



Internationalized Domain Names Expedited Policy Development Process

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Deliberate on Trademark Protection Mechanisms

F1, D6a, D7a, F2

Charter Question F1

F1: Are there any adjustments to the TMCH and its Sunrise and Trademark Claims services needed?

Trademark Clearinghouse Basics

What: A central repository for info to be authenticated / stored / disseminated, pertaining to the rights of mark holders

Accepts and verifies the following types of marks:

1. nationally or regionally registered trademarks
2. court-validated marks
3. marks protected by statute or treaty (such as geographical indications or designations of origin)

Consists of two components:

1. **Trademark Validator (TMV):** an organization that has been authorized by ICANN org to authenticate and validate registrations in the TMDB ensuring the marks qualify
 - Current TMV provider is Deloitte
2. **Trademark Database (TMDB):** a database that concentrates the information about the “verified” Trademark records from the TMVs and provides information to the registries and registrars to support TMCH’s services

Why: Provide protection for verified legal rights of mark holders

How: Major benefit of recording marks with the TMCH includes the following mandatory services

- **Sunrise:** Access to a priority registration period
- **Trademark Claims:** Notification from TMCH when a domain matching a trademark has been registered

Sunrise & Trademark Claims

ICANN mandated mechanisms in the development of Applicant Guidebook for 2012 Round

Sunrise

Allows trademark holders an advance opportunity to register domain names corresponding to their marks during the Sunrise period before names are generally available to the public

Required submissions to TMCH:

- **Trademark record**
 - Trademark info, class of goods or services, justification where the trademark is registered, etc.
- **Proof of use**
 - Declaration stating that the trademark is indeed being used;
 - A sample showing the trademark in use, e.g., advertisement, branded product, etc.

Trademark Claims (Basic Eligibility)

In a minimum 90 day period following the Sunrise period, the prospective registrar provides a notice, displaying relevant trademark info, to prospective registrants of the trademark record, and a notice to trademark holders if the registration proceeds

If determine to proceed with registration, the registrant must acknowledge the claims notice

Required submission to TMCH:

- **Trademark record**

Domain Name Labels Inclusion

A trademark record in the TMCH can include **domain name labels** that correspond to the trademark

- **Up to 10 domain name labels** corresponding to one trademark record are included in the initial cost of verification by TMCH
- These labels are compared against potential registrations and have the capability of triggering claims notifications

Domain name labels generated based on matching rules appear in:

- **Domain Name Label (DNL) list:**
 - All labels covered by a trademark in the TMCH with support for Trademark Claims
 - Used by registries during the Trademark Claims Period to determine whether a requested domain name matches a record in the TMCH
- **Sunrise Label (SURL) list:**
 - Contains only those labels corresponding to trademark holders that are eligible and have chosen to participate in the Sunrise Period
 - Trademark owners be provided with a signed mark data (SMD) file to participate in the Sunrise Period

Matching Rules for Sunrise & Claims Services

- **Exact Match:** When all and only the complete and identical textual elements exist in both the trademark and the label
 - “ICANN” \longleftrightarrow “icann.example”
- **Transformations:** When certain elements contained in a trademark that cannot be represented in the DNS are transformed
 - Spaces contained within a trademark that are either replaced by hyphens (or vice versa) or omitted
 - “ICANN TMCH” \longleftrightarrow “icann-tmch.example”
 - Only two special characters (@ and &) can be replaced by the canonical translation of the word (‘at’ and ‘and’)
 - “Head & Shoulders” \longleftrightarrow “headandshoulders.example”
 - In any official language of the jurisdiction from which the trademark right is protected and verified
 - Punctuation or special characters may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores
 - “Domino’s” \longleftrightarrow “dominos.example”
- **No plural and no “marks contained”** (a mark that appears amidst other words) would qualify for inclusion
- More info: <https://newgtlds.icann.org/sites/default/files/matching-rules-14jul16-en.pdf>

Languages & Scripts in TMCH

Uses globally accessible and scalable systems so that multiple marks from multiple sources in multiple languages can be accommodated and sufficiently cataloged

- Accept trademark data from all over the world
 - In both Latin and non-Latin scripts
 - In some cases, accept trademark labels in mixed scripts
- Verify trademark data from multiple global regions

Intended languages/scripts of trademarks require careful analysis/inquiry with verified trademark owners

- “Language” and “script” might be used interchangeably in some TMCH documentation
- “Language” of the trademark is not submitted, and cannot be reliably assumed from the script or scripts used

of labels on SURL list ≠ # of labels on DNL list ≠ # of verified trademark records

