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Summary of Proposals relating to Open TMCH Charter Questions
Draft prepared by ICANN staff (originally circulated on 17 May 2017; TMCH/AGB references added on 27 August 2019)

As of 28 April 2017, the questions below are those that are currently open as part of the initial TMCH review. All other questions have either been deferred for further review following the Working Group’s discussion of Sunrise and Claims Notifications, or agreed as not requiring further discussion at this time. For details on these other questions, please refer to the “[TMCH Next Steps Table – updated 30 March 2017](#)” on the following wiki page: <https://community.icann.org/x/Jb-RAw>.

Please note: To assist the WG’s deliberations on the open questions, RPM WG Co-Chairs suggested adding relevant rules from the [Applicant Guidebook \(AGB\)](#) and the [TMCH Guidelines](#) in columns 3-4. Note that Q7 and Q8 reference the same rules in the AGB and TMCH Guidelines. Due to space limitations, only partial quotes have been included. Please click the page links for the complete text.

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TMCH Category 3: Breadth & Reach (Scope)			
Q7. How are design marks currently handled by the TMCH provider?			
<p>(1) Proposal submitted by Kathy Kleiman:</p> <p>We (the RPM Working Group) have found a problem:</p> <ol style="list-style-type: none"> We have learned that Deloitte is accepting the words of design marks, composite marks, figurative marks, stylized marks, mixed marks, and any similar combination of characters and design (collectively “design marks”). 	<p>WG discussing whether the TMCH should accept only word marks (i.e. standard character marks) and what, if any, design marks should be included – e.g. stylized text marks (where the</p>	<p>AGB (see full text on pages 292-293)</p> <p>3.2 The standards for inclusion in the Clearinghouse are:</p> <p>3.2.1 Nationally or regionally registered word marks from all jurisdictions.</p>	<p>TMCH Guidelines (see full text on pages 8-18)</p> <p>2.2. Registered trademarks</p> <p>A registered trademark is a nationally or regionally (i.e.,</p>

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<p>2. However, the rules adopted by the GNSO Council and ICANN Board expressly bar the acceptance of design marks into the TMCH Database.</p> <p>3. Accordingly, <i>Deloitte is currently in breach of the rules that ICANN adopted and must revise its practice to follow the rules adopted by the GNSO Council and ICANN Board for TMCH operation.</i></p> <p>4. <i>Alternatively, the Working Group by Consensus may CHANGE the rules and present the GNSO Council and ICANN Board with an expanded set of rules that Deloitte, or any future TMCH Provider, must follow.</i></p> <p>5. <i>In all events, we have a BREACH SITUATION which must be remedied.</i> Further details, information and explanation below¹.</p> <p><u>(2) Proposal submitted by Greg Shatan:</u></p> <p>1. The Working Group recommends that the Trademark Clearinghouse Guidelines be revised as follows:</p> <p><i>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.</i></p>	<p>text may be either descriptive or distinctive), and composite “text+design” marks (where the text may not have been disclaimed)</p>	<p>3.2.2 Any word mark that has been validated through a court of law or other judicial proceeding.</p> <p>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.</p> <p>3.2.4 Other marks that constitute intellectual property.</p> <p>3.2.5 Protections afforded to trademark registrations do not extend to applications for registrations, marks within any opposition</p>	<p>multi-nationally) registered mark on the principal or primary register in the mark’s jurisdiction. This means that the trademark in question must have national effect and be registered at the time it is submitted for verification.</p> <p>2.3. Court validated marks</p> <p>Court validated marks refer to a mark that has been validated by a court of law or other judicial proceeding at the national level,</p>

¹ Where a proposal was sent with accompanying rationale, staff has extracted the rationale and compiled it in the Additional Table immediately following this initial table (see Pages 7-19).

