SELECTED TMCH CHARTER QUESTIONS MATCHED WITH DOCUMENTATION FROM THE APPLICANT GUIDEBOOK AND OTHER MATERIALS DEVELOPED FOR THE 2012 NEW gTLD PROGRAM
28 February 2017

CATEGORY 3 – BREADTH AND REACH (SCOPE)

Charter Questions	STI Recommendations (approved by GNSO Council & ICANN Board)	Applicant Guidebook	Deloitte Guidelines/Other Materials Developed for the Program	WG Discussion (up to 22 February 2017)
7. How are design marks currently handled by the TMCH provider?	**Marks Eligible for Inclusion in the TC:** 4.1: National or Multinational Registered Marks[1] 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 ST	**Criteria for TM Inclusion in the Clearinghouse:** 3.2: Standards for inclusion in the Clearinghouse 3.2.1 Nationally or regionally registered word marks from all jurisdictions. 3.2.2 Any word mark that has been validated through a court of law or other judicial proceeding. 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.	**TMCH Guidelines:** 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. 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.	Follow up with Deloitte on original Sub Team question (especially on validation criteria used and how they differentiate between design marks); add request for: (1) examples of marks that were accepted and marks that were rejected; and (2) Deloitte's view as to whether select WG examples would have been accepted or rejected (e.g. "parents"). Rebecca Tushnet to take lead in developing examples for (2), above.

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[1] This recommendation achieived a Rough Consensus among the STI, with the Commercial & Business Users Constituency (BC) submitting a Minority Statement.

	was under a mandate not to expand existing trademark rights.) 4.2: Common Law Rights[2] No common law rights should be included in the TC Database, except for court validated common law marks; provided that a new gTLD Registry may elect to have the TC Service Provider collect and verify common law right provided that it conforms to Recommendation 2.3. **Functionality of TC:** 2.3: Segregation of TC Database[3] 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.	3.2.4 Other marks that constitute intellectual property. 3.2.5: Protections afforded to trademark registrations do not extend to applications for registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings. 3.6: Data supporting entry into the Clearinghouse 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 based on the services any given registry operator choses to provide.	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: - 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. In the event that there is any doubt about the order	WG to review and discuss if original intent for the TMCH included the acceptance of design marks.

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[2] This recommendation achieved a Rough Consensus amongst the STI, with the At Large community and the BC each submitting a Minority Statement.
[3] This recommendation achieved Unanimous Consensus across the STI.

| | 9: Effect of filing with the TC
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. | 5.2: For validation of marks by the Clearinghouse that were 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.

1.6: Inclusion in the Clearinghouse is not proof of any right, nor does it create any legal rights. Failure to submit trademarks into the Clearinghouse should not be perceived to be lack of vigilance by trademark holders or a waiver of any rights, nor can any negative influence be drawn from such failure.

1.2 The Clearinghouse will be required to separate its two primary functions: (i) authentication and validation of the trademarks in the | 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." | |

		Clearinghouse; and (ii) serving as a database to provide information to the new gTLD registries to support pre-launch Sunrise or Trademark Claims Services.		
8. How are geographical indications, protected designations of origin, and protected appellations of origin currently handled by the TMCH provider?	No express mention of geographical indicators, but the following sections may be useful for the WG's analysis: Marks Eligible for Inclusion in TC: 4.1: 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). Functionality of TC: 2.3: The TC Service Provider should be required to maintain a separate TC database, and may not store any data in the TC database	3.6: Data supporting entry into the Clearinghouse 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 based on the services any given registry operator choses to provide. 3.5: Data supporting entry into the Clearinghouse of word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion, must include a copy of the relevant portion of the statute or treaty and evidence of its effective date.	**TMCH Guidelines:** 2.4.1 Marks protected by statute or treaty "may include but are not limited to geographical indications and designations of origin" (provided the relevant statute or treaty is in effect at the time of submission (for Sunrise eligibility, the statute or treaty must have been in effect on 26 June 2008)). 2.4.4 "Any mark protected under statute or treaty that does not contain any letters, words, numerals or DNS-valid characters" or "of which the statute or treaty is only applicable to a certain region, city or state" will not be accepted for submission.	Deloitte seems to have accepted marks with geographical overtones/elements. This Q8 to be sent to Deloitte, asking specifically how these marks are handled. Following Deloitte's response, WG to discuss whether G.I.s, P.D.O.s and A.O.C.s should be accepted into the TMCH if they are not also nationally/regionally registered TMs, court-validated or protected by statute/treaty (i.e. the current TMCH criteria). Staff to find out from OriGIn who might be able to submit GIs. • From Massimo Vittori (OriGIn): "GIs associations or

