

**Subject:** Re: [GNSO-RPM-WG] Proposal re Q8.  
**Date:** Thursday, October 10, 2019 at 12:25:33 PM Eastern Daylight Time  
**From:** GNSO-RPM-WG on behalf of Tushnet, Rebecca  
**To:** Julie Hedlund, Paul Tattersfield  
**CC:** gnso-rpm-wg  
**Attachments:** ATT00001.txt

Here is what I have:

Rationale:

1. The TMCH Database is for trademarks: those that are registered as trademarks, confirmed by court decision as trademarks, or protected by statute or treaty that specifies the trademarks covered. Sunrise and TM Claims are for the protection of trademarks only. Geographical Indications/Appellations of Origin (“GIs”) are not eligible for protection in the mandatory Sunrise or Claims periods, save where they also qualify as trademarks.
2. Non-trademarks or other identifiers can be the subject of ancillary databases that may be voluntarily used by registries to provide additional services other than the Sunrise and Trademark Claims mandated under the existing RPMs Requirements. Other ancillary service providers may compete to provide these services.

Required actions:

1. GIs may not be registered in the TMCH Database used for Sunrise or Trademark Claims under the theory that they are marks protected by statute/treaty. If they are not also eligible for the TMCH Database as trademarks, any GIs presently in the TMCH Database should be removed.
2. “Other marks that constitute intellectual property” are not eligible for Sunrise or Trademark Claims. If and when the TMCH provider adds ancillary databases covering “other marks,” it should revise its public-facing materials to make this distinction clear.

Proposals for amended language (new language in **bold**):

### 3. CRITERIA FOR TRADEMARK INCLUSION IN CLEARINGHOUSE...

“3.2.3 Any word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion.” This language should be amended to read “3.2.3 Any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion; **the word mark protected by statute or treaty must be a trademark.**” An explanatory footnote to 3 should be added:

**The Clearinghouse is for word marks that are trademarks. “Trademarks” here includes trademarks, service marks, collective marks, and certification marks. Geographic indications (that are not also protected as trademarks) are not trademarks.**

"3.2.4 - other marks that constitute intellectual property" should be amended:

**Marks not eligible for inclusion in the Trademark Clearinghouse: Other marks or identifiers that constitute intellectual property may not be used for the purposes of Sunrise or Claims under the existing RPMs, as set forth in Section 7. Such marks or identifiers may be collected to support the services any given registry operator chooses to provide, solely for the purpose of providing ancillary services as set forth in Section 3.6.**

3.5 should be amended for consistency with the revisions to 3.2.3.

Finally, 3.6 should itself be amended to clarify: “Data supporting entry into **databases that are separate from the Clearinghouse and used to provide ancillary services** of marks that constitute intellectual property of types other than those set forth in sections 3.2.1-3.2.3 above shall be determined by the registry operator and the Clearinghouse, **or other provider chosen by the registry operator**, based on the services any given registry operator chooses to provide, **consistent with 4.1.**”

For reference: Current 4.1: ... There shall be no bar on the Trademark Clearinghouse Service Provider or other third party service providers providing ancillary services on a non-exclusive basis.

Rebecca Tushnet  
Frank Stanton Professor of First Amendment Law, Harvard Law School  
703 593 6759

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