**FOLLOW UP QUESTIONS FOR DELOITTE FROM THE GNSO’S REVIEW OF ALL RIGHTS PROTECTION MECHANISMS (RPM) REVIEW POLICY DEVELOPMENT PROCESS WORKING GROUP**

1. Previous community feedback has indicated that, although the TMCH verification process appears generally effective in restricting non-eligible marks, there may be a lack of consistency in the application of the submission, verification and/or rejection criteria for inclusion of a trademark record in the Trademark Clearinghouse (TMCH). For example, some community commenters have indicated that it is not always clear why a particular submission was rejected, or what is acceptable as proof of use[[1]](#footnote-1). This is a topic that the Working Group would like to discuss further with you at ICANN58 in Copenhagen.
2. The Working Group understands that the TMCH Database (TMDB) is not searchable publicly; however, the TMCH Dispute Resolution Procedures appear to contemplate the possibility of third party (i.e. not a trademark holder or agent who has recorded trademark labels in the TMCH) 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. Is it possible for third parties to find information about what trademarks have been recorded in the TMCH, including for purposes of challenging their recordal?
3. Please provide feedback on what Deloitte’s “learning curve” has been in terms of setting up and operating the TMCH, from its launch to the present.
4. Your initial feedback was that all TMCH-related disputes brought to date have been by trademark holders who did not agree with the TMCH verification process. Can you tell us how many (if any) of those disputes resulted in a reversal of your original decision?
5. We note your feedback that, as stipulated in the TMCH Guidelines, 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 relevant trademark office. Can you tell us whether, in such cases, the trademark record is then withdrawn from the TMDB and, if so, when this is done?
6. In relation to our original question to you about “design marks”, we wish to clarify that we were referring to what the TMCH Guidelines describe as “device” or “image” marks, or otherwise marks that do not exclusively consist of letters, words, numerals, special characters (see TMCH Guidelines p. 20). In this regard, we will appreciate if you can provide feedback on the following questions:
* How many such “device” or “image” marks have been submitted and validated?
* What is your criteria for validating these?
* How are you differentiating between these marks in the practical application of the TMCH Guidelines?
* Can you provide examples of such marks that were accepted into the TMCH?
* Can you provide examples of such marks that were rejected for inclusion in the TMCH?
* Please refer to the list of examples (attached as Annex A) that have been developed by the Working Group as “device” or “image” marks that may hypothetically be submitted for verification and inclusion in the TMCH – can you tell us if these would have been accepted or rejected? In particular, can you tell us what rules are applied in practice to determine the "prominent" textual aspects of a figurative mark?
1. We understand that the TMCH accepts marks that are protected by statute or treaty, in addition to registered and court-validated marks. Can you tell us more specifically how you handle submissions comprising geographical indications, protected designations of origin, or protected appellations of origin?

**ANNEX A: LIST OF EXAMPLES OF DEVICE OR IMAGE MARKS**

**EXAMPLE #1: Parents (registered for magazines)**



Word Mark PARENTS

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Registration Number 2654160

**EXAMPLE #2: Fruit of the Loom (in oval)**

 FRUIT OF THE LOOM



Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Registration Number 1234708

**EXAMPLE #3: Cars**

 

Registration Number 3419857

Mark drawing type 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the word "CARS" in stylized lettering, surrounded by a dark oblong and superimposed over a stylized "V".

<https://tsdr.uspto.gov/#caseNumber=78538954&caseType=SERIAL_NO&searchType=statusSearch>

1. See, e.g., public comments to the October 2015 Preliminary Issue Report for this Policy Development Process: <https://forum.icann.org/lists/comments-rpm-prelim-issue-09oct15/>; and public comments to the draft ICANN staff report on RPMs, published in February 2015: <https://forum.icann.org/lists/comments-rpm-review-02feb15/>. [↑](#footnote-ref-1)