	related to its provision of ancillary services, if any. For validation of marks by the Clearinghouse that were 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. 1.6: Inclusion in the Clearinghouse is not proof of any right, nor does it create any legal rights. Failure to submit trademarks into the Clearinghouse should not be perceived to be lack of vigilance by trademark holders or a waiver of any rights, nor can any negative influence be drawn from such failure.	NOTE: For marks protected by statute or treaty, the TMCH Guidelines state that where there is no online database, a copy of a certificate from an official authority with the right to certify certain marks as qualifying under that statute or treaty must be submitted. An example in the Guidelines refers to the Protected Geographical Indication of Scottish wild salmon (Section 5.5).	groups (called Federations, Consorzia, Consejos Reguladores, Comités interprofessionels, depending on their country and language) are responsible to protect their respective GIs. In practice, they perform the procedures of GIs registration and enforcement at the national level as well as in in foreign jurisdictions where they seek protection. If we use the expression "GIs governance bodies" (rather than "certification bodies/associations"), I believe we will capture the essence of such GIs associations or groups, notwithstanding their country or language."

9. Should the TM+50[4] be retained as is, amended or removed?	Marks Eligible for Inclusion in TC:
	
	 4.3: Conversion of Marks into TC Database[5]:
	 The TC Database should be structured to report to registries strings that are considered an "Identical Match" with the validated trademarks. "Identical Match' [sic] means that the domain name consists of the complete and identical textual elements of the Mark. * * * [details in section]
		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:
		    (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
			20 March 2013 Memorandum on the "Strawman Proposal" for TM+50:
			 … proposal that where there are domain labels that have been found to be the subject of abusive registrations (for example, as a result of a UDRP or court proceeding), a limited number (up to 50) of these could be added to a Clearinghouse record. These names would be mapped to an existing record where the trademark has already been verified by the Clearinghouse.
			
			 Implementation Notes 16 July 2013:
			 1.Submission of Additional Labels
			 Users will be able to add the appropriate domain labels and the relevant decision information to a verified trademark record
				WG to review questions suggested by Registries SG, to see if any/some/all should be followed up with Deloitte on.
				
				 WG to ask Deloitte if a separate SMD file is created for every additional Previously Abused Label submitted.
				 • Note from AC chat: As the TM+50 labels are used only for Claims and not Sunrise, SMD files for these additional labels are not needed.

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[4] Trademark owners can add up to 50 variations that are similar to each valid submission in the TMCH—within the notification process—provided that the variant of the mark was awarded to the trademark holder in a prior UDRP case.
[5] This recommendation achieved a Rough Consensus amongst the STI, with the BC submitting a Minority Statement.

		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 for identical matches; and (d) no plural and no "marks contained" would qualify for inclusion.	via the existing Trademark Clearinghouse user interface. The decision must have been rendered by either an approved UDRP service provider or a court of law at the national level. For UDRP decisions, the user will need to provide the following information: [list of 4 criteria and right of TC to request UDRP decision] * * * 2. Verification of Additional Labels Upon submission of this information, the Trademark Clearinghouse will verify: - (a) the trademark information included in the decision; and - (b) the domain names included in the decision. To be successfully verified, the trademark cited in a decision must match the trademark in the existing Clearinghouse record (number and jurisdiction), and the domain labels submitted for addition to	

			the record must be included in the decision. <u>4. Protections for Additional Labels</u> Labels that are successfully verified and associated with a Clearinghouse record will be included in the Trademark Claims service, with the relevant decision information included as data elements in the Claims notice provided to registrants… These labels will not be eligible for sunrise service (i.e., the holder does not receive an SMD demonstrating eligibility to register these labels as domain names).	
10. Should the TMCH matching rules be retained, modified, or expanded, e.g. to include plurals, 'marks contained' or 'mark+keyword',	<u>Marks Eligible for Inclusion in TC:</u> 4.3: The TC Database should be structured to report to registries strings that are considered an "Identical Match" with the validated trademarks. "Identical Match' [sic] means that the domain	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.	**20 Sept 2012 Explanatory Memorandum on Matching Rules:** "Identical Match" means that a domain name consists of the complete and identical textual elements of the mark. In this regard:	No follow up needed with Deloitte; WG to discuss further.

