

Trademark Clearinghouse Implementation Update

17 October 2012



Agenda

1. Project Update (15)
2. Trademark Clearinghouse System (45)
3. Questions and Comments (30)



Trademark Clearinghouse

- A repository for trademark data supporting rights protection mechanisms offered by new gTLD registries
- Replaces need for trademark holders to register in many databases as TLDs are launched

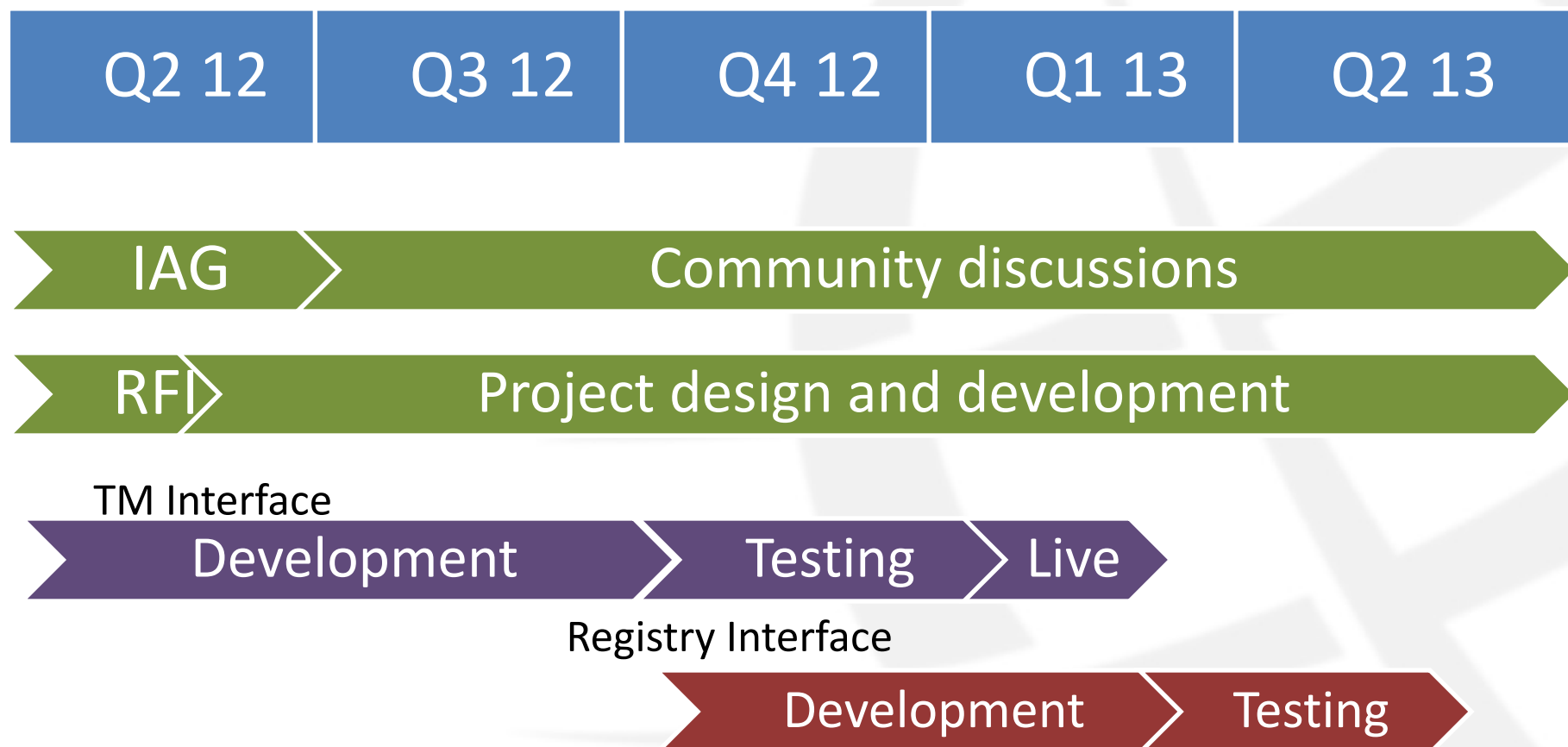


Clearinghouse Functions

- Performing verification of trademark data
- Maintaining database of verified trademark data
- Supporting new gTLD mandatory rights protection mechanisms (RPMs)
 - Sunrise (pre-launch)
 - Trademark Claims (post-launch)