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<p><i>For marks that are Text Marks that do not exclusively consist of letters, words, numerals, 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.</i></p> <p>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.</p> <p>2. The Working Group recommends that the Trademark Clearinghouse Guidelines be revised as follows:</p> <p><i>The Trademark Clearinghouse should <u>not</u> accept for inclusion marks where all textual elements are disclaimed and as such are only protectable as part of the entire composite mark including its non-textual elements.</i></p>		<p>period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings.</p>	<p>such as unregistered (common law) marks and/or well-known marks. In the case of a mark validated by judicial proceedings, the judicial authority must have existed as a competent jurisdiction as of the date of the order or judgment. Any referenced authority must have the indicia of authenticity and must on its face confer the specified rights (i.e., the documentation must be sufficient to show validation of the mark without the need for the Clearinghouse to consult outside resources).</p>

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<p>3. The Working Group recommends that a <i>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.</i></p> <p>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/?isOIdUri=true&uri=CELEX:62008CJ0569.</p>			<p>2.4. Marks protected by statute of treaty For marks protected by statute or treaty, the relevant statute or treaty must be in effect at the time the mark is submitted to the Clearinghouse for inclusion. These marks may include but are not limited to: geographical indications and designations of origin.</p>
<p>Q8. How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?</p>			
<p><u>(1) Proposal submitted by Paul McGrady:</u></p> <p>GIs are not always trademarks. The TMCH is a place to lodge trademarks. <i>Unless a GI is the subject of a national trademark registration, it should not be in the future, and should not have been in the past, included in the TMCH.</i></p>		<p>AGB (see full text on pages 292-293) 3.2 The standards for inclusion in the Clearinghouse are:</p>	<p>TMCH Guidelines (see full text on pages 8-18) 2.2. Registered trademarks</p>

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<p><i>For any GIs that are not the subject of a national trademark registration which are currently lodged in the TMCH, such GIs should not be renewed in the TMCH upon expiration. For any GIs that are currently in the TMCH that are the subject of a national trademark registration, such GIs should be subject to the same use requirements as traditional trademarks as applied to Sunrise registrations.</i> To the extent that there is interest in finding a mechanism to lodge GIs that are not the subject of national trademark registration for use in as yet unidentified RPMs, study of the concept should be split off from this work and given its own study and thought.</p> <p><u>(2) Proposal Submitted by Kathy Kleiman:</u></p> <p>It is with considerable interest that the RPM WG has evaluated the question of Deloitte accepting into the TMCH database marks protected by statute or treaty. In our investigation we have found:</p> <ol style="list-style-type: none"> 1. The wording that creates this subcategory of protected marks does not come from the recommendations adopted by the GNSO Council or ICANN Board; 2. Everyone who sees these rules interprets them differently: <ul style="list-style-type: none"> ● Some think it is solely to protect those marks expressly set out in treaty, e.g., “Olympics” ● Others think it is to protect categories of organizations, such as International Governmental Organizations; and 		<p>3.2.1 Nationally or regionally registered word marks from all jurisdictions.</p> <p>3.2.2 Any word mark that has been validated through a court of law or other judicial proceeding.</p> <p>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.</p> <p>3.2.4 Other marks that constitute intellectual property.</p> <p>3.2.5 Protections afforded to trademark registrations do not extend to applications for registrations, marks</p>	<p>A registered trademark is a nationally or regionally (i.e., multi-nationally) registered mark on the principal or primary register in the mark’s jurisdiction. This means that the trademark in question must have national effect and be registered at the time it is submitted for verification.</p> <p>2.3. Court validated marks</p> <p>Court validated marks refer to a mark that has been validated by a court of law or other judicial proceeding at</p>

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<ul style="list-style-type: none"> ● Still others think it is to protect such as geographical indications. <p>3. Deloitte will not explain how they interpret this section or what they are accepted into the TMCH database.</p> <p>4. Acceptance of “marks protected by statute or treaty” appears to be a direct violation of the original intent and instructions of the rules adopted by the GNSO Council and ICANN Board.</p> <p>Specifically, Item 1.1 of the TMCH rules adopted by the Council and Board provides for only acceptance of trademarks: “The name of the rights protection mechanism should be the ‘Trademark Clearinghouse’ to signify that only trademarks are to be included in the database.”</p> <p>Section 1. Name; 1.1 Trademark Clearinghouse; https://gnso.icann.org/en/issues/sti/sti-wt-recommendations-11dec09-en.pdf</p> <p>Second, by these adopted rules, <u>anything that is not a trademark cannot be entered into the main TMCH Database, but may be segregated into another “ancillary database”</u>: “The TC Service Provider should be required to maintain a separate TC database, and may not store any data in the TC database related to its provision of ancillary services, if any.”</p> <p>Section 2, Functionality of the Trademark Clearinghouse, 2.3 Segregation of the Trademark Clearinghouse Database.</p>		<p>within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings.</p>	<p>the national level, such as unregistered (common law) marks and/or well-known marks. In the case of a mark validated by judicial proceedings, the judicial authority must have existed as a competent jurisdiction as of the date of the order or judgment. Any referenced authority must have the indicia of authenticity and must on its face confer the specified rights (i.e., the documentation must be sufficient to show validation of the mark without the need for the Clearinghouse to</p>

