code to each mark holder, which can be used for any of their marks listed with the TMCH.

Others felt that it was important to associate a specific trademark record to the sunrise period registration, and that it would be difficult to do so if there was no unique code associated with each trademark record. To address this concern, it was suggested that two codes might be passed to the registry—one that referred to the mark holder, and the other that referred to the specific trademark record. However, there was a concern that the process might be too burdensome if there was a requirement to pass two codes instead of one.

Some IAG members felt that it was important for a rights holder to identify which trademark registration the TMCH registrant desires to rely on for the sunrise period if there are more than one trademark records associated with a string. From the perspective of the TMCH, it should not be important which trademark is associated with the domain string—any record should be sufficient. However, trademark holders may have the need to preserve for the record which trademark relied on to support their sunrise registrations. To satisfy this concern, it may be necessary for the TMCH to issue a unique code for each mark.

Significance of the Unique Code

The issuance of the code should not be misconstrued as validating that the name is eligible to be registered, since the registry is ultimately responsible for determine eligibility and there may be additional requirements beyond the baseline requirements that the TMCH addresses. As a result, this code should be named something other than “auth code” to avoid confusion with the term that is used for inter-registrar transfer processes that the registry has confirmed eligibility for registration.

Process to Replace TMCH Codes

The TMCH should incorporate a process for retrieving lost or misplaced TMCH codes as part of its business requirements.

Registry Interaction with the TMCH during Sunrise

It was noted that the registry is contractually responsible for authorization (and there is precedent for registry interaction with clearinghouse-type services). Consequently, with regard to the process flows listed, the registry needs to be able to interface directly with the TMCH (and there is precedent for registry interaction with clearinghouse-type services), since the registries have commitments to ICANN to ensure compliance with the RPM requirements.

Enabling the use of Agents

An additional business requirement for the TMCH is the ability for marks holders to use agents (such as law firms, outside providers, or affiliates of the mark holder) to facilitate managing their interactions with the TMCH. The database should be structured to collect the name of the agent who submitted the records on behalf of the mark holder.

Priority: P4 (see Appendix 1, 2)
Issue: Community Audit/Logging/Compliance Requirements

Description: Complying with best practices and statutes for audit and compliance may require clearinghouse information to be retained or other reporting and audit mechanisms to be implemented. Clearinghouse processes should incorporate the community requirements for retention, publication, and disclosure of clearinghouse information, including audit and logging trails.

Business Requirements*:

- (1) Show effectiveness of TMCH in supporting rights protection mechanisms
- (2) Ensure excellence in technical operations
- (3) Foster productive community interaction
- (4) Identify gaps in policy and inform future discussions about trademark issues
- (5) Prevent misuse and/or abuse of the TMCH mechanisms
- (6) Ensure compliance with applicable statutes and regulations

*There may be other objectives that could become specific requirements. For example:

- 1. Create Transparency
- 2. Accountability and investigation trail to support dispute resolution procedures

IAG P4 Comments

Role of the TMCH

In general, the role of the TMCH should be limited to that of a "fact checker." Any exercise of discretion is likely to be problematic, as this could lead to inconsistent results. Standard procedures need to be established in sufficient detail so as to avoid the exercise of discretion.

In designing the TMCH, it is important to ensure that the TMCH maintains the role of checking existing rights. The TMCH does not have the ability to create trademark rights that do not exist independently of the TMCH.

Reproducibility and Traceability

Logging and audit trails should focus on the collection and documentation of facts to achieve reproducibility and traceability. In the authentication process, reproducibility means that a decision made by the TMCH can be easily reproduced at a later date simply by reviewing the same information used in the original decision.

For the purposes of transparency, the TMCH should announce exactly the specific fields that will be checked, and the specific status values that constitute an "active" trademark in each jurisdiction. This would be useful to authenticate the records, so that there is no surprise to the mark holders.

Having this level of specificity should make it obvious to the auditor that the process was properly followed, and as a result would build trust in the ICANN community in the integrity of the TMCH processes.

Traceability means that the TMCH should be responsible for the collection of proper documentation of external references (sources, effective dates, date/time/identity of authenticator, etc.).

Metrics on the Effectiveness of the TMCH

The IAG suggested that metrics be adopted that measure the lag time from registration to protection.

Data Retention Requirements

The TMCH should maintain logs and data for the length of time necessary to meet the appropriate statute of limitations, which could vary by jurisdiction.

Priority: T1
Issue: Implementation: Data Locations

Description: The clearinghouse is expected to grow into a large database of information about trademarks and authorized contacts. When that information is needed during trademark claims service processing period, where will the data reside? What are the policies surrounding this data?

- Requirements:**
- (1) Avoid introduction of performance impacts that degrade domain name registration SLAs
 - (2) Minimize erroneous decisions introduced by data update delays

Approach	Advantages	Disadvantages
(1) Locate data at clearinghouse only	<ul style="list-style-type: none"> ▪ Maintain maximum confidentiality controls ▪ Only one party responsible and accountable 	<ul style="list-style-type: none"> ▪ Could introduce SLA problems for registries ▪ Could make clearinghouse critical infrastructure for domain registration processes ▪ Requires contingency process if clearinghouse is offline
(2) Distribute clearinghouse data to registries, registrars, or both to minimize performance impacts	<ul style="list-style-type: none"> ▪ Highest performance 	<ul style="list-style-type: none"> ▪ Data synchronization and update delays could introduce errors ▪ Multiple parties are responsible for the confidentiality and integrity of data

IAG T1 Comments:

Misuse of Data

To minimize abuse, distribution of TMCH data should be limited to situations where necessary to implement TMCH functionality. It should also be justified by technical, performance, uptime, availability, and economic factors. At a minimum, there should be sufficient contractual restrictions to provide enforcement capabilities to guard against abuse of the access and information provided through the TMCH.

Specifically, rights holders have expressed concerns related to the aggregation of mark data through the TMCH, which may expose their brand protection strategies or be used to gather competitive intelligence by competitors. If the TMCH database is freely searchable and accessible, it could be possible to identify a rights holder’s gaps in its intellectual property protection strategies. For example, it might be possible to identify jurisdictions in which the rights holder has not registered its trademarks or in which it has not chosen to defensively register domain names. In this regard, this information could be misused by criminals, such as to conduct phishing attacks or other types of social engineering attacks.

In addition, concerns were raised with regard to limiting information submitted in the TMCH that may be valuable to a competitor, especially with regards to a brand-related registry. If it is possible to do extensive searching of the database to compile a list of marks that a mark holder has registered, some IAG members believed that this can reveal the mark holder's brand protection strategy because it shows which marks it believes are more valuable than others. If someone can access all of the countries where a specific brand is registered, this may also create competitive advantage because a competitor might go to the unprotected jurisdiction and register the mark before the mark holder. The TMCH should not allow extensive searching to be done in a manner where a trademark holder's entire portfolio could be easily accessed. Accordingly, the TMCH should be structured to address how to minimize data mining by a registry of a competitor's trademark registration patterns.

Recommendation to Deploy Technological Measures to Minimize Abuse

In order to minimize abuse, the TMCH should restrict access to the data wherever possible. The TMCH should apply varying levels of technological and contractual restrictions depending upon the type of data accessed and the sensitivity of the data.

For example, a lookup string service (identifies whether a string matches a record in the clearinghouse) should strive to achieve 100% availability and very high performance. This may be the only aspect of the data that may need to be replicated or cached at alternative data locations, such as at a registry or registrar's location.

With regard to data associated with the trademark claims service, it is believed that this information generally has more sensitive information, and may raise privacy concerns. From the registry or registrar perspective, there may be fewer performance requirements necessary for querying trademarks claims data, because this information is not required to sustain real-time registrations.

Specific Technological Measures Considered

The IAG explored whether authorization tokens (with strong cryptography) should be used for authentication. Some expressed concerns that if the TMCH's technology is too complicated to use, the end result may be that marks holders may not take advantage of the TMCH. However, most IAG members felt that the use of public/private keys would not be too burdensome, and could be used by the TMCH to validate the request. The token is viewed as a way to save steps in verifying information.

In addition, the TMCH could be required to implement technology to limit the likelihood of mining, such as rate limiting look-ups in the TMCH.

