

**ICANN
Transcription
Review of all Rights Protection Mechanisms (RPMs) in all gTLDs PDP Working
Group call
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Coordinator: The recordings have started. You may now proceed.

Terri Agnew: Thank you. Good morning, good afternoon and good evening. Welcome to the Review of all Rights Protection Mechanisms RPMs in all gTLDs PDP Working Group call held on the 8th of February, 2017.

In the interest of time there will be no roll call as we have quite a few participants. Attendance will be taken via the Adobe Connect room so if you are only on the audio bridge could you please let yourselves be known now? Carrying no names I would like to remind all to please state your name before speaking for transcription purposes and to please keep your phones and microphones on mute when not speaking to avoid any background noise.

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

Phil Corwin: Okay, good morning, good afternoon and good evening to all our participants in this call. Welcome. And I think we've just skipped roll call. Anyone have statements of interest update? I see Rebecca's hand up. Rebecca.

Rebecca Tushnet: Yes, sorry. This isn't a statement of interest update. I actually just had a classic scheduled so I was hoping I could get to talk pretty early on in the next like seven minutes if that's okay?

Phil Corwin: Well, will you be - would you want to address when you talk? The first item in our agenda...

((Crosstalk))

Rebecca Tushnet: Yes, Category 3, Charter Question 7.

Phil Corwin: All right, well Category 3 is our third item. But let's - I assume no one has statement of interest update?

Brian Beckham: No, Phil Corwin, this is Brian Beckham, I just wanted to say I'm on the call only for the attendance purposes.

Phil Corwin: Okay. Hey thank you, Brian. So you're just on the audio. Okay. Alright well our first item is review staff table for Category 1 and 2. And, Rebecca, that's going to take a while I think. I don't even know if we're going to get to Category 3 today.

Rebecca Tushnet: Okay. I'm sorry, I just have a class to teach in 10 minutes so...

((Crosstalk))

Phil Corwin: If you want to type in your comment we take note of it but I don't want to just jump ahead to Category 3 when it's not the first item of business.

Rebecca Tushnet: Fair enough. All right, I'll type it in. Thank you.

Phil Corwin: Okay thank you. Thank you for your understanding. All right so we have here - we're going to be reviewing this staff table for Categories 1 and 2 on

education. We've had some substantial discussions on these matters. So let's just quickly through the pages.

On Page 1, the main question is, is the Clearinghouse clearly communicating the criteria that applies when determining whether or not to accept marks; and the options for right holders when their submissions are rejected; and options for third parties who may have challenges to or questions about records in the Clearinghouse; and then potential further working group questions that the problem may be with inconsistency of approach.

The Deloitte response is the number of invalid trademark records, at an average 8% of the total number of marks submitted. And 43% of the signatures are from the US followed by UK, etcetera. It's all listed there. And continue with Deloitte's response which continues on Page 2 and onto 3. So let's go through the whole response and then check the other things.

At this moment, an average of the active Trademark Clearinghouse records are not sunrise eligible, that means they're eligible for a claims notice but not for the sunrise. No third parties have been brought to date including on the basis the Clearinghouse incorrectly accepted trademark record and all disputes to date have been with trademark holders who did not agree with the sort of verification process.

Customer support has answered more than 15,000 questions via the portal, email or phone. The most relevant and frequent questions have been turned into FAQs on the Website. And most questions relate to actual trademark management, such as how do I submit a record. For what purpose is it deemed incorrect? And I have received a claims notification, what do I do now? Okay so that was Deloitte's response.

Registry Stakeholder Group suggests the working group obtain data to evaluate utilization in the Trademark Clearinghouse including number of rejected trademarks, statistics on the number of registration attempts made

for domains matching Clearinghouse recorded marks. Cost to Deloitte to carry out trademark verification, and extent to which these costs vary by region. So that's something I think we'd have to get back to Deloitte on. And cost to registries and registrars including for integration.

And the working group discussion to date, we didn't get much response. We can possibly discuss some of these issues with Deloitte at ICANN 58. So that's the sum of everything we've got right now on Charter Question 1. So let me stop there and see if anyone has further comments on this table or thinks that anything is inaccurate or incomplete in the table. Kathy, go ahead please.

Kathy Kleiman: Hi, everyone. Kathy Kleiman. Phil, is this the first time we're seeing this table? Just wondering because I've been reviewing the documents. I know many people are. I'm hearing from some people that they're swimming in documents. But a question, is this - have we seen this document before? I don't recall it. And if so - if not, we should probably give the working group some time to think about it. Thanks.

Phil Corwin: Yes. Yes, and Mary is raising her hand, I assume to respond to your question. So go ahead, Mary.

