**QUESTIONS FROM THE REVIEW OF ALL RIGHTS PROTECTION MECHANISMS IN ALL GTLDS TO THE TRADEMARK CLEARINGHOUSE PROVIDER**

**Updated as of 5 December 2016**

1. What is the rate of rejection (e.g. in percentage terms) of an attempted registration of a trademark into the TMCH, by country/region of the trademark holder?

The Trademark Clearinghouse is a repository of verified trademark information. The verification provider checks whether a specific mark record meets the requirements as specified in the Applicant Guidebook and further defined in the Trademark Clearinghouse Guidelines. In the event that a specific trademark record does not meet the requirements the trademark record will not receive any services, such as sunrise services or trademark claims services and receives the status “invalid”. Such reasons can be, but are not limited to: 1) the name of the mark as submitted to the TMCH does not match the name of the mark that is registered with the Trademark Office; 2) The name of the holder as submitted to the TMCH does not match the name of the holder that has a registered trademark with the Trademark Office; 3) The trademark is not yet registered with the Trademark Office and 4) The trademark has expired and no proof of renewal was submitted by the trademark holder.

The number of invalid trademark records is on average 8% of the total number of mark records submitted to the Clearinghouse. In this population 43% of these trademark records have been submitted by trademark holders are residing in the United States, followed by the UK with 9%, France, Germany and Switzerland with each 6% and another 63 countries divided over the remaining 30%.

1. What were the most frequently asked questions, by trademark owners, by registry operators, and by registrars?  (Note – not necessarily what made it to the TMCH website but, rather, what questions did you get the most?)

Since the beginning of the TMCH operations, its customer support has answered more than 15.000 questions via the customer support portal, e-mail or phone.

The TMCH has always done an effort to transform the most relevant and frequent questions into frequently asked questions that were documented on the TMCH marketing website and as such could be consulted 24/7. As it was never requested to have official statistics on the type of support questions received we are currently not in a position to provide official statistics. Based on our customer support team experience, most of the questions relate to the actual trademark management such as 1) how do I a submit a trademark record; 2) for what purpose is the trademark record deemed incorrect or; 3) I have received a claims notification, what do I do now.

1. If you are able, please provide the number and/or percentages of SMD files that were used in Sunrise periods corresponding to specific time periods (e.g. as of January, June and September 2014; April and September 2015; and April and September 2016).

The TMCH is a central repository of the verified trademark information. Once the trademark information and Proof of Use is verified, the users obtain access to their SMD file. However, to which extent and how they use these SMD files is not part of the TMCH scope.

1. Are the registration totals contained within the various monthly/quarterly reports made to ICANN cumulative?

As the TMCH is not allowed to delete any mark records, the total number of trademark records submitted to (the TMCH doesn’t register trademarks) the Trademark Clearinghouse can be found under section 2.3. in the report provided to ICANN on a monthly basis and are indeed cumulative.

1. What is meant by the term ‘expired marks’ in the various monthly/quarterly reports made to ICANN?

A user can submit a trademark record for a certain period of time. Upon verification of the trademark record, the user obtains access to the different services provided by the TMCH. Once the duration of the services has lapsed, the TMCH user can opt to renew the services. In the event that that the user does not opt to renew the services, the services will no longer be provided and the trademark record, will receive that status “expired”.

1. In relation to the statistics regarding the number of marks submitted to the TMCH, as noted in the various monthly/quarterly reports to ICANN, does this statistic relate to individual marks that are submitted, or the number of labels generated, or the number of SMD files created?

We explicitly refer to TMCH’s monthly report provided to ICANN per ICANN’s requirements. The multiple sections in this report relate to any and/or combination of the above mentioned items.

1. How are marks cancelled within national/regional registries handled at the TMCH level, if validation is only done annually? In other words, what is the TMCH process (if any) relating to marks that are cancelled or expire: reactive (e.g. TM owner/agent obligations) or proactive?

As stipulated in the TMCH guidelines by ICANN, a user with a verified mark in the TMCH has the obligation to notify the TMCH as soon as possible when a trademark is cancelled by the trademark office. Upon notification of such information, the user will no longer obtain the services of the TMCH.