Issues Raised by Allowing Registries to Access Copies of Trademark Strings

The IAG explored the circumstances under which registries could be allowed to locally save or cache trademark strings (marks & variations) for lookup services. Specifically, the IAG evaluated how often these caches should be synchronized. The IAG suggested that the TMCH be modeled after the DNS system, where there would be created a registry similar to "zone files" where there is a time to live (TTL), and the TMCH would be responsible for updating within a certain time (i.e., hours).

Many IAG members acknowledged that DNS may be an appropriate method of distributing trademark strings (for lookup), leveraging TTL and refresh implementations. The information in

the zone files would be generally publicly available, but should not raise privacy concerns since it is a limited file consisting of just the strings in the TMCH and their variations. No information pertaining to the mark holder would be included in the zone files.

It was recommended that if local copies/caching were permitted, there would need to be additional work conducted to identify appropriate refresh and retention policies and requirements, including the minimum periodic updates. Some IAG members felt that, at a minimum, a refresh of this data should occur daily.

Contractual Restrictions Recommended

Some IAG members believed that exposure of content from the trademark claims notice as specified in the AGB may expose information that mark holders may have concerns about. In order to address these concerns, the IAG suggested that the applicable contracts (such as the RAA, RRA, or Registry agreements with the TMCH) include confidentiality provisions to protect the information obtained through the TMCH. The IAG also noted the importance of having robust enforcement of these contractual commitments.

Opt-Out of Trademark Claims Service

It was suggested that if a mark holder is concerned about the distribution of data relating to the trademark claims, it could have the right to opt-out of the sending of notices to potential registrants. In such instances, the mark holder would only be taking advantage of the sunrise registrations, and could voluntarily elect not to receive the benefit of trademark claims notices.

Physical Access to Locally Available Copies of the Data

It was suggested that the TMCH could be designed to have data located in various diverse places to maintain access and speed. This “remoteness” should not necessarily cause issues if the data is maintained in a secure/encrypted format. For example, copies of data could be in equipment controlled by the TMCH in a database that is adjacent to the data center of a registry so that the registry could have the level of performance it desires, provided that the TMCH utilize proper security/encryption protections to minimize abuse and data mining.

Need for Access by Registries/Registrars

Registries and Registrars have raised concerns regarding being required to use a solution where there may be insufficient amounts of data provided to ensure appropriate uptime/performance. Inability to access the required information may affect the success of the domain registration business. As a result, registries and registrars are seeking to avoid having a single point of failure in the TMCH operator for new gTLD launch.

Specifically, Registrars and Registries need access to TMCH information as follows:

- In connection performing with domain availability checks.
- Registrars need to be able to present the trademark claims notice as specified in the Applicant Guidebook. The information in the trademark claims notice should be freely available, and generally unrestricted. Or in the alternative, the TMCH could serve up the trademark notice itself directly to the registrant through some API or something similar.
- Registries need to be able to confirm that the registrant’s trademark data is verified and correct.

- For sunrise periods, the transactions do not need to be real-time because the registries could take the applications during the sunrise period and then validate when the sunrise period is closed

Expected Data Transactions Between the TMCH and Third Parties

The IAG explored and identified the external data transactions that the TMCH is expected to conduct. These include:

- Agent/Submitter registration with the TMCH
- Submit for listing or edit a mark in the TMCH
- Sunrise domain name eligibility check
- Determining that a claims notice is required
- Generating claims notices
- Presenting claims notices
- Capturing claims acknowledgement
- Notifying rights holders of matching domain registration

Priority: T2 (see Appendix 1, 2)
Issue: Implementation: Data Access

Description: In order to meet statutory and regulatory obligations, which data can be shared by the TMCH with registries, registrars and/or the public as part of the clearinghouse transaction? What implementation constraints should be incorporated into the clearinghouse design in order to ensure that community requirements on access restrictions are taken into account?

- Requirements:**
- (1) Limit information to a Need to Know basis
 - (2) Minimize performance impacts on the registration process
 - (3) Use of industry best practices for data encryption and protection
 - (4) A clear industry standard for how clearinghouse data is used

The following draft data classification table illustrates how requirements could be captured:

Data Use	Description			
Internal	Information is not published or distributed except as required by court orders			
Public	Information may be published or distributed without restriction			
Partner	Distribution is limited to specific parties. Clear text is available to recipients			
Restricted	Distribution is limited to specific parties. Clear text is not available to recipients			
Class of data	Internal	Public	Partner	Restricted
Trademarks (includes jurisdiction, class, and documentation)				
Mark Holder or Agent Contact Information				
Strings Potentially Registerable as Domain Names				
Domain Registrant Contact Information				
Authentication and Validation History				
Transactional Information				

IAG Comments:

Methods of classifying data, propose access controls

In exploring methods of identifying appropriate access controls, the TMCH vendor should be provided with a list of the possible classes of data to be held by the TMCH. The following classes were identified:

- Trademark strings potentially registrable as domain names
- Authentication credentials (username/passwords, Sunrise Authentication codes or tokens)
- Trademark data, including jurisdiction, class, registered owner
- Supporting documentation submitted by mark holders or used by the TMCH to verify rights
- Mark holder or agent contact information
- Domain registrant contact information
- Authentication and Validation history
- Transactional information—payment
- Sunrise and trademark claims history for a particular record
- History of internal users and what they did in the TMCH database so that there is a full traceability of actions conducted with respect to records in the TMCH
- Data having to do with ancillary services or other specialized registry processes that the TMCH may be involved in
- Matching Rules for IDNs, and procedural rule sets that needs to be disclosed, would probably need to be public and easily available
- Other IP Rights (other than trademarks), since then TMCH envisages dealing with other types of intellectual property, possibly copyrights, geographic designations. If so, the text strings deriving from this type of intellectual property, as well as other data specific to these other intellectual property rights.
- Information & metrics to be used to generate reports for ICANN policy or compliance purposes

Identifying Parties that may need access to the TMCH Data

In exploring methods of identifying appropriate access controls, the TMCH vendor should be provided with a list of the possible parties that may need to access the data to be held by the TMCH. The following parties were identified:

- Mark holders and their agents
- Registries
- Registrars
- Domain name applicants and registrants
- General public
- Interested members of the ICANN community for policy purposes or to evaluate how effective the TMCH is addressing the needs it was designed to meet
- Potential dispute providers
- Internal users- validators and others doing the work. There will be data processing agents of some description

In addition these parties may be further classified as:

- Partner- refers to those parties that have general restrictions on use, more likely contractual & not technological limitations.

- Restricted could be a subset of partner with more restrictions, such as technological limitations (i.e., a interface is needed to access it).

The IAG further evaluated how access controls need to be applied for each of these parties. For example, where it is noted that there may be access “without restriction,” many IAG members noted that there are concerns with the concept of “unlimited” access. There should be ways to limit use for those that are designated to have unrestricted access, such as through acceptable use clauses, contract terms, and rate limiting.

Identifying Appropriate Data Flow Models for Sunrise Services

In order to determine the access restrictions for sunrise services, it is important to identify the transactions that are expected to take place. The IAG explored whether the domain registrant needs to provide its trademark information to the registry or whether it should just provide the basic domain information only. Two methods were suggested for the data flow- (1) post application validation, where the trademark data is submitted by the registrar and submitted to the registry and then validated some time afterwards, or (2) post validation application model, where validation occurs prior to application, and then somehow it gets transmitted to the registry.

From the registry/registrar perspective, the better approach is the post validation application model. In building this model, ICANN should keep in mind that there may be specific registry related additional requirements beyond the basic trademark information, so it is important to also define the method of submitting this additional information. This could be done separately or through the TMCH.

Education of the Registrars/Registries of the Sunrise Model

It was recommended that extensive education be conducted by the TMCH so that the registrars/registries understand what to expect.

