What is the Trademark Clearinghouse?

ICANN

Deloitte

TM holders
TM agents

IBM

DN registrars
TLD registries

The Clearinghouse user interface

Trademark Database
TMDB: Trade Mark DataBase for Sunrise and Claims

Francis Werquin
The TMDB system

- The Trademark Clearinghouse Database (TMDB) system serves as the central database to provide information for Registries and Registrars to support Sunrise or Claims processes.
August 9th 2013: the TMDB system offers support for the Sunrise processes:

- Retrieve the SMD Revocation List
- Submit the Sunrise LORDN Files and retrieve the related LORDN Log Files
Introduction: TMDB implementation status update

September 9th 2013: the TMDB system also supports the Claims processes:

- Retrieve the DNL List
- Submit the Claims LORDN Files and retrieve the related LORDN Log Files
- Retrieve CNIS files
October 18th 2013:
Abused Name Label support has been added to the TMDB Claims services.
The TMDB system: Configuring & using the TMDB systems

Steps to undertake before you can use the TMDB system:

• Register to use the TMDB system (Using an ICANN provided registration token)

• Configure your connections in order to use the TMDB services

• Test if your configured connections function properly

• Use TMDB services in the production environment

These steps will be explained in the upcoming webinars
TMDB registration steps

- **Obtain email from ICANN with your Registration Token**
- **Register with this token**
- **Receive TMDB admin user account & temporary password from TMDB**
- **Change password**

- **Token can be obtained after signing:**
  - Registry Agreement OR
  - 2013 Registrar Accreditation Agreement.

- **Test Registration Token can also be obtained by:**
  - prospective Registry Service Providers with an active gTLD application OR
  - ICANN accredited Registrars that have signed a RAA.
TMDB registration steps

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1. Obtain email from ICANN with your Registration Token
2. Register with this token
3. Receive TMDB admin user account & temporary password from TMDB
4. Change password
5. Complete TMDB profile pages
6. Test connections
7. IBM & ICANN Confirmation
8. Use Production TMDB services
Configuring TMDB services

Configuring the Sunrise and Claims services on the TMDB Profile Pages

In order to connect to the services, the following values are required for each service:

- password (can be the same as for the other services)
- Min.1 / max. 5 IP address for each service (can be the same as for the other service)

The user names are allocated by the TMDB system
Testing Sunrise & Claims services:

ICANN Certification: Overview

ICANN requires Registries and Registrars to go through a TMDB testing and certification process before using production functionality.

- This process is described in the ICANN “welcome package”
- Only use TMDB test functions, before certification
Testing Sunrise & Claims services:

ICANN Certification: Tests to be performed by Registries

- Download a SMD Revocation List
- Upload a Sunrise LORDN file with at least three (3) domain names that have been validated using the “testing SMDs” generated by the Trademark Clearinghouse and retrieve the related LORDN Log files.

- Download a DNL list.
- Upload a Claims LORDN file with at least three domain names; and retrieve the related LORDN log files.
Testing Sunrise & Claims services:

ICANN Certification: Tests to be performed by Registrars

• Download a SMD Revocation List

• Download a CNIS file.

• Validate/compare a screen shot of the rendering of the Trademark Notice (in English) to the sample Trademark Notice in the Applicant Guidebook.
Testing Sunrise & Claims services:

ICANN Certification: Tests validation process

After successful testing a Service Request must be raised requesting test certification:

- email IBM at ICANNSD@nl.ibm.com

- **Registrar:**
  - include the Registrar IANA ID
  - screenshot of the rendering of the Trademark Notice (in English) to the Registrant.