As for the expiration of a mark by the trademark office, this is monitored by us as the actual expiration date is part of the trademark information that is verified. In the event that a mark would expire during the term of service, the user is notified hereof and is requested to provide us with a renewal certificate of the actual trademark.

8. If it is possible, please provide a breakdown (by country) of where the corporate headquarters of those registrants using TM agents are located.

Please note that the Trademark Clearinghouse does not have this information as this is not part of the scope of the Trademark Clearinghouse.

9. Some data has been provided regarding outreach efforts; if you can, please provide additional information on the precise nature of the activities undertaken and who was the audience for this? Were any outreach efforts made to potential registrants or trademark owners? More specifically:

* How much time and resources were expended on educating TM owners and/or registrants on the TMCH?
* Was outreach and education part of the TMCH remit? What are the contractual obligations for education imposed by ICANN, if any?
* In what regions/languages were outreach sessions held?

Outreach & education was not defined as being part of the TMCH scope. However, the necessity of education and outreach became very clear from the start of the TMCH as there was limited awareness of the gTLD program as whole and by consequence also the TMCH. Taking this into account, the TMCH has invested a lot of time & effort in creating awareness through:

* Organizing various webinars
* Attending all ICANN meetings
* Attending and promoting the TMCH at INTA
* Organizing various workshops together with our agents
* Creating educational brochures and video’s
* Creating marketing material
* Drafting articles for various IP magazines

These sessions and materials have been delivered and provided in various regions and languages. More specifically the TMCH has hosted and sponsored various IP meetings and seminars in various countries of Europe, Russia, China, Taiwan, Japan, the Middle East and in the US in the various languages spoken in these countries.

10. How many design marks have been submitted and validated? What is your criteria for validating these? How are you differentiating between design marks in the practical application of the TMCH guidelines?

Please define what is exactly understood under “design marks” as there is no globally consistently accepted definition of this mark type.

However, we refer to Section 5 of the Trademark Clearinghouse Guidelines in order to better understand our verification process.

11. In relation to Claims Notice statistics, can any discernible trends be noted in relation to: (i) registrar gaming, and (ii) registrant turn-back as a result of a possible “chilling effect” resulting from the issuance of a Claims Notice (via the CNIS)?

* While the Working Group understands that the TM Database (TMDB) does not show whether a label is ultimately registered, can you tell us if there is a way of tracking trends e.g. by logging the times of responses, the number of automated responses, or number of queries from the same registrar?
* NOTE: By using the term “registrar gaming”, the Working Group is seeking information from the TMCH as to whether and the extent to which interrogations of the TMCH data by registrars may not be legitimate attempts to register domain names but attempts to identify the marks which have been recorded for some other purpose.

As you refer in your question to the TM Database, we suggest that you contact that the TMDB provider.

12. Can you tell us who is using the TMDB and under what circumstances (other than for providing the Sunrise and Claims Notice services required by ICANN)? How many “blocking”-type services are you supporting (e.g. protected marks lists), and with/for whom? Are you aware of other services that may be provided by registry operators using the TMDB other than via contract with you?

As you refer in your question to the TM Database, we suggest that you contact that the TMDB provider.

13. How many "court-validated" marks are there currently in the TMCH?

The monthly numbers of the court validated marks have been reported in the monthly reports provided to ICANN.

14. How many marks in the TMCH fall under the following category: "Other marks that constitute intellectual property and meet a registry's individual requirements"? How would Deloitte keep these marks from being used in the Sunrise and Claims periods of other registries?

As to date, no registry operator has pursued this option with the TMCH.

15. Did any trademarks that applied for entry into the TMCH fail in the “actual use” test? If so, how many? Did you receive any complaints of trademarks registered in the TMCH that they were not in

actual use?

Under this section we assume that the “actual use” refers to the sunrise eligibility requirements as laid down by the Applicant Guidebook. In this respect, it is very difficult to provide historical figures on this at any moment of time. We can however, state that at this moment an average 4% of the active TMCH records are not sunrise eligible. We have not received any complaints regarding the sunrise eligibility requirements and our verification process.

16. How many TMCH records include a TM+50 list; and how many are on this list on average? How many registrations were made for entries on the TM+50 list?