Clearinghouse Project Overview



Discussions in Toronto

- Technical requirements
 - Sunrise process: implementation via codes, files, access to data
 - TM Claims process: centralization/decentralization and data access
- Proof of use
 - How Clearinghouse verifies proof of use for sunrise eligibility
- Matching rules
 - How Clearinghouse applies definition of “Identical Match”

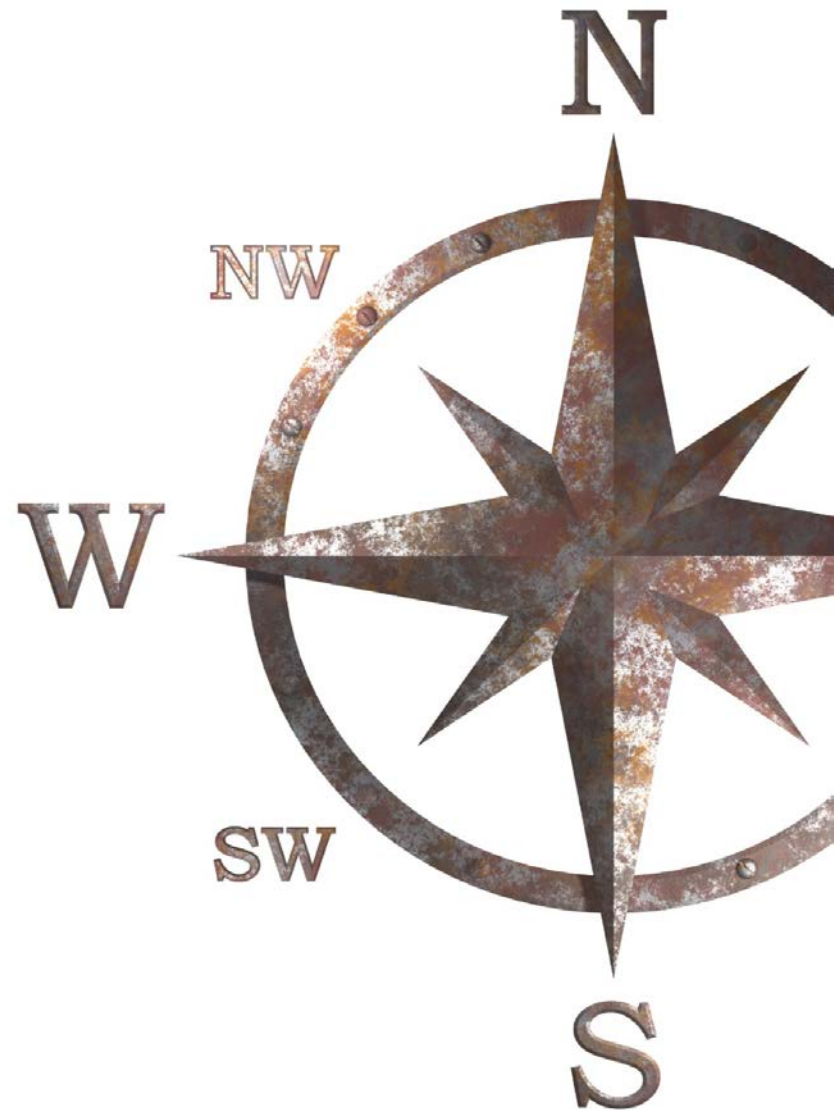
Trademark Clearinghouse



Agenda

- ☐ Introduction
- ☐ Registration with the Clearinghouse
- ☐ Proof of use
- ☐ Matching rules
- ☐ Dispute Resolution
- ☐ Customer support
- ☐ Implementation