Mary Wong: Thanks, Phil. And thanks, Kathy, for the question. This table was circulated to the working group mailing list I believe it might have been last Thursday. And it is the work product of staff based on agreement on the last working group call on Wednesday that because there are indeed a number of documents, such as the list of charter questions, the discussion from the mailing list, the response from Deloitte, the various registry responses and papers and so on, that it would be helpful for staff to try and put it all into one table. So this is what it is. And this one was circulated, like I said, as soon as we could following the call last week.

For the next table if we get there, that was circulated I believe on Monday because we needed time to prepare that. So hopefully this helps.

Phil Corwin: Okay. Thank you for that explanation, Mary. So this is the first time that the working group is going through this together. So - we've got 10 pages here. We're going to run through this and get any feedback now. But since this is the first reading of this by the full working group we - it won't - any discussion on it won't be closed out today.

So I'm not seeing any hands on discussion of Question 1 so let's go into Question 2 which is about whether it's the Clearinghouse's responsibility for educating rights holders, domain name registrants and potential registrants about its services. And if so, how? If not, who is responsible?

So the - have to scroll back up to remember what each column represents. Okay. So the further working group questions was whether it was ICANN's responsibility rather the Clearinghouse's. And the Clearinghouse has reached out to its direct or potential customers, but not to potential registrants of domains. Should it be a community effort? That there's a limit to the education the Clearinghouse can provide on sunrise since there's different types of sunrise depending on how the registry operates them.

Registries have the option to extend the claims period so they can do education. I'm not sure personally I'm convinced of that one, that individual registries are going to do the education about the meaning of all this. And then others think it's the registrar since they have the customer relationship with the registrants or potential registrants. How would it work if we have multiple Clearinghouse providers in the future? I don't know the answer to that one.

And how is the Clearinghouse done education in the past? I think they responded to us it has primarily been through their presence at various

industry gatherings focused primarily on the rights holders who are the potential registrants in the Clearinghouse.

Next column, which is the Deloitte response was they say that outreach and education was not defined as being part of their scope, however, it became clear from the start and the Clearinghouse invested a lot of time and effort in awareness - creating awareness through webinars, presence at ICANN meetings, attending and promoting the TMH at INTA gatherings, organizing various workshops with their agents, creating educational brochures and videos and I believe we learned those are on the Website.

Marketing materials, drafting articles of various IP magazines, again, oriented toward the IP community. They've done this in several languages and various regions and including meetings and seminars in Europe, Russia, China, Middle East, etcetera and in various languages.

And additional working group discussion was that ICANN should be a neutral educator and at least prepare materials to extend beyond rights holders, possibly a hybrid model where ICANN and the Clearinghouse can post materials on both their websites.

And okay that individual registrants don't need to know every detail of the Clearinghouse, just what to do about the meaning of the claims notice and what to do when they get one. And ICANN can develop a FAQ sheet - FAQ - for distribution by registrars to their customers with a link in the claims notice. And that there is public comments in the 2015 RPM staff paper suggesting that education of rights holders outside Europe and North America should be approved especially in underserved regions.

So that's the full gamut of the education issue. We went through our working group discussion so far. Any further discussion on that one? Anyone think anything's incomplete, inaccurate or missing? Kathy.

Kathy Kleiman: Hi, Phil. I think - this is Kathy Kleiman of course. And I think that, as you were reading down through it, we got narrower and narrower. So I'm not sure the recommendation of the working group is that ICANN develop an FAQ. Certainly, you know, or that we're only dealing with registrants and trademark claims. There've certainly been discussion in the working group that registrants and registrant representatives need to better understand what is in the Trademark Clearinghouse database.

And what the whole Trademark Clearinghouse system is. So I'm not sure there's consensus that, you know, it's as simple as an FAQ. Certainly the Trademark Clearinghouse for trademark owners provides webinars and overviews and diagrams.

And so I'm not sure, you know, it's - I would say we're probably - that that's an example of the type - an FAQ is an example of the type of material ICANN might want to offer but that it should really talk with the community it's trying to reach when it gets, you know, if we instruct it, and it looks like we will, to do some education it should do - really do some outreach to the community and see what it needs to understand. Thanks.

Phil Corwin: Okay thank you, Kathy. And now let's hear from our other cochair, Mr. Evans. Go ahead, please.

J. Scott Evans: Speaking as - in my capacity as cochair, one, I - the only person I've really heard bring all this up is Kathy so to say that we don't have consensus and we've got one vocal person I'm not sure is necessarily true.

Secondly, as I stated in the text or the chat area, I don't know why there needs to be broad educational understanding that is a burden for anyone about how the Trademark Clearinghouse works, about what it takes in, what it does unless you're a user of that, which it seems that Deloitte and others, by the mere practicality of trying to run a business and offer a service that

they're trying to intake revenue from, have imparted and tried to educate their consumer on that.

Now with regards to the trademark claims, and sunrise, which do affect general users or general registrants who either receive a claims notice or are denied a registration because someone has obtained a sunrise, perhaps there needs to be some education about what that is, what that means, how that happens. But that has nothing to do with the Trademark Clearinghouse except for the fact that how the trademark owner qualified for this rights protection mechanisms be triggered is because their information is in the Clearinghouse.

