

**REMAINING TMCH CHARTER QUESTIONS MATCHED WITH DOCUMENTATION FROM THE APPLICANT GUIDEBOOK AND OTHER MATERIALS
DEVELOPED FOR THE 2012 NEW gTLD PROGRAM – CATEGORIES 1 & 2
5 March 2017**

CATEGORY 1 – EDUCATION

Charter Questions	STI Recommendations (approved by GNSO Council & ICANN Board)	Applicant Guidebook	Deloitte Guidelines/Other Materials Developed for the Program	WG Discussion to Date
<p>1. Is the TMCH clearly communicating: (i) the criteria it applies when determining whether or not to accept marks for entry into the TMCH; (ii) options for rights-holders when their submissions are rejected; and (iii) options for third parties who may have challenges to or questions about records in the TMCH?</p>	<p><u>9: Effect of filing with the TC¹</u> It should be clearly stated in mandate of the TC that inclusion of a TC validated mark into the Database is not proof of any right, nor does it confer any legal rights on the trademark holder. Also, failure to file should not be perceived to be lack of vigilance by Trademark holders.</p>	<p>Criteria for TM Inclusion in the Clearinghouse:</p> <p><u>3.2: Standards for inclusion in the Clearinghouse</u></p> <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>TMCH Guidelines:</p> <p>2.2.5 “Any registered trademark that does not contain any letters, words, numerals or DNS-valid characters” will not be accepted as a registered TM for submission.</p> <p>2.3.4 “Figurative part of the court-validated trademark” and “any court-validated mark that does not contain any letters, words, numerals or DNS-valid characters” will not be accepted as a court-validated mark for submission.</p>	<p>Discuss with Deloitte previous community feedback regarding inconsistent or unclear application of the submission, verification and rejection criteria.</p> <p>Confirm whether it is possible for third parties to find information on (and thus challenge, if appropriate) TMCH records, given that TMDB is not publicly searchable².</p>

¹ This recommendation achieved unanimous consensus among the STI.

² Note that the TMCH Dispute Resolution Procedures contemplate third party challenges, e.g. to the provider’s decision that a trademark record was valid because it was incorrectly verified, or to the validity of a trademark record based on information not available to the provider at the time the trademark record was verified (<http://trademark-clearinghouse.com/dispute>).

		<p>3.2.4 Other marks that constitute intellectual property.</p> <p>[Sections 3.3 – 3.7 detail the type of data to be submitted for each type of mark]</p> <p>3.8: All mark holders seeking to have their marks included in the Clearinghouse will be required to submit a declaration, affidavit, or other sworn statement that the information provided is true and current and has not been supplied for an improper purpose. The mark holder will also be required to attest that it will keep the information supplied to the Clearinghouse current ... [and] has an affirmative obligation to notify the Clearinghouse [of cancellations, transfers or abandonment]. There will be penalties for failing to keep information current.</p>	<p>5.2.1 To determine whether the recorded name of the TM is identical to the reported name for marks that do not exclusively consist of letters, words, numerals, special characters – “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 they appear, the description provided</p>	
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		<p>3.9: As an additional safeguard, the data will have to be renewed periodically by any mark holder wishing to remain in the Clearinghouse.</p> <p>4.1: All mark holders seeking to have their marks included in the Clearinghouse will have to consent to the use of their information by the Clearinghouse. However, such consent would extend only to use in connection with the stated purpose of the Trademark Clearinghouse Database for Sunrise or Trademark Claims services.</p>	<p>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>7. Should the TMCH be responsible for educating rights-holders, domain name registrants and potential registrants about the services it provides? If so, how? If the</p>	<p>No specific recommendation.</p>	<p>No express provisions.</p>	<p>The TMCH website hosts FAQs, documents and materials, and is available in multiple languages.</p>	<p>In relation to education of registrants and the public, WG to further consider if ICANN should prepare materials (e.g. factsheets, FAQs) about how the TMCH works (e.g. for Claims Notices and Sunrise). One way to reach registrants is for Registrars to distribute or</p>