Introduction



Introduction

The Clearinghouse will provide marks holders with the following services:

- ☐ Trademark verification services
- ☐ Sunrise Services
- ☐ Trademark Claim Services
- ☐ Dispute Resolution Services
- ☐ Customer Support
- ☐ Other Services (TBD)

Registration with the Clearinghouse



Registration – Eligibility requirements

- ❑ Agent acting on behalf of a trademark holder or a trademark holder that is a holder of:
 - A nationally or regionally or registered trademark
 - US trademark, EU trademarks, etc.
 - Trademark must be registered in accordance to the national laws at the time of verification
 - Court validated marks
 - Unregistered trademarks, well-known protected marks
 - Marks protected by statute or treaty
 - Geographical indications, designation of origin, names relating to the International Olympic Committee and the Red Cross/Red Crescent
 - Statute or treaty must be in force before or on 26 June 2008
 - Other marks
 - To be determined

Registration – Eligibility requirements

☐ Not Eligible

- Any mark starting with or containing a dot (.)
- Any registered mark that was subject to successful invalidation, cancellation or rectification proceedings
- Any intellectual property rights which cannot be represented within the technical limitations of the Domain Name System (e.g. patents, designs, etc.)

Proof of Use



Proof of Use – Sunrise Services

❑ Principle:

- Only necessary for registered trademarks
- Completed declaration and a sample of use needs to be uploaded

❑ Sample of use:

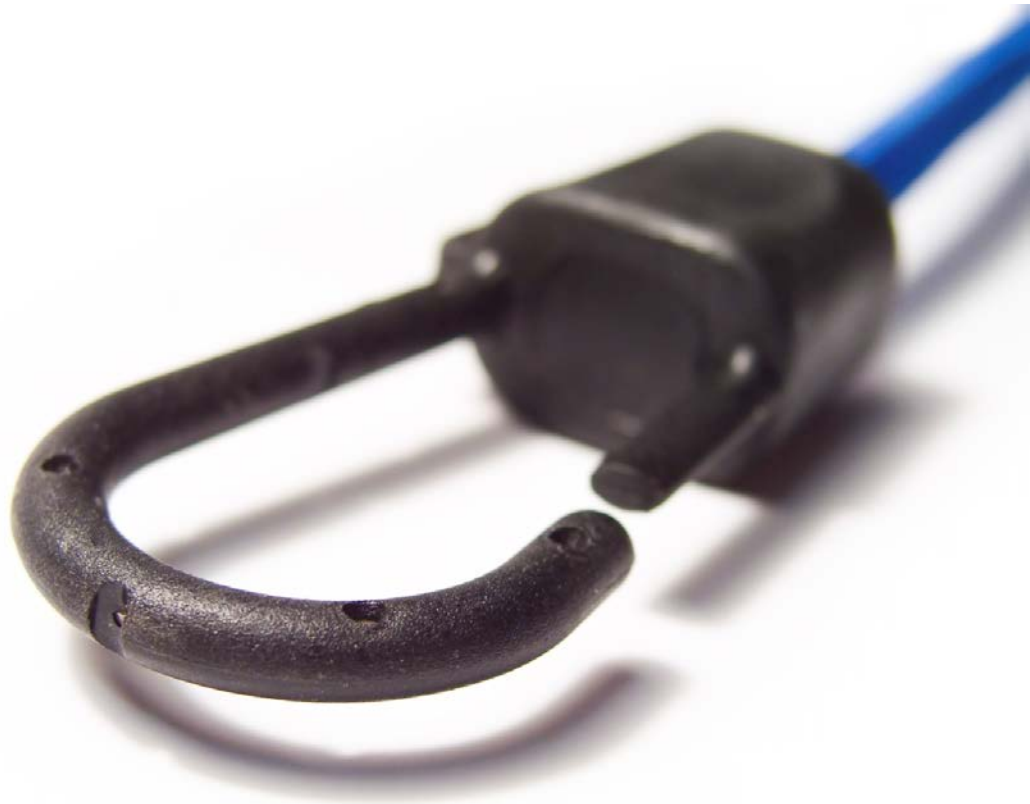
- Acceptable:
 - Labels, tags, or containers from a product
 - Advertising and marketing materials (including brochures, pamphlets, catalogues, product manuals, displays or signage, press releases, screen shots, or social media marketing materials)
- Unacceptable:
 - Inclusion of a mark in a domain name
 - Email messages
 - Licenses to use a mark
 - Business cards