TMCH External Transactions

The following external transactions were identified:

- Create Agent/Submitter record with the TMCH
- Submit for listing or edit a trademark record in the TMCH
- Renewals of records
- Sunrise domain name eligibility check
- Determining that a claims notice is required-
 - The IAG notes that this needs to be captured and recorded to determine if data mining is occurring
- Generating claims notices
- Presenting claims notices
- Capturing claims acknowledgement-
 - One IAG member suggested that the TMCH could capture if the registration was abandoned
- Notifying rights holders of matching domain registration
- Request to produce history/audit trails

Priority:
Issue:

T3 (see Appendix 1, 2)
Implementation: Communication Protocols

Description:

Protocol-level changes may be required to support specific clearinghouse models and functionality. For example:

- Querying TM Claimant Contact Information
- Receiving Domain Name Registrant Contact Information
- Receiving Notice Event Information
- Receiving Trademark Validation Status
- Receiving Registration Status Information

While it is expected that registrar-registry communications will continue to use EPP, this may require extensions to convey the additional information needed for Sunrise and Trademark Claims processes. The protocol(s) used to implement these data exchanges between the clearinghouse and registries or registrars are also a necessary decision point in designing the architecture.

Requirements:

(1) Minimize the cost and impact of implementation on the existing framework and infrastructure of the domain name registration system wherever possible.

Approach	Advantages	Disadvantages
(1) Use EPP	<ul style="list-style-type: none">▪ EPP is already used in registrars and registries▪ EPP is designed for the "provisioning and management of objects stored in a shared central repository" – such as a trademark database▪ The protocol definition already includes guidelines for extending EPP, which would help to shape the technical discussions	<ul style="list-style-type: none">▪ Once the protocol is extended, each registry or registrar that requires these extensions still must implement them.▪ The use of EPP may not necessarily be more cost effective to implement than the development and implementation of a different protocol
(2) Use EPP and other Protocol(s)	<ul style="list-style-type: none">▪ Some required clearinghouse exchanges may fall neatly within other protocols and thus could leverage prior public implementation work in those protocols	<ul style="list-style-type: none">▪ Some of the problems EPP has already addressed may include issues that will need to be solved for other protocols. This may result in some "re-inventing the wheel" in terms of protocol design and implementation effort

SUNRISE DATA PROTOCOLS

Sunrise Transaction	Protocol	Send	Receive
Check domain name availability	EPP <check>	Registrar	Registry
Add a domain name	EPP <create>	Registrar	Registry
Perform a TMCH lookup of a domain name and auth code	EPP <check>	Registry	TMCH
Notification of a new domain name registration	EPP <create>	Registry	TMCH
Notification of a new domain name registration	EPP <response>	Registry	Registrar
Transmit notice of sunrise registration	TMCH-defined	TMCH	Mark holder

CLAIMS DATA PROTOCOLS³

Claims Transaction	Protocol	Send	Receive
Check domain name availability	EPP <check>	Registrar	Registry
Check for claims on a requested domain name	DNS	Registrar*	TMCH
Obtain trademark claims notice text and content	EPP <info+>	Registrar*	TMCH
Present trademark claims notice	Registrar UI	Registrar	Applicant
Capture acknowledgement of claims notice	Registrar UI	Applicant	Registrar
Communicate acknowledgement to TMCH	EPP <update+>	Registrar	TMCH*
Registrar registration process	Registrar UI	Registrar	Applicant
Add domain name	EPP <create>	Registrar	Registry
Confirm acknowledgement of claims notice	EPP <check>	Registry*	TMCH*
Notification of new domain registration	EPP <create>	Registry	TMCH
Notification of new domain registration	EPP <response>	Registry	Registrar
Transmission of trademark claims watch notice	TMCH-defined	TMCH	Mark holder

³* signifies that the party identified could change

IAG T3 Comments

Evaluation of Protocols

The IAG considered various protocols:

- EPP for notifications of domain creation
- WHOIS for lookups of domain registrant information
- DNS for lookup strings
- HTTP GET for claims notice data for potential domain registrants
- SMTP for claims notice data to mark holders

Several IAG members noted that ICANN should also consider protocols for delivering or communicating or tokens in a secure manner. There was consensus that EPP should be used for all communications between registrar/registries, since there is no need to create new protocols. EPP is known by all registrars/registries.

Several IAG members agreed with the suggestion to utilize a zone file model, with no identifying information with trademarks associated with it, as this could minimize abuse scenarios. If the zone file approach was adopted, there would be the need to address the latency issue (time between updates), which was generally believed to be manageable. The requirement could be to update the zone files periodically, consistent with what is currently applicable to new gTLDs.

For sunrise transactions, the IAG supported either the use of EPP or HTTP/XML for the clearinghouse lookup and authorization confirmation services, and EPP for notification of registrations.

Other Critical Communications

ICANN should consider the appropriate communication protocol for the distribution of tokens, in the event tokens were to be adopted by the TMCH.

Communication Channels for Trademark Claims Service

The IAG considered various types of communications to be expected in connection with the trademarks claims service. With regard to interactions with the TMCH, it was pointed out that there are service providers, some of them being registrars, that will be facilitating delivery of information to the TMCH. This activity would be separate from their role as a registrar.

For regular communications pertaining to registrar activity, it is envisioned that most communications would be expected to go through the registrar to the registry to the TMCH. There is the notion that for any communications involving the registrant, it is recommended that the registrar be making that communication. Application of the principle of “closeness” suggests that the registry should generally communicate with the TMCH, and the registrar should generally communicate with the registrants.

With regard to the second notice (a notice that a registration was made), this communication to the rights holder should be made in a method where one could prove that the notice was actually made. It was noted that the registry would need to have access to this information to ensure it has been properly done.

It was suggested that ICANN prepare two distinct flow-charts to map the proposed data flow for comparison purposes, displaying one model where all of the information flows through the registry, and a separate model where all the information flows through registrars, to see if one model is more efficient than the other.

Preventing Gaming and Preserving First Come-First Served Principle in Registrations during Trademark Claims

When checking availability of domain names, there is generally no hold placed on the domain name registration. Applying this principle to the lookup of strings in the TMCH, the IAG explored whether there is a way to use PENDING CREATE command so that there is no gaming to deny registrations. The suggestion was made that the registrar not send a DOMAIN CREATE command until after it has captured acknowledgement to trademark claims notice.

Further analysis is suggested to ensure that the rules do not place the TMCH in the middle of the registration process and cause delays in domain name registrations.

Priority: P2 (see Appendix 2)
Issue: Responsibility for Registrant Claims Notice

Description: The trademark claims service requires a registrant to be notified (prior to completing domain name registration) that a claim has been asserted for a colliding string associated with one or more marks registered in the clearinghouse. This notice allows the registrant to decide whether or not to proceed with the registration. The party responsible for transmitting these notices to the applicable recipient, and the data points contained in the notice, must be defined as part of completing the model.

Business Requirements: (1) Notifications should be sent by a party that the registrant has an existing relationship with.
 (2) Transmission of notices must be verifiable.

Approach	Advantages	Disadvantages
(1) Registrar provides trademark claims notices to domain registrants	<ul style="list-style-type: none"> ▪ Communication with known party follows existing relationship 	<ul style="list-style-type: none"> ▪ Requires implementation at every participating registrar ▪ May require EPP protocol enhancements ▪ Registrar must have access to mark holder contact information ▪ Difficult for clearinghouse or registry to verify that notice was sent
(2) Registry provides trademark claims notices to domain registrants	<ul style="list-style-type: none"> ▪ Less work for the registry to verify that claims notices are sent to registrant 	<ul style="list-style-type: none"> ▪ Difficult for clearinghouse to verify that notice was sent ▪ Registrant communication with a possibly unknown or unfamiliar party ▪ Registry must have access to mark holder contact information
(3) Clearinghouse provides trademark claims notices to domain registrants	<ul style="list-style-type: none"> ▪ Implementation primarily required with the clearinghouse (limited registrar to clearinghouse transmission implementation required) ▪ Straightforward to demonstrate claims notices were transmitted ▪ Reduces need for transmission of clearinghouse data 	<ul style="list-style-type: none"> ▪ Registrant communication with an unknown or at least unfamiliar party ▪ Clearinghouse must be informed that trademark claims notice is required ▪ Clearinghouse must receive domain name registrant information

IAG P2 Comments:

Linkage of Notices

There should be a linkage between the entity that sends the notice, the form of the notice itself, and the form of the lookup service (whether or not it is real-time).

