

TRADEMARK CLEARINGHOUSE
~~DRAFT~~—~~MAY~~NOVEMBER 2010

1. INTRODUCTION

The proposal for establishment for the Trademark Clearinghouse was among the potential solutions to trademark protection issues in new gTLDs. It was developed through community consultations including the recommendations of the Implementation Recommendations Team (see <http://icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>) and others, and feedback gathered in online fora and public meetings. (The Implementation Recommendation Team (IRT) was assembled to help identify and propose rights protection mechanisms (RPMs) for trademark holders within the New gTLD Program <http://www.icann.org/en/minutes/resolutions-06mar09.htm#07>.)

After receiving recommendations from the IRT relating to the proposed Clearinghouse and extensive comments and consultation with the broader community, a revised proposal for the Clearinghouse was developed.

Given that the original GNSO Policy direction was very general in nature, the ICANN Board provided the GNSO council with the opportunity to offer input on the specific rights protection mechanism of a Trademark Clearinghouse. The GNSO promptly took on this task and established the Special Trademark Issues Review Team (“STI”) to review the proposal and offer its input upon which the GNSO would be able to reach consensus.

While the STI could not reach unanimous consensus on every specific detail, it did reach such consensus on many aspects and broad consensus on many others. The GNSO unanimously approved the concept of a Trademark Clearinghouse as well as the GNSO-STI Model that was developed (see <http://www.icann.org/en/announcements/announcement-2-17dec09-en.htm>).

This revision to the Draft Trademark Clearinghouse proposal is based upon the version of the proposal posted in February 2010. That earlier version reflected the recommendations in the GNSO-STI Model. This version of the draft proposal incorporates changes based upon comments that have been raised in the most recent public comment period that closed on 1 April 2010. In balancing competing comments, not all suggested revisions have been, or could have been adopted since they often reflected opposite viewpoints and many of those viewpoints had been considered in the IRT and STI.

In addition to the revisions below, please see the summary of comments and analysis in response to public comments made to the Trademark Clearinghouse proposal that was posted before the Nairobi International Public Meeting.

2. ~~TREATMENT OF MARKS~~

The major purpose for the creation of the Trademark Clearinghouse is the treatment of trademark registrations during Sunrise or Trademark Claims services. Significant numbers of comments concerned

~~Clearinghouse discretion to recognize trademark registrations from countries that do not perform substantive review. The IPC submitted a Minority Statement on this issue and significant opposing comments were submitted by a variety of others, including trademark holder associations and several large trademark holders. Compromise was sought.~~

~~Is the STI-GNSO Model, the exclusion of marks that have not undergone substantive review allowed registries to treat registered trademarks differently depending on where they were registered. The approach suggested in the February 2010 proposal was to ensure that all nationally or multi-nationally registered trademarks could be eligible for the Sunrise or Trademark Claims services. The proposal recommended the availability of additional validation processes for trademarks from countries that do not conduct substantive review. Namely, such a validation would confirm that those marks have been used in connection with the applicable goods and services for which they were registered.~~

~~Additional significant comments on this topic were received to the February 2010 proposal. Again, no uniform approach was suggested and compromise is required.~~

~~This Trademark Clearinghouse proposal requires that:~~

- ~~A. For Trademark Claims services – Registries must recognize all text marks that have been or are: (i) nationally or multi-nationally registered (regardless of whether the country of registration conducts a substantive review); (ii) court validated; or (iii) protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.~~
- ~~B. For Sunrise services – Registries must recognize all text marks: (i) nationally or multi-nationally registered in a jurisdiction that conducts a substantive examination of trademark applications prior to registration; or (ii) that have been court- or Trademark Clearinghouse-validated; or (iii) that are protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.~~

~~This proposal is an attempt to address the goal of the GNSO-STI Model, as well as those that are concerned that marks in non-substantive review countries can simply be excluded by registries from pre-launch Sunrise or Trademark Claim services. As always, community input is sought on this compromise or any other suggestions to address these competing concerns.~~

~~3. PURPOSE OF CLEARINGHOUSE~~

- 1.1 The Trademark Clearinghouse is a central repository for information to be authenticated, stored, and disseminated pertaining to the rights of trademark holders. As such, ICANN will contract with service provider or providers, awarding the right to serve as a Trademark Clearinghouse Service Provider, i.e., to accept, authenticate, validate and facilitate the transmission of information related to certain trademarks. This entity or these entities will have an “arms-length” relationship with ICANN. ICANN will not perform these tasks.