- Differ due to label matching rules, eligibility, and trademark holders’ preference
- SURL: Not all trademarks qualify for participation in the Sunrise period, and some choose to opt-out
- DNL: A trademark holder may opt-out the Claims service, resulting in no label additions to the DNL list; several labels could be generated in the DNL list for another trademark record

High-Level Stats

TMCH validator provided ICANN org relevant data as of November 2021

Verified Trademarks	DNL List Labels	SURL List Labels
47,058 trademarks	1,502 labels	1,114 labels
14 scripts	13 scripts	10 scripts
Arabic, Bengali, Cyrillic, Devanagari, Georgian, Greek, Han, Hangul, Hebrew, Hiragana, Katakana, Latin, Thai	Arabic, Cyrillic, Devanagari, Georgian, Greek, Han, Hangul, Hebrew, Hiragana, Katakana, Latin, Thai	Arabic, Cyrillic, Devanagari, Greek, Han, Hangul, Hebrew, Katakana, Latin
Mixed scripts	Cyrillic-Latin, Greek-Latin, Han-Hiragana-Katakana, Han-Katakana, Han-Latin	Cyrillic-Latin, Greek-Latin, Han-Hiragana-Katakana, Han-Katakana, Han-Latin
Common (i.e., trademarks consisted of numbers)	IDNA2008_NOTVALID (i.e., labels didn't pass IDN 2008, invalid for registration)	IDNA2008_NOTVALID
<ul style="list-style-type: none"> Latin script trademarks = 96.82% of total Han script trademarks = 56.7% of <u>non-Latin</u> 	<ul style="list-style-type: none"> Latin script labels = 53.8% of total Han script labels = 25.1% of total 	<ul style="list-style-type: none"> Latin script labels = 53.1% of total Han script labels = 27.7% of total

Variant Handling in TMCH

TMCH does not calculate variants for its matching rules

- Support any official language used in a jurisdiction that grants trademark rights
- Alternative characters used in the creation variant labels will not experience matching rule transformations
 - E.g., if a trademark in traditional Chinese characters is recorded in the TMCH, the matching rules do not define a process for calculating variant labels in simplified Chinese characters
- Requirements and responsibilities for calculating variant labels belong to the registry operator and do not apply to the TMCH itself

TMCH Ancillary Service: Ongoing Notification

TMCH Validator (Deloitte) provides voluntary ancillary services not mandated by ICANN

Ongoing Notification: Following the Trademark Claims Period, the TMCH will notify a trademark holder of potential intellectual property infringement indefinitely, beyond the original 90 day Claims period

- Provide notifications for domain names that are:
 - Exact match to the trademark
 - “trademark clearinghouse” ↔ “trademark-clearinghouse.example”
 - Contain the trademark
 - “trademark clearinghouse” ↔ “thetrademarkclearinghouse-db.example”
 - Partially contain the trademark
 - “trademark clearinghouse” ↔ “clearinghouse.example”; “mark-clearing.example”
 - Similar to the trademark
 - “trademark clearinghouse” ↔ “trademarkclearinghouse.example”; “tràdémàrk-çlearinghòuse.example”
 - **Only apply to Latin script labels based on the “[accepted variants](#)”**

Registry operators and other third parties may also provide ancillary services (e.g., Donuts, Minds & Machines)

**Ancillary services require ICANN approval to offer, but they may be outside the remit of policy review, as they are voluntarily adopted, separate from ICANN mandated RPMs*

Variant Handling at Registries

Trademark Clearinghouse Rights Protection Mechanisms Requirement **make reference to how a registry may handle variants** in the situation where it has implemented IDN variant registration policies for the TLD

- **Section 2.4.2:** Registry Operator MAY Allocate or register IDN variant labels generated from a label included in a valid SMD file during the Sunrise Period, provided that
 - (i) such IDN variant registration policies are based on the Registry Operator's published IDN tables for the TLD and
 - (ii) such policies are imposed consistently in the Sunrise Period, any Limited Registration Period, any Launch Program and during General Registration
- **Section 4.1.2:** Registries MAY implement additional matching rules at the TLD level, provided that the Claims Services are still implemented for any Claims Registration satisfying such additional matching rules
- **Section 4.1.3:** During the Claims Period, if Registry Operator has established IDN variant policies for Allocation of domain names in the TLD, Registry Operator MUST check all labels in a variant set against the DNL List before any domain names in the set are registered

Registry operator's policy would NOT have an effect on what domain name labels are generated as part of the TMCH's matching rules

How Does 2.4.2 Work?