Discussion of whether the Registry or Registrar should send Notice

Regardless of which party (registrar/registry) sends the notice, the acceptance event must be captured. The content of the notice could be hosted by either the registry or the clearinghouse.

The IAG supported the view that the registrar is the most appropriate entity to present the trademark claims notice to a registrant, because it has the primary relationship with the registrant.

Recognizing that registries are contractually obligated to meet SLA uptime requirements, there was support for the principle that the trademark claims check service should support real-time processes. It was suggested that the TMCH should have similar contractual obligations with respect to SLA uptime requirements to those that apply to registries.

The trademark claims process must be flexible to accommodate multiple registry approaches.

Verification of Transmission of Notices

The responsible parties (registries) need to ensure that the notices are being provided and the registrant is actually seeing the notice before they decide to proceed with the registration. Since this might be a compliance issue that ICANN may choose to audit, the record keeping aspect of this function is important. It was suggested that the notice could be forwarded after transmission to the registrant as an additional step that could be used to verify that the notices were in fact transmitted for the specific domain name.

Determining the Content of Trademark Claims Notices

There may not be a need for registrars to access the rights holder's contact information.

The IAG suggested that the TMCH could generate the content of the claims notice for the registrar to present the trademark claims notice. This would result in standardization of notices, and facilitate compliance with the requirements.

Real-Time v. Time Shifted Models

The IAG discussed whether the TMCH should adopt real-time or time-shifted look-up models, such as instances where the domain registration is pending until a TMCH lookup is complete. In sunrise registrations, it was noted that there could be non-real time transactions, depending upon on the registry's business model.

Priority:

P3 (see Appendix 2)

Issue:

Responsibility for Trademark Holder Registration Notice

Description:

After domain name registration has occurred within the period specified for the trademark claims service, a notification is to be sent to mark holders when the string that has been registered in a TLD collides with a mark registered in the clearinghouse. The party responsible for transmitting these notices to the applicable recipient must be defined as part of completing the model.

Business

Requirements:

- (1) Notifications should be sent by a party that the customer has an existing relationship with.
- (2) Transmission of notices must be verifiable

Approach	Advantages	Disadvantages
(1) Registry provides trademark claims notice to mark holder	<ul style="list-style-type: none">▪ Provides opportunity for registry to demonstrate compliance with contractual obligations▪ Avoids registrar and clearinghouse implementation of mark holder notification	<ul style="list-style-type: none">▪ Mark holder receipt of communication from an unknown or unfamiliar party▪ Registry must receive mark holder info▪ Difficult for the clearinghouse to verify that notice was sent
(2) Registrar provides trademark claims notice to mark holder	<ul style="list-style-type: none">▪ Registrar has the registrant contact info▪ Avoids registry and clearinghouse implementation of mark holder notification functions	<ul style="list-style-type: none">▪ Mark holder receipt of communication from an unknown or unfamiliar party▪ Registrar must receive mark holder info▪ Difficult for the registry or clearinghouse to verify that notice was sent▪ All participating registrars must implement notice function
(3) Clearinghouse provides trademark claims notices to mark holder	<ul style="list-style-type: none">▪ Clearinghouse has contact info for all existing mark holders▪ Clearinghouse has the business relationship with mark holder▪ Implementation primarily required by clearinghouse (implementing transmission of events occurring in the registry or registrar is still required)▪ Clearinghouse can reliably verify that claims notices were transmitted	<ul style="list-style-type: none">▪ Clearinghouse must receive notification that domain registration occurred▪ May require implementation to ensure the registry can verify that notice was sent

IAG P3 Comments:

Appropriate Party to Send Registration Notices

The IAG supported the principle that the TMCH is most appropriate to send claims notices to rights holders.

Concern that Notices will be Filtered as Spam

The IAG considered how to minimize risk that the registration notices could be treated as e-mail spam. Standardizing notice text, subject lines, etc. may increase probability they will go through, not only for mark holder notices, but also potential registrant notices. This is seen as a way to minimize the risk that the notices will be filtered out as e-mail spam.

Scenarios for Possible Abuse of Rights Holder Data

The IAG explored the possible scenarios for misuse and/or abuse of clearinghouse data that are not possible through other commercial or public sources today, including:

- Concerns that the centralized aspect of the info could lead to scams, like the “dear CEO” letter scams
- Concerns about solicitation of unnecessary services
- Concerns about competitive intelligence regarding the competitor’s brand protection strategies.
- Concerns about misuse of registrant information, and the possibility of a chilling effect.
 - There is the possibility of a rights holder to use the information to harass the registrants if that information is available, even though the registrants may have legitimate reason to use the domain names.
- Concerns about mining the data to blackmail the holder to identify gaps in registrations and beating the mark holder to the registration in other countries.

Information to be included in the Notice to the Mark Holder

It was noted that the content of the notice to mark holders has not previously been addressed. It was suggested that the information be limited to what is in the zone file- i.e. the name, registrar, and the DNS servers. The IAG observed that the TMCH should not conduct WHOIS lookups to identify the name of the registrants.

Timing of the Notice to the Rights Holder

In evaluating the appropriate time to send notice to the rights holder, the IAG noted that it would depend upon how often the TMCH would be able to download the zone files to see what domain names were actually registered. The data should be passed in another method if the notice is to be generated more frequently than every 24 hours. For example, the TMCH could receive a notice from the registry that the registration was successful.

One IAG member expressed the concern that waiting 24 hours may be too long in the instances of online fraud/abuse. It was suggested that ICANN should explore whether there could be some type of registry interface that could support the earlier transmission of registration information.

The IAG considered whether the notice should be triggered when the name goes live. It was noted that doing so may introduce complexities because that would require someone to watch for when the DNS servers are activated.

Deletions during the Add/Grace Period

The IAG discussed the possibility that a registrar's deletion percentages during the add/grace period could go up as a result of the timing of the notices. If so, exemptions to this policy may need to be considered.

Priority: N1
Issue: Authentication Standards

Description: The Trademark Clearinghouse is a central repository for information to be authenticated, stored, and disseminated, pertaining to the rights of trademark holders. One of the core functions of the Clearinghouse will be authentication of the data to be included.

The authentication criteria should be: (1) clearly specified; (2) made available prior to the submission of data by rights holders; and (3) subject to review from time to time to be sure that they support the goals of efficiency and accuracy in the process.

- Business Requirements:**
- (1) Create a workable, efficient authentication process for trademark data
 - (2) Establish well-defined roles for Clearinghouse administrators and reviewers
 - (3) Establish a standard that is globally accessible
 - (4) Establish a standard that produces consistent, predictable results
 - (5) Avoid unfair prejudice in favor of or against any particular type of rights holder

Authentication Process Elements

A clear standard that provides notice of what does and does not constitute adequate supporting information for a Clearinghouse record should support the authentication process. A preliminary set of recommended requirements are described in this document for discussion.

To facilitate prompt authentication reviews, the process should not facilitate ongoing dialogues between submitters and the Clearinghouse. If a record is not capable of authentication as submitted it should generally be rejected without any prejudice toward resubmission of the data. However, some notice as to the basis for the deficiency should be provided in every case so that the same mistake is not made multiple times.