- 1.2 The Clearinghouse will be required to separate its two primary functions: (i) authentication and validation of the trademarks in the Clearinghouse, and (ii) serving as a database to provide information to the new gTLD registries to support pre-launch Sunrise or Trademark Claims Services. Whether the same provider could serve both functions or whether two providers will be determined in the tender process.
- 1.3 The Trademark Clearinghouse Service Provider will be required to maintain a separate Trademark Clearinghouse database, and may not store any data in the Clearinghouse database related to its provision of ancillary services, if any.
- 1.4 The Registry shall only need to connect with one centralized database to obtain the information it needs to conduct its Sunrise or Trademark Claims Services regardless of the details of the Trademark Clearinghouse Service Provider's contract(s) with ICANN.
- 1.5 Trademark Clearinghouse Service Provider may provide ancillary services, as long as those services and any data used for those services are kept separate from the Clearinghouse database.
- 1.6 The Clearinghouse database will be a repository of authenticated information and disseminator of the information to a limited number of recipients. Its functions will be performed in accordance with a limited charter, and will not have any discretionary powers other than what will be set out in the charter with respect to authentication and validation. The Clearinghouse administrator(s) cannot create policy. Before material changes are made to the Clearinghouse functions, they will be reviewed through the ICANN public participation model.
- 1.7. Inclusion in the Clearinghouse is not proof of any right, nor does it create any legal rights. Failure to submit trademarks into the Clearinghouse should not be perceived to be lack of vigilance by trademark holders or a waiver of any rights, nor can any negative influence be drawn from such failure.

2. SERVICE PROVIDERS

- 2.1 The selection of Trademark Clearinghouse Service Provider(s) will be subject to predetermined criteria, but the foremost considerations should be the ability to store, authenticate, validate and disseminate the data at the highest level of technical stability and security without interference with the integrity or timeliness of the registration process or registry operations.

4.12.2 Functions – Authentication/Validation; Database Administration. Public commentary has suggested that the best way to protect the integrity of the data and to avoid concerns that arise through sole-source providers would be to separate the functions of database administration and data authentication/validation.

2.2.1 One entity will authenticate registrations ensuring ~~they~~ the word marks qualify as registered or are court-validated word marks or word marks that are protected by statute or treaty. This entity would also be asked to validate marks that are from jurisdictions that do not conduct substantive review before registration.

4.12.2.2 The second entity will maintain the database and provide Sunrise and Trademark Claims Services (described below).

2.3 Discretion will be used, balancing effectiveness, security and other important factors, to determine whether ICANN will contract with one or two entities - one to authenticate and validate, and the other to, administer in order to preserve integrity of the data.

2.4 Contractual Relationship.

2.4.1 The Clearinghouse ~~should~~ shall be separate and independent from ICANN. It ~~should~~ will operate based on market needs and collect fees from those who use its services. ICANN may coordinate or specify interfaces used by registries and registrars, and provide some oversight or quality assurance function to ensure rights protection goals are appropriately met.

2.4.2 The Trademark Clearinghouse Service Provider(s) (authenticator/validator and administrator) will be selected through an open and transparent process to ensure low costs and reliable, consistent service for all those utilizing the Clearinghouse services.