Sunrise Period

1. A trademark holder submits mark “example” to the TMCH. The trademark record is verified and the proof of use is accepted; a SMD file is generated
2. The trademark holder is eligible to register the domain name `<example.tld1>` during Sunrise Period
3. A registry of tld1 uses an IDN table where “è” is an allocatable variant to “e”; hence “èexample” is a second-level variant label of “example” under tld1
4. When presented with the SMD file for registration of `<example.tld1>`, the registry has the ability to activate `<èexample.tld1>` for the registrant of `<example.tld1>` during Sunrise Period, at the request by the registrant and in accordance with the registry’s policy

How Does 4.1.3 Work?

Trademark Claims Period

1. A registrant attempts to register `<example.tld1>`
2. The registry of tld1 applies its IDN Table, generating its corresponding allocatable variant domain, e.g., `<example.tld>`
3. The registry of tld1 is required to query TMCH's DNL list for both `<example>` and `<example>` to determine whether there is a match to a label in the DNL list
4. Since the the mark "`example`" is recorded in the TMCH and its corresponding label is in the DNL list, the registry of tld1 will notify the sponsoring registrar that a Claims notice should be shown to the registrant of `<example.tld1>`
5. A Claims notice is shown to the registrant of `<example.tld1>` due to the recorded mark and label "`example`" in the TMCH
6. Registrant can elect whether to proceed with registration of `<example.tld1>`

Recommendation 10: The current rights protection regime associated with the Trademark Clearinghouse (TMCH) process is susceptible to homographic attacks. The roles of the involved parties, specifically registrars, registries, and TMCH, related to matching must be made clear.

Recommendation 12: The matching algorithm for TMCH must be improved.

Recommendation 13: The TMCH must add support for IDN variant TLDs. Particularly during the TM Claims service, a name registered under a TLD that has allocated variant TLDs should trigger trademark holder notifications for the registration of the name in all of its allocated variant TLDs.

Source: <https://itp.cdn.icann.org/en/files/security-and-stability-advisory-committee-ssac-reports/sac-060-en.pdf#page=16>

Recommendation 10: The current rights protection regime associated with the Trademark Clearinghouse (TMCH) process is susceptible to homographic attacks. The roles of the involved parties, specifically registrars, registries, and TMCH, related to matching must be made clear.

The current method: Variant calculation at the registry level, and checking TMCH for the existences of marks for variants in the calculated variant domain set

- **Advantage**: the role of the TMCH is to record existing rights, and not make determinations concerning the scope of rights and whether certain variant label qualify for the same right
- **Downside**:
 - Registries have different IDN Tables, which can be used to generate and register variant domains under different TLDs and cause security, stability, or resiliency concerns
 - Large number of transactions between registry and TMCH due to permutations of certain label

An alternative method: Variant calculation conducted via the TMCH, meaning the matching rules would also define if a variant of the registered label matches a label in the DNL, triggering Claims notice

- **Advantage**: Address the downside of current method
- **Downside**:
 - Expand the role of the TMCH by making determinations concerning the scope of rights
 - Could conflict with local law or approved IDN Tables

Recommendation 12: The matching algorithm for TMCH must be improved.

Rationale:

- Exact match as defined by TMCH is not really an identical match as in “bit-by-bit” or “character-by-character comparison”
- The transformation stage currently as specified from is unclear and does not take non-ASCII based scripts into account

Recommendation 13: The TMCH must add support for IDN variant TLDs. Particularly during the TM Claims service, a name registered under a TLD that has allocated variant TLDs should trigger trademark holder notifications for the registration of the name in all of its allocated variant TLDs.

Rationale:

- If an allocated and activated variant TLD's second-level label results in a match in the TMCH, then such registration must be reported to the trademark holders for the label
- If ICANN approves and delegates variant TLDs, it is important that the TMCH must support such a capability
- SSAC recommends that during the Claims period, a name registered under a TLD that has variant labels should trigger Claims notice for the registration of the name in the TLD and all its allocated variant TLDs

Review of All Rights Protection Mechanisms in All gTLDs PDP

- **Feb 2016:** GNSO Council initiated the PDP on the Review of All Rights Protection Mechanisms in All gTLDs PDP
 - **Phase 1 focuses on reviewing all RPMs applicable to New gTLD Program 2012 Round:**
 - Uniform Rapid Suspension System (URS)
 - Trademark Clearinghouse (TMCH)
 - Sunrise and Trademark Claims services offered through TMCH
 - Trademark Post-Delegation Dispute Resolution Procedure (TM-PDDRP)
 - **Phase 2 will focus on reviewing the Uniform Dispute Resolution Policy (UDRP)**
- **Nov 2020:** [Phase 1 Final Report](#) delivered to the GNSO Council
- **Jan 2021:** GNSO Council adopted the Phase 1 Final Report
- **Jan 2022:** ICANN Board adopted the Phase 1 Final Report - implementation effort ongoing

RPM PDP Phase 1 Final Report

TMCH Final Recommendation #2: The Working Group considered the following aspects of the TMCH:...2. Whether the current “exact match” rules should be changed or maintained...The Working Group’s recommendation...is that the status quo (i.e. the current rules as applied to the gTLDs delegated under the 2012 New gTLD Program round) should be maintained.