- **Registry:**
  - include gTLD for which certification is requested

- **IBM:**
  - Will verify the request
  - Will notify ICANN of successful test completion
  - Will update and close the Service Request
  - Will notify the requester of the status

- In case of a failure, only the requester will be informed.
Sunrise services: process
Sunrise services: process

1. Trademark Holder/Agent
   - Provide Signed Mark Data (SMD) file

2. Clearinghouse
   - List of Signed Mark Data (SMD) files

3. Registry
   - SMD Revocation List (SMDRL)

4. Registrar
   - Trademark Holder/Agent

5. Registrant
Sunrise services: process

Validate Signed Mark Data (SMD)

Request Domain Name Incl Signed Mark Data (SMD)

Request Domain Name Incl Signed Mark Data (SMD)

Provide Signed Mark Data (SMD) file

Trademark Holder/Agent

CLEARINGHOUSE

Trademark Database (TMDB)
Sunrise services: process

If SMD valid
Register Domain Name

Registry

Submit List Of Registered Domain Names (LORDN)

TMDB
TRADEMARK DATABASE

Inform TMCH

CLEARINGHOUSE

Notification of Registered Domain Name (NORDN)

Trademark Holder/Agent

Registrant

Registrar
Claim services: process
Claim services: process

1. Registrant
2. Registrar
3. Registry
4. Check Availability of Domain Name
5. Request Domain Name
6. Trademark Holder/Agent
Claim services: process

- Registry
  - Registrar
    - Registrant
    - Trademark Holder/Agent

Validate match with Mark in TradeMark DataBase (TMDB)

Provide Domain Name Label List (DNL)

Trademark Holder/Agent

CLEARINGHOUSE
Claim services: process

1. Provide Look up key

2. Provide Claims Notification Information (CNIS)

3. Claims notice

Trademark Holder/Agent
Claim services: process

Registry

Registrar

Registrant

Submit List Of Registered Domain Names (LORDN)

Inform TMCH

Trademark Holder/Agent

Notification of Registered Domain Name (NORDN)
Claim services: **process:** 48 hour window

1. Provide Claims Notification Information (CNIS)
2. Claims notice
3. Accept Claims notice
4. Creates application for auction or creates registration

Trademark Holder/Agent

Registry

Registrar

Registrant
Fees

• No Fee for Registrars

• Registry fee
  • 5000 USD
  • when the new gTLD contract is signed with ICANN

  • 0,25 USD
  • Fee per successful matching domainname registration

• Invoicing is done by ICANN
Help resources: Published sources

For technical queries, consult the following resources:
• TMDB user manuals
• TMDB frequently asked Questions (FAQ)
• Recordings of webinars

http://newgtlds.icann.org/en/about/trademark-clearinghouse
Help resources: Published sources

For technical queries without answer in the published resources Contact IBM Service Desk as follows:

• By phone:
  • + 32 2 711 8604
  • + 48 7 1760 8509
• By mail: ICANNSD@nl.ibm.com
Supporting Material

The draft TMCH functional specification

ICANN TMDB webpages with:
- TMDB manuals
- FAQs
- explanation of SMD files
- details about the TMDB registration process
- ...
http://newgtlds.icann.org/en/about/trademark-clearinghouse/scsvcs

The TMDB webinar announcements & recordings:
http://newgtlds.icann.org/en/announcements-and-media/webinars
In which capacity are you seeking assistance?

- Trademark Holder: all questions regarding submitting marks go via Deloitte
- TMCH agent: all agent questions regarding marks go via Deloitte
- Registrar: Registrars with questions regarding claims interface go via IBM
- Registry: Registrees with questions go via IBM
Important to take away

 ✓ Early Bird registration period is over
 ✓ All marks that were submitted before 5 NOVEMBER 2013 enjoy an extended registration period (i.e. Marks submitted on April 1 2013 for 3 years will expire on the 5 November 2016).