2.4.3 The Service Provider(s) providing the authentication of the trademarks submitted into the Clearinghouse shall adhere to rigorous standards and requirements that would be specified in an ICANN contractual agreement. ~~The suggested model to be suggested for this contractual relationship would be similar to the detailed registrar accreditation agreement, rather than the current approval practice adopted by ICANN for UDRP providers.~~

2.4.4 The contract ~~should~~ shall include service level requirements, customer service availability (with the goal of seven days per week, 24 hours per day, 365 days per year), data escrow requirements, and equal access requirements for all persons and entities required to access the Trademark Clearinghouse database.

2.4.5 To the extent practicable, the contract should also include indemnification by Service Provider for errors such as false positives for participants such as Registries, ICANN, Registrants and Registrars.

- 2.5. Service Provider Requirements. The Clearinghouse Service Provider(s) should utilize regional marks authentication service providers (whether directly or through sub-contractors) to take advantage of local experts who understand the nuances of the trademark in question. Examples of specific performance criteria details in the contract award criteria and service-level-agreements are:
- 2.5.1 provide 24 hour accessibility seven days a week (database administrator);
 - 2.5.2 employ systems that are technically reliable and secure (database administrator);
 - 2.5.3 use globally accessible and scalable systems so that multiple marks from multiple sources in multiple languages can be accommodated and sufficiently cataloged (database administrator and validator);
 - 2.5.4 accept submissions from all over the world - the entry point for trademark holders to submit their data into the Clearinghouse database could be regional entities or one entity;
 - 2.5.5 allow for multiple languages, with exact implementation details to be determined;
 - 2.5.6 provide access to the Registrants to verify and research Trademark Claims Notices;
 - 2.5.7 have the relevant experience in database administration, validation or authentication, as well as accessibility to and knowledge of the various relevant trademark laws (database administrator and authenticator); and
 - 2.5.8 ensure through performance requirements, including those involving interface with registries and registrars, that neither domain name registration timeliness, nor registry or registrar operations will be hindered (database administrator).

53. CRITERIA FOR TRADEMARK INCLUSION IN CLEARINGHOUSE

3.1 The trademark holder will submit to one entity – a single entity for entry will facilitate access to the entire Clearinghouse database. If regional entry points are used, ICANN will publish an information page describing how to locate regional submission points. Regardless of the entry point into the Clearinghouse, the authentication procedures established will be uniform.

3.2 The proposed standards for inclusion in the Clearinghouse are:

- a) 3.2.1 Nationally or multi-nationally registered text-trademarkword marks from all jurisdictions (including from countries where there is no substantive review).
- b) 3.2.2 Any textword mark that has been validated through a court of law or other judicial proceeding.
- c) 3.2.3 Any text-marksword mark protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.

3.3 No ~~Common~~common law ~~rights~~marks should be included in the Trademark Clearinghouse Database, except for court-validated common law marks, or those protected by statute or treaty as set forth herein. This shall not preclude any gTLD registry from entering into a separate agreement, with no ICANN involvement, with the Clearinghouse Service Provider to collect and verify other information for ancillary services, provided that any such information is held separate from the Trademark Clearinghouse Database.

3.4 The type of data supporting an application for a registered word mark might include a copy of the registration or the relevant ownership information, including, the requisite registration number(s), the jurisdictions where the registrations have issued, and the name of the owner of record.

3.5 Data supporting a judicially validated word mark ~~would~~must include the court documents, properly entered by the court, evidencing the validation of a given word mark.

3.6 Data supporting word marks protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008, ~~would~~must include a copy of the relevant portion of the statute or treaty and evidence of its effective date.

3.6 Registrations that include top level extensions such as “icann.org” or “.icann” as ~~part of~~ the ~~trademark or service~~word mark will not be permitted in the Clearinghouse regardless of whether ~~a trademark registration that mark~~ has ~~issued~~been registered or it has been otherwise validated or protected ~~as a trademark~~ (e.g., if a ~~trademark mark~~ existed for icann.org, ~~icann.org would~~or .icann, neither will not be permitted in the Clearinghouse).

