



# In depth overview of Trademark Clearing House (TMCH) | 14 September 2016

In depth overview of Sunrise Period | 21 September 2016

In depth overview of TM Claims Notice | 28 September 2016

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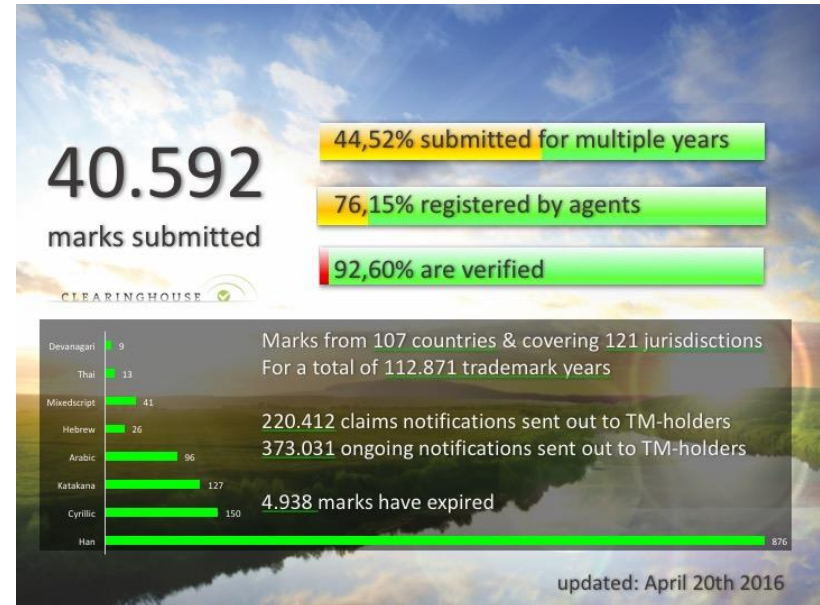
# The Trademark Clearinghouse (TMCH)

## ⦿ What is it?

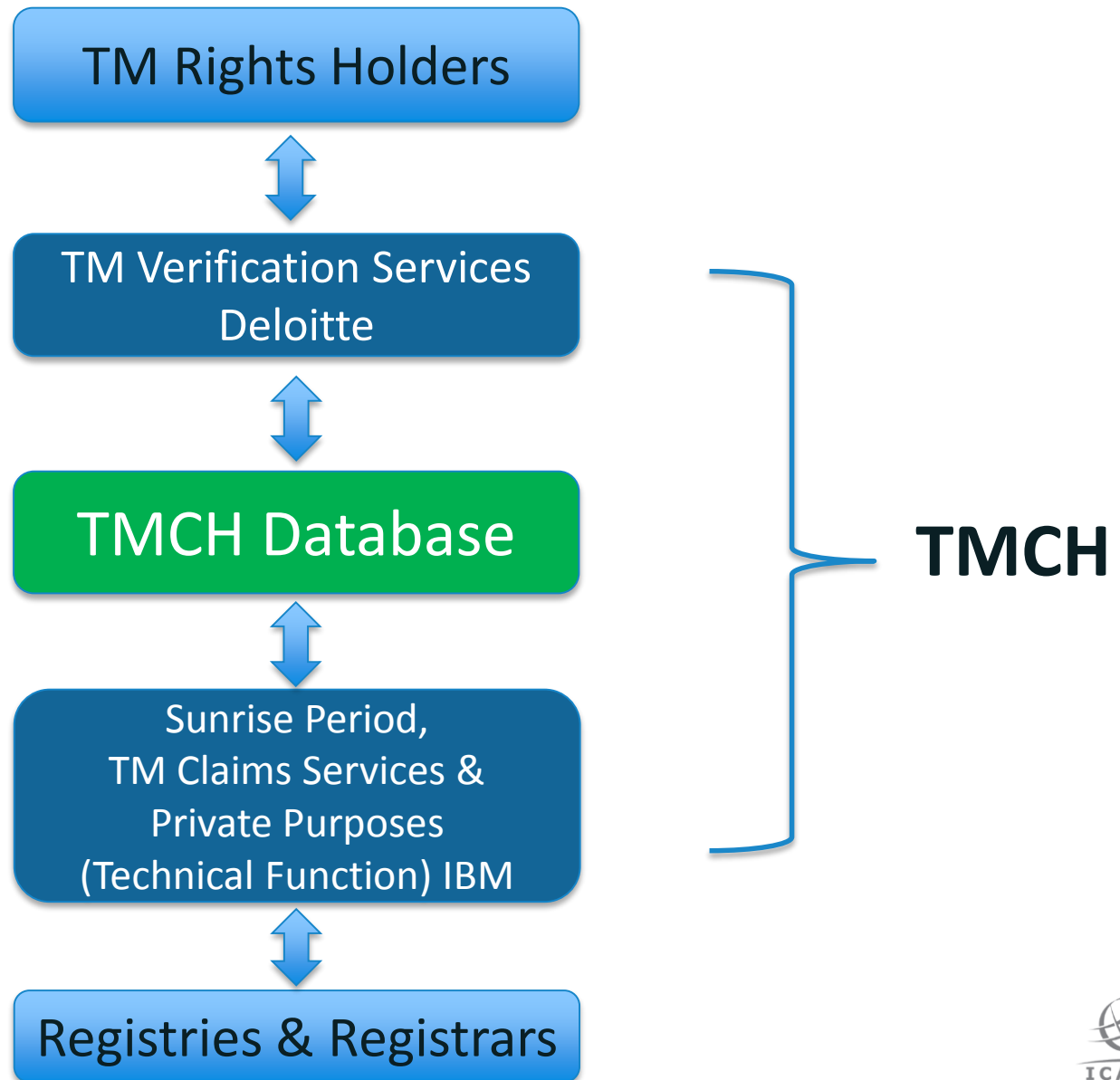
- ✓ Global database of verified trademark information
- ✓ Supports Sunrise Registrations & Trademark Claims notice service
- ✓ Verifies trademark data received – does not adjudicate or create TM rights