Proof of Use – Sunrise Services

- ❑ Declaration and a submission of a current sample of use: once every five (5) years to maintain sunrise eligibility
 - Annual renewal of the TM record will only require re-submission of a new sample when the sample is no longer eligible

- ❑ Upon verification of the trademark data and proof of use (when applicable):
 - *Sunrise code/file* will be generated.
 - Sunrise notifications will be sent to the trademark holders/agents with a corresponding domain name, when a domain name with a *sunrise code/file* has been registered.

Matching Rules



Matching Rules

- ❑ Applicable to both Sunrise Services and Trademark Claims Services

- ❑ “identical match” = domain name consists of complete and identical textual elements of the mark
 - E.g.: icann => icann.test
 - Not included: plurals and “marks contained”
 - “icann ex” NOT => icann-exes.test
 - “icann ex” NOT => icann.test

- ❑ Additional criteria to constitute an identical match
 - Spaces, punctuations or other IDN-impermissible characters(!, +, = etc.) may be omitted or replaced by hyphens
 - “icann ex”/ “icann.ex”/ “icann_ex => icannex.test /icann-ex.test

Matching Rules

- ❑ Exception to the rule above: special characters @ and &
- ❑ May be replaced by a hyphen, omitted or translated
 - Translation based on the applicable official language(s) corresponding to the language of the jurisdiction

Dispute Resolution



Dispute Process – Correction Process

- ❑ All trademark holders/agents will be able to correct any trademark information that has been marked as incomplete/incorrect by the Clearinghouse
- ❑ Free of charge (one time)
- ❑ After the correction process → trademark record is still incorrect or does not meet the Clearinghouse guidelines → Invalid

Grounds for Dispute

- ☐ Any trademark holder/agent that does not agree with the verification.
- ☐ Any third party that does not agree with the verification.
- ☐ Any third party that has become aware of any new information that has an impact on a valid trademark record.

