

CLEARINGHOUSE



Clearinghouse User Interface

Pre-Launch Webinar
March 2013

Agenda

- Introduction
- Eligibility requirements
- Verification process
- Generation of Labels
- Implementation
- Dispute process

Introduction



Introduction

What is the Trademark Clearinghouse?

- **Central Database for verified trademarks**
 - Clearinghouse User Interface will be provided by Deloitte
 - Database will be provided by IBM



Eligibility requirements

Eligibility

Who can participate?

- **Trademark Holders**
 - Individuals or entities
 - Owners of a Trademark OR
 - Designees (licensees or assignees) of the owner
- **Trademark Agents**
 - Individuals or entities authorized to act on behalf of a Trademark Holder

Eligibility requirements

Which Trademarks are accepted in the Clearinghouse?

- **Nationally or Regionally Registered Trademarks**
 - US trademark, EU trademark etc.
 - Must be registered at the time of verification and in accordance with national laws
- **Court Validated Trademarks**
 - Unregistered trademarks, well-known protected marks
- **Trademarks Protected by Statute or Treaty**
 - Geographical indications, designation of origin
 - Statute or treaty must be in force before or on 26 June 2008
- **Other Trademarks that constitute intellectual property**
 - Determined by the registries

Eligibility requirements

Which Trademarks are NOT accepted in the Clearinghouse?

- Trademarks starting with or containing a Dot (.)
Deloitte.
- Registered Trademarks subject to successful invalidation, cancellation, rectification or opposition proceedings
- Intellectual property rights which cannot be represented within the technical limitations of the Domain Name System (e.g. patents, designs, etc.)
- Any mark that is not at least of national effect

Eligibility requirements

Do marks need to contain only letters or words?

- **Marks exclusively consisting of letters, words, numerals and/or special characters**
 - Provided that all characters included in the Trademark Record are in the Clearinghouse in same order as on the mark certificate

DealSafe

- **Marks not exclusively consisting of letters, words, numerals, special characters**
 - Provided that they are predominant AND
 - Clearly separable or distinguishable from the device element AND
 - Included in the Trademark Record submitted to the Clearinghouse in the same order they appear in the mark



Eligible Registered Trademarks

What information is requested?

- Name of the mark
- Registration number
- Registration date
- Application number (not mandatory)
- Application date (not mandatory)
- Jurisdiction
- Expiration date (not mandatory)
- Description of goods and services class
- Detailed description of goods and services
- Information about the holder (organization or full name, address and contact information)
- Status of the Trademark Holder (owner/licensee/assignee)

Eligible Registered Trademarks

Documentary evidence?

Mandatory: Proof of use

- Opting in for Sunrise Services requires evidence for the bona fide use of the Trademark by submitting :
 - 1) A signed **Declaration of use** AND
 - 2) A single **Sample of proof of use**
- Sample of proof 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

Acceptable Proof of Use Samples

New Generic Top-Level Domains Fact Sheet

INTERNATIONALIZED DOMAIN NAMES
Now web domains speak your favorite language

Internationalized domain names will be available through ICANN's New generic Top-Level Domains (gTLD) Program. For the first time, Internet names at every level may also incorporate character sets such as Chinese, Arabic, Cyrillic or any non-Latin alphabet. Imagine the opportunities and benefits for the 70 percent of Internet users around the world who are non-English speakers.

What is a gTLD?
If you've heard of .com, .org or .net, then you know what a top-level domain or TLD is -- a domain name extension. When you combine one of these with a second-level name, such as the name of your organization, you see the familiar structure of a Web address - yourorg.com.

What will IDNs change?
Before IDNs were rolled out on a large scale, you might see non-Latin characters only at the second, third or even fourth level. Here is an example of Thai script appearing in the fourth level:
<http://www.idn.icann.org/>
Through the new gTLD program, IDNs will be more widely available in the top-level name space. This will allow users to register and use domain names based on their local languages and scripts, including those, such as Arabic, that are read right-to-left, as well as non-alphabetic languages, like Mandarin Chinese. Such domain names also could contain Latin characters with diacritical marks, like the accent, cedilla or umlaut, as required by many European languages.

