**Trademark Clearinghouse Questionnaire**

**Non-Trademark Holder Registrants**

Analysis Group, one of the largest private economic consulting firms in the United States, has been retained by ICANN to assess the effectiveness of Trademark Clearinghouse (TMCH) services. As part of this work, we are interested in the views of various groups that interact with either all or some of the TMCH services. To assess these views, we have developed a questionnaire, which is provided below.

We recognize the value of your time and appreciate your participation. The questionnaire should take less than 30 minutes to complete. Please answer as many questions as you are able. If you prefer to discuss the topics covered in this questionnaire rather than respond in writing, please contact us, and we can schedule a time to talk. Your feedback will not be attributed to you if shared publicly, unless you provide permission (see Question 4 below).

You may email your completed questionnaire to Stacey.Chan@analysisgroup.com. We appreciate receiving your response by Friday, May 6th. Thank you for your participation.

**Respondent Information**

Please provide the following information about yourself and/or your organization.

1. Your name – Kathy Kleiman
2. Your organization’s name – ICANN’s Noncommercial Users Constituency
3. Your email address – Kathy@kathykleiman.com
4. May we publicly attribute your responses to your organization?

Yes

No

1. May we contact you if we have follow-up questions based on your survey responses?

Yes

No

1. Which of the following best describes your organization:

Registry

Registrar

Trademark holder registrant

☒ Non-trademark holder registrant

TMCH agent

Other, please specify All future domain name registrants – everyone who will want to use a basic word or name in a domain name in the future.

**TMCH Claims Service and Sunrise Registration Period**

The purpose of the TMCH is to protect the trademark rights of rights holders. No: the purpose of the TMCH is to protect the rights of trademark holders for the roll-out of the New Generic Top Level Domains. The creation of potentially hundreds of new gTLDs at approximately the same gave rise to a need for a) every trademark owner not to have to register its trademark in a registry-specific trademark database for roll-out. It was efficient and expedient to put all the trademarks in one place. But is it fair, balanced or consistent with the legal limits of trademark law? We hope you will look at these goals of ICANN and the GNSO too… To this end, the claims service provides notifications to registered trademark holders if a domain is registered that may infringe upon their rights Actually: if a domain name is registered that happens to have the same letters as their trademark. Whether it is infringing or not - especially if it is a common dictionary word, a generic industry term, a common first name, an oft-found last name or a geographic term – is an entirely different issue. We would urge and request great specificity in your language and report to reflect the clear balance the GNSO’s STI Group (final drafters of these TMCH and related policies) sought to achieve. Trademark holders also are given priority to request domain names associated with their registered trademark(s) during the sunrise registration period. The questions in this section ask about the effectiveness of these two TMCH services. The question is also the fairness of these new policies. Should a trademark owner in shoe, e.g., MASSEY SHOES, have an automatic priority (right of first refusal, Sunrise registration option) in .HORSE and .BUILDING as well as .SHOE? For Massey Shoes may be a famous business in DC, but the Massey Family, related or unrelated, may have horses that run the Kentucky Derby and there is a big building in Northern Virginia called the Massey Building that is completely unrelated.

1. What are the positive aspects associated with the TMCH claims service and/or the sunrise registration period?
2. What improvements or changes would you like to see made to the TMCH claims service and/or the sunrise registration period?

Limitation of Sunrise to only those new gTLDs appropriate to the registered categories of goods and services of the trademark (e.g,. related to its international classes of goods and services). Otherwise the goal of the STI Group and the GNSO, to give trademark owners existing rights, but not greater than existing rights, is not achieved.

1. Please share any other thoughts you have regarding the TMCH claims service and/or sunrise registration period.

**Trademark Claims Service Notifications**

The claims service provides notices to potential domain name registrants when a domain name that the registrant is attempting to register matches an existing trademark on record in the TMCH. The questions in this section ask how you respond to receiving notifications.

1. Have you ever received a trademark claims service notification from a registrar?

Yes

No

Don’t know/Not sure

(If not, please skip to the next section.)