But I don't think that there needs to be a huge general education of every user in the world about how the - what goes in the Clearinghouse, how it's verified, how it all works. But they do need to understand what the ramifications of sunrise, registration that denies them or registration or trademark claims notice that puts on them a duty to read it and understand it and take whatever action they feel is appropriate based on their understanding of the trademark claims notice.

And it seems to me that the registrars who are serving registrants are in the best position to do that because they, it seems, would want their customers or their customers-to-be to understand the system. And so the market itself works. I don't understand why we expect ICANN to do all this education. It seems to me that there is an obligation upon a user who wants something to understand it. And on a registrar who wants to sell you something to make sure you understand it. That's all.

Phil Corwin: Okay well thank you, J. Scott. I wouldn't disagree with a lot of what you said, though I don't personally see any harm in ICANN developing some basic information about - for two parties who are not going to be direct users of the Clearinghouse, one would be a potential registrant, perhaps even a

trademark owner who has chosen not to use the Clearinghouse and then finds that the domain they wanted is gone because of a sunrise registration.

The other one would be a domain registrant hopefully with non-infringing intent who gets a claims notice in the course of attempting to register a domain name and needs to understand exactly what that means and whether they're in trouble if they go forward with the registration. So because we've got big registrars and we've got little registrars and they're not - it might be better to have them all reference one uniform explanation of this stuff rather than each one either creating their own version or not doing anything at all at the smaller registrars.

I'll be quiet now and call on the esteemed Mr. McGrady.

Paul McGrady: Thanks, Phil. Paul McGrady here. I guess one harm I see in it may be less so if ICANN does it because ICANN's primary revenue sources are from registrants and from registries and registrars, but one harm if we require that the Trademark Clearinghouse do this is that the Trademark Clearinghouse revenues are from brand owners and so essentially that's shifting the burden of the cost of educating people about their obligations to not interfere with other people's trademark rights onto the brand owners.

And I guess my thought on that is that, you know, that's something that either the people selling the domain name should bear or the people buying the domain name should bear. But I don't know that giving the Trademark Clearinghouse this task is really where it should sit. Thanks.

Phil Corwin: Yes, and, Paul, again speaking personally, I'm in general agreement that the education of non - of folks who aren't going to be registering trademark in the Clearinghouse probably is not the primary responsibility of the Clearinghouse. I would observe that if one our recommendations is that ICANN should develop a standard explanation for either other rights holders or for and/or

registrants about the effect of - if they think a sunrise has taken place and registration improperly or effect of a claims notice.

If we were to recommend some uniform document that could be linked to by registrars as an informational tool for their customers that could be developed by the community rather than by ICANN in the implementation phase of whatever our recommendations for Phase 1 are.

So Kristine.

Kristine Dorrain: Hi, Kristine Dorrain, Amazon Registry Services. I just wanted to point out that, you know, whether or not we come up with an informal document that registrars could link to, we have to be mindful and I think we sometimes lose sight of the fact that there is a certain amount of discretion within individual registries as far as how the sunrise is structured, how it looks, their registration and allocation mechanisms in addition to just being a part of the Trademark Clearinghouse. There are some decisions that registries make with respect to claims notices.

So I think that, you know, to the extent that we think it would be great for ICANN to create some general instruction on claims and sunrise, and I would speculate that ICANN would do that before the Trademark Clearinghouse would. But I think we need to be careful that we're going to try to force how many different registries into kind of a mold. And I think that's going to be a really hard thing to do. Thanks.

Phil Corwin: Okay. Thanks for the input. Alright that was a good discussion on education. Let's go on to Question Point 3 here, what information on the following aspects of the operation of the Clearinghouse is available and where can it be found? Clearinghouse services, contractual relationships between the Clearinghouse providers and private parties, and with whom does the Clearinghouse share data and for what purposes?

The only further data we have on that question comes from Donuts. So this is a - this one is wide open for input from the working group. Donuts replied that they use the Clearinghouse to verify their own proprietary DPML list block requests. They look at the SNL and TCM list for business intelligence such as confirming of numbers, report industry blogs and ICANN reports are accurate. They leverage the SMD files as qualifiers for their DPML service. Only a few registrars complained about the cost and effort required to acquire a SDM file from the TMCH to participate in the DPML program.

They're aware of brand owners that entered their trademarks in the Clearinghouse just to be able to participate in blocking mechanism services, I assume like the DPML, but not for sunrise registrations. PIR and AfNIC said they don't use the database for purposes other than providing sunrise and claims services. Registry Stakeholder Group said we should look at whether service level agreements for the TMCH providers should have been established and published.