<http://مثال.إختبار>
<http://例子.测试/首页>
<http://пример.испытание>

Learn More:
If you are interested in running a registry and applying for an IDN through the new gTLD program, a comprehensive Applicant Guidebook is available online in six languages, with information on how the process works, how applications will be evaluated, procedures for objections and dispute resolution, and how the new gTLD will be delegated to a successful applicant.
For more information: <http://newgtlds.icann.org/en> or <http://icann.org/en/topics/idn/>.

About ICANN
The Internet Corporation for Assigned Names and Numbers (ICANN) was formed in 1998 to coordinate the Internet's unique identifiers around the world. Without that coordination we wouldn't have one global Internet. It is a not-for-profit, public-benefit corporation with participants from all over the world dedicated to keeping the Internet secure, stable and interoperable. It promotes competition and develops policy on the Internet's unique identifiers. ICANN doesn't control content on the Internet. It cannot stop spam and it doesn't deal with access to the Internet. But through its coordination role of the Internet's naming system, it does have an important impact on the expansion and evolution of the Internet.


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Beginner's Guide to
PARTICIPATING IN ICANN



Eligible Registered Trademarks

Documentary evidence?

Not obligatory - but can be requested

- Copy of the trademark certificate
- Copy of the renewal fees
- License declaration
- Assignee declaration
- Other

Eligible Court Validated Marks

What information is requested?

- Name of the mark
- Reference number
- Date of protection
- Country
- Description of goods and services
- Court name
- Court order
- Information about the holder (namely organization or full name, address and contact information)
- Status of the Trademark Holder

Eligible Court Validated Marks

Documentary evidence?

Mandatory: Copy of the court order or judicial proceedings

- Certified copy
- National court or judicial proceedings

Non obligatory - but can be requested

- License declaration
- Assignee declaration

Eligible Marks protected under Statute or Treaty

What information is provided?

- Name of the mark
- Reference number
- Date of protection
- Country
- Description of goods and services
- Title of statute or treaty
- Jurisdiction
- Date of execution
- Information about the holder (namely organization or full name, address and contact information)
- Status of the Trademark Holder

Eligible Marks protected under Statute or Treaty

Documentary evidence?

Non obligatory - but can be requested

- License declaration
- Assignee declaration
- Other: e.g. Copy of the statute or treaty

Generation of Labels



Domain name/labels

Identical?

- Labels that are identical to the name of the mark will automatically generated
- “identical matches” = 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