## ⦿ Key statistics:

- ✓ **90%** of submissions verified and included into TMCH
- ✓ **92%** of verified submissions had marks verified for proof of use
- ✓ As of August 2015, over **37,000 marks from 121 jurisdictions** had been submitted



# Trademark Clearinghouse Functions



# How the TMCH works: Providers

## **Verification function**

- ⦿ Provided by Deloitte
- ⦿ Verification services related to verification of the correctness and completeness of the submitted Trademark Record information (the assessment of whether the Trademark meets the eligibility requirements as stated by the Trademark Clearinghouse)
- ⦿ Also provides the Clearinghouse User Interface

## **Technical function**

- ⦿ Provided by IBM
- ⦿ Provides the central database in which all the trademark information will be stored

# How the TMCH works: Verification (1)

## Who can apply?

- ⦿ Either a trademark holder (individual or an entity, including its licensees and assignees) or its trademark agent (who submits and maintains the information on the TM holder's behalf, and receives notices related to Sunrise and TM Claims)

## What types of marks are accepted?

- ⦿ Nationally or regionally-registered TMs (on primary register)
- ⦿ Marks protected by statute or treaty in effect at the time the mark information is submitted to the TMCH
  - *May include geographical indications and designations of origin*
- ⦿ Court-validated marks (court of law or other national judicial proceeding)
  - *May include unregistered (common law) marks and well-known marks*
- ⦿ Other marks that constitute intellectual property and that meet a registry's individual requirements

# How the TMCH works: Verification (2)

## What types of marks are not accepted?

- ⦿ TM applications or applications for protection of a mark
- ⦿ Well-known or famous trademarks, unless also protected by a TRADEMARK statute, treaty or court-validated
- ⦿ US state trademarks
- ⦿ International trademark applications made via the Madrid system
- ⦿ Registered trademarks that were subject to successful invalidation, cancellation, opposition or rectification proceedings
- ⦿ A mark protected under statute or treaty that includes a top level extension such as “icann.org” or “.icann” as a mark
- ⦿ A mark protected under statute or treaty starting with or containing a “dot” (.) unless functioning as punctuation, abbreviation or as figurative part of the mark
- ⦿ A mark protected under statute or treaty that does not contain any letters, words, numerals, or DNS-valid characters
- ⦿ Any mark protected under statute or treaty of which the statute or treaty is only applicable to a certain region, city or state

# How the TMCH works: Verification (3)

## What about device/image marks?

For marks that do not exclusively consist of letters, words, numerals, special characters:

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:

- Predominant;
- 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

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. If 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.