The early implementation of the Clearinghouse on notable outages that resulted in multiday delays for brand owners to get notifications that domains matching their Clearinghouse registered marks have been registered. Registry Stakeholder Group further recommends that the Clearinghouse publish statistics regarding the performance and consideration of whether this could have been approved via published SLAs and the working group should look at the cost effect on this of the RPMs, including the Trademark Clearinghouse.

I'm not - speaking personally I'm not sure how we do a cost effectiveness analysis other than seeking the services of an economist. But that's what we've got on the availability of identified aspects of the Clearinghouse. So there's a lot of blank columns here including the one for working group discussion. So do we have further working group questions or discussion on the operational aspects of the Clearinghouse? Now is your chance. Kathy.

Kathy Kleiman: Phil, Kathy Kleiman. I think it might be appropriate to ask Mary kind of where we stand in some of the surveys. I think there may be - I think there is preparation of the second round of surveys for the Registries on some of these questions. So it's possible we may have more information in a few weeks. Thanks.

Phil Corwin: Mary, go ahead.

Mary Wong: Hi, Phil. This is Mary. So I'll go ahead and respond to Kathy. So as the working group knows, we had gotten three responses to the initial outreach to registries and that's in this table from Donuts, PIR and AfNIC. So what we are doing with the cochairs is reaching out specifically to Right Side and Minds+Machines through their members who are part of this working group and we're also going to try to reach out to other registry operators, again, through members of this working group who may be associated with registry operators.

So that is in process. We don't know of course if we're going to get additional responses and what they will say. But of course we will put those in as soon as we get them, hopefully before ICANN 58. I will note that we did reach out initially to registrars through the Registrar Stakeholder Group but to date we have not received any responses. I hope that helps.

Phil Corwin: Okay. Ivett, you have your hand up. Please go ahead. Are you off mute? We're not hearing anything.

Terri Agnew: And, Ivett, this is Terri from staff. I don't see where you've joined on the telephone bridge. And your Adobe Connect mic is not active. To activate your mic on the top toolbar select the telephone icon and follow the prompts or you can send me a private Adobe Connect chat with your telephone number and I can have the operator dial out to you.

Phil Corwin: Okay, well while we're waiting for Ivett to connect on audio, while we're waiting, again, soliciting input from other working group members on the availability of these operational aspects of the Clearinghouse, and further inviting comment on the Registry Stakeholder Group, and we do have Registry representatives on the call I believe, made some point of comments about looking at SLA, service level agreements because of concern about outages. And they also would like a cost effectiveness study of all the RPMs including the Clearinghouse. So inviting comment on the Registry Stakeholder Group input on this.

Ivett, are you connected yet by audio?

Terri Agnew: And, Phil, this is Terri. I am working with her privately at this time. Audio is not connected as of yet.

Phil Corwin: Okay. All right well other working group members, while we're waiting for Ivett, any comments from anyone else on the adequacy of this operational information or on the specific recommendations that we got back from the Registry Stakeholder Group? Now is your opportunity. And as another area, silence will indicate consent to the way things are. Kristine.

Kristine Dorrain: Thanks. Kristine Dorrain. I moved my mic a little closer, is that better?

Phil Corwin: That's very good, Kristine.

Kristine Dorrain: Okay great. So I wanted to echo a point Kurt raised in the chat, maybe he's not on the phone today. So his point is why are we leaving education behind? My question does kind of follow up on that. I mean, I missed last week, and my apologies for that. What's the structure of the format here? I see that we're going through the charter questions, we're comparing Deloitte's answers and Registry answers. Do we have a - are we circling back to these? Do we have action items? This seems like an academic sort of debate that

we're having right now, but I'm not seeing any sort of outcome as a result of this. What's next? And maybe - I'm sorry if I'm the only one who's not sure.

Phil Corwin: No, that's a very good question, Kristine. The - I don't believe the cochairs have discussed next steps with staff yet. But I would imagine that once we review these questions at a certain point, and it could be soon because we're going to try to at least make provisional decisions about the Clearinghouse before we move onto the RPMs that are rooted in it, would be to see if there's consensus within the working group to recommend anything on any of these - that relate to these questions.

So are we going to recommend that - could someone please mute so - all right, got a horrible echo there for a second. So whether there's - whether it's clearly needs to improve its communications to rights holders, whether it needs to - it or someone else needs to develop some basic educational materials for those affected by sunrise registrations or who receiver claims notices, whether there's an inadequacy of this operational information that needs to be improved.

So I guess I'm saying I think at a certain point we get past the questions and decide whether we're going to recommend anything in response to the information received in regard to the questions. And Mary has her hand up and I'm sure she can provide further guidance on this. Go ahead, Mary.

Mary Wong: Thanks - thank you, Phil. I'm not sure I can, I'll try. I think one specific action item that I would assume we're looking for out of the review of this table is to see if the working group feels that there is sufficient information from Deloitte, particularly on things like verification, operations and so forth. If not, if there are follow-up questions that we would need to ask them it would be very helpful indeed if we can get those to them within the next week or two seeing as we are inviting them to join us for at least part of our meeting at ICANN 58.

