



# In Depth Overview: Trademark Claims Services

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# Trademark Claims Services through the TMCH

## Overview:

- The Claims Services provide both:
  - (i) Notices to potential domain name registrants that a domain name they are seeking to register in a New gTLD matches a trademark record of a trademark holder that has been verified by the Trademark Clearinghouse (a “**Claims Notice**”); and
  - (ii) Notifications of Registered Names (“**NORNs**”) to the relevant trademark holder, after a registrant that has received a Claims Notice affirmatively confirms continuation with the registration and the registration proceeds
  
- The Claims Notice is intended to provide notice to the prospective domain name registrant of the scope of the relevant trademark holder’s rights
  - The Claims Notice is sent by the registrar to a prospective registrant
  - The NORN is sent by the TMCH to the relevant trademark holder

# Minimum mandatory Trademark Claims Service for All New gTLDs (2)

- All registrars must clearly and conspicuously display the Claims Notice to the potential domain name registrant and inquire as to whether he/she wishes to continue with the registration
- The Claims Notice must be provided at the time of potential registration in real time, without cost to the prospective domain name registrant
- The Claims Notice must be in the form specified in the Claims Notice Form, and must require an affirmative confirmation by the potential domain name registrant to continue with the registration in order for the registration to proceed
- The Claims Notice is provided in English and, preferably, the language of the registration agreement

## Contents of the Claims Notice sent to a prospective registrant (1)

- *“You have received this Trademark Notice because you have applied for a domain name which matches at least one trademark record submitted to the Trademark Clearinghouse. You may or may not be entitled to register the domain name depending on your intended use and whether it is the same or significantly overlaps with the trademarks listed below. Your rights to register this domain name may or may not be protected as noncommercial use or “fair use” by the laws of your country [in bold italics or all caps].*
- *Please read the trademark information below carefully, including the trademarks, jurisdictions, and goods and services for which the trademarks are registered.*
- *Please be aware that not all jurisdictions review trademark applications closely, so some of the trademark information below may exist in a national or regional registry which does not conduct a thorough or substantive review of trademark rights prior to registration. If you have questions, you may want to consult an attorney or legal expert on trademarks and intellectual property for guidance.”*

## Contents of the Claims Notice sent to a prospective registrant (2)

*“If you continue with this registration, you represent that, you have received and you understand this notice and to the best of your knowledge, your registration and use of the requested domain name will not infringe on the trademark rights listed below.*

*The following [number] marks are listed in the Trademark Clearinghouse:*

*Mark:*

*Jurisdiction:*

*Goods and Services:*

*International Class of Goods and Services or Equivalent if applicable:*

*Trademark Registrant:*

*Trademark Registrant Contact:*

*This domain name label has previously been found to be used or registered abusively against the following trademarks according to the referenced decisions:*

*Decision Number:*

*UDRP Provider:*

*For more information concerning the records included in this notice, see [link to information page].”*

## Contents of the Notice of Registered Name (NORN) sent to Trademark Holders

- *“You have received this Notice of Registered Name because your agent has requested that you receive a copy of this notice that notifies you that the following domain name matching one of your Trademark Clearinghouse records has been registered during the claims period of a new gTLD. For additional information on this notice, please contact your Trademark Clearinghouse agent.*

*Mark name:*

*Domain name:*

*Registration date:*

- *In certain circumstances, one or more of these domain names may no longer be registered. A domain can be deleted at any time. Additionally, a domain name that is deleted during the first five calendar days of registration becomes immediately available again for registration. You may receive multiple Notices of Registered Names under these or similar conditions.*
- *For additional information, please refer to the Whois record for the domain name at the applicable registry. A list of gTLD registries is available at <http://www.icann.org/en/resources/registries/listing>.”*

## Scope of the Claims Service:

- ⦿ The Claims Service is mandatory in all New gTLDs
- ⦿ All New gTLD registry operators must provide the Claims Services for at least the first ninety (90) calendar days of General Registration (the **“Claims Period”**)
  - Registry operators may elect to provide the Claims Service for longer than 90 days
- ⦿ The Sunrise Period and the Claims Period must be two distinct phases, and must not overlap
- ⦿ Registry operators may provide additional periods to accept registrations following the Sunrise Period and prior to General Registration (a **“Limited Registration Period”, which may include “Landrush”**)
  - The Limited Registration Period may overlap with the Sunrise Period, but domain names cannot be allocated in a Limited Registration Period until all Sunrise Registrations have been registered
  - If Registry Operator offers a Limited Registration Period, the TM Claims Services must be provided during the entire Limited Registration Period in addition to the standard 90-days Claims Period during General Registration.