Customer Support



Customer Support

Customer Support interfaces

Hotline

- Issues related to **signing in** to the Clearinghouse web interface

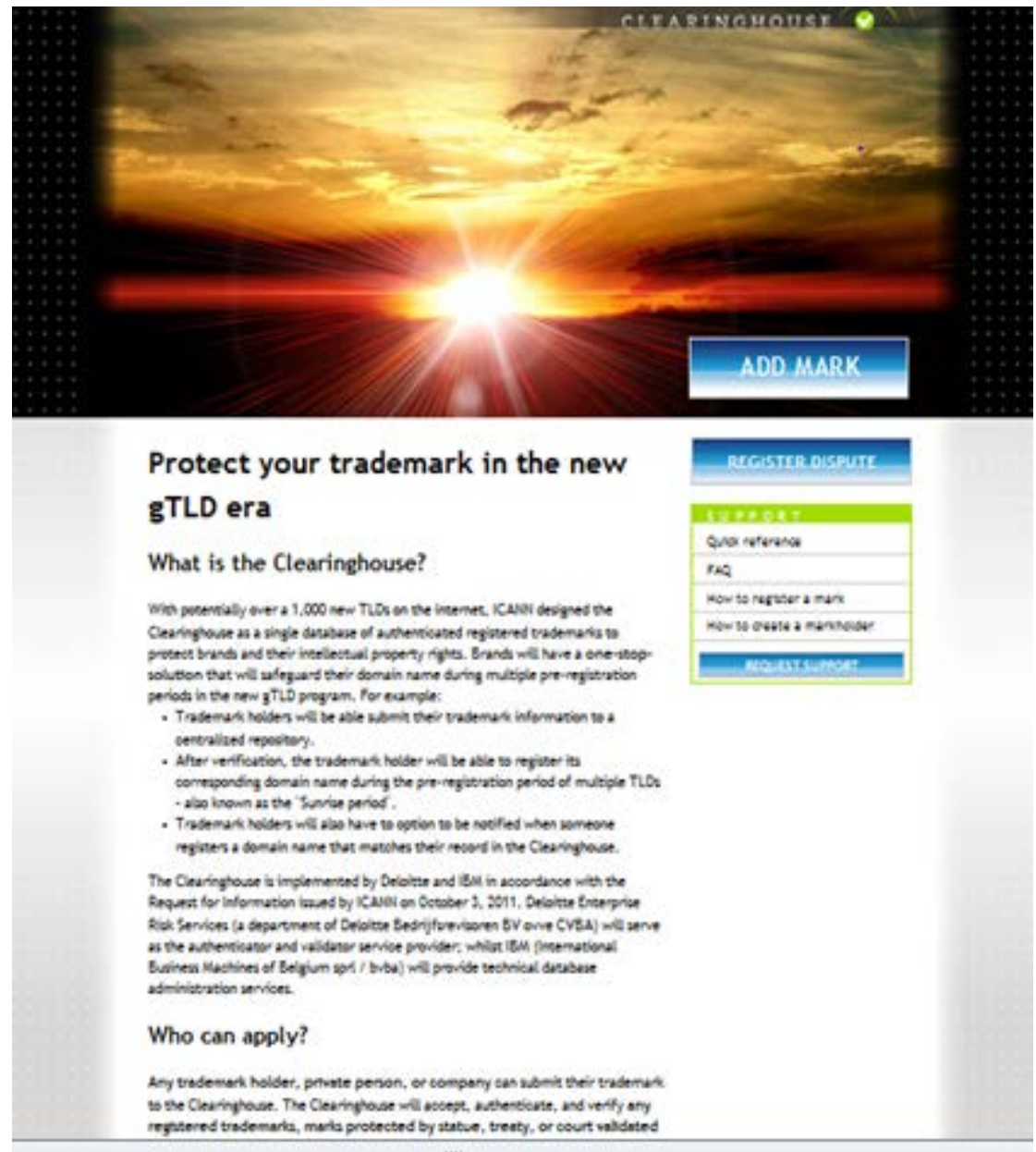
Web ticketing tool

- All questions related to the Clearinghouse
- Accessible via the Clearinghouse
- Tool will be made available in English, additional support will be available in other languages

Implementation



Registration in the Clearinghouse



The screenshot shows the top section of the ICANN Clearinghouse website. At the top, there is a banner image of a sunrise over a horizon with the word "CLEARINGHOUSE" and a green checkmark icon in the top right corner. Below the banner, on the right side, is a blue button labeled "ADD MARK".

Protect your trademark in the new gTLD era

What is the Clearinghouse?

With potentially over a 1,000 new TLDs on the Internet, ICANN designed the Clearinghouse as a single database of authenticated registered trademarks to protect brands and their intellectual property rights. Brands will have a one-stop solution that will safeguard their domain name during multiple pre-registration periods in the new gTLD program. For example:

- Trademark holders will be able submit their trademark information to a centralized repository.
- After verification, the trademark holder will be able to register its corresponding domain name during the pre-registration period of multiple TLDs - also known as the "Sunrise period".
- Trademark holders will also have to option to be notified when someone registers a domain name that matches their record in the Clearinghouse.

The Clearinghouse is implemented by Deloitte and IBM in accordance with the Request for Information issued by ICANN on October 3, 2011. Deloitte Enterprise Risk Services (a department of Deloitte Bedrijfsrevisoren BV ouve (CVBA)) will serve as the authenticator and validator service provider; whilst IBM (International Business Machines of Belgium sprl / bvba) will provide technical database administration services.

Who can apply?