3.6 All ~~trademark~~mark holders seeking to have their marks included in the Clearinghouse will be required to submit a declaration, affidavit, or other sworn statement that the information provided is true and current and has not been supplied for an improper purpose. The ~~trademark~~mark holder will also be required to attest that it will keep the information supplied to the Clearinghouse current so that if, during the time the mark is included in the Clearinghouse, a ~~trademark~~registration gets cancelled or is transferred to another entity, or in the case of a court- or Clearinghouse-validated ~~trademark~~mark the holder abandons use of the ~~trademark~~mark, the ~~trademark~~mark holder has an affirmative obligation to notify the Clearinghouse. There will be penalties for failing to keep information current. Moreover, it is anticipated that there will be a process whereby registrations can be removed from the Clearinghouse if it is discovered that the ~~trademarks~~marks are procured by fraud or if the data is inaccurate.

3.7 As an additional safeguard, the data will have to be renewed periodically by any ~~trademark~~mark holder wishing to remain in the Clearinghouse. Electronic submission should facilitate this process and minimize the cost associated with it. The reason for

periodic authentication is to streamline the efficiencies of the Clearinghouse and the information the registry operators will need to process and limit the marks at issue to the ones that are in use.

64. USE OF CLEARINGHOUSE DATA

4.1 All ~~trademark~~mark holders seeking to have their marks included in the Clearinghouse, will have to consent to the use of their information by the Clearinghouse. However, such consent would extend only to use in connection with the stated purpose of the Trademark Clearinghouse Database. The reason for such a provision would be to ~~presently~~ prevent the Clearinghouse from using the data in other ways. There ~~should~~shall be no bar on the Trademark Clearinghouse Service Provider or other third party service providers providing ancillary services on a non-exclusive basis. ~~For example, additional information might consist of a list of generic words or common typographical variations of its trademark to be used in a post-launch Trademarks Claims Service or Trademark Watch Service.~~

4.2 In order not to ~~have~~create a competitive advantage ~~over competitors~~, the Trademark Clearinghouse ~~database~~Database (as well as other relevant data obtained by the Trademark Clearinghouse to perform ancillary services) should be licensed to competitors interested in providing ancillary services on equal and non-discriminatory terms and on commercially reasonable terms. Accordingly, two licensing options will be offered to the ~~trademark~~mark holder: (a) a license to use its data for all required features of the Trademark Clearinghouse, with no permitted use of such data for ancillary services either by the Trademark Clearinghouse Service ~~provider~~Provider or any other entity; or (b) license to use its data for the mandatory features of the Trademark Clearinghouse and for any ancillary uses reasonably related to the protection of ~~trademarks~~marks in new gTLDs, which would include a license to allow the Clearinghouse to license the use and data in the Trademark Clearinghouse to competitors that also provide those ancillary services. The specific implementation details will be determined, and all terms and conditions related to the provision of such services shall be included in the Trademark Clearinghouse Service Provider's contract with ICANN and subject to ICANN review.

4.3 If the Trademark Clearinghouse Service Provider does provide ancillary services, any information should be stored in a separate database. Access by the Registrant to verify and research Trademark Claims Notices shall not be considered an ancillary service, and shall be provided at no cost to the Registrant. Misuse of the data by the service providers would be grounds for immediate termination.

75. DATA AUTHENTICATION AND VALIDATION GUIDELINES

5.1 One core function for inclusion in the Clearinghouse would be to authenticate that the data meets certain minimum criteria. As such, the following minimum criteria are suggested:

- a) 5.1.1 An acceptable list of data authentication sources, i.e. the web sites of patent and trademark offices throughout the world, third party providers who can obtain information from various trademark offices;
- b) 5.1.2 Name, address and contact information of the applicant is accurate, current and matches that of the registered owner of the trademarks listed;
- c) 5.1.3 Electronic contact information is provided and accurate;
- d) 5.1.4 The registration numbers and countries match the information in the respective trademark office database for that registration number.