Review steps to be taken by the Clearinghouse could include the following:

1. Name of the Submitter – Where the name of the submitter matches the name associated with the registration of the trademark in the issuing jurisdiction, verification of the names can be a simple and straightforward process. Where issues are expected to arise is in cases where the submission is made by party A and the record shows party B. In such cases, evidence of authorization for the submission by party A will have to be established. The steps required could vary depending on whether it is an individual or a company that is submitting the record. The objective is to ensure that the entity asserting the rights is authorized by the rights holder to exercise those rights.
2. Contact information – The ability to communicate with the submitter through electronic means is of primary concern. At a minimum, a mechanism should be employed whereby the Clearinghouse can transmit information to the electronic contact provided, such that the contact would have to respond within a fixed period of time to confirm the accuracy of the address. Additional contact verification steps could be added as needed.
3. Declaration – This would consist of a sworn statement that the information submitted is true and current and has not been supplied for an improper purpose.
4. Registration Numbers (for registered trademarks) – Registration numbers submitted to the Clearinghouse must match the numbers identified on records in the issuing jurisdiction. Such data can be confirmed by resort to the issuing office. Some jurisdictions have such data available online. For those that do not, contact will be made by the Clearinghouse to confirm the accuracy of the data. However, a principle of equitable treatment should be adopted here. The steps required of similarly situated mark holders should be essentially the same regardless of whether the relevant jurisdiction makes data available in an online database.
5. Statute/treaty information – The Clearinghouse would also perform confirmation of the treaty or statute for those marks that identify a treaty or statute as the basis of submission. In such cases, submitters will need to properly identify the relevant instruments and provide a copy of the relevant language, as well as the date of the treaty or effective date of the statute. In some cases, the Clearinghouse will be able to refer to existing data sources (e.g., <http://treaties.un.org/Home.aspx>) for confirmation of the information submitted. If the statute or treaty is not properly identified, it should not be up to the Clearinghouse to find the right authority. Nor should it be up to the Clearinghouse to interpret a statute or treaty; it must appear on the face of the authority claimed as a basis, that it confers the rights.

6. Court proceedings – As above, if the submitter is relying upon a court order to establish rights, it should appear on the face of the materials submitted that a court conferred such rights, i.e., the documentation should indicate that the relevant party has rights to <mark> for <class of goods or services>. Further, there should be evidence that the court has entered the order or judgment. A simple court document or pleading without evidence that a Court approved, adopted or entered the order or judgment should not be sufficient. Legal interpretation cannot be the basis for the submission. The Clearinghouse would verify that the court existed as of the date of the order or judgment and that the order has the indicia of authenticity (i.e., it is signed by a judicial officer, it names the parties that were the subject of the proceedings, it confers a grant of rights). The authentication process will not be an inquiry into the underlying legal basis for a court proceeding.

IAG N1 Comments:

Minimal Initial Verification Suggested

Some IAG members suggested that the TMCH conduct a minimal level of verification initially, when the trademark information is submitted. This initial level of up-front verification work could consist of a declaration /registration certificate and email contact info. Doing so would effectively shift the verification burden to take place during the sunrise period. Verification of authorization would then occur during the sunrise period, by more qualified personnel. It was suggested that verification of ownership / address data should be required for sunrise authorizations.

Identifying the Appropriate Registrant in Sunrise Periods

The IAG explored the question of who may be the registrant during the sunrise period. If the only person or entity eligible for a registration is the actual rights holder, it may not be necessary to authenticate how the information was input into the TMCH. However, if someone other than the trademark holder is allowed to do the registration, then it becomes more important to incorporate a second level of authentication, either by the TMCH or some other sunrise operator.

Licenses or Assignments by the Rights Holder

If it is possible to authorize someone other than the rights holder to register the domain name, the TMCH will need to design a process to account for this possibility. Some IAG members believe that it may be necessary to have assignments or licenses recorded in the applicable government trademark registry in order to have the right to register names. Otherwise, it is unclear how others would have knowledge of the license or assignment.

The burden on the TMCH may be greater if it is required to review documentation (such as licenses or assignment documents) from the rights holder beyond what is listed in the appropriate trademark database.

Imposing Strict Penalties on Fraudulent Submissions

The IAG recommended imposing strict penalties on fraudulent submissions, to include banning from the clearinghouse and reporting to law enforcement. Removal of data from the TMCH could also be evaluated as a possible remedy for fraudulent submissions.

Quality Control Suggestions for Verification

The TMCH should maintain copies of all materials used in verification to be able to reconstruct the decision to create a clearinghouse record.

In addition, the TMCH should be required to use highly qualified personnel in the authentication process, to include attorneys, paralegals, and former examiners from government agencies.

Comparison between the Authoritative Sources and Submitted Trademark Data

The IAG considered how to treat word marks versus picture marks or device marks. This issue is relevant in determining how close of a connection there needs to be to allow for submission in the TMCH.

Priority: N2
Issue: Validation Standard for Proof of Use

Description: A trademark holder must demonstrate use of a trademark to establish eligibility to participate in sunrise registrations.

The Applicant Guidebook provides that: *For validation of marks by the Clearinghouse that were not protected via a court, statute or treaty, the mark holder shall be required to provide evidence of use of the mark in connection with the bona fide offering for sale of goods or services prior to application for inclusion in the Clearinghouse. Acceptable evidence of use will be a signed declaration and a single specimen of current use, which might consist of labels, tags, containers, advertising, brochures, screen shots, or something else that evidences current use.*

Additional guidance is required to define the process followed by the Clearinghouse in examining and accepting the evidence of use presented.

Business Requirements:

- (1) Protect the existing legal rights of registered mark holders
- (2) Limit creation of new requirements affecting trademark holders
- (3) Ensure financial and operational feasibility
- (4) Avoid imposing a role for the clearinghouse that is inconsistent with the role agreed upon by the community
- (5) Establish a standard that is globally accessible
- (6) Avoid unfair prejudice in favor of or against any particular TM holder

Proof of Use Elements

A single standard should be applicable across all jurisdictions, to avoid confusion and to provide service to users across the globe. A process that minimizes subjective reviews by the Clearinghouse will serve this goal and will also help to minimize the costs for Clearinghouse users. A preliminary framework for proof of use validation is described in this document for discussion:

Declaration:

This declaration would only be relevant in the event that a submitter requests validation by the Clearinghouse for proof of use. While all parties submitting records into the Clearinghouse will make a declaration concerning the data submitted, a declaration specifically concerning the proof of use documentation will be made. This could take the form of the following:

The [Trademark Holder/Representative/Licensee/Agent] hereby certifies that the information submitted to the Clearinghouse, is, to the best of [Trademark Holder/Representative/Licensee/Agent's] knowledge complete and accurate, that the trademarks set forth in this submission are currently in use in the manner set forth in the accompanying specimen; that this information is not being presented for any improper purpose; and that if, at any time, the information contained in this submission is no longer accurate, the [Trademark Holder/Representative/Licensee/Agent] will notify the Clearinghouse within a reasonable time of that information which is no longer accurate, and to the extent necessary, provide that additional information necessary for the submission to be accurate. Furthermore, if any Clearinghouse-validated mark subsequently becomes abandoned by the holder, the holder will notify the Clearinghouse within a reasonable time that the mark has been abandoned.

The declaration can be built around check-boxes so that users have the appropriate flexibility according to the party completing the form; however, the substance of the declaration must be completed in all cases.

Sample/Specimen of Use:

The baseline standard is intended to be flexible to accommodate practices from multiple jurisdictions. The specimen should be something *that evidences an effort on behalf of the holder to communicate to a consumer so that the consumer can distinguish, without the possibility of confusion, the products or services of one from those of another.*

Examples of such evidence would include:

- Labels
- Tags
- Containers
- Marketing materials
- Advertising
- Brochures
- Screen shots

Given the need for flexibility, other evidence that could be considered includes:

- Applications for business licenses that include the mark as part of the business name
- Letterhead
- Licenses to use the mark in question
- Catalogs
- Manuals
- Displays
- Pamphlets
- Infomercial/video presentation excerpts
- Electronic display

- Press release
- Business cards
- Social media marketing materials

Mere inclusion of a mark in a domain name should not constitute use, nor should email messages or blog postings.

IAG N2 Comments:

Form of Specimens Submitted

The IAG suggested that submission of digital photographs should be an acceptable method of submitting samples or proof of use.

Language of Specimens

One IAG member suggested that the TMCH clarify whether the specimen needs to be in the language that the trademark is awarded.

Length of Validity of Specimens

The IAG suggested that specimens for proof of use be valid for a period of 3-5 years. However, one IAG member disagreed, and suggested that the verification be “current” use at the time of the sunrise period, not when submitted to the TMCH.

It was noted that samples (e.g., labels) often do not have any dates associated with them. As a result, the TMCH may need to require use of an affidavit or declaration as evidence that the specimen is in use as of the date of submission to the TMCH.

Form of Declaration of Use

The TMCH should adopt a standard form for the Declaration of Use rather than risk receiving different formats. A globally-relevant validation standard should be adopted that simply requires a declaration and sample that “shows the mark in a bona fide promotion or offering of goods or services covered by the registration.” The sample or specimen should match the goods and services being provided.