# Other Key Points about the Trademark Claims Service (1)

- A New gTLD registry operator is obliged to provide the Claims Service according to certain Technical Requirements. The Registry Operator works with the TMCH Technical Functions Provider (IBM) to coordinate testing and implement the Claims Services Technical Specifications. (<http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-14may14-en.pdf>)
- All New gTLD registry operators and registrars must accept the Terms of Service applicable to Sunrise and Claims Services prior to offering any of these services (<https://marksdb.org/tmdb/public/tandc>)

## Note:

- The TMCH provides an optional Ongoing Notification Service that applies beyond the mandatory 90-day period required by ICANN:  
<http://www.trademark-clearinghouse.com/content/ongoing-notifications>
  - No additional cost for exact matches; cost of US\$1 per year for variations (i.e. domains containing the mark; domains that are part of the exact match label; variations of the exact match label such as replacement by similar characters: <http://www.trademark-clearinghouse.com/content/variants>)

## Other Key Points about the Trademark Claims Service (2)

- Recent research seems to show there is a relatively high proportion of prospective registrations that do not proceed following receipt of a Claims Notice (Draft Report of Independent Review of the TMCH, 25 July 2016: <https://newgtlds.icann.org/en/reviews/tmch/draft-services-review-25jul16-en.pdf>):
  - 93.7% of 1.8 million registration attempts that received a Claims Notice did not proceed (i.e. only 6.3% went on to complete the domain name registration)
  - As of December 2015, of 114,000 registrations that were completed following receipt and acknowledgment of a Claims Notice, only 0.3% were subject to subsequent domain disputes
  - NOTE FROM THE ANALYSIS GROUP: the Claims Notice data shows only the number of notices issued and the number of completed registrations; *cannot definitively conclude whether Claims Service notifications have a deterrent effect on either type of registration activity.*

# Private purposes of the TMCH database (1)

## PRIVATE PURPOSES FOR WHICH THE TMCH DATABASE IS CURRENTLY USED:

1. Donuts' Domains Protected Marks List (DPML) – A service that allows a TM holder registered in the TMCH Database to block its mark from registration in Donuts 200 New gTLDs for a single fee to Donuts. The protected mark need not be an exact match of the mark in the TMCH Database:

<http://www.donuts.domains/services/dpml/dpml-overview>

2. Rightside's Domain Protected Marks List (DPML):

<http://rightside.co/registry/dpml/>

3. Minds+Machines' Protected Marks List (MPML): <http://mm-registry.com/mpml-faq/>

(See generally *Blocking Mechanisms for TMCH-clients (DPML)*:

<http://www.trademark-clearinghouse.com/content/blocking-mechanisms-tmch-clients-dpml>)

# Private purposes of the TMCH database (2)

General characteristics of these Private Purposes and Protected Marks Lists:

- TM holders can block second level domain registrations across all New gTLDs operated by the registry operator
- Block can be of a term matching a TM, or containing a TM
- Block is based on the SMD file(s) that is issued by the TMCH to a TM holder upon validation of its marks
- Not applicable to Reserved Names or Premium Names
- Submission through a registrar authorized by that registry operator to sell the block(s)

# Questions from WG Charter concerning the Claims Service

- Should the Trademark Claims period be extended beyond ninety (90) days?
- Should the Trademark Claims period continue to apply to all new gTLDs?
- Should the Abused Domain Name Label (TM+50) service be continued?
- Does a Trademark Claims period create a potential “chilling effect” on genuine registrations, and, if so, how should this be addressed?
- Is the TMCH and the Sunrise Period allowing key domain names to be cherry-picked and removed from New gTLDs unrelated to those of the categories of goods and services of the trademark owner (e.g., allowing “Windows” to be removed from a future .CLEANING by Microsoft)?
- What is the effect of the 90-day Trademark Claims process?

# Additional General Questions and Issues from WG Charter

- Do the RPMs work for registrants and trademark holders in other scripts/languages, and should any of them be further “internationalized” (such as in terms of service providers, languages served)?
- Do the RPMs adequately address issues of registrant protection (such as freedom of expression and fair use)?
- Are the processes being adopted by Providers of UDRP, URS, and TMCH services fair and reasonable?
- 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?
- What remedies exist, or should exist, to allow questions about new policies by the Providers offering UDRP, URS and TMCH services, and how can they be expeditiously and fairly created?

# Additional Questions and Issues from WG Charter

- What changes need to be made to ensure that procedures adopted by providers are consistent with the ICANN policies and are fair and balanced?
- Examine the protection of country names and geographical indications, and generally of indications of source, within the RPMs
- In the light of concrete cases (case law) and from the perspective of owners of protected signs and of marks, which are the identified deficits of the RPMs?
- How is the emerging discourse within the ICANN community on human rights issues relevant to these issues?

Please examine the questions in the Charter.

What would you add or remove? 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?