1. When you receive a notification from the registrar, what factors inform your decision to continue or abandon the registration?
   1. Did you have any difficulty receiving or understanding the notification?

Yes

No

Don’t know/Not sure

* 1. If so, did you ask registrar representatives or other individuals for help understanding the notification?

1. What type of information would have been useful to help you to better understand the notification that you received?
2. In situations where you receive a notification from the registrar and decide to abandon the original registration, did you try to find a different domain name to use instead?

Please figure out why so many, many, many, many Registrants are turning back. The STI tried to phrase the Trademark Claims notice for the specific purpose of not “chilling speech.” What can we do to make the Trademark Claims notice better, clearer, more easily understood and accessible – to that all legal, non-infringing and/or noncommercial registrations more easily and quickly go through?

**TMCH Protection of Trademark Holder Rights**

The original goal of the TMCH was to protect the existing rights of trademark holders without expanding or creating new rights. The questions in this section ask whether that goal is being achieved.

1. In your view, does the current TMCH system sufficiently protect the existing rights of trademark holders?

Yes

No

Don’t know/Not sure

1. If not, what additional protections do you think are needed?
2. In your view, does the current TMCH system provide increased protection to trademark holders, beyond their existing rights?

Yes

No

Don’t know/Not sure

1. If so, what protections do you think extend beyond trademark holders’ rights?

Per the above, the use of the TMCH registrations in the Sunrise Period of New gTLDs and in the TM Notice for New gTLDs is completely unrestricted or limited to the categories of goods and services or the international classifications in which the trademark is actually registered within its country. In allowing trademark owners to pre-register a second level domain name in a new gTLD completely unrelated to its goods and services during Sunrise, we deprive a future domain name registrant – legitimately tied to this new gTLD and with a future legal and legitimate good, service, organization or group name – from using that name in the domain name. We give it to a company with no legal right and deprive all with legitimate future rights. That makes no sense and is radically unfair to the millions of current Registrants and the billions of future Registrant who will come online.

Ditto for the sending of a TM Claims notice purely because the string of letters happens to match the registration. TM Claims Notices should be sent only when the New gTLD matches the category of goods and services of the registered trademark. Otherwise, the process of “scaring off” the Registrant is too broad. Registrants (including entrepreneurs, small businesses, individuals, noncommercial organizations) should only experience the TM Notice (and its clearly very successful chilling effect) if the trademark first matches or corresponds to the type of services the New gTLD is intended to cater to. Otherwise, the trademark protection is far broader under the TMCH than trademark law in the “real world” – contrary to the intentions of the STI, GNSO and ICANN. Your assistance on this narrowing process would be greatly appreciated!

**TMCH Trademark Matching Criteria**

Currently, the TMCH sends notices of potential trademark infringement when applicants attempt to register domains that are exact matches of trademarked strings. The questions in this section ask your opinion regarding expanding the matching criteria.

1. What are your thoughts regarding the costs and benefits of expanding the matching criteria?

Thoughts above – the matching process needs to be narrowed, not expanded.

**Claims Service Period**

Currently, registries are required to provide claims service for 90 days. The questions in this section ask your opinion regarding extending the claims service period.

1. In your view, would it be useful to expand the claims service period beyond 90 days?

Yes

No

Don’t know/Not sure

Clearly, hundreds of thousands of good faith registrants are being turned back. The STI Group was deeply worried about the “chilling effect” of the TM Notice (although we drafted it to be a lighter touch). To expand the TM Notice and the Chilling Effect even farther is to hurt legitimate registrants who have valid legitimate and legal reasons to register the domain names that they need for their new businesses, new products and services, new clubs, new groups, new organization and new children.

* 1. If yes, what is the length of time you would have the claims service period cover? If not, why not? No, no and no.

1. In your view, how would such an extension impact your organization?

Such an extension would badly harm all current and future noncommercial organizations by not allowing them to timely register domain names that will allow them to launch their campaigns, raise awareness, focus on concerns, build funding, organize members and launch websites, listservs and email addresses in a timely manner – based on legal and legitimate names that they have chosen. Happy to explain this deep concern at greater length.