Variations of Trademarks

If the original registration includes insignificant generic words or phrases, minor variations between the proof of use and the trademarks should be allowed. The TMCH rule could be to allow non-material variation in the specification standard. This is something that is acceptable in the United States, for example.

Revalidation of Use Process

Some IAG members believe that re-validation of use should occur annually or bi-annually or when trademark registration lapses with the national authority. If revalidation fails, there should be no retroactive effect, so that existing registrations that were registered during sunrise period would still be valid, but the rights holder would not have the ability to register new names during sunrises until re-validated.

One IAG member suggested that the Proof of Use could be revalidated when the underlying trademark registration is renewed and a new expiration date is provided to the TMC.

Rather than creating a system to require revalidating use, one IAG member suggested creation of a complaint system to challenge a sunrise registration for lack of use. It may be onerous to require, for example, revalidation of proof of use on an annual basis.

Priority: P5 (see Appendix 2)
Issue: Responsibility to Perform Trademark Claims Checks

Description: For at least the first 60 days of general registration, trademark claims service must be in place in all new gTLDs. Claims service includes a query against the TMCH and – in the event of a collision with a registered string in the clearinghouse a notification must be sent. This notice includes information about each mark where there was a match. The party responsible for performing the claims check for the requested domain name must be defined as part of completing the model.

Performing this check early in the domain name registration process provides more opportunity for domain registrants to ensure that their registrations are clear of intellectual property encumbrances or to perform risk analysis prior to committing to a course of action.

Business Requirements:

- (1) Contain the implementation cost/complexity
- (2) Prevent degradation of the integrity, reliability, and performance of the existing domain name registration process
- (3) Ensure notices are sent accurately and in a timely manner

Approach	Advantages	Disadvantages
(1) Registry performs check	<ul style="list-style-type: none"> ▪ Registrars do not need to implement this functionality 	<ul style="list-style-type: none"> ▪ May require an EPP feature such as PENDING CREATE to implement. ▪ May require extensions to EPP to implement ▪ Registry SLA becomes dependent on TMCH SLA ▪ Varying registry implementations may add complexity for registrars
(2) Registrar performs check	<ul style="list-style-type: none"> ▪ Query takes place at point closest to domain name registration 	<ul style="list-style-type: none"> ▪ Potentially complicated to implement ▪ May require EPP extensions

IAG P5 Comments:

Registrar as the Appropriate Party to Conduct Claims Checks

The IAG supported the view that the Registrar is the most appropriate place to check for claims. Designating the Registrar as the party to perform the check is justified by enhancing speed of process, and limiting distribution of data to unnecessary parties. The TMCH would need to clarify where this check would be made, whether by looking to the registry, the TMCH, or by use of a cached copy of the TMCH database.

Registrar Liability for Completing Checks

The IAG noted that the RAA may need to be amended to have Registrars assume liability for having the checks done—the registry should not have liability if it is not involved in the check process and the registrar is required to perform that function. This would enhance the speed of process, and limit distribution of data to unnecessary parties.

However, noting that a registry's brand may be affected if the registrars don't handle the claims properly, registries may be concerned if this responsibility is moved to the registrars. To address this concern, SLA and other performance requirements could be imposed on registrars if they are assigned responsibility for completing these checks.

Quality Control Issues if Registrars Complete Checks

The IAG discussed whether there is a way to guarantee a consistent process for all registrars all over the world. It was suggested that designing an interface to make it easy for registrars to do this may help establish accountability, and ensure that the service works the way it was intended.

Confidentiality Requirements on Registrars

If Registrars complete the checks, confidentiality requirements on registrar's part should be imposed so that this data cannot be used for improper purposes.

Priority: N3
Issue: Dispute Resolution

Description: Disputes of various types may arise during the operation of the Trademark Clearinghouse. Processes should be in place to address these in a fair and efficient manner.

Business

Requirements:

- (1) Focus resources on addressing the most likely types of disputes
- (2) Ensure that disputes are decided on an impartial basis
- (3) Ensure that dispute resolution processes are not burdensome to use
- (4) Avoid imposing a role for the clearinghouse that is inconsistent with the role agreed upon by the community

Sunrise Dispute Resolution

The text in the Applicant Guidebook provides for challenges to a sunrise registration based on at least the following four grounds:

- (i) At the time the challenged domain name was registered, the registrant did not hold a trademark registration of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty;
- (ii) The domain name is not identical to the mark on which the registrant based its Sunrise registration;
- (iii) The trademark registration on which the registrant based its Sunrise registration is not of national effect (or regional effect) or the trademark had not been court-validated or protected by statute or treaty; or
- (iv) The trademark registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received.

It is also noted that the Trademark Clearinghouse will hear challenges.

Additional Types of Disputes

Additional types of disputes are possible concerning the Clearinghouse processes. Any dispute resolution mechanisms should concern Clearinghouse processes themselves, rather than determinations on the underlying rights. In some cases, this might resemble more of a reconsideration or appeal process rather than a dispute resolution model.

The Clearinghouse should not be a venue for deciding legal claims.

A list of some types of scenarios is included below, with possible mechanisms for resolution:

Relevant action	Basis of dispute	Initiated by	Mechanism
Recording data in Clearinghouse	Record was accepted in error, due to faulty authentication or validation	Third party	Clearinghouse review/appeal process
Recording data in Clearinghouse	Record was denied in error	Rights holder	Clearinghouse review/appeal process
Sunrise	Sunrise registration was permitted in error	Third party or other rights holder	Sunrise Dispute Resolution process
Sunrise	Sunrise registration was denied in error	Rights holder	Registry process
Sunrise	Dispute over allocation between more than 1 qualified sunrise registrant for same name	Rights holder	Registry process
Sunrise	Notice of sunrise registration not sent to rights holder	Rights holder	Dependent on party with responsibility for sending notice
TM Claims	Notice sent to domain name applicant in error	Rights holder or domain name applicant	Dependent on party with responsibility for sending notice
TM Claims	Notice not sent to domain name applicant	Rights holder or domain name applicant	Dependent on party with responsibility for sending notice
TM Claims	Notice of registration not sent to rights holder	Rights holder	Dependent on party with responsibility for sending notice

IAG Comments:

Sunrise Challenge based on "Incorrect" Information

One IAG member noted that it has been suggested that a Sunrise challenge could be brought if the registration request was in some way "incorrect, misleading, or fraudulent" information. Such member believed that an "incorrect" standard may be too broad, as this could apply to innocent typos in an applicant's address, etc. Instead, a "catch-all" provision was suggested to allow challenges to be based on "fraudulent" information that led to the award of a domain name that the applicant was not entitled.

Penalties for Fraudulent Use of the TMCH

The IAG reached a consensus on the principle that the deliberately fraudulent use of the TMCH should bar those users from TMCH, and that there should be a process to challenge sunrise

registrations based on the lack of bona-fide use. Specifically, the lack of bona-fide use at the time the Sunrise application was filed should be a basis for challenging a Sunrise registration, as such use is required to be eligible. It was noted that permitting such challenges may lessen the burden on the TMCH from needing to carefully scrutinize all claims of use, many of which may never be relied upon for a sunrise registration.

One IAG member expressed the view that a lifetime ban from the TMCH might be too onerous of a penalty and could cause an extreme hardship. Instead, it was suggested that bans should come in 5 year "chunks" for the deliberate (non-negligent) and repeated submission of material fraudulent information. A lesser penalty could apply if only one such fraudulent submission is made.

Challenges for Abandonment of the Trademark

The issue of abandonment (non-use) of a trademark that is the subject of a trademark recorded in the TMCH may become a common issue. There may be instances where a trademark has been abandoned, or a mark holder has ceased doing business, or cancelled product line, so there should be an ability to challenge records in the clearinghouse for records that are still valid on their face. Members of the IAG expressed a desire to be able to challenge sunrise registrations based on the lack of bona fide use.

