**TMCH Recommendation # [insert number]**

The Working Group recommends that the scope and applicability of the TMCH be clarified and limited in accordance with the following agreed policy principles:

1. Only word marks that meet one of the following requirements are eligible for the mandatory Sunrise and Trademark Claims RPMs:
	1. Nationally or regionally registered word marks from all jurisdictions; or
	2. Word marks validated by a court of law or other judicial proceeding; or
	3. Word marks that are protected by a statute or treaty that is in effect at the time the mark is submitted to the TMCH and that are listed with a national or regional trademark office. This provision is important for the protection of certain marks of international governmental and non-governmental organizations (see Explanatory Note below).
2. “Word marks” include service marks, collective marks, certification marks and word marks protected by statute or treaty, as further limited by Policy Principle #3 below.
3. Geographical indications, protected designations of origin, and other signs protected by quality schemes[[1]](#footnote-1) for distinguishing or indicating the geographic source or quality of goods or services are not eligible for the mandatory Sunrise and Trademark Claims RPMs unless they are also trademarks as defined in 1(a) or 1(b) above.
4. The TMCH provider(s), registry operators and other third parties may provide ancillary services to intellectual property rights-holders. To the extent that the TMCH provider validates and accepts other forms of intellectual property (such as geographical indications) in order to provide such additional voluntary services, these other forms of intellectual property must be held in a separate ancillary database.

The Working Group recommends that the Implementation Review Team consider adopting the following language in amending the Applicant Guidebook to reflect the agreed policy principles noted above:

3.2.1 Nothing in this section shall exclude the Clearinghouse provider and registry operators from offering additional voluntary services to mark holders.

3.2.2 In this section “word mark” includes service marks, collective marks, certification marks, and word marks protected by statute or treaty.

3.2.3 The standards for inclusion in the Clearinghouse in order to be eligible for the mandatory Trademark Claims and Sunrise RPMs are:

(1) Nationally or regionally registered word marks from all jurisdictions;

(2) Word marks that have been validated through a court of law or other

 judicial proceeding;

(3) Word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion and listed at a national or regional trademark office.

(4) Subsection (3) does not apply to geographical indications, protected designations of origin, or other quality schemes unless they also satisfy subsections (1) or (2).

3.2.4 The standards for being validated and accepted for the sole purpose of inclusion in ancillary databases to permit the provision of additional voluntary services, but not for the purpose of accessing mandatory Trademark Claims or Sunrise RPMs are:

(1)  Other marks that constitute intellectual property;

(2) Geographical indications, protected designations of origin, or other quality schemes for distinguishing or indicating the geographic source or quality of goods or services.

3.2.5 ~~A~~pplications for trademark registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings are not eligible for inclusion in the Clearinghouse.

Explanatory Note in relation to word marks protected by statute or treaty:

Treaty organizations and non-governmental organizations protected by statute are not always able to register their word marks at a national trademark office. In some jurisdictions their marks are reflected as a “non-registration” (e.g. the 89 series in the United States Patent & Trademark Office) which ensures no one can subsequently register those marks as a trademark, or are otherwise listed with the relevant trademark office. Where such word marks are listed with a national or regional trademark office, they must be treated within the Clearinghouse in the same way as a registered word mark or a court validated word mark and must be eligible for Claims and Sunrise.

An illustrative example of a network of societies whose word marks are protected by international treaty and national statutes is the Red Cross, whose signs and emblems are protected by the Geneva Conventions, and which has signs listed, inter alia, in the 89 series at the United States Patent & Trademark Office.

1. The Working Group is using the phrase “quality scheme” in the sense used by the European Union when describing its quality policy: see, e.g.: <https://ec.europa.eu/info/food-farming-fisheries/food-safety-and-quality/certification/quality-labels/quality-schemes-explained_en>. [↑](#footnote-ref-1)