So I would say that is one potential specific item which folds into the broader context of what Phil was saying understanding that the working group has only had a few days to look at this table, then idea is then if there are additional gaps whether that be data or whether that be input from particular types of parties, staff can then go out and get those and for you to review as a working group so that we can close off this aspect and move on as Phil as noted. Thank you.

Phil Corwin: Okay. Thanks, Mary. So to sum up...

Ivett Paulovics: Can you hear me?

Phil Corwin: Who's this? Who's this?

Ivett Paulovics: It's Ivett.

Phil Corwin: Okay. Just...

Ivett Paulovics: Can you hear me?

Phil Corwin: ...hold one second, Ivett so I can sum up and then we can...

Ivett Paulovics: Okay thank you.

Phil Corwin: ...just give me 10 seconds here. So working group over the course of the next week if working group members believe that we should be submitting further questions to Deloitte on the operational aspects or other data, let's get that together and get it transmitted to them so we can have a more informed dialogue with them in Copenhagen. And with that, go ahead Ivett. Look forward to your comment.

Ivett Paulovics: Hello. Hi. I'm Ivett Paulovics from (MSSD). And I would like to make a comment regarding Point 3, Letter C. (Unintelligible) the Trademark

Clearinghouse share data and for what purposes. I can see here on the call (unintelligible) domain name dispute resolution center, but as US providers, we should have access to the (unintelligible) files in order to verify the proof of use of complainants when they are submitting a URS complaint.

I don't know if the other providers have this access to Trademark Clearinghouse. But, we as a dispute resolution center contacted the Trademark Clearinghouse but up until now we didn't have any response from them to have access to such files.

Phil Corwin: Okay so you're saying you're a URS provider...

Ivett Paulovics: Yes.

Phil Corwin: ...you get complaints filed. It would be useful to fulfill your function to have access to the SMD files to verify the trademark - the claim of the trademark related to the URS. And that the Clearinghouse does not provide that to you despite the request.

Ivett Paulovics: Correct. Correct. Up until now we haven't received any complaint containing an SMD file or complainants who were asserting their rights and proving they are a trademark rights through registration at the Trademark Clearinghouse. But it would be useful in the future if it happens to have the access to the SMD file.

Phil Corwin: Okay. May I ask, did they respond? Did they give you a response for why they did not provide the SMD file or did they...

Ivett Paulovics: No, they haven't replied.

Phil Corwin: So no response at all. I'm sure that...

((Crosstalk))

Ivett Paulovics: No response at all.

Phil Corwin: Okay. All right well that's useful information. Thank you for that comment.
Kristine Dorrain, please go ahead.

Kristine Dorrain: Hi. Kristine Dorrain from Amazon Registry. I first have a comment in my capacity as former director of the Forum, when I had reached out a couple years ago to the Trademark Clearinghouse they were willing at that time to work with Forum in creating an API so that the provider could get direct access to match the SMD file so basically red light, green light the SMD file the complainant provided was accurate or not.

We didn't follow up with it at that time, I don't know what Forum is doing with that so I will stay out of that conversation. But to that point, I suggest that because the purpose of the SMD file, in Ivett's specific anecdote here, is related to the URS, I suspect that this particular point should be brought up under our conversation a year from now about the URS where we talk about proof of use and the provision of the SMD file.

I mean, it might make a nice footnote here, but I think this is predominantly relevant to the implementation of the URS. So I just throw that out there for thought.

Phil Corwin: Okay thank you, Kristine. And I just have to say you said when we get to the URS a year from now, the cochairs are very hopeful that we will be able to adhere to our schedule and get to it much sooner than a year from now. And, Ivett, did you still have a question? If not - or comment - if not please put your hand down in the chat room. Thanks.

So let's move on to Charter Question 4 which is whether - should the verification criteria used by the Clearinghouse to determine if a submitted

mark meets the eligibility and other requirements of the Clearinghouse be clarified or amended? And if so, how?

I'm not sure that it's unclear now what the criteria is, though I defer to others who are users. All we have in the matching columns is the Deloitte response noting that the number of invalid trademark records is on average 8% of the total number of mark records submitted. The principle reason for rejection, and I assume that's what this means, are name of the mark as submitted to the Clearinghouse does not match the name of the mark that is registered with the Trademark Office.

The name of the holder is submitted to the Trademark Clearinghouse does not match the name of the holder that has the registered trademark. And the trademark is not yet registered, that would certainly be a problem. And the trademark has expired and no proof of renewal was submitted.

So basically, the - while these - Deloitte has noted that these are not the only reasons, the primary reasons are that they get a request to put a mark in the Clearinghouse and something doesn't match up with what's at the Trademark Office that granted the trademark or there is no registered trademark or the trademark expired and was never renewed. Seems fairly straightforward.