and/or common typos of a mark?	name consists of the complete and identical textual elements of the Mark. In this regard: (a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted, and (b) only certain special characters contained within a trademark are spelt 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 contained" would qualify for inclusion.	"Identical Match" means that the domain name consists of the complete and identical textual elements of the mark. In this regard: (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 for identical matches; and (d) no plural and no "marks contained" would qualify for inclusion.	(B) Special characters @ and & contained within a trademark may be spelled out with appropriate words; and (C) Other 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 hyphens. Plural versions of a mark or domain names containing the mark are not considered an Identical Match for purposes of these baseline services 2.1 Defining an Identical Match: All Clearinghouse trademark comparisons occur by comparing the textual elements of a mark with the second level label of the domain name being registered. When all and only the complete and identical textual elements exist in both the trademark and the label, it is	

			considered an identical match.

Four additional criteria, any of which could result in additional matches to a trademark record, are also applicable according to the community-developed requirements:
    (a) Spaces contained within a mark that are either replaced by hyphens (or 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 may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches
    (d) No plural and no "marks contained" would qualify for inclusion. | |

			2.2 Critical Principles: 2.2.1 The Clearinghouse must be able to apply the matching rules consistently. 2.2.2 Application of the matching rules must be done in a technically feasible and commercially viable manner. 2.2.3 The approach adopted should provide value for the cost. 2.2.4 Application of the matching rules must protect trademark rights as agreed during the community development of the Clearinghouse processes, without either unduly expanding or limiting the scope of verified rights. **TMCH Guidelines:** 4.2 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 … 4.3 When a Trademark contains a special character that cannot be represented in a domain name label, the following rules will apply: - Special characters contained within a Trademark that are unable to be used in a domain name label may be either: (i) omitted; or (ii) replaced by hyphens. - In addition, special characters "@" and "&" contained within a Trademark may be spelled out with appropriate words of the official language(s) of the country/jurisdiction in which the mark is protected. However, in accordance with	

			the ICANN IDN Guidelines, labels with mixed scripts will not be generated. NOTE: Labels have to be added manually to the relevant TMCH record.	
11. Should the scope of the **RPMs associated with the** TMCH be limited to apply only to **TLDs that are related to** the categories of goods and services in which the dictionary term(s) within a trademark are protected?	5.1 TM Claims or Sunrise[6]: All new gTLD registries should be required to use the TC to support its pre-launch rights protection mechanisms (RPMs) that should, at a minimum, consist of a TM Claims process or a sunrise process that meets the minimum standards and sunrise challenge grounds as specified in the IRT Report, except to the extent that a registry elects not to extend sunrise protection for certain trademarks as described in 5.2 below. There is no requirement that a registry adopt both of these RPMs.	All new gTLD registries will be required to use the Trademark Clearinghouse to support its pre- launch or initial launch period rights protection mechanisms (RPMs). These RPMs, at a minimum, must consist of a Trademark Claims service and a Sunrise process.		No follow up needed with Deloitte; WG to discuss further.

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[6] This recommendation achieved Unanimous Consensus across the STI.

	5.2: Protection for all TMs in the TC[7] New gTLD registries should provide equal protection to all trademarks in the TC for their RPMs, except as follows: (i) Inclusion of a trademark in the Trademark Clearinghouse from a country where there is no substantive review does not necessarily mean that a new gTLD Registry must include those trademarks in a Sunrise or IP Claims Process; or (ii) Registries shall have discretion to decide whether to grant protections to trademarks in the TC. ICANN could allow specialized gTLDs			

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[7] This recommendation achieved Rough Consensus amongst the STI, with the Intellectual Property Constituency filing a Minority Statement.

	to restrict eligibility for sunrise registrations to fit the purpose of the registry as described in the charter.			

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.