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<p>Finally, the limitations above were passed by “Unanimous consent” of all Stakeholder Groups in the STI, and then adopted unanimously by the GNSO Council and ICANN Board.</p> <p><i>Accordingly, the rules adopted by the GNSO Council and ICANN Board are very clear: the Trademark Clearinghouse is for Trademarks.</i></p> <p><u>(3) Proposal submitted by Jonathan Agmon:</u></p> <p>GIs comprise of word marks. When registered, GIs serve as collective trademarks. If a GI is the subject of a national trademark registration, or a national GI registration, it could have been, in the past, and may be included, in the future in, the TMCH. For any GIs that are not the subject of a national trademark or GI registration, or otherwise qualified for registration under the Trademark Clearinghouse Guidelines, at the time of registration, which are currently registered in the TMCH, such GIs should not be renewed in the TMCH upon expiration.</p> <p><u>(4) Proposal submitted by Claudio di Gangi:</u></p> <p>(1) Add the consideration of GIs to the policy review of the Sunrise and Claims services; and (2) withhold final consideration of the current TMCH proposals relating to GIs, until we conclude the policy review of the new gTLD RPMs (as described in the Charter).</p>			<p>consult outside resources).</p> <p>2.4. Marks protected by statute of treaty For marks protected by statute or treaty, the relevant statute or treaty must be in effect at the time the mark is submitted to the Clearinghouse for inclusion. These marks may include but are not limited to: geographical indications and designations of origin.</p>

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<p>Q10. Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, ‘marks contained’ or ‘mark+keyword’, and/or common typos of a mark?</p>			
<p><u>(1) Proposal submitted by Michael Graham:</u></p> <p>We (the RPM Working Group) have identified a minor change in current TMCH Trademark Claims Service practices that could benefit both Domain Name Applicants and Trademark Owners:</p> <ol style="list-style-type: none"> 1. We have become aware that Domain Name Applicants (Applicants) and Trademark Owners who have registered their trademarks in the TMCH (TMCH Trademarks) have both sustained unnecessary expense in time, effort, and planning when Domain Names that have proceeded to registration contain strings that are confusingly similar to TMCH Trademarks are challenged after their registration. 2. Current Trademark Claims Notice rules limit the issuance of Notifications to applications that consist solely of the exact TMCH Trademark. 3. As a result, Applicants are unaware of potential conflicts and may proceed with expending time, money and planning on the use of Domain Names that may be challenged. 4. Applicants should have the ability to consider whether to proceed with their planning and use of Domain Names in light of TMCH Trademarks at the earliest 	<p>WG notes that this proposal is limited to:</p> <ul style="list-style-type: none"> ● TM Claims ● Plurals and “marks containing the TM” 	<p>AGB (page 296)</p> <p>6.1.5 The Trademark Clearinghouse Database will be structured to report to registries when registrants are attempting to register a domain name that is considered an “Identical Match” with the mark in the Clearinghouse. “Identical Match” means that the domain name consists of the complete and identical textual elements of the mark. In this regard:</p>	<p>TMCH Guidelines (pages 21-22)</p> <p>4.2 Identical Match For purposes of the trademark claims and sunrise services, “Identical Match” means that a domain name label is an identical match to the trademark, meaning that the label must consist of the complete and identical textual elements of the trademark in accordance with section 4.2.1 of the Clearinghouse Guidelines.</p>