Any trademark holder, private person, or company can submit their trademark to the Clearinghouse. The Clearinghouse will accept, authenticate, and verify any registered trademarks, marks protected by statute, treaty, or court validated

On the right side of the page, there is a sidebar with a blue button labeled "REGISTER DISPUTE". Below it is a green header labeled "SUPPORT". Under "SUPPORT", there are four links: "Quick reference", "FAQ", "How to register a mark", and "How to create a markholder". At the bottom of the sidebar is a blue button labeled "REQUEST SUPPORT".

Registration with the Clearinghouse

First time User

EMAIL* ?

ESTIMATED # OF SUBMISSIONS

I AM

Who will be using the applica

Holder

Who is the contracting party

NAME* ?

ORGANIZATION*

STREET AND NUMBER*

POSTAL CODE*

CITY*

STATE/PROVINCE

COUNTRY

PHONE NUMBER* ?

FAX NUMBER ?

VAT NUMBER*

EMAIL* ?

ESTIMATED # OF SUBMISSIONS

I AM

Who will be using the application

NAME ?

PHONE NUMBER* ?

EMAIL* ?

Registration with the Clearinghouse

Registering an “Agent”/Holder

- Contracting party
- Application user

Who is the contracting party

NAME*	TMCH Toronto Demo Agent	?
ORGANIZATION*	TMCH	
STREET AND NUMBER*	Street 1	
POSTAL CODE*	1000	
CITY*	City1	
STATE/PROVINCE		
COUNTRY	Belgium	
PHONE NUMBER*	+1.0000000	?
FAX NUMBER		?
VAT NUMBER*	0000001	
EMAIL*	TMCHTorontoAgent@Demo.org	?
ATED # OF SUBMISSIONS	1-20	
I AM	Agent	

Who will be using the application

NAME	TMCH Toronto Demo Agent2	?
PHONE NUMBER*	+1.0000001	?
EMAIL*	TMCHTorontoAgent2@Demo.org	?

Submission in the Clearinghouse

Submission of trademarks

- Sign in as a Trademark Holder
- Sign in as a Trademark Agent



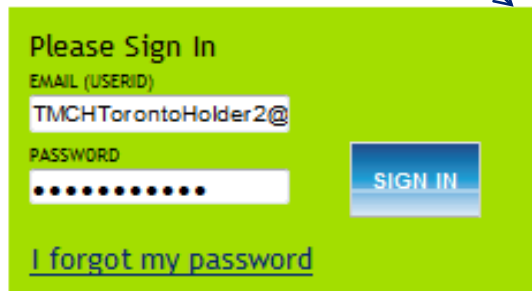
Please Sign In

EMAIL (USERID)

PASSWORD

[I forgot my password](#)

SIGN IN



Please Sign In

EMAIL (USERID)