Do we have anyone on the working group who believes there are other problems with the eligibility requirements either that they're unclear in some way or that they're too broad, too narrow? Again, now is the opportunity to get this on our agenda if you want us to make any recommendations in this regard. Questions that appear to be satisfied by responses where members of the working group have no issues with the current system. Those are going to be areas where we're probably not going to make any recommendations for change.

So Mary go ahead please and then I'll recognize Miss Payne. Go ahead, Mary.

Mary Wong: This is just two brief comments. One brief comment is that if you look at the Deloitte response this, in some ways, would answer one of the requests from the Registry Stakeholder Group about seeking information on the number and reasons for rejection.

The second brief comment is that in preparing this particular table, because the working group has gone through Categories 1 and 2 at least quickly, but not the other categories, what we did not include in this table is some of the comments from that 2015 RPM staff paper that Kathy asked about via email.

You'll notice that we did include those comments in the next table, which is the next few categories. So for now I'll just say with respect to this charter question, as I think many working group members know, because they did submit comments, that it looks from the comments that we got in 2015 anyway that the problems primarily were not with the criteria, but with how they worked and inconsistency of application. So I don't know if this is something that helps but I thought I should add it for working group members who may not have followed the conversation for a few years. Thanks.

Phil Corwin: Okay, well of course inconsistency application of the criteria would be an excellent topic to bring up in our face to face with Deloitte in Copenhagen if people are concerned that they haven't been treated on an equal or fair basis. Susan Payne, go ahead please.

Susan Payne: Thank you, Phil. This may be that I misheard you and so if I did I apologize. But in case I didn't mishear you or in case anyone else heard you in the same way that I did, this question, just to be clear, is not seeking our input on whether we think the eligibility criteria themselves are in any way sufficient or lacking, it's about whether the communication of, you know, how those criteria are verified by the TMCH, the adequacy of that. I mean, I think there's a big discussion that no doubt we'll be having about eligibility criteria but I don't think this is the discussion point.

Phil Corwin: Well, I'm not - Susan, I'm just reading the question. It says, "Should the verification criteria used by the Clearinghouse," so that's what it - the rights holder has to show to get registered in the Clearinghouse database, "to determine if a submitted mark meets the eligibility and other requirements be clarified or amended?" I think the amended portion of that question suggests that - it's at least raising the possibility of amending the verification criteria to either narrow or broaden the criteria. I'm not arguing that they should be but I think a reading of the question, the word "amended" implies changing the criteria. You wouldn't amend the operational aspects...

Susan Payne: Sure, sorry.

Phil Corwin: Okay?

Susan Payne: Sorry, Phil. Then maybe I misunderstood what you said. I thought you were saying to us so now people, if you feel that the eligibility criteria are incorrect, this is your time to raise it. So that was the only point I was wanting to say.

Phil Corwin: Okay well, substitute "amended" for "incorrect" but it would - it's basically the same inquiry. But we're not seeing any hands raised so people don't seem to have any significant level of dissatisfaction, at least on this call, with the current criteria or on how they're being applied. But if people think they're being applied inconsistently that would be an excellent topic to raise with Deloitte in Copenhagen.

And I'm going to - we're 45 minutes into this call, we have a quarter hour left. And we have two pages left. And I'm going to push very hard for us to finish those last two pages so at least we get through this document on this call.

So next question, "Should there be an additional or a different recourse mechanism to challenge rejected submissions for records in the Clearinghouse?" Deloitte's response on this is that no third party disputes

have been brought to date including on the basis that the Clearinghouse incorrectly accepted a trademark record or alleging that a trademark record is no longer valid based on new information. All disputes to date have been with trademark holders who did not agree with the verification process.

So that kind of side steps the question because Deloitte is reporting on the current recourse mechanism that's available to those who have their marks rejected on the basis of not meeting the criteria. So far as third party challenges, I don't want to side track this debate other than personally observing that until you try to register what you think is a domain matching your trademark and find that it's gone in a sunrise registration or it's blocked in a private blocking service, based on Clearinghouse SMD files, you wouldn't know that because the Clearinghouse at this point is a private database, there's no way to know which marks have been registered in it.

So let's open up for a quick discussion whether anything thinks there needs to be additional or recourse mechanism or a change in the current recourse mechanism for those whose marks are rejected by the Clearinghouse. Any comments on that please? Kathy, go ahead please.

Kathy Kleiman: Thanks, Phil. It's interesting that the question asks about the mechanism and the - and Deloitte responds that no one's brought any disputes. That doesn't tell us how someone would, how a third party would bring a dispute if they had one. So I think we have to rephrase the question and bring it back so that we can find out what the mechanism is when someone wants to - here again and I confused this last week as well. We've got two questions here, and I've asked Mary to actually bring down one from Category 1 because it really belongs here.