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<p>opportunity in order to conserve fees and planning efforts.</p> <p>5. Trademark Owners should have the ability to identify both Domain Names that could create confusion and those that will not at the earliest opportunity.</p> <p><u>Proposal:</u> <i>The TMCH Rules should be revised to require Trademark Claims Notices be issued not only for Domain Names that consist of the Exact string of TMCH Trademarks, but also of any Domain Name that includes anywhere in the string the Exact string of TMCH Trademarks.</i></p> <p>In addition, we believe the success of the Trademark Claims Service in enabling both trademark owners and domain name applicants to learn of potential conflicts from an early stage in the application process -- when changes can be made or applications either abandoned or continued with the least expense of time, effort, or disruption – would support expansion of the service beyond the new gTLDs. For the same reasons, we propose the following:</p> <p><u>Proposal:</u> <i>The Trademark Claims Service and TMCH registration program should be expanded to apply to all Legacy TLDs as well as New gTLDs.</i></p>		<p>(a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted; (b) only certain special characters contained within a trademark are spelled out with appropriate words describing it (@ and &); (c) punctuation or special characters contained within a mark that are unable to be used in a second-level domain name may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches; and (d) no plural and no “marks</p>	<p>TMCH Requirements (pages 11-12)</p> <p>4.1 Matching.</p> <p>4.1.1 For purposes of the Sunrise Services and Claims Services, matching 4.4 Service Levels. ICANN MUST use commercially reasonable efforts to ensure accordance with the Trademark Clearinghouse’s domain name matching rules and made available to Registry Operator on the Domain Name Label List (as mentioned in the Functional Specifications).</p> <p>4.1.2 Registry Operator MAY implement additional matching rules at the</p>

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		<p>contained” would qualify for inclusion.</p> <p>6.2.1 Sunrise registration services must be offered for a minimum of 30 days during the pre-launch phase and notice must be provided to all trademark holders in the Clearinghouse if someone is seeking a sunrise registration. This notice will be provided to holders of marks in the Clearinghouse that are an Identical Match to the name to be registered during Sunrise.</p>	<p>TLD level, provided that the Claims Services are still implemented for any Claims Registration satisfying such additional matching rules.</p> <p>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 Domain Name Label List before any domain names in the set are registered.</p>

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RATIONALE AND ADDITIONAL CONTEXT FOR THE PROPOSALS

Q7. How are design marks currently handled by the TMCH provider?

Rationale for the proposal submitted by Kathy Kleiman:

A. Expressly Outside the TMCH Rules Adopted by the GNSO Council & ICANN Board

The GNSO Council & ICANN Board-adopted rules (based on the STI Final Report and IRT Recommendations) that were very clear about the type of mark to be accepted by the Trademark Clearinghouse:

“4.1 National or Multinational Registered Marks The TC Database should be required to include nationally or multinationally registered “text mark” trademarks, from all jurisdictions, (including countries where there is no substantive review).” <https://gns0.icann.org/en/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

Further, the adopted rules themselves are very clear about the Harm of putting design marks into the TMCH Database:

“[Also 4.1] (The trademarks to be included in the TC are text marks because “design marks” provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.)

The Applicant Guidebook adopted the same requirements, as it must and should, namely:

“3.2: Standards for inclusion in the Clearinghouse

3.2.1 Nationally or regionally registered word marks from all jurisdictions”

Nonetheless, and in violation of the express rules adopted by the GNSO Council and ICANN Board and placed into the Applicant Guidebook, TMCH Provider Deloitte is accepting into the TMCH database words and letters it has extracted from composite marks, figurative marks, stylized marks, composite marks and mixed marks. Deloitte is removing words and letters from designs, patterns, special lettering and other patterns, styles, colors, and logos which were integral to the trademark as accepted by the national or regional trademark office.

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B. Harm from the Current Form

The harm from this acceptance is that it violates the rules under which Deloitte is allowed to operate. It creates a situation in which Deloitte is operating under its own authority, not that of ICANN and the ICANN Community. Such action, in violation of rules clearly adopted by the GNSO Council and ICANN Board and written into the New gTLD Applicant Guidebook, gives too much power to Deloitte -- a contractor of ICANN, to make its own rules and adopt its own protocol without regard to the scope, breadth and reach of the governing rules.

It is the type of misconduct anticipated by the GNSO Council and ICANN Board, and why the rules demand that ICANN hold a close relationship with the TMCH Provider *by contract* to allow close oversight and correction of misinterpretation or failure to follow the rules. (See, 3.1 in *Relationship with ICANN*, Special Trademark Issues Review Team Recommendations).

C. Presumption of Trademark Validity Does Not Extend to Non-Stylized Version of the Registration Marks

Further, words and letters within a composite marks, figurative marks, stylized marks, and mixed marks are protected within the scope of the designs, logos, lettering, patterns, colors, etc. That's not a Working Group opinion, that's a legal opinion echoed through case law and UDRP decisions.

In WIPO UDRP Decision *Marco Rafael Sanfilippo v. Estudio Indigo*, Case No. D2012-1064, the Panel found:

“Complainant has shown that it owns two trademark registrations in Argentina. The Panel notes that both registrations are for “mixed” marks, where each consists of a composition made of words and graphic elements, such as stylized fonts, a roof of a house, etc. See details of the registrations with drawings at section 4 above.

