

Q7 Proposals

(2) Proposal submitted by Greg Shatan:

1. Section 3.2 of the Applicant Guidebook describes the marks that may be accepted into the TMCH Database as “word marks.” However, the term “word mark” is not defined in the AGB. This has created ambiguity and the potential for misunderstanding.
 - a. Specifically, it appears that marks may have been accepted into the TMCH Database where all of the words in the mark have been disclaimed.
 - b. This ambiguity should therefore be clarified.
2. The Working Group recommends that Section 3.2 of the Applicant Guidebook be revised to use the term “text marks” rather than “word marks.” “Text marks” would be defined to consist of:
 - a. Marks consisting of text only, including marks where the text is portrayed in color, in a typeface (or typefaces), in a logo form, in a fanciful manner, and/or otherwise portrayed in a stylized fashion, as well as “standard character” marks.
 - b. Marks consisting of text in combination with design elements or devices, sometimes referred to as, e.g., composite marks or figurative marks, except for marks where the text portion of the mark is disclaimed in its entirety.

3. The Working Group recommends that the Trademark Clearinghouse Guidelines be revised as follows:

An Applicant to the Trademark Clearinghouse must include in its application a sworn statement that the trademark registration does not include a disclaimer as to any portion of the mark, or if it does, the text portion of the mark is not disclaimed in its entirety. Where the text portion of a mark is disclaimed in its entirety, the mark is not eligible for registration in the Clearinghouse.

For marks that are Text Marks that do not exclusively consist of letters, words, numerals, and/or special characters, the recorded name of the Trademark will be deemed to be an identical match to the reported name as long as the name of the Trademark includes letters, words, numerals, signs, keyboard signs, and punctuation marks (“Characters”) and all Characters are included in the Trademark Record submitted to the Clearinghouse in the same order they appear in the mark.

In the event that there is any doubt about the order in which the Characters appear, the description provided by the Trademark office will prevail. In the event no description is provided, such Trademarks will be allocated to a Deloitte internal team of specialists with thorough knowledge of both national and regional trademark law who will conduct independent research on how the Trademark is used, e.g. check website, or they may request that the Trademark Holder or Trademark Agent provide additional documentary evidence on how the Trademark is used.

4. The Working Group recommends that the Trademark Clearinghouse Guidelines be revised as follows:

The Trademark Clearinghouse should not accept for inclusion marks where all textual elements are disclaimed and as such any Characters are only protectable as part of the entire composite mark including its non-textual elements.

5. The Working Group recommends that a ***new grounds to the challenge procedure be added to assess whether the underlying trademark registration was obtained in bad faith as a pretext solely to obtain a Sunrise registration.***

In preparing the grounds for such challenges, guidance may be drawn from the pre-delegation Legal Rights Objection consideration factors: <http://www.wipo.int/amc/en/domains/lro/faq/#3a> and the judgement of the European Court of Justice in Case C-569/08 Internetportal und Marketing GmbH v. Richard Schlicht <http://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?isOldUri=true&uri=CELEX:62008CJ0569> .