

**FOLLOW UP QUESTIONS FOR DELOITTE FROM THE GNSO'S REVIEW OF ALL RIGHTS PROTECTION
MECHANISMS (RPM) REVIEW POLICY DEVELOPMENT PROCESS WORKING GROUP
Updated 5 March 2017**

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 use¹. This is a topic that the Working Group would like to discuss further with you at ICANN58 in Copenhagen.

The verification services performed by the Trademark Clearinghouse verification agents strictly follow the requirements and rules set forth in the Trademark Clearinghouse guidelines. Note that these TMCH guidelines are drafted based on ICANN's requirements as specified in the gTLD Applicant Guidebook.

The TMCH guidelines are published on the Trademark Clearinghouse website and available for all trademark agents/holders who are submitting trademark records. When trademark records are submitted, these records are verified by at least 2 independent TMCH verification agents who verify the eligibility requirements; these include the accuracy and completeness of the information submitted matching the trademark certificate available in the online trademark database or provided in attachment as documentary evidence by the trademark agent/holder. When a trademark record or POU submission is rejected or set on 'incorrect', the verification agents always provide "standardized external comments" regarding the errors made. These comments indicate why a trademark record does not meet the eligibility requirements and/or which fields are not corresponding with the trademark certificate. Trademark agents and holders are notified of their records' incorrect status. Hence, they are offered one chance to correct and re-submit their trademark records based upon the external comments provided. Moreover, the external comments are clarifying to the trademark holder or agent why a record is set on an incorrect status and which fields need to be corrected/amended before re-submission. As a result, any holder or agent should have sufficient self-explanatory info as to why a particular submission was rejected.

Incorrect POU submissions are also clarified by the provision of standardized external comments on which trademark holders and agents can rely to correct the POU submission. The Trademark Clearinghouse has clearly defined proof of use verification as follows: "When examining the sample of proof of use submitted by the trademark holder or trademark agent it will be verified that the sample submitted is a sample that evidences an effort on behalf of the trademark holder to communicate to a consumer so that the consumer can distinguish the product or services of one from those of another." Therefore, examples of acceptable evidence would include items from either of the following categories:

- 1. Labels, tags, or containers from a product.*

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/>.

2. Advertising and marketing materials (including brochures, pamphlets, catalogues, product manuals, displays or signage, press releases, screen shots, or social media marketing materials). Furthermore, the Trademark Clearinghouse has submitted a “how to submit a proof of use manual” on its marketing website which clearly explains the purpose of a sample of proof of use and includes examples of (im)permissible samples.

Please refer to http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/how_to_submit_a_proof_of_use_v1.1.pdf

- The range of samples accepted to support verification of Proof of Use by the Clearinghouse is intended to be flexible to accommodate practices from multiple jurisdictions.
- The sample Proof of Use must be an item that evidences Trademark Holder communication to the consumer to distinguish products or services from another Trademark Holder.
- The sample submitted must contain the complete name of the registered trademark as recorded in the trademark records and as verified and determined correct.
- The Clearinghouse will not assume the role of making determinations on the scope of rights associated with a recorded trademark or the labels it can generate.

Deloitte welcomes any further suggestions from the community or ICANN to further define POU standards across the different trademark jurisdictions.

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 trademark records have been recorded in the TMCH, including for purposes of challenging their recordal?

It is correct that the Trademark Clearinghouse database is not publically available and therefore third parties cannot retrieve information regarding what trademark records are recorded in the TMCH.

However, a third party is informed of a record in the TMCH through the claims notice which is presented prior to registration. The claims notice holds the Mark name, Registrant and registrant contact and the jurisdiction and goods and services of the mark recorded in the TMCH.

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.

Working with the TMCH requires understanding of both the complexities of the new gTLD Program as international trademark law. Since its launch the TMCH has received a myriad of questions from different types of actors covering different levels of knowledge. This has resulted in positioning the TMCH as a neutral party and service provider between all actors and setting up

conversations and partnerships with as many stakeholders as possible while offering new forms of collateral such as “how to manuals”, a sunrise calendar, webinars and sponsorship of events. The channel of TMCH agents has proven to be extremely valuable as they can inform their clients, have insight local outreach opportunities and can feedback directly on TMCH operations which has resulted in optimization of the service (such as standardized external comments).

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?

To this date no disputes filed have resulted in a reversal of a trademark record verification.

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?