“As explained on the INPI website, “[m]ixed (marks) are those constituted by the combination of word elements and figurative elements together, or of word elements in stylized manner.” Accordingly, the protection granted by the registration of a mixed mark is for the composition as a whole, and not for any of its constituting elements in particular. Thus, Complainant is not correct when he asserts that it has trademark rights in the term “cabañas” (standing alone), based on these mixed trademark registrations.”

Similarly, in the US, federal courts have found that **the presumption of trademark validity provided by registration does not extend to the non-stylized versions of the registration marks**. See e.g.,

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<p><i>Neopost Industrie B.V. v. PFE Intern., Inc.</i>, 403 F.Supp.2d 669 (N.D. Ill. 2005) (registration of stylized mark didn’t extend protection to nonstylized uses); <i>Kelly–Brown v. Winfrey</i>, 95 F.Supp.3d 350, (S.D.N.Y. 2015) (dealing with special form mark whose words were unprotectable absent stylization), <i>aff’d</i>, <i>Kelly–Brown v. Winfrey</i>, 659 Fed.Appx. 55 (2d Cir. 2016).</p> <p><i>D. Beyond the Scope of the TMCH Protection that the GNSO Council and ICANN Board Agreed to Provide Trademark Owners.</i></p> <p>As has been pointed out in our Working Group calls, the STI evaluations and IRT evaluations were long and hard and both groups decided in their recommendations to protect only the word mark – the text itself when the text was registered by itself. Neither allowed for the extraction of a word or letters from amidst a pattern, style, composite or mixed marks; neither created a process for doing so; neither accorded the discretion to the TMCH Provider (now Deloitte) to adopt any processes to handle this process independently.</p> <p>The STI clearly elaborated its reasoning: that extracting a word or letters from a larger design, gives too many rights to one trademark owner over others using the same words or letters. As clearly elaborated in the STI Recommendations and adopted by the GNSO Council and ICANN Board (unanimously), it would be an unfair advantage for one trademark owner over others using the same words or letters. Specifically:</p> <p>“(The trademarks to be included in the TC are text marks because “design marks” provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.)”</p> <p>To the extent that Deloitte as a TMCH Provider is operating within its mandate, and the limits of the rules and contract imposed on it, <i>it may not take steps to expand existing trademark rights</i>. The rights, as granted by national and regional trademark offices are rights that expressly include the patterns, special lettering and other styles, colors, and logos that are a part of the trademark granted by the Trademark Office and certification provided by each Trademark Office and presented to the Trademark Clearinghouse.</p> <p>Breach and Correction</p> <p>Accordingly, Deloitte is in breach of the rules that ICANN adopted and must revise its practice to go to follow the rules adopted by the GNSO Council and ICANN Board. Deloitte’s extraction of words and letters from patterns, special lettering, styles, colors and logos, as outlined above, violates the rules adopted by the GNSO Council and ICANN Board for the Trademark Clearinghouse operation.</p>

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Bringing Deloitte’s operation of the TMCH – and its terms and requirements - rules does not require a consensus of the Working Group. Rather, it is a fundamental aspect of our job as a Working Group, as laid out by the GNSO Council in our charter, to review the operation of the Trademark Clearinghouse in compliance with its rules. As Deloitte is not operating in compliance with its rules in this area, it is in breach and must come into compliance. The excellent work of the Working Group in this area, and finding this problem through hard work and research, should be sufficient for ICANN Staff to act in enforcement of its contract and our rules. Point it out clearly and directly to Deloitte, to ICANN Board and Staff, and to the ICANN Community is one small additional step the Working Group might take.

Alternatively, the Working Group **by consensus** may CHANGE the rules and present to the GNSO Council and ICANN Board a new set of standards by which Deloitte (or any future TMCH provider) may use to accept the design and stylized marks currently barred by the rules. But such a step would require a **change** to the ICANN rules under which the Trademark Clearinghouse operate, and then acceptance by the GNSO Council and ICANN Board. ICANN contractors do not have the unilateral power to make their own rules or to change the rule that are given them.