TMCHTorontoHolder2@

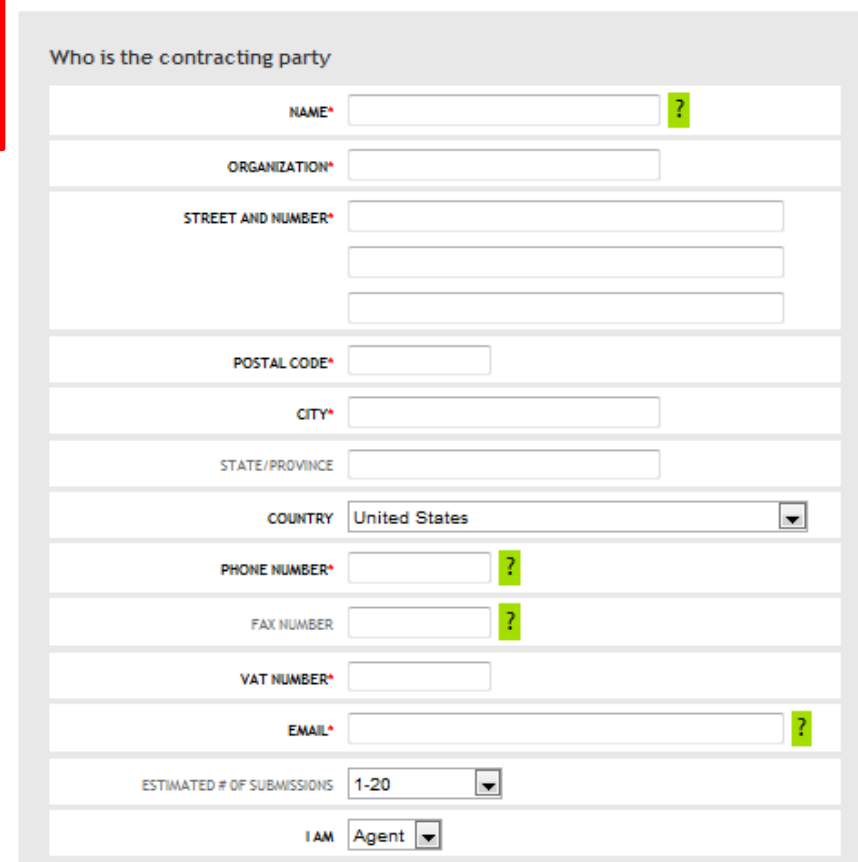
PASSWORD

.....

[I forgot my password](#)

SIGN IN

Or Register Below



Who is the contracting party

NAME* ?

ORGANIZATION*

STREET AND NUMBER*
/
/

POSTAL CODE*

CITY*

STATE/PROVINCE

COUNTRY United States

PHONE NUMBER* ?

FAX NUMBER ?

VAT NUMBER*

EMAIL* ?

ESTIMATED # OF SUBMISSIONS 1-20

I AM Agent

Submission of data in the Clearinghouse

USER: TMCH Toronto Demo Agent2 AGENT: TMCH CREDITS REMAINING: \$3500

My account Logout

CLEARINGHOUSE

MARKS DOMAINS & SERVICES

Mark overview

Mark	Status	Markholder
------	--------	------------

ADD MARK

TOTAL: 0

SEARCHED: None

FILTERED: Any status

SORTED:

SORT

Date of latest status change Sort

FILTER BY STATUS

- New
- Corrected
- Cleared
- Incorrect
- Expired
- Invalid
- Deactivated

Filter

SEARCH

Search

Submission in the Clearinghouse

MARKS

DOMAINS & SERVICES

New mark

MARK TYPE	<div>Registered Trademark ▼ Registered Trademark Court validated Treaty or statute</div>	
HOLDER ID		demo A ▼ ?
NEW HOLDER	<input type="checkbox"/>	?
STATUS OF THE HOLDER	Owner ▼	
NAME OF THE MARK*	<input type="text"/>	
JURISDICTION	United States of America ▼	
APPLICATION NUMBER	<input type="text"/>	
REGISTRATION NUMBER*	<input type="text"/>	
APPLICATION DATE	<input type="text"/>	?
REGISTRATION DATE*	<input type="text"/>	?
EXPIRATION DATE	<input type="text"/>	?
DESCRIPTION OF GOODS AND SERVICES*	<input type="text"/>	

Submission in the Clearinghouse

MARKS

DOMAINS & SERVICES

New mark

MARK TYPE

HOLDER ID ?

NEW HOLDER ☒ ?

Mark holder

ORGANIZATION*

STREET AND NUMBER*

POSTAL CODE*

CITY*

STATE/PROVINCE

COUNTRY

PHONE NUMBER ?

FAX NUMBER ?

Submission in the Clearinghouse

MARK TYPE	Registered Trademark	
HOLDER ID	Deloitte Vicky Folens	?
NEW HOLDER	<input type="checkbox"/>	?
STATUS OF THE HOLDER	Owner	
NAME OF THE MARK*	A & B	
JURISDICTION	United States of America	
APPLICATION NUMBER		
REGISTRATION NUMBER*	890899	
APPLICATION DATE		?
REGISTRATION DATE*	20040801	?
EXPIRATION DATE		?
DESCRIPTION OF GOODS AND SERVICES*	16,17	

Uploaded attachments

DOCUMENT TYPE Assignment declaration

FILE

Browse...