Sunrise Final Recommendation #4: In the absence of wide support for a change to the status quo, the Working Group recommends that the current availability of Sunrise registrations only for identical matches should be maintained, and the matching process should not be expanded.

Trademark Claims Final Recommendation #4: In the absence of wide support for a change to the status quo, the Working Group recommends that the current exact matching criteria for the Claims Notice be maintained.

Rationale: *The Working Group believes that the exact match criteria strike the appropriate balance of deterring bad-faith registrations without clear evidence that good-faith domain name applications are substantially deterred.*

TMCH Final Recommendation #1

...4. The TMCH Validation Provider(s), registry operators and other third parties may provide ancillary services to intellectual property rights-holders. To the extent that the TMCH Validation Provider validates and accepts other forms of intellectual property (such as geographical indications) in order to provide such additional voluntary services, these other forms of intellectual property must be held in a separate ancillary database.

Additional Agreements

The Working Group agreed not to develop any recommendation concerning:

- additional marketplace RPMs (as they are outside scope); or
- additional mandatory RPMs

F1: Discussion Questions (TBC)

F1: Are there any adjustments to the TMCH and its Sunrise and Trademark Claims services needed?

1. Should the matching rules of the TMCH be changed to calculate variant labels corresponding to a verified mark?
 - a. If so, should such a variant label be also included in the DNL list for the Trademark Claims service?
 - b. If so, should such a variant label be also included in the SURL list for the Sunrise service?
2. Should any enhancement be made to the TMCH to enhance protection for non-ASCII domain names generated from registered marks?
3. Do the provisions in the Trademark Clearinghouse Rights Protection Mechanisms Requirement provide sufficient flexibility to registry operators for managing variant domain name registrations during Sunrise and Trademark Claims period?

D6a: Should transfers ordered by the Uniform Domain Name Dispute Resolution Policy (UDRP) or any other dispute resolution mechanisms be treated the same way to follow the “same entity” requirement?

What is Uniform Domain Name Dispute Resolution Policy (UDRP)?

- Longest standing ICANN Consensus Policy (ICANN Board adoption in October 1999)
- Sets out the legal framework for the resolution of disputes between a domain name registrant and a third party over the abusive registration and use of a domain name in all gTLDs (some ccTLDs have voluntarily adopted this Policy)
- Administered by dispute resolution service providers accredited by ICANN, e.g., WIPO
- UDRP operation is based on two documents:
 - 1) Policy that sets out its scope, relief, and basis for mandatory administrative proceedings
 - 2) Rules that set out the procedural requirements that the administrative proceedings must follow

Who can use UDRP?

- Any person or company can file a domain name complaint concerning a gTLD using the UDRP

What types of disputes are covered by UDRP?

- Only available for disputes concerning an alleged abusive registration of domain name
- Must meet the following criteria:
 - Domain name is identical or confusingly similar to a trademark or service mark
 - Registrant has no rights or legitimate interests in respect of domain name in question
 - Domain name has been registered and is being used in bad faith

UDRP Basics (Cont.)

What are the various stages in the UDRP procedure?

The five basic stages are:

1. The filing of a Complaint with an ICANN-accredited dispute resolution service provider chosen by the Complainant
2. The filing of a Response by the person or entity against whom the Complaint was made
3. The appointment by the chosen dispute resolution service provider of an Administrative Panel of one or three persons who will decide the dispute
4. The issuance of the Administrative Panel's decision and the notification of all relevant parties
5. The implementation of the Administrative Panel's decision by the registrar(s) concerned should there be a decision that the domain name(s) in question be cancelled or transferred

What decisions can the UDRP Administrative Panel take?

Only three types of decisions can be made by the Administrative Panel:

1. Decide in favor of the person or entity that filed the Complaint and **order that the disputed domain name(s) be transferred to that person or entity**
2. Decide in favor of the person or entity that filed the Complaint and **order that the disputed domain name(s) be cancelled**
3. Decide in favor of the domain name registrant (i.e., deny the requested remedy)

UDRP Basics (Cont.)