Rationale for the proposal submitted by Greg Shatan:

A. Introduction.

1. The GNSO Council recommendations (based on the STI Final Report) stating that the types of marks to be accepted by the Trademark Clearinghouse are as follows:

“4.1 National or Multinational Registered Marks The TC Database should be required to include nationally or multinationally registered “text mark” trademarks, from all jurisdictions, (including countries where there is no substantive review). (The trademarks to be included in the TC are text marks because “design marks” provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.)”
<https://gns0.icann.org/en/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

2. The ICANN Board “supported the substantive content” of the STI recommendations and tasked ICANN staff with analyzing public comments and developing a final version of the Clearinghouse proposal for the Applicant Guidebook:

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<p>“ Whereas, subject to any amendments in response to public comment, the Board supports the substantive content of the Clearinghouse and URS proposals that were posted on 15 February 2010 for public comment and expects that they will be included in version 4 of the Draft Applicant Guidebook.</p> <p>Resolved (2010.03.12.19), ICANN staff shall analyze public comments on the Clearinghouse proposal and develop a final version to be included in version 4 of the Draft Applicant Guidebook.” https://www.icann.org/resources/board-material/resolutions-2010-03-12-en#6 (emphasis added)</p> <p>3. The Applicant Guidebook adopted the following formulation:</p> <p>“3.2 Standards for inclusion in the Clearinghouse 3.2.1 Nationally or regionally registered word marks from all jurisdictions” https://newgtlds.icann.org/en/applicants/agb/trademark-clearinghouse-04jun12-en.pdf</p> <p>4. The Trademark Clearinghouse Guidelines adopted the following approach in Section 4.2.1 of the Trademark Clearinghouse Guidelines (the “Guidelines”):</p> <p>“1. For a Trademark exclusively consisting of letters, words, numerals and/or special characters:</p> <p>The recorded name of the mark is an identical match to the reported name as long as all characters are included in the Trademark Record provided to the Clearinghouse, and in the same order in which they appear on the Trademark certificate.</p> <p>In the event that there is any doubt about the order in which they 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 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 alternatively request that the Trademark Holder provide additional documentary evidence on how the Trademark is used.</p> <p>2. For a Marks that does not exclusively consist of letters, words, numerals, special characters.</p>

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<p>The recorded name of the Trademark is an identical match to the reported name as long as the name of the Trademark includes letters, words, numerals, keyboard signs, and punctuation marks (“Characters”) that are:</p> <ul style="list-style-type: none"> • predominant; and • clearly separable or distinguishable from the device element; and • all predominant characters are included in the Trademark Record submitted to the Clearinghouse in the same order they appear in the mark. <p>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.”</p> <p>5. Following 4.2.1(1) (“a Trademark exclusively consisting of letters, words, numerals and/or special characters”) Deloitte provided an example with two registrations of the mark DEALSAFE (see Guidelines, p. 19), with the legend “Based on the above trademark, the recorded name of the mark is DealSafe. In no event would the Clearinghouse accept “DEAL”, “SAFE” or “SafeDeal” based on the reported name of the trademark.” Notably, the EU registration identifies the “Type of Mark” as “Figurative,” while the U.S. registration identifies the “Mark Drawing Code” as “(6) Words, Letters, and/or Numbers in Stylized Form.” In other words, the example of “a Trademark exclusively consisting of letters, words, numerals and/or special characters” is a figurative or stylized mark, not a “text” or “standard form” mark.</p> <p>6. There are a variety of different types of marks, but as Deloitte notes “there is no unilateral international definition of different types of trademarks.” (Follow Up Questions For Deloitte From The GNSO’s Review Of All Rights Protection Mechanisms (RPM) Review Policy Development Process Working Group, Updated 5 March 2017, Para. 6 (responding to the question “How many such “device” or “image” marks have been submitted and validated?")) Nonetheless, one can consider the types of marks along a spectrum, with the following non-exhaustive examples:</p> <ol style="list-style-type: none"> 1. exclusively consisting of letters, words, numerals and/or special characters, with no claim as to font or color 2. exclusively consisting of letters, words, numerals and/or special characters but using a particular font

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3. exclusively consisting of letters, words, numerals and/or special characters but stylized in some manner beyond simply using a stock font)
4. exclusively consisting of letters, words, numerals and/or special characters and claiming color(s) and a font or stylization
5. exclusively consisting of letters, words, numerals and/or special characters but with non-textual details (e.g., adidas's use of a trefoil to dot the "i")
6. text with a design element, and the text is predominant and clearly separable or distinguishable from the device element
7. text with a design element, and the text is predominant but is not clearly separable or distinguishable from the device element
8. text with a design element, and the text is not predominant although it is clearly separable or distinguishable from the device element
9. text with a design element, and the text is neither predominant nor clearly separable or distinguishable from the device element
10. a design that does not contain any text element
11. three-dimensional marks
12. sound marks
13. color marks
14. other non-traditional marks

Under current TMCH practice, examples 1 through 6 would be registrable in the TMCH, while examples 7 through 14 would not be registrable. However, examples 1-9 are all word marks, at least in part.

