

Kleiman & Muscovitch Design Mark Proposal

(1) Proposal submitted by Kathy Kleiman and Zak Muscovitch:

We (the RPM Working Group) have found a problem:

1. We have learned that Deloitte is accepting the words of design marks, composite marks, figurative marks, stylized marks, mixed marks, and any similar combination of characters and design (collectively “design marks”).
2. However, the rules *of the Applicant Guidebook (together with STI rules* adopted by the GNSO Council and ICANN Board) expressly limits the acceptance of marks into the TMCH Database to “word marks”.
3. Accordingly, Deloitte is not following the applicable rules adopted by the GNSO Council and ICANN Board for TMCH operation.
4. Whether the current rules should be changed is a separate issue from whether Deloitte is currently complying with the applicable rules. The Working Group by Consensus can determine that the current rules should be changed and present the GNSO Council and ICANN Board with an expanded set of rules that Deloitte, or any future TMCH Provider, must follow.

Rationale for the proposal submitted by Kathy Kleiman and Zak Muscovitch:

A. Expressly Outside the TMCH Rules of the Applicant Guidebook and Prior Work Adopted by the GNSO Council & ICANN Board

STI

The GNSO Council & ICANN Board-adopted rules (based on the STI Final Report and IRT Recommendations) that were very clear about the type of mark to be accepted by the Trademark Clearinghouse:

“4.1 National or Multinational Registered Marks The TC Database should be required to include nationally or multinationally registered “text mark” trademarks, from all jurisdictions, (including countries where there is no substantive review).”
<https://gns0.icann.org/en/issues/sti/sti-wt-recommendations-11dec09-en.pdf>

Further, the adopted rules themselves are very clear about the Harm of putting design marks into the TMCH Database: “[Also 4.1] (The trademarks to be included in the TC are text marks because “design marks” provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.)

Applicant GuideBook

The Applicant Guidebook adopted the same requirements, as it must and should, namely:

“3.2: Standards for inclusion in the Clearinghouse

3.2.1 Nationally or regionally registered word marks from all jurisdictions”

The definition of “word mark” is consistent across trademark organizations around the world:

INTA: *Word Mark (“standard character” drawings)—All letters and words in the mark are depicted in Latin characters; all numbers in the mark are depicted in Roman or Arabic numerals. The mark includes only common punctuation or diacritical marks and does not include a design element. The letters and/or numbers are not stylized.*

<http://www.inta.org/TrademarkBasics/FactSheets/Pages/FilinginUSFactSheet.aspx>

WIPO: *A mark in standard characters is equivalent in some countries to what is known as a “word mark”, as opposed to a “figurative” mark.*

<https://www.wipo.int/export/sites/www/madrid/en/guide/pdf/partb2.pdf>

CIPO: *Word mark: A trademark consisting of words in standard character, without regard to colour or font type.*

<https://www.ic.gc.ca/eic/site/cipointernet-internetopic.nsf/eng/wr00837.html#w>

EUIPO: *A word mark consists exclusively of words or letters, numerals, other standard typographic characters or a combination thereof that can be typed.*

<https://euipo.europa.eu/ohimportal/en/trade-mark-definition>

Nevertheless, and in apposite to the requirements and limitations of the Application Guidebook (and STI rules adopted by the GNSO Council and ICANN Board), TMCH Provider Deloitte is accepting into the TMCH database words and letters it has extracted from composite marks, figurative marks, stylized marks, composite marks and mixed marks. Deloitte is removing words and letters from designs, patterns, special lettering and other patterns, styles, colors, and logos which were integral to the trademark as accepted by the national or regional trademark office.

B. Harm from the Current Form

The harm from this acceptance is that it violates the rules under which Deloitte is allowed to operate. It creates a situation in which Deloitte is operating under its own authority, not that of ICANN and the ICANN Community. Such action, in violation of rules clearly adopted by the GNSO Council and ICANN Board and written into the New gTLD Applicant Guidebook, gives too much power to Deloitte -- a contractor of ICANN, to make its own rules and adopt its own protocol without regard to the scope, breadth and reach of the governing rules.

It is the type of misconduct anticipated by the GNSO Council and ICANN Board, and why the rules demand that ICANN hold a close relationship with the TMCH Provider by contract to allow close oversight and correction of misinterpretation or failure to follow the rules. (See, 3.1 in Relationship with ICANN, Special Trademark Issues Review Team Recommendations).

C. A graphical mark incorporating generic or descriptive terms does not afford protection over the constituent words themselves

It is widely recognized that Words and letters within a composite marks, figurative marks, stylized marks, and mixed marks are generally protected within the mark as a whole only, i.e. marks which incorporate descriptive or generic terms within a logo which includes designs, images, etc are not the subject of independent trademark protection. This lack of rights in such descriptive or generic terms within a “design” or “composite” or “mixed mark” was illustrated in the following WIPO UDRP decision of a unanimous three member panel concerned with an Argentinian registered trademark which comprised graphical elements and a generic term:

Marco Rafael Sanfilippo v. Estudio Indigo, WIPO Case No. D2012-1064, the Panel found:

“Complainant has shown that it owns two trademark registrations in Argentina. The Panel notes that both registrations are for “mixed” marks, where each consists of a composition made of words and graphic elements, such as stylized fonts, a roof of a house, etc. See details of the registrations with drawings at section 4 above.

“As explained on the INPI website, “[m]ixed (marks) are those constituted by the combination of word elements and figurative elements together, or of word elements in stylized manner.” Accordingly, **the protection granted by the registration of a mixed mark is for the composition as a whole, and not for any of its constituting elements in particular.** Thus, Complainant is not correct when he asserts that it has trademark rights in the term “cabañas” (standing alone), based on these mixed trademark registrations.”

In US courts, the **presumption of trademark validity provided by registration does not extend to the non-stylized versions of the registration marks.** See e.g., Neopost Industrie B.V. v. PFE Intern., Inc., 403 F.Supp.2d 669 (N.D. Ill. 2005) (registration of stylized mark didn’t extend protection to nonstylized uses); Kelly–Brown v. Winfrey, 95 F.Supp.3d 350, (S.D.N.Y. 2015) (dealing with special form mark whose words were unprotectable absent stylization), aff’d, Kelly–Brown v. Winfrey, 659 Fed.Appx. 55 (2d. Cir. 2016).

D. Beyond the Scope of the TMCH Protection that the GNSO Council and ICANN Board Agreed to Provide Trademark Owners.

As has been pointed out in our Working Group calls, the STI clearly elaborated its reasoning: that extracting a word or letters from a larger design, gives too many rights to one trademark owner over others using the same words or letters. As clearly elaborated in the STI Recommendations and adopted by the GNSO Council and ICANN Board (unanimously), it would be an unfair advantage for one trademark owner over others using the same words or letters.

Specifically: “(The trademarks to be included in the TC are text marks because “design marks” provide protection for letters and words only within the context of their design or logo and the STI was under a mandate not to expand existing trademark rights.)”

The Applicant Guidebook, in its wording, took the same stance.

To the extent that Deloitte as a TMCH Provider is operating within its mandate, and the limits of the rules and contract imposed on it, it may not take steps to expand existing trademark rights. The rights, as granted by national and regional trademark offices are rights that expressly include the patterns, special lettering and other styles, colors, and logos that are a part of the trademark granted by the Trademark Office and certification provided by each Trademark Office and presented to the Trademark Clearinghouse.

Breach and Correction

Accordingly, Deloitte is currently not complying with the established rules that ICANN adopted and must therefore be directed to revise its practice to comply with the rules published in the Applicant Guidebook and adopted by the GNSO Council and ICANN Board. Deloitte’s purported extraction of words and letters from logos, as outlined above, violates the rules adopted for the Trademark Clearinghouse operation.

It is a fundamental aspect of the Working Group’s mandate, as laid out by the GNSO Council in our charter, to review the operation of the Trademark Clearinghouse for compliance with its rules. The excellent work of the Working Group in this area, and finding this problem through hard work and research, should be sufficient for ICANN Staff to act in enforcement of its contract and our rules.

Alternatively, the Working Group **by consensus** may CHANGE the rules and present to the GNSO Council and ICANN Board a new set of standards by which Deloitte (or any future TMCH provider) may use to accept the design and stylized marks currently barred by the rules. But such a step would require a change to the ICANN rules under which the Trademark Clearinghouse operate, and then acceptance by the GNSO Council and ICANN Board. ICANN contractors do not have the unilateral power to make their own rules or to change the rule that are given them.

One potential alternative to the existing rules:

1) If the applicant has a trademark registration in a national system which allows word marks and other marks, they would need to present a word mark for registration to the TMCH (and Deloitte would need to make a list of such countries).

2) If the applicant has a trademark registration in a national system that does not differentiate between word marks and other marks (e.g., stylized, design plus, and figurative marks), they could submit evidence, such as information from a national registry about its classifications, to show that the trademark registration confers rights over the words claimed as such, not limited to words + other elements; or

(3) a court decision confirming that their rights extend to the words claimed as such, not limited to words + other elements.