Submission in the Clearinghouse

Domain name

UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	ab
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	a-b
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	a--b
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	aandb
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	aand-b
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	a---b
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	a-andb
UNICODE LABEL (U-LABEL) *	<input checked="" type="checkbox"/>	a-and-b

MARK TYPE	Registered Trademark	
HOLDER ID	Deloitte Vicky Folens	?
NEW HOLDER	<input type="checkbox"/>	?
STATUS OF THE HOLDER	Owner	
NAME OF THE MARK*	A & B	
JURISDICTION	United States of America	
APPLICATION NUMBER		
REGISTRATION NUMBER*	890899	
APPLICATION DATE		?
REGISTRATION DATE*	20040801	?
EXPIRATION DATE		?
DESCRIPTION OF GOODS AND SERVICES*	16,17	

Submission in the Clearinghouse

MARK TYPE	Registered Trademark ▾
HOLDER ID	Deloitte Vicky Folens ▾ ?
NEW HOLDER	<input type="checkbox"/> ?
STATUS OF THE HOLDER	Owner ▾
NAME OF THE MARK*	A & B
JURISDICTION	United States of America ▾
APPLICATION NUMBER	
REGISTRATION NUMBER*	890899
APPLICATION DATE	<input type="text"/> ?
	<input type="text"/> ?

SUNRISE CODE + NOTIFICATION

☐

TRADEMARK CLAIM NOTIFICATION

☒

SUNRISE CODE + NOTIFICATION

☒

PROOF OF USE*

Browse...

TRADEMARK CLAIM NOTIFICATION

☒

Trademark Records Management

MARKS

DOMAINS & SERVICES

Mark overview

Mark	Status	Markholder
T & EST	NEW	Deloitte
m&m	NEW	Deloitte
my mark	NEW	Deloitte
A & B	VERIFIED	Deloitte
A & B	INVALID	Deloitte
Deloitte	NEW	Deloitte

ADD MARK

TOTAL: 6

SEARCHED: None

FILTERED: Any status

SORTED:

SORT

Date of latest status change Sort

FILTER BY STATUS

New

Corrected

Cleared

Incorrect

Expired

Invalid

Deactivated

Filter

SEARCH

Search

Trademark Records Management

- Search
- Sort

MARKS

DOMAINS & SERVICES

Mark overview

Mark	Status	Markholder
Toronto Demo Registered Trademark	NEW	TMCH
TorontoDemoAgentRegisteredTrademark	NEW	TMCH
TorontoDemo@CourtValidated	NEW	TMCH
Toronto Demo Agent Court Vlidated	NEW	TMCH
TorontoDemoAgent@TreatyorStature	NEW	TMCH

ADD MARK

TOTAL: 5
SEARCHED: None
FILTERED: Any status
SORTED: Date of last change

SORT
Date of latest status change
Date of latest status change
Mark (Ascending)
Mark (descending)
Markholder (ascending)
Markholder (descending)
Status
Corrected
Cleared
Incorrect
Expired
Invalid
Deactivated
Filter

SEARCH

Search

MARKS

DOMAINS & SERVICES

ADD MARK

TOTAL: 5
SEARCHED: treaty
FILTERED: Any status
SORTED: Date of last change

SORT
Date of latest status change
Sort

FILTER BY STATUS
New
Corrected
Cleared
Incorrect
Expired
Invalid
Deactivated
Filter

SEARCH
treaty
Search

Trademark Records Management

MARKS

DOMAINS & SERVICES

Mark overview

Mark	U-Label	Sunrise code	Sunrise notification	Trademark claim notification
Deloitte	deloitte		on	on
A & B	aandb		on	on
	a-andb		on	on
	a-and-b		on	on
	aand-b		on	on
	ab		on	on
	a-b		on	on
	a--b		on	on
	a---b		on	on

ADD MARK

TOTAL: 6

SEARCHED: None

FILTERED: Any status

SORTED:

SORT

Date of latest status change

Sort

FILTER BY STATUS



New



Corrected



Cleared



Incorrect



Expired



Invalid

Contact

www.trademark-clearinghouse.com

info@trademark-clearinghouse.com



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.

Thank You



Questions

One World

One Internet