Example 1 may be referred to under U.S. law and practice as "standard form" marks, while 2-5 may be referred to as "stylized" marks, while examples 6-10 may be referred to as "design marks." Under E.U. law and practice, example 1 may be referred to as a "text" mark, while examples 2-9 may be referred to as "figurative + text" and example 10 as "figurative." However, as may be seen from the example on page 19 of the Guidelines, the E.U. does not appear to consistent – the word DEALSAFE in a stock font is referred to as a "figurative" mark.

7. Certain national trademark laws (e.g., the United States, see 15 U.S.C. Section 1056 ("The Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.") and multinational treaties (e.g., the Madrid Protocol, Rule (9)(4)(b)(v)) include or recognize the use of disclaimer requirements, Disclaimers may be used to disclaim certain words in any mark containing text,

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whether it is a “standard character” text-only mark (example 1), a stylized mark, or a mark with words and a design element. The significance of disclaimers under U.S. law is explained as follows in the Trademark Manual of Examining Procedure 1213:

The significance of a disclaimer is conveyed in the following statement:

As used in trade mark registrations, a disclaimer of a component of a composite mark amounts merely to a statement that, in so far as that particular registration is concerned, no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark.

Sprague Electric Co. v. Erie Resistor Corp., 101 USPQ 486, 486-87 (Comm’r Pats. 1954).

A disclaimer may be limited to pertain to only certain classes, or to only certain goods or services.

<https://tmep.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e11717.html> (emphasis added). The essence is that the disclaimer indicates that the registrant is not claiming any rights in the disclaimed component “only within the context of” the composite mark.

8. The situation that the RPM Working Group seeks to address is the inclusion of certain “design marks” in the Trademark Clearinghouse where the underlying trademark registration provides “protection for letters and words only within the context of their design or logo” (i.e., where the registrant would otherwise not be permitted to own trademark rights in that term, but for the inclusion in the mark of non-text elements.) As can be seen above, this is consistent with the description of a disclaimed term. However, it is not consistent with the extent of protection under most (if not all) trademark legal regimes for the letters or words in a mark where the words are not disclaimed, including a stylized or design mark. Stylized marks do not include a “design or logo” so are clearly protected beyond the context of a design or logo, while even marks that consist of text are protected beyond “the context of their design or logo.”

9. As such, the TMCH is currently both under- and over-inclusive. Marks where all text is disclaimed may be registered in the TMCH. On the other hand, marks consisting of words and designs where the words do not predominate and/or the words are not clearly separable or distinguishable are not registrable in the TMCH even though the words in the mark are not disclaimed and thus protected beyond the context of a design or logo.

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<p>10. The TMCH should not expand existing trademark rights, but neither should it fail to recognize existing trademark rights.</p> <p>11. The Trademark Clearinghouse has a Dispute Resolution Procedure that allows an aggrieved Third Party to challenge a decision of the Verification Provider that a Trademark Record was valid on the grounds that the Trademark Record has been incorrectly verified (more specifically: (i) The Trademark Record is not in full force and effect; (ii) The Trademark Holder specified in the Trademark Record is not the holder of the underlying trademark; or (iii) The Trademark Record does not meet the eligibility requirements for inclusion in the Clearinghouse). In addition, a Third Party may challenge the validity of Trademark Record based upon the existence of new information (i.e., information not available to the Verification Provider at the time it reviewed the Trademark Record).</p> <p>12. An aggrieved Third Party may also challenge the underlying national or regional trademark registration.</p> <p>13. Noting that trademark offices may differ in their approach to defining and examining the protectable text elements for a mark which includes non-text elements, ICANN and its agents (such as the Trademark Clearinghouse and its Verification Provider) should not be in a position to re-assess or reject the validity of a trademark registration granted by a national or regional office.</p>			
<p>Q8. How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?</p>			
<p><u>Rationale For the proposal submitted by Kathy Kleiman:</u></p> <p><i>Origin of Problem:</i> The Applicant Guidebook appears to be the source of this odd expansion of subcategories for “marks” being accepted into the Trademark Clearinghouse database. In the Applicant Guidebook, Module 5, <i>Trademark Clearinghouse Section</i>, we find:</p> <p>Section 3, <i>Criteria for Trademark Inclusion in Clearinghouse:</i> “3.2 The standards for inclusion in the Clearinghouse are: 3.2.1 [Skipped] 3.2.2 [Skipped]</p>			

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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.