What is the registrar's role in the UDRP proceeding?

1. To provide **requested information** to the dispute resolution provider, including:
 - confirming disputed domain name is registered with it
 - confirming it is registered by the person or entity identified as the Respondent in the Complaint
 - providing the Respondent's contact details and, when necessary, the Registration Agreement and associated documents
2. To **prevent the transfer** to a third party of a domain name registration after an Administrative Proceeding has commenced
3. To **implement the Administrative Panel's decision**

Can one still go to court if use the UDRP?

- Yes. It is possible for a party to start a lawsuit in court before a proceeding is commenced. A party can also commence a lawsuit after the proceeding is concluded if it is not satisfied with the outcome

UDRP Statistics

Numbers below extracted from [ICANN org's UDRP Policy Status Report](#) submitted to the GNSO Council in September 2022:

- Total **UDRP cases filed ranged from 4,157 cases in 2013 to 6,271 in 2020**, with a total of 38,349 UDRP complaints involving 67,318 domain names filed with UDRP Providers
- January 2013 - December 2020:
 - **over 32,000 UDRP decisions have been rendered**
 - **Complainants succeeded in obtaining the disputed domain name in about 78% of cases**, on average, across all dispute resolution Providers
- 2014 - 2019:
 - Number of **UDRP-related tickets received by ICANN has slightly gone up**
 - ICANN's Global Support Center (GSC) received **8,056 UDRP-related inquiries**. Around 61% of these inquiries involved **issues related to a trademark holder alleging cybersquatting or IP infringing domain name registrations**

D6a: Discussion Questions (TBC)

D6a: Should transfers ordered by the Uniform Domain Name Dispute Resolution Policy (UDRP) or any other dispute resolution mechanisms be treated the same way to follow the “same entity” requirement?

1. Is Preliminary Recommendation 7 adequate to address charter question D6a? If not, what additional Recommendation or Implementation Guidance may be required to address this question?

Charter Question D7a

D7a: Should the suspensions ordered by the Uniform Rapid Suspension System (URS) or any other dispute resolution mechanisms be treated the same way to follow the “same entity” requirement?

URS Basics

Purpose:

- Provide trademark owners with a **quick and low-cost process** to act against those **clear-cut cases** of intellectual property rights infringement and to combat cybersquatting
- **Complement to the UDRP**
- Substantive grounds upon for filing an URS Complaint are essentially similar to UDRP

Fees: Range from \$300-500 USD per proceeding

Procedure:

- Trademark holders files a Complaint to initiate an URS proceeding with a Provider
- Registry operator immediately **locks the domain** against changes
- Provider notifies the registrant who has fourteen (14) days to submit a response

Remedy:

- **Suspension of the domain name** for the balance of the registration period
- Complainant has the **option to extend suspension period** for one additional year

Key Difference with UDRP:

- Standard of proof required to succeed on a claim: **preponderance of the evidence** for UDRP vs. **clear and convincing evidence** for URS
- Remedy: Cancellation or transfer of the domain name for UDRP vs. suspension of the domain name for URS
- More differences, see pp.90-98: <https://newgtlds.icann.org/sites/default/files/rpm-review-11sep15-en.pdf>

URS Statistics (Compared against UDRP)

Year	UDRP Cases Filed Against Registrants	URS Cases Filed Against Registrants	UDRP Complaints to ICANN	URS Complaints to ICANN
2014	4,077	233	227	19
2015	4,192	220	250	11
2016	4,387	227	235	9
2017	4,561	163	213	12
2018	4,650	158	-	-

Source: <https://www.icann.org/resources/pages/cct-metrics-rpm-2016-06-27-en#1.9.a>

Phase 2 Preliminary Recommendation 6

Preliminary Recommendation 6: The “same entity” principle, as set out in Preliminary Recommendation 2, must be adhered to in all stages of the domain name lifecycle of the activated* variant domain names in the same variant domain set. The grandfathered variant domain names pursuant to Preliminary Recommendation 3 are exempt from this requirement.

** Terminology (e.g., “activated” vs. “allocated”) to be confirmed after discussion of glossary*

Rationale: “...**Lock:** Lock placed on one domain name does not necessarily mean the other activated variant domain names from the same variant domain set have to be locked at the same time. However, the lock will likely disable transfer of the affected variant domain set, as set out in Preliminary Recommendation 7.”

Suspension: Suspension placed on one domain name does not necessarily mean the other activated variant domain names from the same variant domain set have to be suspended as well.”