One IAG member noted that the current list of four challenges in Section 6.2.4 does not clearly allow a challenge that the use determination was improperly made or that a mark recorded in the TMCH was no longer eligible because it was not in use at the time the domain name was registered. Unless there is another manner to remove these non-used, abandoned marks from the TMCH, it was suggested that another ground for an SDRP be created, namely: "(v) At the time the challenged domain name was registered, the registrant's mark contained in the trademark registration entered in the Trademark Clearinghouse used to support the sunrise registration of the challenged domain name was not in current use."

Identifying the Entity to Administer the Sunrise Dispute Processes

It was originally envisioned that the TMCH Operator would hear challenges from the sunrise period. The IAG questioned whether this model is still valid, or whether another party should hear these challenges. For example, if the claim is against the TMCH Operator, such as in instances where the TMCH did not deliver notices that it was required to send, it would not be appropriate for the TMCH Operator to be the venue for hearing that claim.

Qualifications of Those Hearing Disputes

One IAG member noted that the TMCH should have a cadre of higher level employees or outside consultants who can be relied upon to evaluate the proof of use, so that the average TMCH employee who is merely verifying factual information in various trademark registries is not called upon to make a judgment call as to the sufficiency of the proof of use.

Limiting the Types of Challenges to be brought before the TMCH

The type of challenges the TMC may resolve should be limited to questions regarding meeting the minimum Sunrise Eligibility Requirements as set forth in the AGB. If a registry has other requirements (similar to .xxx preferences for members of the adult entertainment industry), the TMCH should not be responsible for resolving such issues. It should be up to the registry to put a process in place for doing so.

Allocation of Costs of TMCH Disputes

The cost of an SER challenge should be borne by the parties, perhaps on a loser pays system, and not spread among all trademark owners who submit marks into the TMCH but who may never be a party to an SER challenge.

Priority: N4
Issue: Information Accuracy and Update

Description: The data stored in the Clearinghouse should be as accurate, up-to-date and complete as reasonably possible. However, since rights data, proof of use, and contact data are voluntarily submitted to the clearinghouse by its customers, and because that information may change over time without any obvious indication to the Clearinghouse, it is necessary to identify the relevant processes and requirements to ensure that clearinghouse data is as accurate and up-to-date as reasonably possible.

Business

- Requirements:**
- (1) Ensure the clearinghouse maintains usable accurate data
 - (2) Avoid an overly onerous set of data maintenance requirements which reduce the market viability of clearinghouse services.

Elements of data maintenance:

- 1. Required frequency with which to re-authenticate rights data
- 2. Required frequency with which to re-validate proof of use
- 3. Required frequency with which to re-confirm e-mail address validity and other contact data
- 4. How long to continue using data without some form of refresh (1-3 above)
- 5. Expiration: when to remove “stale” data from the system
- 6. Required steps for reviving expired data
- 7. Expiration notice frequency

Processes required for data maintenance:

- 1. User interface for provision of updated data (e.g., notice of abandonment, name change)
- 2. Re-authentication of rights data
- 3. Re-validation for proof of use
- 4. Re-confirmation for contact data
- 5. Removal of records (i.e., removal from active database – historical records can still be retained)
- 6. Re-instatement of removed records

IAG N4 Comments:

Process to Challenge & Remove TMCH Data

It was suggested that the TMCH should include the ability for third-parties to challenge and remove non-used trademarks from the data set for Sunrise Eligible trademarks.

Adopting a Process Similar to the WDRP

The IAG discussed whether to follow a process similar to that used for the Whois Data Reminder Policy on a periodic basis (yearly, for example). It was pointed out that trademarks go abandoned frequently and it may not be unreasonable to ask for confirmation on a yearly basis. The IAG noted that there is a need to balance the burden on rights holders versus recognizing that rights often change with respect to trademarks.

The IAG suggested submission of a sworn statement that the trademark is still valid, but create a mechanism for challenges if the statement is inaccurate. It is not expected that this update would require a new proof of use or specimen to be submitted. Also, there would be no need to resubmit all of the information that was previously provided, but instead use a general statement that all of the information is still valid and accurate.

In any event, the IAG suggested sending an email to the mark holder confirming any updates to the TMCH records.

Frequency of Updates

It is noted that the IRT requested updates on an annual basis, modeled after the process for WHOIS updates. It might be useful to have the specimens updated every five years for example, just to make sure that the information does not become too stale.

One IAG member noted that after entry into the TMCH, adopting a concept of periodic renewals (between 1 and 3 years) of the trademark data could be easy and quick for registrants.

Modeling the TMCH on the Domain Registration System

One IAG member suggested a process similar to the maintenance of domain name registrations that could have the following qualities. First, electronic submission such as e-mail reminders providing a link and/ or a website registrant portal should be used whereby the trademark owner reaffirms that the data initially provided is accurate and pays its renewal fee. Second, the owner of TMCH records should be able to renew those records within a set period of time so that they have the option of renewing early to synch all of their records to one periodic renewal date. Third, trademark owners could opt in for renewal fees to be automatic charges to a credit card account. This would ensure that records are not accidentally lost for non-payment of renewal fees. In order to make sure, however, that information is reaffirmed correctly and timely, late charges and penalties could be assessed via this method.

Priority: N5
Issue: Matching Rules

Description: The Trademark Clearinghouse will perform numerous comparisons between strings, with parameters for identifying an “identical match” as defined in the Applicant Guidebook. Because of the plethora of languages and character sets used in trademarks, and the limited set of DNS-permissible characters, clear definition of both the principles and rules by which matches are to be permitted must be established to ensure transparency of Clearinghouse operations.

Business

Requirements: (1) Ensure predictability and reproducibility of matches
(2) Avoid divergence from the legally recognized protection of trademark rights
(3) Provide transparency into rules and processes used in Clearinghouse processes

Issue 1: Applying the Identical Match rules

As noted in the published Trademark Clearinghouse model, “Identical Match” means that the domain name consists of the complete and identical textual elements of the mark. In this regard:

- a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted;
- b) only certain special characters contained within a trademark are spelled out with appropriate words describing it (@ and &);
- c) punctuation or special characters contained within a mark that are unable to be used in a second-level domain name may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches; and
- d) no plural and no “marks contained” would qualify for inclusion.

Some interpretation is required of these rules, as described below.

Rule B.

When translation of a “rule b” special character into appropriate words describing it (in the case of ‘@’ and ‘&’) must occur, should it occur into a given language (for example: the UN languages, the intended language(s) for the domain name registration, the national language(s) of the jurisdiction where the mark is registered)? How could the appropriate language(s) be determined for each case? Alternatively, should a single set of languages be established as a standard to apply in all cases? How would this be determined?

Consider the fictional mark “X & Y.” Looking only at English, French and Spanish, the ampersand could be spelled out as “and,” “et,” or “y,” causing the mark to match to “X and Y,” “X et Y” or “X y Y.” What circumstances will dictate which language(s) are to be used?

For a Sunrise period, these issues will have an impact on the number of names a trademark holder is eligible to register.

For a Trademark Claims service, this issue will have an impact on the number of Claims notices generated and displayed to prospective domain name registrants.

Rule C.

When a mark contains more than one “rule c” special character that is to be dropped or transformed into a dash (to be a DNS-permissible character), an expanded number of relevant strings will be generated (i.e., the rule applies more than once for the same string).

If a mark contains, for instance, three “rule c” characters, this means that there will be 8 possible matches. Consider the fictional mark “a’b:c,d” -- how it might be presented. This would be an identical match to “abcd,” “a-bcd,” “a-b-cd,” “a-b-c-d,” “ab-cd,” “abc-d,” “a-bc-d,” “ab-c-d.”

Issue 2: Registry Character Mappings

The Unicode standard provides a repertoire of code points used in world scripts, including various classifications of character properties, and normalization rules. The Internationalizing Domain Names in Applications (IDNA) protocol specifies rules for determining whether a code point is a candidate for inclusion in domain names. An internationalized domain name label can be represented as a Unicode string or an ASCII string. Taking the IDN test TLD string in Cyrillic script as an example, the U-label is <испытание> and the A-label is <xn--80akhbyknj4f>.

It is expected that no characters outside the Unicode standard would be included in trademark records in the Clearinghouse. This should not pose a difficulty as the vast majority of characters in common use are included in this standard. Additionally, except as provided in the matching rules above, a trademark containing characters that may not appear in a domain name would not be a basis for a Sunrise registration or a Trademark Claims notice.