Domain name/labels

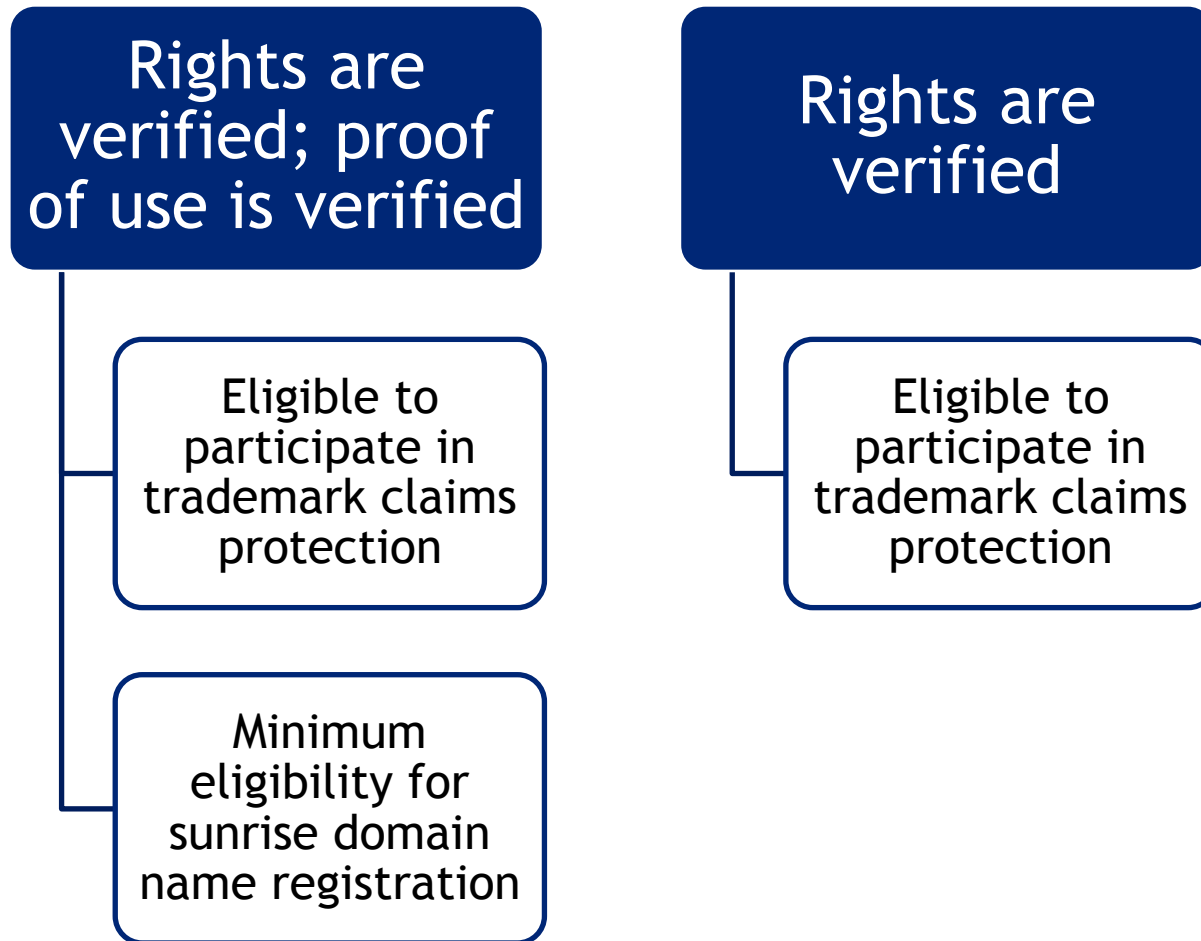
How will the Matching Rules function?

- Additional criteria to constitute an identical match
 - Spaces, or other IDN-impermissible characters (!, +, = etc.) may be omitted or replaced by hyphens
 - “icann ex”/ “icann_ex => icannex.test /icann-ex.test
- Special characters @ and &:
 - May be replaced by a hyphen, omitted or translated
 - Translation based on the applicable official language(s) that correspond(s) with the language of the jurisdictions
- Implies that more than 10 labels could qualify as identical match

Verification process



Verification process flow



Verification process

What will be verified?

- Verification of the trademark record in order to determine whether:
 - 1) all provided information is accurate and complete
 - 2) the mark meets the eligibility requirements
- If the eligibility requirements are not met or information is missing or is not accurate:
 - The trademark holder/agent will be notified and requested to correct the trademark record or provide additional documentary evidence

Implementation



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Implementation

What to do?

- **Step 1:** Decide to enter marks directly as a trademark holder or via an agent
 - **Step 1 A:** Register with the Clearinghouse OR
 - **Step 1 B:** Provide trademark application to your agent
- **Step 2:** Submit trademark record data, select the services, and pay the fees
- **Step 3:** Wait until the verification agents have verified your trademark record
 - **Step 3A:** Trademark record is verified: Eligible to participate in Sunrise and receive TM Claims notifications
 - **Step 3B:** Information is missing/incorrect: Correct information ASAP and/or provide documentary evidence (correction process)

Implementation

How will sunrise and trademark claims services work?

- Sunrise: Utilizes an SMD (signed marked data) file
 - Generated once the trademark record has been verified
 - All the sunrise eligible selected labels will be included in the SMD file
 - Sunrise notifications
- TM Claims: Notifications
 - Sent when a domain name matching the trademark record registered in the Clearinghouse is registered
 - May be turned on or off on a per label basis

Dispute Resolution



Grounds for Dispute

Who can be a complainant?

- 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.

Contact

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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.