One is challenging rejected submissions, and the other is just challenging things that are recorded, so you get a trademark claimed. And I know it doesn't apply here but we should make this question apply to both and clarify because we keep talking about it. But if someone gets a trademark claims

notice and for some reason wants to bring - wants to bring questions to the Trademark Clearinghouse, again, that's in Category 1 but we should bring it down here.

And Deloitte really hasn't answered the question, how would they do that. They should be pointing us to a section in their rules that say you would do it X, Y and Z but it doesn't look like there is that mechanism. Thanks.

Phil Corwin: Right. Yes, thanks, Kathy. I'd also observe that Deloitte has told us that all disputes to date using the existing recourse mechanism one must presume, have been with rights holders who didn't agree with the verification process. I have to presume that's because their marks weren't accepted. But Deloitte has not told us whether any of those disputes resulted in a reversal of their initial decision. It would be - that would be useful information to have.

So I think this is - I hope staff is taking notes that this is - this question we probably have to have a deeper inquiry than what we've - to get further responses beyond what we've gotten to date. And now at 11 minutes before the top of the hour, I'm going to get to the last question - oh, J. Scott, go ahead. I don't want to cut you off.

J. Scott Evans: Well, I think Kristine Dorrain just posted in the chat a link to the Clearinghouse rules that talks about a dispute. And as I've stated in the chat, I think that we should look at that ourselves and make sure we understand what they're saying in their materials rather than asking them for an answer because it seems to me that if we're looking for how it's laid out we want to look at how they present it to the public and then we can ask specific questions around that once we understand it. But just asking them a blanket question, if you asked me I'd just point you to this Website. That doesn't answer Kathy's question.

So I would post that those that find this terribly concerning, and I hear Kathy speaking up, and I'm sure there are others that are aligned with Kathy's

interests that feel the same, they should look at this, they should then come back to us where they think that there are inadequacies or concerns and then we can go to Deloitte and ask the specific questions. That's all.

Phil Corwin: Okay. Okay yes, good comment, J. Scott. And let me ask staff to please, after this call, since we do have 46 participants today which is great, but that's still only about 1/3 of our total membership, if you could print out what's in that link at trademarkclearinghouse.com/dispute and circulate it to everyone in the working group so that with a note that we reached this question today and we would like everyone to look at what Deloitte has posted about the availability of dispute mechanisms so that members of the working group can see what the Clearinghouse provider has put out there, read it for themselves and see whether they think it's adequate or needs to be amended or expanded in some way. I think that would be a useful exercise.

Again, Deloitte - we do need to also get back to Deloitte either by email or in our face to face with them and find out whether any of these - when the dispute process has been used, has anyone been successful or - which would indicate an error in the initial rejection or are all of them - all of the disputes fail. And it may be perfectly fine that they fail if they weren't meeting the criteria in the first place.

So, Kathy, is that an old hand?

Kathy Kleiman: Yes, Phil. Thanks.

Phil Corwin: Okay. Reaching the last question on this sheet, "How quickly can and should a canceled trademark be removed from the Clearinghouse database?" which would be useful because people shouldn't have sunrise rights if their trademark has been canceled and it shouldn't generate a claims notice if it's no longer valid.

Deloitte's response, as stipulated in the Clearinghouse guidelines by ICANN, the user has the obligation to notify the Clearinghouse as soon as possible when a trademark is canceled by the Trademark Office. Upon notification of such information, the user will no longer obtain the Clearinghouse services. As for the expiration of the mark by the Trademark Office, this is monitored by us, that is Deloitte, as the actual expiration date is part of the trademark information that's verified.

In the event that a mark expires during the term of service, the user is notified here of and is requested to provide us with a renewal certificate of the actual trademark. So Deloitte has informed us that they monitor expiration dates because that's something that's filed with them when the application is made for Clearinghouse database registration.

They don't monitor cancellations, that the burden on cancellations is on the rights holder. And I guess Deloitte would probably have no idea of whether rights holders are doing that as they're supposed to do. So that's Question 6. Anyone think we need further information about how the type of job Deloitte is doing? And they seem to be doing an okay job based on their response on expirations on making sure that the marks in the Clearinghouse database continue to be valid and have not been cancelled and have not expired.

Susan Payne and then Kathy. Go first, Susan.

Susan Payne: Thanks very much, Phil. I just wanted to say I think that response from Deloitte seems very clear. It's very clear to all of us what they do. For my part I think I agree with your comment that you just made which was I think they would find it very difficult themselves to know if a trademark got cancelled. I don't know how they could do it and therefore they do have to rely on being notified.

I suspect that it's not an extremely common occurrence for a trademark to be cancelled. It's, you know, it's a fairly adversarial process that that happens.

And so, you know, and sometime takes probably quite a long time. But, you know, in - I think perhaps what we need to do, if we feel we need to do anything further on this, and I'm not sure we do but is, you know, is - are there any examples that any of us have of there being any problems where there's been a cancelled mark that hasn't come out when it should have done.

I'm not aware of any. And if there haven't been any known problems, then I think we can just accept this response and move on.

