

Trademark Claims Notification Process Flow

May 15, 2011

All new gTLD registries will be required to offer the Trademark Claims service using information stored in the Trademark Clearinghouse (CH). Although not specific in the latest Draft Applicant Guidebook, we have made the following assumptions:

1. Trademark Claims Notifications to prospective registrants for domain names that match Trademark Claims will commence after the completion of the Sunrise registration period
2. Therefore, during the Sunrise period, prospective registrants will not be displayed TM Claims notices. However, at the conclusion of the Sunrise period, TM Claimants in the CH will receive notice of just-accepted sunrise registrations.
3. “General Registration” shall mean the time period following the Sunrise Period in which domain names in the TLD are made generally available to registrants who are otherwise qualified to register domain names in the TLD. This can be accomplished through any one of a number of processes including, but not limited to, first-come first –served, founders programs, auctions, etc.
4. The Trademark Claims Notification process shall last for a time period of no less than sixty (60) days following the launch of “General Registration” and shall end according to a schedule announced by the Registry.

The Trademark Claims Notification service is designed to perform two functions:

1. Notify a prospective Registrant that a domain name has one or more Trademark Claims associated with it, provide the information necessary to research the claim, and allow the prospective Registrant to make an informed decision about the registration, prior to the completion of the registration; and
2. Notify the Trademark Claimant(s) that a domain name has been registered.

There are four discrete steps involved in the Trademark Claims Notification process:

Step 1. Trademark Claim submission and validation by CH.

Step 2. CH shares list of registrable strings with TM Claims along with relevant trademark data with the gTLD Registry Operators (each a “Registry”, collectively, the “Registries”).

Step 3. Registrar displays Trademark Claim notice (based on data from the CH) to Registrant, who decides whether to proceed with the registration

Step 4. If the registration is completed, notice of domain registration sent to Trademark Claimant(s).

High Level Data Flow :

Step 1. Trademark Claim submission and validation process.

In order to be eligible to participate in the Trademark Claim Notification service, a trademark owner must submit a claim application to the CH for validation and must have been validated by the CH in accordance with the criteria set forth by ICANN in the Draft Applicant Guidebook.

Step 2. CH shares list of validated Trademark Claims with Registries.

The CH is responsible for providing two critical pieces of information to new gTLD Registries and Registrars:

1. List of eligible registrable strings that will trigger TM Claims notices; and
2. The trademark information and boilerplate required for TM Claims notices.

Prior to the launch of the post-Sunrise registration process in a given new gTLD, the CH shall share the list of strings impacted by TM Claims with the Registry. This allows the Registry and its Registrars, at their option, to handle TM Claim Notification processing with Registrants without any operational dependencies on the CH during the registration process.

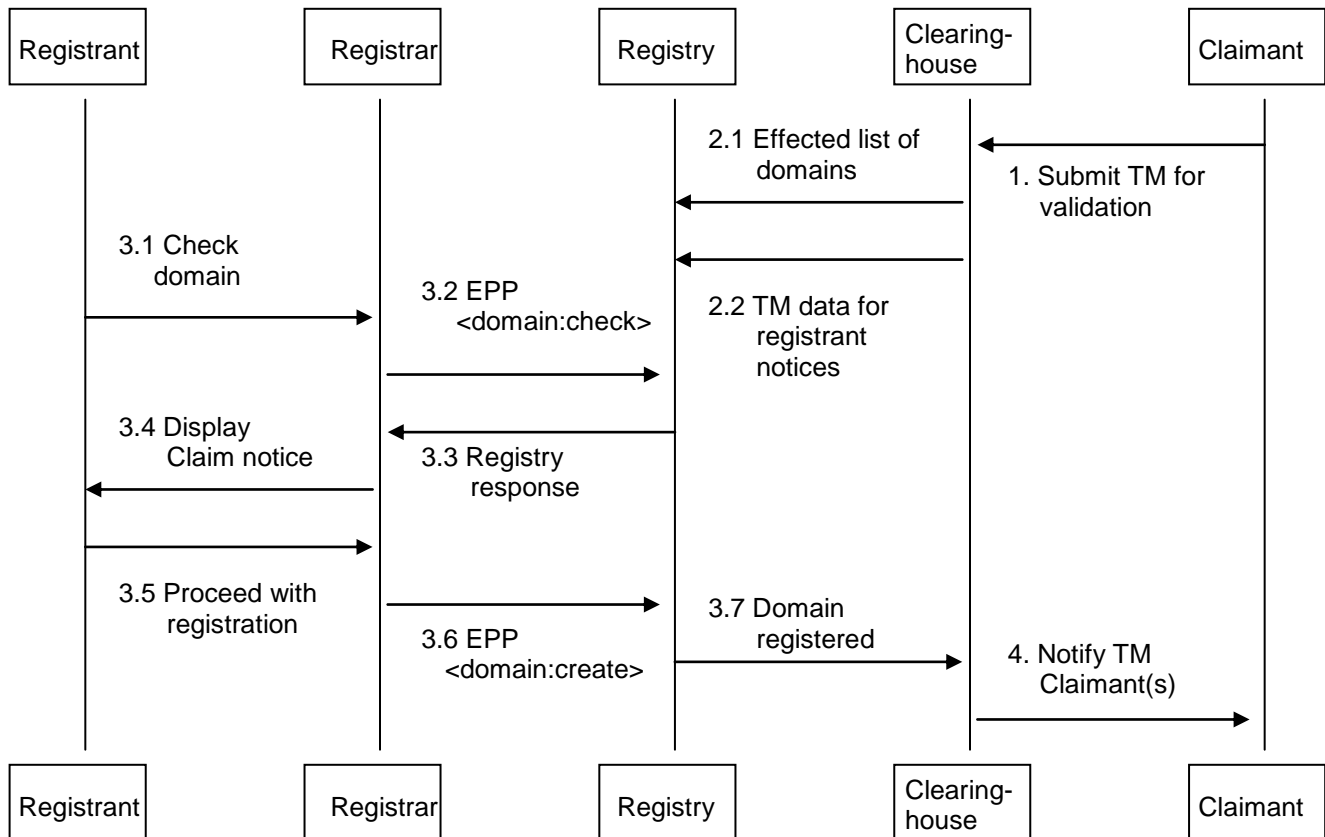
Although Registries shall have the option of querying the CH real time to see if a Trademark Claim exists for a given domain name, for some Registries, this will may introduce an additional point of failure during the point-of-sale registration process. Instead, if Registries are provided with a list of all potential domain name strings associated with Trademark Claims, the Registries themselves may elect to handle real time queries to see if a Trademark Claim exists for a given domain name. This initial file must be provided to the Registry within a reasonable period prior to General Registration to enable Registries to adequately prepare for TM Claims processing. A Registry may elect, but shall not be required, to receive updates of this file from the CH during its Trademark Claims period and incorporate them into their general registration process.