When a trademark holder informs the TMCH that a mark has been cancelled the mark will be deactivated and the Sunrise and Claims services will be cancelled within 24 hours.

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?
As there is no unilateral international definition of different types of trademarks and the TMCH was designed as a global trademark database covering all jurisdictions the TMCH cannot make a distinction in types of marks and therefore no data is collected on the types of marks submitted in the TMDB.
- What is your criteria for validating these?
These are mentioned in the TMCH guidelines: For those marks that do not exclusively consist of letters, words, numerals or special characters, the verification agents will verify the trademark name based upon the image on the trademark certificate. In the event that there is any doubt about the order in which the characters appear, the description provided by the Trademark office will prevail. In the event no description is provided, such Trademark records will be allocated to a Deloitte internal team of specialists 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 they may request that the trademark holder or agent provide additional documentary evidence on how the Trademark is used.
- How are you differentiating between these marks in the practical application of the TMCH Guidelines?

Except for the verification of the trademark name (i.e. image prevails over description), no special verification guidelines are used for these trademark records that do not exclusively consist of letters, words, numerals or special characters.

- Were there practical or technical considerations that determined the language and scope of the TMCH Guidelines, e.g. the fact that the TMCH is obliged to accept marks from all jurisdictions but not all jurisdictions make a distinction between word or standard character marks, and design/device/image marks?

The TMCH guidelines are created in such way that they could be applied to trademark records across all jurisdictions.

- Can you provide examples of such marks that were accepted into the TMCH?
As there is no unilateral international definition of different types of trademarks and the TMCH was designed as a global trademark database covering all jurisdictions the TMCH cannot make a distinction in types of marks and therefore no data is collected on the types of marks submitted in the TMDB.
- Can you provide examples of such marks that were rejected for inclusion in the TMCH?
As there is no unilateral international definition of different types of trademarks and the TMCH was designed as a global trademark database covering all jurisdictions the TMCH cannot make a distinction in types of marks and therefore no data is collected on the types of marks submitted in the TMDB.
- 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?

The validation team has evaluated the examples as official trademark certificates matching submissions of mark in the TMCH solely for the purpose on providing insight in the verification of marks that do not exclusively consist of letters, words, numerals or special characters. Note that actual submission of marks or labels by a holder/agent may differ from the matching certificate and could cause reasons for rejecting the submission.

Example 1: *Based on the submitted trademark certificate to include the mark “PARENTS” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As such the trademark name “PARENTS” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.*

Example 2: *Based on the submitted trademark certificate to include the mark “FRUIT OF THE LOOM” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As such the trademark name “FRUIT OF THE LOOM” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.*

Example 3: Based on the submitted trademark certificate to include the mark “CARS” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As such the trademark name “CARS” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.

Example 4: Based on the submitted trademark certificate to include the mark “MUSIC” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As such the trademark name “MUSIC” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.

Example 5: Based on the submitted trademark certificate to include the mark “A” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As the image is not fully clear, the description of the trademark as per the trademark certificate was subsequently reviewed. As such the trademark name “A” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.

Example 6: Based on the submitted trademark certificate to include the mark “OWN YOUR POWER” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As such the trademark name “OWN YOUR POWER” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.

Example 7: Based on the submitted trademark certificate to include the mark “DEALHUNTER” in the TMCH the validation team has reviewed the submitted trademark certificate of the trademark record, where the image prevails. As such the trademark name “DEALHUNTER” is acceptable for inclusion in the Clearinghouse providing all other verification standards are met.

7. 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? For example, for those that have been accepted into the TMCH, was verification done purely on the basis either of their being a registered trademark, or demonstrably protected by a statute or treaty?

Submissions comprising geographical indications, protected designations of origin, or protected appellations of origin are only accepted if they are protected by statute or treaty.

For marks protected by statute or treaty, the relevant statute or treaty must be in effect at the time the mark is submitted to the Clearinghouse for inclusion.

The following marks are not considered marks protected by statute or treaty and will NOT be eligible for inclusion in the Clearinghouse:

- Trademark applications or applications for protection of a mark;
- Well-known or famous trademarks, unless also protected by a statute or treaty;
- US state trademarks;
- International trademark applications made via the Madrid system

- *Registered trademarks that were subject to successful invalidation, cancellation, opposition or rectification proceedings;*

See accompanying document for ANNEX A: LIST OF EXAMPLES OF DEVICE OR IMAGE MARKS