- How should the Clearinghouse service the different character mapping rules that could occur in different new TLD registries?

Registries may establish rules and policies for characters to be allowed in the TLD, including, in some cases, “variant” characters or characters that are mapped to one or more other characters in some way. At the present time, registry practices differ, and so it is likely that a number of character mappings may apply in some registries and not others. As is the case presently, this results in a different experience across various TLDs.

In consideration of registry character mappings and the Clearinghouse services, there are two broad approaches:

- (a) One is that the registry maintains the responsibility for integrating its character mapping policies into the Sunrise and Claims services.

For example, in the Trademark Claims service, where a registry policy maps “e” to “é” and a domain name applicant attempts to register the string “xyz” – the registry could query both “xyz” and “éxyz” to determine whether there is a match to a Clearinghouse record, and provide the results for both queries to the domain name applicant. However, the registry should also ensure that the domain name applicant is provided an explanation that this is occurring according to the registry policy, to aid in the interpretation of the Claims notice information.

In the case of a Sunrise period, the registry could take the information on Sunrise name eligibility generated from a Clearinghouse record and apply the registry rules to generate the additional eligible names based on that record, as appropriate.

- (b) In the other approach, the Clearinghouse would be provided the mapping rules for each TLD, and would need to have a mechanism for applying the correct set of rules in a given case. Essentially, the definition of “Identical Match” would be supplemented with the registry-specific matching rules to be applied.

Under this approach, the results returned for a Clearinghouse query would differ according to the TLD and its rules, and the same string might trigger a Claims notice in one TLD but not another.

For a Sunrise period, the Clearinghouse would be able to generate the eligible strings for a Clearinghouse record according to both the Identical Match rules, and the registry mapping rules.

In this case, the issue arises of what process requirements are desirable with respect to adding, removing or changing the Clearinghouse mapping rules used for a given TLD. For example, is it acceptable to change the mapping rules applied to a given TLD during a Sunrise or Claims period? If not, how long prior to the new TLD’s Sunrise should the rules be established?

IAG Comments:

Trademark Variations Submitted by Rights Holder

One IAG member suggested that the trademark holder be allowed to submit the variations of the translations that it desired and that this not be left up to the TMCH as it may not desire the variation that the TMCH might impose.

Additional Symbols & Characters

In different languages, there may be additional symbols or characters that mean “and.” As a result, the foreign language equivalents to “and” may need to be explored and evaluated.

Some IAG members questioned why there are the only two special characters that are afforded the special treatment for trademark owners. There are other special characters, such as “+” and “*” that also could deserve such treatment. It was pointed out that the rules on the special characters originated from the STI group, and that this tracked limitations from existing protocols on what characters can be included in a domain name string.

Another IAG questioned whether registries would be allowed to augment this rule if they wish by allowing additional special characters to be spelled out.

Transcription of Special Characters

One IAG member suggested that the transcription of the special characters “@” and “&” be based on the language of the trademark itself, rather than the intended language for the domain name or national language of the jurisdiction.

Determining the Language of the Trademark

It was suggested that the language of the trademark be collected from the trademark owner during the initial application to the clearinghouse.

Variant Character Tables to be Adopted by the TMCH

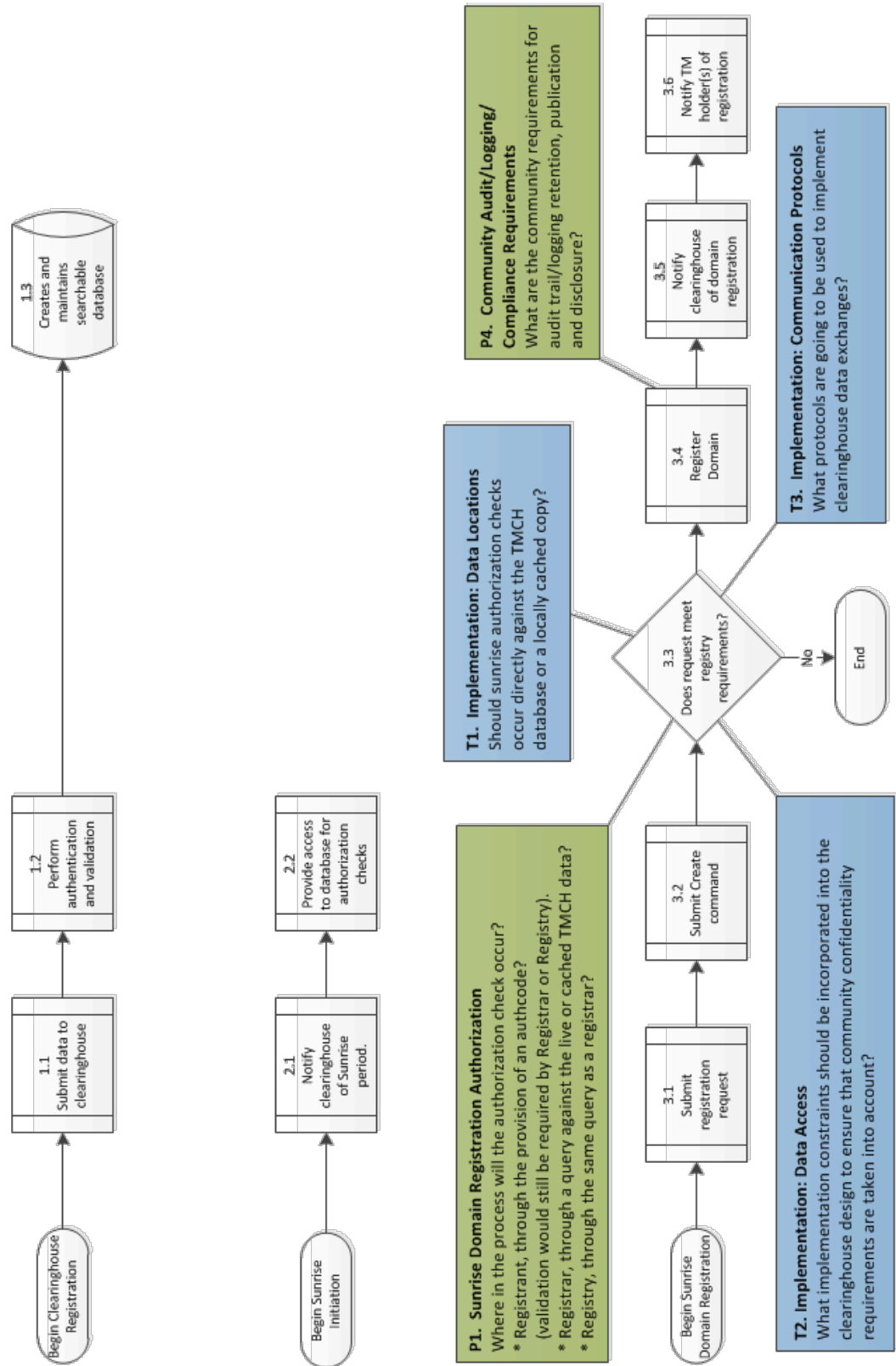
One IAG member recommended the approach where the TMCH is responsible for providing the mapping rules for each TLD, as this will help ensure consistency across TLDs for matching during sunrise and claims periods. Another IAG member disagreed with this view and suggested that the TMCH should not have the liberty of establishing its own character variant tables, but should instead adopt the IANA variant character tables.

Some IAG members recommended that where variant characters exist for certain languages, that ICANN encourage Registries follow a universal standard rather than develop their own unique approach. Staff clarified that there may not be a uniform table adopted for each language. As a result, another option could be that each registry provides its tables for the specific TLD to the TMCH. It was noted that the issue of variants is being addressed separately rather than through the IAG and that the results of that will be taken into account as the TMCH is developed.

The question was also raised whether the issue of variants applied to IDNs only or whether Registries could develop additional transcription rules for "variants" including special characters, numbers, etc.

Appendix 1 – Generic Sunrise Process

Sunrise Process Model Draft



Appendix 2 – Generic Trademark Claims Process

Trademark Claims Process Model Draft