The abused domain name labels can only be added in the event that a submitted trademark record has been verified. In this respect, 209 UDRP cases have been submitted to the trademark records linked to 209 TMCH records. These URDP cases cover in total 375 abused domain name labels.

17. Have any gTLDs used the TMCH option to limit registrations by goods and services during a particular registration period?

* NOTE: the question refers to the following from the TMCH RPMs Requirements:

*2.3.1.1 Registry Operator MAY apply restrictions relating to the underlying rights of a Trademark Record related to the purpose of the TLD (e.g., restrictions on the class of goods or jurisdiction of the Trademark Record that are related to the TLD).*

* This question also refers to the ability of registry operators to use the TMCH to register additional terms into a Provider database tailored to the specific use/need of the New gTLD. E.g., as originally envisioned, it was to allow (for example), a .PIZZA registry to allow pizza restaurants to preregister in a Provider-run database. Thus, Joe's Pizza might not have a trademark (being too descriptive, for example), but it could pre-register into a special database or place in the database run by the Provider for .PIZZA. Is there any use of the TMCH for this type of use? If so, how much, how extensive, who?

Upon request of the community, the SMD-file was designed in such a way that the Registry Operator had at all times the necessary information to limit registration by goods and services themselves. As such the TMCH has not been involved in the management or decisions in relation to any restrictions implemented by the Registry Operator.

18. How many (or what percentage of) marks were rejected? Of those accepted, how many (or what percentage) failed the “actual use” test? Of those that passed the “actual use” test, how many were the subject of complaints? What is a breakdown of the reasons?

We kindly refer to our responses in question 1 and question 15.

19. How many SMD files has the TMCH revoked as a result of cancellation or expiration of the underlying trademark(s)?  How many TMCH disputes have been brought relating to SMD file validity for trademarks that are cancelled/expired?

Please note that are numerous reasons why a SMD file is revoked. A SMD file, as requested by the community, contains the trademark information and the contact information. This entails that each change revokes the current SMD file and a new SMD file is generated. In addition, a user can opt out of the sunrise services at any time which revokes the current SMD file as well as the fact that the information of trademark record is no longer accurate.

Consequently, we do not keep track of the reasons why a SMD file is revoked as this is technically linked to the different stages and interactions with the Trademark Clearinghouse. Due to this and the mere fact that this was never imposed by the community, the validity of a SMD file is not a reason for dispute with the TMCH.

20. Have there been any Sunrise Dispute Resolution Processes (DRPs) where the underlying trademarks relied on at Sunrise had already expired or been cancelled? In addition to this specific point, the Working Group welcomes information relating to all three types of DRP:

·         Disputes brought by trademark holders or agents alleging that the TMCH **incorrectly rejected** a trademark record;

·         Disputes brought by third parties alleging that the Clearinghouse **incorrectly accepted** a trademark record; and

·         Disputes brought by third parties alleging that a trademark record is **no longer valid** based on new information (i.e. information not available to the Verification Provider at the time it reviewed the trademark record.

As of date, the TMCH has not received any formal TMCH disputes from third parties which excludes types2 and 3 as described above. All disputes that have been brought before the TMCH related to the fact that the trademark holder did not agree with the verification process (type 1).

21. What is the geographic distribution of those who record marks in the TMCH – bearing in mind that TMCH agents may be in a different country to the TM owner and that TM owners may record a mark registered in a different country to the one they are based in?

We kindly refer to the reports made available to ICANN.

22. By country/region, what is the percentage of: (i) trademarks recorded in the TMCH; (ii) Sunrise registrations by trademark holders; and (iii) Notices of Registered Name (bearing in mind that TMCH agents may be in a different country than the TM owner and that TM owners may record a mark registered in a different country from the one in which they are based)?

The monthly numbers of trademark records submitted and split up by country/region can be found in the monthly report provided to ICANN.

The numbers of sunrise registrations refer to the actual domain name registration during sunrise and is not part of the scope of the TMCH.

The split by country/region of notices of registered names should be in line with the split of monthly number of the trademark records per country/region, as a notice of registered name can only be sent/received based on a submitted and verified trademark record.