



ICANN Seeks Comments On The Procedures To Be Used by the Trademark Clearinghouse In Connection With The Implementation of New gTLDs

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On September 24, 2012, ICANN requested comments on two important procedures in the implementation of the Trademark Clearinghouse¹ – proof of trademark use and determination of a match. <http://www.icann.org/en/news/announcements/announcement-7-24sep12-en.htm>. The Trademark Clearinghouse will serve as a repository used by trademark owners to protect against the use of their marks for domain names in any of the new gTLDs during the sunrise period of a new gTLD and for trademark claims generally.² See prior coverage here: <http://blog.pattishall.com/2011/11/08/trademark-protection-in-icann%E2%80%99s-new-generic-top-level-domain-%E2%80%9Cgtld%E2%80%9D-space-will-require-diligence-by-trademark-owners/>. The deadline to submit comments is **November 7, 2012**.

The specific procedures for which ICANN seeks comment now are: 1) the procedures that the Trademark Clearinghouse will use to verify that a claimed trademark is in use; and 2) the process by which the Trademark Clearinghouse will determine a match between a trademark recorded with the Trademark Clearinghouse and an applied-for domain name. Highlights of these memoranda are below.

¹ A draft of the current Trademark Clearinghouse requirements can be found here: <http://newgtlds.icann.org/en/about/trademark-clearinghouse/draft-tmch-requirements-24sep12-en.pdf>.

² For a complete list of new gTLD applications see here: <http://newgtlds.icann.org/en/program-status/application-results/strings-1200utc-13jun12-en>.



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Proof of Use

ICANN has decided that only marks that are in use will be provided protection through the Trademark Clearinghouse during the sunrise period of a new gTLD.³ Most jurisdictions throughout the world do not require proof of use to obtain a trademark registration, but the U.S. does have such a requirement (with notable exceptions for foreign trademark registration holders).

To prove use, a trademark owner must submit a signed declaration of use and a single sample of current use. The specific proposed declaration is below:

The [Trademark Holder/Licensee/Agent] hereby certifies that the information submitted to the Clearinghouse, is, to the best of [Trademark Holder/Licensee/Agent's] knowledge complete and accurate, that the trademarks set forth in this submission are currently in use in the manner set forth in the accompanying specimen, in connection with the class of goods or services specified when this submission was made to the Trademark Clearinghouse; that this information is not being presented for any improper purpose; and that if, at any time, the information contained in this submission is no longer accurate, the [Trademark Holder/Licensee/Agent] will notify the Clearinghouse within a reasonable time of that information which is no longer accurate, and to the extent necessary, provide that additional information necessary for the submission to be accurate. Furthermore, if any Clearinghouse-verified mark subsequently becomes abandoned by the holder, the holder will notify the Clearinghouse within a reasonable time that the mark has been abandoned.

The sample of use must be “an item that evidences an effort on behalf of the trademark holder to communicate to a consumer so that the consumer can distinguish the products or services of one from those of another.” Examples include:

- Labels, tags, or containers from a product; and
- Advertising and marketing materials (including brochures, pamphlets, catalogues, product manuals, displays or signage, press releases, screen shots, or social media marketing materials).

Physical copies of samples will not be required. Links, copies, or photographic submissions will be acceptable.

Annual renewal will be required, although a new declaration and sample will only be necessary once every five years. ICANN envisions a procedure for challenging a proof of use, but it has not proposed procedures to-date.

The entire Proof of Use memorandum can be found here:

<http://newgtlds.icann.org/en/about/trademark-clearinghouse/proof-of-use-24sep12-en.pdf>.

³ All trademarks meeting the criteria for inclusion, regardless of use, and actually registered with the Trademark Clearinghouse must be honored during the Trademark Claims process by the new registries.

Trademark/Domain Name Matching

Generally, to determine whether an applied-for domain name matches a mark registered with the Trademark Clearinghouse, the comparison will be between “the textual elements of a mark with the second level label of the domain name being registered.” Critically, “when all and only the complete and identical textual elements exist in both the trademark and the label, it is considered an identical match.” That is, domain names: a) confusingly similar to a mark, b) typopsquats of a mark, e.g. Pattishall and patishall.newgtd; c) plurals, e.g., Pattishall and pattishalls.newgtd, and d) marks contained within a domain name, e.g., Pattishall and pattishall-ip-law.newgtd, will not be deemed matches.

Trademarks, however, often include symbols that cannot be used in the domain name system (DNS). ICANN, therefore, has proposed certain criteria for addressing such uses when determining a match.⁴ In particular, three additional matches will be possible:

- Spaces contained within a mark that are either replaced by hyphens (or vice versa) or omitted.

For example, Pattishall McAuliffe would be a match with pattishallmcauliffe.newgtd and pattishall-mcauliffe.newgtd.

- “@” and “&” spelled out as language specific words will constitute matches. The trademark owner will have some control over the language in which the character is to be translated by designating it (See Section 3.2 of the Matching Rules memo, link below).

For example, Pattishall&McAuliffe, with a designation of English and Spanish would be a match for pattishallandmcauliffe.newgtd and pattishallymcauliffe.newgtd.

- Punctuation or special characters that cannot be used in a second-level domain may either be omitted or replaced by spaces, hyphens or underscores. This rule, in effect, subsumes the first rule above.

For example, Pattishall_McAuliffe (underscores are not permitted in second-level domain names) would be a match with pattishallmcauliffe.newgtd and pattishall-mcauliffe.newgtd.

For marks that have many impermissible symbols, the Trademark Clearinghouse service provider will be able to charge more for the trademark owner’s selection of more translations of its mark.

The entire Matching Rules memorandum can be found here:

<http://newgtds.icann.org/en/about/trademark-clearinghouse/matching-rules-24sep12-en.pdf>.

⁴ If a mark contains a non-letter symbol that is permitted in the DNS, however, a match must truly be exact. Thus, Pattishall-McAuliffe (hyphens are permitted symbols in the DNS) would NOT be a match for pattishallmcauliffe.newgtd.

Comment Period Open Through 6:59 P.M. Eastern Standard Time on November 7, 2012

The comment period will remain open until 6:59 p.m. Eastern Standard Time (after Daylight Savings Time ends in the U.S.). To submit comments on either memorandum, go here:
<http://www.icann.org/en/news/public-comment/tmch-docs-24sep12-en.htm>.

The new gTLD process still has a long way to go, but ICANN is pushing the applications forward to allow them to go live as soon as possible. For all the latest developments, see
<http://newgtlds.icann.org/en/>.

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