Phil Corwin: Okay thank you, Susan. Kathy.

Kathy Kleiman: What Susan says makes sense except I'm troubled from the opposite side because there's no way to verify. So of course in the United States we have a very famous canceled mark, the Redskins. And how would anyone know if it's been pulled out of the Trademark Clearinghouse database or not? It's probably not going to be the first thing the trademark owner thinks of is to take it out of the Trademark Clearinghouse. And yet there will be - there are rights associated with it, there is sunrise associated with it, trademark claims notices.

This is another case where we don't know if it's a problem. We don't know if the marks have been pulled out. And there should be a way to find out.

Thanks.

Phil Corwin: Okay. Thank you, Kathy. All right, it's four minutes before the top of the hour so let me just summarize here. We've gone through the - these six questions related to Trademark Clearinghouse charter questions on education and verification, updating the Clearinghouse data.

On some of them, we may well follow up with recommendations for - regarding communication of the criteria by the Clearinghouse about perhaps some greater education on that sunrise registrations and claims notices to be

developed, I would think by an implementation team if we accept such a recommendation to be put on the ICANN Website and linked to by registrars about use of the operational data by other parties, registries and registrars and availability of that. And we heard some concern that it's not available to URS providers.

And didn't hear much feedback on need to change the challenge mechanism for when a mark is rejected by the Clearinghouse. There may - or that something more needs to be done by the Clearinghouse in regard to canceled marks. But all of this preliminary - it's the first time we've gone through this paper. And are there any further comments on any of those topics? And I know there's been some robust discussion in the chat room, which I have not been able to entirely monitor and comprehend while I've been running this meeting.

If anyone has any further questions or any comments on anything that arose in the chat room in our remaining two minutes of this call, I'm going to give you one opportunity, we could take one or two comments, and then we're going to discuss the time of our next call and adjourn. So anybody have any - oh, and Mary, let's not forget Mary's had her hand up. Go ahead, Mary. Didn't mean to ignore you.

Mary Wong: Thanks very much, Phil. And, while folks - not at all - while folks compose their final thoughts just a couple of follow up points on the early discussion. One is a reminder that the Deloitte response that you see in this column isn't necessarily to the question that is in our charter. And I heard a few comments that made me think perhaps some folks are thinking that way. So for that I would direct folks to the actual Deloitte response which we have posted to the wiki.

So in some ways that is why the Deloitte response may not seem entirely on point. And I think one or two of the questions you discussed today illustrates that, so just to give the fuller picture.

A second follow up point is that I've been trying to keep up with the chat as well, Phil, and I may not have succeeded. But there was one question that I had put on action items list that I'd like folks to provide some I guess guidance on. One is that we also ask Deloitte for a list of all TMCH registrations that have a sunrise preference and that are dictionary terms.

I will say that the staff concern with that is asking Deloitte to decide what is and is not a dictionary term so perhaps that particular question can be rephrased. And finally, while all these questions are pretty detailed, I think at the end, and I think Kristine, you mentioned next year, and Phil, you said we hope to be done by this before next year, is that we do have to take the step-back overall and look at the TMCH, for example, the rules that it applies for verification, which may not be captured in these specific questions. So just three points from staff, Phil. Thank you.

Phil Corwin: Okay. Thank you, Mary. All right so staff, when is our next call? I know - and it's next Wednesday, correct? Do we have the time for that?

Terri Agnew: Hi, Phil. It's Terri. Currently our next call is scheduled for Wednesday the 15th of February at 1700 UTC for 60 minutes.

Phil Corwin: Okay, 1700 UTC. I'm going to be at the Non Contracted Party House intercessional meeting in Iceland next Wednesday, I believe Kathy will be there too. But J. Scott will be available to chair that call.

I had one comment on one thing in the chat room, there was some discussion about the cancellation of the trademark for the Washington professional football team, the Redskins, that's a controversial issue, but I will note for our non-US participants, that the US Supreme Court recently heard a related case brought by an Asian American band that has called themselves the Slants, and that term was deemed offensive and ineligible for registration. And now that issue is before the Supreme Court so we may have a Supreme

Court decision on the Trademark Office's right to reject applications for marks that they believe to be disparaging so just a point of information there.

Thank you, everyone, for participating today, for our almost 50 participants, for a good discussion. And again, if we - on the issues we covered if you believe we need to make recommendations on them that we need to get more information from the Clearinghouse or other parties, please get that out there because if we don't hear about a need for change we're not going to recommend any changes.

And staff is going to circulate the Deloitte informational page on how rights holders bring disputes when their marks are rejected so that we can all decide whether that process is adequately explained and seems to be effective. So thank you all. And that is it for this call. Good-bye.

Terri Agnew: Thank you. Once again, the meeting has been adjourned. Thank you very much for joining. Please remember to disconnect all remaining lines and have a wonderful rest of your day.

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