3.2.4 Other marks that constitute intellectual property.”

[https://newgtlds.icann.org/en/applicants/agb\[newgtlds.icann.org\]](https://newgtlds.icann.org/en/applicants/agb[newgtlds.icann.org])

It is not clear that 3.2.3 is only for trademarks (and clearly Deloitte does not interpret it so) or what 3.2.4 means or includes. In all events, neither of two subcategories were discussed or approved by the GNSO Council and ICANN Board.

Further, under the express rules adopted, any results of 3.2.3 and 3.2.4 that are not trademarks would have to be entered into a **different database, not the main Trademark Clearinghouse database used for Community-Approved RPMs** (per STI Recommendations, Section 2, Functionality of the Trademark Clearinghouse, 2.3 Segregation of the Trademark Clearinghouse Database above).

Overall, we know that at least 75 terms have been approved by Deloitte under 3.2.3 without regard to their trademark status and are currently in the TMCH Database.

Harm:

The TMCH Database is growing beyond the rules established and set by the GNSO Council, ICANN Board or ICANN Community. This deeply harms the Multistakeholder Process. As discussed extensively on the RPM PDP WG list, the original GNSO committees worked long and hard and carefully balanced the rights of those seeking trademark protection and those seeking to register domain names in New gTLDs. Allowing into the Trademark Clearinghouse new types of entries is a decision for this Working Group, but not for Deloitte or ICANN Staff.

Second, these subsections allow a level of interpretation and discretion never intended for the Trademark Clearinghouse Provider. Through Section 3.2.3 and 3.2.4, Deloitte is engaged in a new function of discretion, interpretation and choice – one without rules, guidance and oversight by ICANN and ICANN Community. Ultimately, we don’t even understand what is being accepted (and Deloitte would not tell us).

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Third, these subsections (3.2.2 and 3.2.4) harm all of those seeking to register domain names, in good faith for their new groups, companies, goods, services, hobbies, speech, research and education. Absent a trademark right of precedence, all other domain names should be open and available to the world to register. That was the promise of the New gTLD Program.

Action:

The WG has an oversight obligation to ensure the rules adopted by the Community are followed. We can ensure that subcategories 3.2.3 and 3.2.4 are allowed **only to the extent they are registered trademarks**. Alternatively, the Working Group **by consensus** may CHANGE the rules and present to the GNSO Council and the ICANN Board a new set of standards by which Deloitte (or any future TMCH provider) may review and accept these subcategories of marks.

Rationale For the proposal submitted by Claudio di Gangi:

With regards to GIs, our Charter states the following: "Examine the protection of country names and geographical indications, and generally of indications of source, within the RPMs."

In my view, this signifies that the issue of GIs is properly within scope, but if anyone feels differently I would encourage substantive feedback so we can resolve any alternative points of views on this subject ...

... The Clearinghouse is a database designed to administratively support the RPMs across new gTLDs. When we conduct the policy review of the RPMs, we can assess the nature of the protections and assess whether any changes are needed to protect the rights of others, consistent with the GNSO policy recommendations on new gTLDs. The specific design of the Clearinghouse database, and the associated IP records contained therein, should be consistent with the outcome of that policy assessment.

Q10. Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?

Rationale for the proposal submitted by Michael Graham:

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The intent of this Proposal is to expand the scope of domain name strings subject to Trademark Claims Service notices in order to help good faith domain name applicants avoid possible conflict and expense when they inadvertently seek to register a domain name that includes and could create confusion with a Trademark registered in the TMCH. This will avoid unnecessary cost to the Applicant, and enable it to either prepare for or ensure that its planned use of a domain name will not lead to conflict.

For the same reasons – and because of the success of the Trademark Claims procedure in deterring bad faith domain name registrations in the new gTLDs in the interests of both trademark owners and Internet users – I also propose expanding the scope of the Trademark Claims Service.