

## Recommendation for Question #8: Marks Protected by Statute or Treaty

It is with considerable interest that the RPM WG has evaluated the question of Deloitte accepting into the TMCH database marks protected by statute or treaty. In our investigation we have found:

1. The wording that creates this subcategory of protected marks does not come from the recommendations adopted by the GNSO Council or ICANN Board;
2. Everyone who sees these rules interprets them differently:
  - Some think it is solely to protect those marks expressly set out in treaty, e.g., “Olympics”
  - Others think it is to protect categories of organizations, such as International Governmental Organizations; and
  - Still others think it is to protect such as geographical indications.
3. Deloitte will not explain how they interpret this section or what they are accepted into the TMCH database.
4. Acceptance of “marks protected by statute or treaty” appears to be a direct violation of the original intent and instructions of the rules adopted by the GNSO Council and ICANN Board.

Specifically, Item 1.1 of the TMCH rules adopted by the Council and Board provides for only acceptance of trademarks:

**“The name of the rights protection mechanism should be the ‘Trademark Clearinghouse’ to signify that only trademarks are to be included in the database.”**

Section 1. Name; 1.1 Trademark Clearinghouse;

<https://gnso.icann.org/en/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

Second, by these adopted rules, anything that is not a trademark cannot be entered into the main TMCH Database, but may be segregated into another “ancillary database”:

**“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.”**

Section 2, Functionality of the Trademark Clearinghouse, 2.3 Segregation of the Trademark Clearinghouse Database.

Finally, the limitations above were passed by “Unanimous consent” of all Stakeholder Groups in the STI, and then adopted unanimously by the GNSO Council and ICANN Board.

***Accordingly, the rules adopted by the GNSO Council and ICANN Board are very clear: the Trademark Clearinghouse is for Trademarks.***

*Origin of Problem:*

The Applicant Guidebook appears to be the source of this odd expansion of subcategories for “marks” being accepted into the Trademark Clearinghouse database. In the Applicant Guidebook, Module 5, *Trademark Clearinghouse Section*, we find:

**Section 3, *Criteria for Trademark Inclusion in Clearinghouse:***

**“3.2 The standards for inclusion in the Clearinghouse are:**

**3.2.1 [Skipped]**

**3.2.2 [Skipped]**

**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.**

**3.2.4 Other marks that constitute intellectual property.”**

<https://newgtlds.icann.org/en/applicants/agb>

It is not clear that 3.2.3 is only for trademarks (and clearly Deloitte does not interpret it so) or what 3.2.4 means or includes. In all events, neither of two subcategories were discussed or approved by the GNSO Council and ICANN Board.

Further, under the express rules adopted, any results of 3.2.3 and 3.2.4 that are not trademarks would have to be entered into a **different database, not the main Trademark Clearinghouse database used for Community-Approved RPMs** (per STI Recommendations, Section 2, Functionality of the Trademark Clearinghouse, 2.3 Segregation of the Trademark Clearinghouse Database above).

Overall, we know that at least 75 terms have been approved by Deloitte under 3.2.3 without regard to their trademark status and are currently in the TMCH Database.

*Harm:*

The TMCH Database is growing beyond the rules established and set by the GNSO Council, ICANN Board or ICANN Community. This deeply harms the Multistakeholder Process. As discussed extensively on the RPM PDP WG list, the original GNSO committees worked long and hard and carefully balanced the rights of those seeking trademark protection and those seeking to register domain names in New gTLDs. Allowing into the Trademark Clearinghouse new types of entries is a decision for this Working Group, but not for Deloitte or ICANN Staff.

Second, these subsections allow a level of interpretation and discretion never intended for the Trademark Clearinghouse Provider. Through Section 3.2.3 and 3.2.4, Deloitte is engaged in a new function of discretion, interpretation and choice – one without rules, guidance and oversight by ICANN and ICANN Community. Ultimately, we don't even understand what is being accepted (and Deloitte would not tell us).

Third, these subsections (3.2.2 and 3.2.4) harm all of those seeking to register domain names, in good faith for their new groups, companies, goods, services, hobbies, speech, research and education. Absent a trademark right of precedence, all other domain names should be open and available to the world to register. That was the promise of the New gTLD Program.

*Action:*

The WG has an oversight obligation to ensure the rules adopted by the Community are followed. We can ensure that subcategories 3.2.3 and 3.2.4 are allowed **only to the extent they are registered trademarks**. Alternatively, the Working Group **by consensus** may CHANGE the rules and present to the GNSO Council and the ICANN Board a new set of standards by which Deloitte (or any future TMCH provider) may review and accept these subcategories of marks.