## Other useful notes:

- ⦿ Basic fee: USD150 for 1 TM record per year
- ⦿ To be eligible for Sunrise registrations – must also submit proof of use (signed declaration and a sample of use e.g. labels or advertisements)
- ⦿ All TM comparisons done by the TMCH (e.g. for purposes of TM Claims) compare the textual elements of a mark with the second level label of the domain name being registered
- ⦿ An “identical match” with a TMCH record = a domain name consists of the complete and identical textual elements of the mark:
  - *Special characters “@” and “&” contained within a trademark may be spelled out with appropriate words, for example:*

***Sargent&Krahn***

*sargentkrahn.xyz*

*sargent-krahn.xyz*

*sargentandkrahn.xyz*

***Watch@Tablet***

*watchtablet.xyz*

*watch-tablet.xyz*

*watchattablet.xyz*

### Other useful notes (continued):

- *Other special characters contained within a mark that are unable to be used in a second-level domain name may either be omitted or replaced by hyphens*
- *Plural versions of a mark (or domain names containing the mark) are not considered an identical match*
- *Multi-year registrations for one (1), three (3) or five (5) years available*

## TM + 50

Also called the “Abused Domain Name Label Service,” TM+50 allows a trademark already registered in the TMCH to be linked to a maximum of 50 variants—provided that each variant of the mark was awarded to the trademark holder in a prior UDRP decision or legal decision.

Some examples: yah00  
ad0be  
legobox

## Questions from Charter

- Should the Abused Domain Name Label service be continued?
- Is the protection of the TMCH too broad?
- Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word, thus allowing a trademark in one category of goods and services to block or postpone the legitimate and rightful use of all others in other areas of goods and services? Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?

# Questions from Charter

- Should further guidance on verification guidelines for different categories of marks be considered?
- Is the protection of the TMCH too broad? Is the TMCH providing too much protection for those with a trademark on a generic or descriptive dictionary word?
- Should TM+50 be reversed?
- Are legitimate noncommercial, commercial and individual registrants losing legitimate opportunities to register domain names in New gTLDs?
- How should the TMCH scope be limited to apply to only the categories of goods and services in which the generic terms in a trademark are protected?
- Should the TMCH matching rules be expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword', and/or common typos of a mark?

# Questions from Charter

- Should there be an additional or a different recourse mechanism to challenge rejected trademarks?
- How quickly can a cancelled trademark be removed from the TMCH?
- How can TMCH services be much more transparent in terms of what is offered pursuant to ICANN contracts and policies vs. what is offered to private New gTLD registries pursuant to private contracts?
- Should there be a review on accessibility to TMCH for individuals, private trademark holders and trademark agents in developing countries?
- How can the TMCH provide education services not only for trademark owners, but for the registrants and potential registrants who are equally impacted by their services?

# Questions from ICANN56, Helsinki

- Does the TMCH provide avenues that are procedurally and substantively fair so effectively balance the rights of rights holders versus normal Internet users?
- Does the trademark clearinghouse create a tendency to perpetuate the status quo?
- How accessible is the TMCH to reviewing accessibility for trademark agents in developing countries?
- What is the effect of the 90-day Trademark Claims process?
- Should the TMCH remain a single provider or should we open it to different providers, of course with a central database that should be accessed by the different providers?
- Are the costs of the TMCH, for rights holders, for ICANN, for the community proportionate to the benefits it provides?
- How do we determine what is “good chilling effect” and “bad chilling effect” in relation to RPMs?

## From “Additional Questions and Issues” in Charter:

- Are the Providers' procedures fair and equitable for all stakeholders and participants?
- Are the Providers consulting with all stakeholders and participants in the evaluation, adoption and review of these new procedures?
- Are the Providers training both the Complainants and the Respondents, and their communities and representatives, fairly and equally in these new procedures?
- Are Providers exceeding the scope of their authority in any of the procedures they are adopting?
- Is ICANN reaching out properly and sufficiently to the multi-stakeholder community when such procedures are being evaluated by ICANN at the Providers' request? Is this an open and transparent process? expeditiously and fairly created?
- What changes need to be made to ensure that procedures adopted by providers are consistent with the ICANN policies and are fair and balanced?



## Questions & Discussion

Please examine the questions in the Charter and from Helsinki.

What would you add? What do you find duplicative? What might be grouped together? What might we examine first?

For future discussion: what data would you need to evaluate and analyze the answers to these questions?