<p>TMCH is not to be responsible, who should be?</p>				<p>display information to their customers (e.g. as part of a Claims Notice). This may be something to be developed further in implementation.</p> <p>In relation to education of rights-holders (which the TMCH considers its primary customers), WG to consider if additional outreach to under-served regions and outside Europe and North America may be needed.</p>
<p>2. What information on the following aspects of the operation of the TMCH is available and where can it be found?</p> <p>(a) TMCH services; (b) Contractual relationships between the TMCH providers and private parties; and</p>	<p><u>6.1: Use of TC for Ancillary Services</u>³ There should be no bar on the TC Service Provider or other third party service providers providing ancillary services on a non-exclusive basis. Such services could include, without limitation, a “marks contained” service, or a TM watch service. In order not to have a competitive advantage over</p>	<p>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.</p> <p>4.2: In order not to create a competitive advantage, the data in the Trademark Clearinghouse should be licensed to competitors interested in providing</p>		<p>WG to follow up with Deloitte on URS provider feedback about lack of access to SMD files to verify rights-holders claims and proof of use – this can be done when WG reviews the URS.</p>

³ This recommendation achieved Rough Consensus amongst the STI, with the BC submitting a Minority Statement.

<p>(c) With whom does the TMCH share data and for what purposes?</p>	<p>competitors, the TC database should be licensed to competitors interested in providing ancillary services on equal and non-discriminatory terms, and on commercially reasonable terms; provided that the TC Service Provider is not materially advantaged in the provision of such ancillary services by virtue of it being the TC Service Provider. The specific implementation details should be left to Staff to address possible monopoly and competition concerns, and all terms and conditions related to the provision of such services shall be included in the TC Service Provider's agreement with ICANN and subject to ICANN review.</p> <p>[I]f the TC Service Provider provides such ancillary services, any information should be</p>	<p>ancillary services on equal and non-discriminatory terms and on commercially reasonable terms if the mark holders agree.</p> <p>Accordingly, two licensing options will be offered to the mark holder: (a) a license to use its data for all required features of the Trademark Clearinghouse, with no permitted use of such data for ancillary services either by the Trademark Clearinghouse Service Provider or any other entity; or (b) license to use its data for the mandatory features of the Trademark Clearinghouse and for any ancillary uses reasonably related to the protection of marks in new gTLDs, which would include a license to allow the Clearinghouse to license the use and data in the Trademark Clearinghouse to competitors that also</p>		
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	stored in a separate database	provide those ancillary services. The specific implementation details will be determined, and all terms and conditions related to the provision of such services shall be included in the Trademark Clearinghouse Service Provider's contract with ICANN and subject to ICANN review.		
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CATEGORY 2: VERIFICATION & UPDATING OF TMCH DATA

Charter Questions	STI Recommendations (approved by GNSO Council & ICANN Board)	Applicant Guidebook	Other Program Documentation	WG Discussion
7. Should the verification criteria used by the TMCH to determine if a submitted mark meets the eligibility and other requirements of the TMCH be clarified or amended? If so how?	No specific recommendations.	See Section 3.3 – 3.9 (detailing submission data required for verification of each type of mark submitted) 5.1: One core function for inclusion in the Clearinghouse would be to authenticate that the data meets certain minimum criteria. As such, the following	TMCH Guidelines: See Section 2, pages 8-18: http://trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH_guidelines_v1.2_0.pdf	WG to follow up with Deloitte concerning community feedback on inconsistency of application of criteria (see also Category 1 Question 1). Ask Deloitte for a list of all TMCH registrations with Sunrise preference and to indicate which are dictionary terms (NOTE: Not included on follow up