 ✓ SMD files:
   ✓ Downloadable file made available through the Validation interface
   ✓ TM holder needs to provide the SMD to the registrars when applying for a domain name during a sunrise period
   ✓ Without the SMD you cannot register a domain name during sunrise
   ✓ Contains information so that registries can ensure that the domain name application and thus the trademark qualifies to their sunrise registration policies
   ✓ SMD files can be submitted to the URS provides → less administrative burden
Important to take away

✓ All SMD files will be revoked and reissued

WHEN?
• Targeting December – full transition schedule to be posted shortly

WHY?
• Registries wanted SMD files without white spacing
• SMD files will include the correct start and end date
• SMD file will be valid for the recordal period of the TM with the db: 1/3/5 yrs

✓ Are current SMD files still valid? YES, until revocation date
Important to take away

✓ Trademarks with a dot can only be included when they do not include an existing TLD or extension under review and when the dot functions as:
  - Punctuation (e.g., period); or
  - Abbreviation; or
  - Figurative part of the registered trademark

✓ ICANN.ORG or .ICANN is not allowed
Statistics
Over 17,000 trademark records submitted

One out of two registers for multiple years
Statistics

Over 17,000 trademark records submitted

One out of two registers for multiple years

99 jurisdictions are represented in the Clearinghouse
Top 15 jurisdictions = 93% of all TMCH TMs
Statistics

Over 17,000 trademark records submitted

One out of two registers for multiple years

99 jurisdictions are represented in the Clearinghouse

550 TM’s in non-latin script
92% of all trademark records pass verification

9 out of 10 records are submitted by a TMCH agent
92% of all trademark records pass verification

9 out of 10 records are submitted by a TMCH agent

More than 165 official TMCH agents
Statistics

- 90 abused labels
- 76 UDRP cases
- 2 court cases
Clearinghouse Marketing Outreach
Clearinghouse Marketing Outreach

✓ Assisting TMCH agents in creating global awareness
Clearinghouse Marketing Outreach

- Assisting TMCH agents in creating global awareness

- 165 agents (registrars, law firms, ...)
- Multi-lingual & personalized marketing collateral
  - Videos, website, brochures
  - Available in 16 different languages (including IDN’s)
- Sponsoring events, conferences, webinars, ... by agents
Clearinghouse Marketing Outreach

- Updating our clients on the new gTLD program
- Both agents as holders
- http://sunrise.clearinghouse.org
- Webinars for new gTLDs
- Recruiting new agents
- PR outreach to brand owners, law firms and domain press

ICANN's Trademark Clearinghouse Sees Slow Initial Take-up

Despite over 10,000 Participants, Many Still Wait to Register

By Ian Greene

Launched this year, the Internet Corporation for Assigned Names and Numbers (ICANN) Trademark Clearinghouse (TCR) is designed to help resolve trademark disputes that arise when companies try to register domain names that are similar to their well-known trademarks. The TCR allows trademark owners to submit claims to prevent others from registering domain names that could be confusing or diluting their marks.

In the first three months of operation, the TCR received over 10,000 claims from trademark owners seeking to prevent others from registering domain names that could be confusing or diluting their marks. However, many of these claims have not been resolved, and many owners have not yet taken advantage of the TCR's services.

The TCR has encountered some challenges in getting trademark owners to use its services. Some owners have been reluctant to submit claims due to concerns about the cost and time required to complete the process. Others have been uncertain about the effectiveness of the TCR in resolving disputes.

Despite these challenges, the TCR has the potential to be a valuable tool for trademark owners. By providing a centralized platform for resolving disputes, the TCR can help reduce the number of trademark disputes that arise when companies try to register domain names that are similar to their well-known marks.

The TCR has also been praised for its efforts to educate trademark owners about the importance of registering domain names that are similar to their marks. By providing information about the TCR and the importance of registering domain names, the TCR has helped to raise awareness about the need for trademark owners to take action to protect their marks online.

Overall, the TCR has shown promise as a tool for resolving trademark disputes that arise when companies try to register domain names that are similar to their well-known marks. While there have been some challenges in getting trademark owners to use its services, the TCR has the potential to be a valuable tool for trademark owners in the future.
The concepts covered in this presentation are for discussion purposes only and are not intended to be all-inclusive on the topic of the trademark clearinghouse. Many of the concepts are still in the development stage and therefore could change the development or the implementation of certain concepts and/or services in the future. As a result, Deloitte reserves the right to make any changes needed to deliver the TMCH-related services as directed by ICANN.