The CH will also provide a database of the trademark claim information necessary to generate the notices displayed to Registrants in multiple languages (as required by ICANN).¹ . In order to minimize operational dependencies, a copy of this database will be made available to Registries desiring to host it themselves.

Step 3. Registrar displays Trademark Claim notice to Registrant.

Prospective Registrants must be notified of a Trademark Claims' existence prior to completing the registration of a domain name that has one or more Trademark Claims associated with it. Registrars could retrieve this information through a publically available service utilizing common protocols such as DNS, via WHOIS, Web or RESTful API. One possible solution is a query/response scheme that allows registrars to query for the string and receive all the claims information covering that string. The CH should work to standardize this retrieval mechanism in order to simplify operations for the Registry/Registrar community. In instances where the Registry is allocating a string directly to a Registrant, then the Registry could also access the trademark claims database to display the claim notice directly to the Registrant.

¹ When trademark owners submit applications to the CH, they will be given the option of including a description of their goods/service in each of the UN Sponsored languages for which it wants include in Trademark Claim notices. If the trademark owner elects not to provide translations of the goods/services, The CH shall not be required to perform translations of descriptions of goods/services in the Trademark Claim. The CH will provide Registries with translations for the Trademark Claim boilerplate language (Send link).



The process flow for Step 3 is as follows:

- 3.1. Prospective Registrant queries the availability of a domain name at their Registrar
- 3.2. Registrar sends the availability <domain:check> EPP command to Registry
- 3.3. Registry responds with domain’s availability and Trademark Claims indicator (via an extension to domain:check).
- 3.4. If there is a Trademark Claim associated with a requested domain name, the Registrar generates Trademark Claim notice and displays to the Prospective Registrant (as further described below).
 - 3.4.1 The Registrar retrieves the claim information from the URL returned in the check command or from the CH or Registry-provided string/claims response system.
 - 3.4.2 With the claim information, the Registrar can direct the Registrant to the CH for further information as required by ICANN in the Applicant Guidebook.
- 3.5. After receiving the notice and claim information, the Prospective Registrant elects whether or not to continue with registration.
- 3.6. If the Prospective Registrant elects to continue, Registrar sends a <domain:create> EPP command to Registry a verification flag is included in the create command by the Registrar to confirm to the Registry that the Registrant has been displayed the claims notice.

3.7. Registry notifies CH that domain has been registered² and the CH subsequently notifies the Claimant (according to processes defined elsewhere).

Notes on Step 3.3: Registries may choose to host its own copy of the Trademark Claim information to eliminate the need for Registrars to query the CH in real time for Trademark Claims information and mitigate the risks associated with any downtime of the CH. Thus, in Step 3.3 above, we are recommending that the Registry's response should also include a URL to the Trademark Claims information (hosted by the CH or Registry) to facilitate retrieval by the Registrar and allow the Registrar to generate the Trademark Claims notices described in Step 3.4 below.

Notes on Section 3.4: In Step 3.4, in the event that the Registry indicates to the Registrar in response to its availability check that the domain is in fact available and there is a Trademark Claim associated with the particular string, the Registrar shall be responsible for using the information provided by the Registry in Step 3.3 to display the Trademark Claims notice to the Prospective Registrant.

Step 4. Notice of registration sent to Trademark owner(s).

The Draft Applicant Guidebook requires that Trademark owners with active Trademark Claims in the CH shall be notified after a matching domain name is registered. Although the DAG states that the Registrar should be responsible for submitting these notices, we believe it makes more sense to have the notices provided via the CH given the fact that it is the CH that has the relationship with the Trademark Claimants and not the Registrant's selected Registrar. In order to assist the CH, Registries should be required to provide the CH with a file of all registered names that match the list of Trademark Claims previously provided by the CH to the Registries under Step 2. Registries shall be required to provide this file to the CH on a daily basis during the General Registration Period when the IP Claims process is active.

² If a Registry allocates domain names in a method other than through a "Create" command, the process described in Step 3 may not be sufficient. In such a case, the Registry must ensure that it provides Trademark Claims notices directly to the Registrants and obtain the Registrant's acknowledgement to proceed in accordance with the Draft Applicant Guidebook. An example where this may be utilized is in the case of an initial auction for domain names during the landrush phase in which the Registry initially reserves all premium names that will be subjected to an auction. As in the case with Neustar's phased allocation program for 1 and 2 character .BIZ domain names, once a winner was announced, the registry provided the winner with an "auth code" and rather than submitting a "create" request, the winner's registrar initiated a transfer request using the auth code.