		<p>minimum criteria are suggested:</p> <p>5.1.1 An acceptable list of data authentication sources, i.e. the web sites of patent and trademark offices throughout the world, third party providers who can obtain information from various trademark offices;</p> <p>5.1.2 Name, address and contact information of the applicant is accurate, current and matches that of the registered owner of the trademarks listed;</p> <p>5.1.3 Electronic contact information is provided and accurate;</p> <p>5.1.4 The registration numbers and countries match the information in the respective trademark office database for that registration number.</p> <p>5.2: For validation of marks by the Clearinghouse that were</p>		<p>list pending further clarification from WG)</p>
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		<p>not protected via a court, statute or treaty, the mark holder shall be required to provide evidence of use of the mark in connection with the bona fide offering for sale of goods or services prior to application for inclusion in the Clearinghouse.</p> <p>Acceptable evidence of use will be a signed declaration and a single specimen of current use, which might consist of labels, tags, containers, advertising, brochures, screen shots, or something else that evidences current use.</p>		
<p>8. Should there be an additional or a different recourse mechanism to challenge rejected submissions for records in the TMCH?</p>	<p>No specific recommendations.</p>	<p>No express provisions.</p>	<p>TMCH Dispute Resolution Procedures, Section 3: http://trademark-clearinghouse.com/dispute#3</p> <p>1. Disputes can be brought by third parties alleging that the Clearinghouse incorrectly accepted a trademark record (e.g. to challenge a</p>	<p>Follow up with Deloitte as to whether the disputes to date relating to rights-holders' challenges resulted in a reversal of Deloitte's original decision.</p> <p>Note on first question in the second column that was moved from Category 1 – the TMCH Dispute</p>

			<p>decision of the Verification Provider that a trademark record was valid on the grounds that it was incorrectly verified, such as where there are 2 trademark holders with the same trademark record and one registers in a Sunrise period for a new gTLD) – see Section 3.3.</p> <p>2. Disputes can brought by third parties alleging that a trademark record is no longer valid based on new information (meaning information not available to the Verification Provider at the time it reviewed the trademark record) – see Section 3.4.</p>	<p>Resolution Procedures are published online: http://trademark-clearinghouse.com/dispute</p>
<p>9. How quickly can and should a cancelled trademark be removed from the TMCH Database?</p>	<p>No specific recommendation.</p>	<p>3.8: A mark holder will be required to attest that it will keep the information supplied to the Clearinghouse current so that if, during the time the mark is included in the Clearinghouse, a registration gets cancelled</p>	<p>TMCH’s Terms & Conditions for Trademark Holders and Agents provide that all information submitted is accurate and correct, and that Deloitte will be “promptly” notified of any changes (including to the</p>	<p>WG may consider closing this question unless there have there been issues reported regarding removal of cancelled trademarks from the TMDB.</p>

		<p>or is transferred to another entity, or in the case of a court- or Clearinghouse-validated mark the holder abandons use of the mark, the mark holder has an affirmative obligation to notify the Clearinghouse. There will be penalties for failing to keep information current.</p> <p>Moreover, it is anticipated that there will be a process whereby registrations will be removed from the Clearinghouse if it is discovered that the marks are procured by fraud or if the data is inaccurate.</p>	<p>term of registration, name of the mark holder, classes of goods and services etc.): see http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/Terms%20and%20Conditions%20for%20Trademark%20Holders.pdf and http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20terms%20and%20conditions%20-%20Trademark%20Agent%20-%201.1.pdf,</p>	<p>WG to follow up with Deloitte on finding out information as to whether and when a cancelled trademark has been pulled out of the TMCH.</p>
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GENERAL NOTE:

From the Applicant Guidebook –

1.5: [TMCH] functions will be performed in accordance with a limited charter, and will not have any discretionary powers other than what will be set out in the charter with respect to authentication and validation. The Clearinghouse administrator(s) cannot create policy. Before material changes are made to the Clearinghouse functions, they will be reviewed through the ICANN public participation model.