5.2 For validation of marks by the Clearinghouse that were not previously validated at registration or protected via a court, statute or treaty, the trademarkmark holder shall be required to provide evidence of continuous use of the mark in connection with the bona fide offering for sale of goods or services prior to application for inclusion in the Clearinghouse. Acceptable evidence of use might be labels, tags, containers, advertising, brochures, screen shots, and something that evidences continued use.

86. MANDATORY PRE-LAUNCH SERVICES

6.1 All new gTLD registries will be required to use the Trademark Clearinghouse to support its pre-launch rights protection mechanisms (RPMs) that must, at a minimum, consist of either a Sunrise or Trademark Claims Service. Such services shall meet the minimum standards specified in the IRT Report (~~see <http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>~~), which shall be incorporated by reference herein (~~see <http://www.icann.org/en/topics/new-gtlds/irt-final-report-trademark-protection-29may09-en.pdf>~~). There is no requirement that a registry adopt both of these RPMs.

6.2 The Trademark Claims Notice is intended to provide clear notice to the Registrant of the scope of the trademarkmark holder's rights in order to minimize the chilling effect on registrants. A form that describes the required elements is attached. The specific statement by Registrant warrants that: (i) the Registrant has received notification that the trademarkmark(s) is included in the Clearinghouse; (ii) the RegistrantsRegistrant has received and understood the notice; and (iii) to the best of the Registrant's

knowledge, the registration and use of the requested domain name will not infringe on the trademark rights that are the subject of the notice.

6.3 The Trademark Claims Notice should provide Registrant access to the Trademark Clearinghouse Database information referenced in the Trademark Claims Notice to enhance understanding of the Trademark rights being claimed by the trademark holder. These links (or other sources) shall be provided in real time without cost to the Registrant. ~~The implementation details are to be determined.~~ Preferably, the Trademark Claims Notice should be provided in the language used for the rest of the interaction with the registrar or registry, but it is anticipated that at the very least in the most appropriate UN-sponsored language (as specified by the prospective registrant or registrar/registry). Then, if the domain name is registered, the registrar (again through an interface with the Clearinghouse) will notify the trademark holders(s) of the registration. This notification should not be before the registration is effectuated so as not to provide an opportunity for a trademark holder to inappropriately attempt to block a legitimate registrant from registering a name in which the registrant has legitimate rights.

6.4 The Trademark Clearinghouse Database will be structured to report to registries domain names that are considered an “Identical Match” with the validated trademarks. “Identical Match” means that the domain name consists of the complete and identical textual elements of the trademark. In this regard: (a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted; (b) only certain special characters contained within a trademark are spelled out with appropriate words describing it (@ and &); (c) punctuation or special characters contained within a mark that are unable to be used in a second-level domain name may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches; and (d) no plural and no “marks contained” would qualify for inclusion.

6.5 Notification should be limited to identical marks so as to ensure operational integrity, limitation of overly broad notifications and an unmanageable volume of processing by the Clearinghouse.

97. PROTECTION FOR TRADEMARKS IN CLEARINGHOUSE

7.1 New gTLD registries must provide Sunrise or Trademark Claims services for trademarks in the Trademark Clearinghouse. As described below, the scope of registered marks used by the Claims Service is broader than those used for Sunrise periods.

7.1.2 For Trademark Claims services - Registries must recognize all textword marks that have been or are: (i) nationally or multi-nationally registered (regardless of

whether the country of registration conducts a substantive review); (ii) court-validated; or (iii) specifically protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.

7.1.3 For Sunrise services - Registries must recognize all textword marks: (i) nationally or multi-nationally registered in a jurisdiction that conducts a substantive examinationevaluation of trademark applications prior to registration; or (ii) that have been court- or Trademark Clearinghouse-validated; or (iii) that are specifically protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.

7.2 In certain cases, registries shall have discretion whether to include protections for trademarksmarks that do not satisfy these eligibility requirements.

7.3 Definition: Substantive evaluation upon registration has essentially three requirements: (i) evaluation on absolute grounds - to ensure that the applied for mark can in fact serve as a trademark; (ii) evaluation on relative grounds - to determine if previously filed marks preclude the registration; and (iii) evaluation of use - to ensure that the applied for mark is in current use.

The Trademark Clearinghouse or its agent shall develop and publish a list of the countries that conduct substantive review upon trademark registration.

9.17.4 Substantive evaluation by Trademark Clearinghouse validation service provider shall require: (i) evaluation on absolute grounds; and (ii) evaluation of use.

7.5 Sunrise Registration Process. In cases where the registry opts to provide a Sunrise registration service, sunrise eligibility requirements (SERs) will be met as a minimum requirement, verified by Clearinghouse data, and incorporates a Sunrise Dispute Resolution Policy (SDRP).

7.5.1 The proposed SER'sSERs include: (i) ownership of a trademarkmark (that satisfies the criteria in section 27.1 above) on or before the effective date of the registry agreement and was applied for on or before ICANN publishes new gTLD application list that is an identical match (as defined in section 86 above) to the applied for domain name; (ii) optional registry elected requirements re: international class of goods or services covered by registration; (iii) representation that all provided information is true and correct; and (iv) provision of data sufficient to document rights in the trademark.

7.5.2 The proposed SRDP must allow challenges based on at least the following four grounds: (i) at time the challenged domain name was registered, the registrant did not own a trademark registration of national effect; (ii) the domain name is

not identical to the ~~trademark~~mark on which the registrant based its Sunrise registration; (iii) the ~~trademark~~ registration on which the registrant based its Sunrise registration is not of national effect; and (iv) the ~~trademark~~ registration on which the domain name registrant based its Sunrise registration did not issue on or before the effective date of the Registry Agreement and was not applied for on or before ICANN announced the applications received.

7.5.3 The Clearinghouse will maintain the SERs, validate and authenticate ~~trademarks~~marks, as applicable, and hear challenges.

108. COSTS OF CLEARINGHOUSE

Costs should be completely borne by the parties utilizing the services. The Clearinghouse should not be expected to pay fees to ICANN. ~~For a Clearinghouse to be effective, the new gTLD registry operators would need to have certain obligations to use the information provided to it by the Clearinghouse. Part of the registry agreement shall require the operator to use the information provided by the Clearinghouse.~~

TRADEMARK NOTICE

[In English and the language of the registration agreement]

You have received this Trademark Notice because you have applied for a domain name which matches at least one trademark record submitted to the Trademark Clearinghouse.

You may or may not be entitled to register the domain name depending on your intended use and whether it is the same or significantly overlaps with the trademarks listed below.

Your rights to register this domain name may or may not be protected as noncommercial use or "fair use" by the laws of your country. [in bold italics or all caps]

Please read the trademark information below carefully, including the trademarks, jurisdictions, and goods and service for which the trademarks are registered. Please be aware that not all jurisdictions review trademark applications closely, so some of the trademark information below may exist in a national or regional registry which does not conduct a thorough or substantive review of trademark rights prior to registration.

If you have questions, you may want to consult an attorney or legal expert on trademarks and intellectual property for guidance.

If you continue with this registration, you represent that, you have received and you understand this notice and to the best of your knowledge, your registration and use of the requested domain name will not infringe on the trademark rights listed below. The following [number] Trademarks are listed in the Trademark Clearinghouse:

1. Mark: Jurisdiction: Goods: [click here for more if maximum character count is exceeded] International Class of Goods and Services or Equivalent if applicable: Trademark Registrant: Trademark Registrant Contact:

[with links to the TM registrations as listed in the TM Clearinghouse]

2. Mark: Jurisdiction: Goods: [click here for more if maximum character count is exceeded] International Class of Goods and Services or Equivalent if applicable: Trademark Registrant:

Trademark Registrant Contact:

***** [with links to the TM registrations as listed in the TM Clearinghouse]

X. 1. Mark: Jurisdiction: Goods: [click here for more if maximum character count is exceeded] International Class of Goods and Services or Equivalent if applicable: Trademark Registrant: Trademark Registrant Contact: