

Trademark Clearinghouse & Internationalized Domain Names Webinar – 19 June 2013 Additional Questions & Answers

We receive a host of questions during webinars that go unanswered due to time constraints. Because all participant questions are important, we've provided responses to these additional questions below.

Trademark Verification Process

Q: Where in the Clearinghouse guidelines are the Simplified and Traditional Chinese trademark rules indicated (i.e., separate records for separate scripts)?

A: This case is not specifically addressed in the published guidelines. Additional information will be published soon on the [Clearinghouse website](#).

Q: What are the unique qualifications of the Clearinghouse staff that verify trademark records? Do they have a legal/TM background or do trademark attorneys supervise them?

A: The team is comprised of a mix of auditors, trademark attorneys and staff with legal backgrounds.

Q: What special characters (including punctuation marks) are not accepted in trademark names?

A: The dot (.) is the only special character that is not accepted. Note, however, that some special characters, like the comma, are not valid for use in domain names. These special characters are treated according to a set of matching rules employed by the Clearinghouse (e.g., the character may be omitted or replaced by a hyphen).

Q: During the verification process, will clarification/modification questions be handled by the Deloitte team in Belgium? Or can we work with a local team?

A: Validation teams are spread across the Deloitte network. If you have a specific question, you can log a ticket through the customer support tool and this will be allocated to the right person depending on the question.

Q: Aren't China and Venezuela exceptions to the NICE classification?

A: Both countries now follow the Nice Classification.

Q: For Clearinghouse data tracked by "Nice Classification number," do you mean "NAICS classification number"?

A: The Nice Classification refers to the international classification of goods and services.

Q: How many ASCII entries (i.e., Clearinghouse records) are there as of today?

A: As of June 2013, there are approximately 4,000 records.

Q: One of our trademarks was declined because "no address was provided on the trademark certificate," but the certificate in our country has no space for the address to be provided. This means that no trademark certificate can be used from our country. We believe this is unfair. What can we do if the address is not on the certificate? We should be able to have a chance to fix this.

A: Any questions related to the verification of the trademark record should be logged through the customer support tool provided through the [Clearinghouse user interface](#). If your trademark certificate does not mention an address, documentation such as a copy of the company registration form may be requested.

Q: Could you confirm that in the case of Latin scripts with diacritic marks, it is not possible to protect both versions with two separate records? (Example: "ICANN Cafe" and "ICANN Café")

A: "ICANN Cafe" and "ICANN Café" can both be included in the Trademark Clearinghouse if trademarks for both have been verified by the Clearinghouse.

Q: Besides Deloitte, are there currently any other authorized Trademark Clearinghouse providers?.

A: Currently, Deloitte is the only provider authorized to perform trademark verification services for the Trademark Clearinghouse. The Trademark Clearinghouse works with a number of agents; these can be found at <http://trademark-clearinghouse.com/agents>.

Q: ICANN has expressed its desire to enlist additional Trademark Clearinghouse providers. When will ICANN re-open the application process for TMCH service providers?

A: Our first priority is to ensure that all Clearinghouse services are up and running smoothly in time to support new gTLD launches. As stated previously, we believe it may be beneficial in the long term to have many service providers who can perform verification services. Our agreement with Deloitte provides that we may appoint additional providers of verification service (i.e., validators) after 10 new gTLD sunrise periods have been conducted successfully, according to criteria established in the agreement. Once that milestone has been reached, we would welcome additional interest and would then be in a position to consider securing additional qualified verification service providers.

Signed Mark Data (SMD) Files

Q: Will simplified and traditional Chinese trademarks appear in one Signed Mark Data file with two marks (one simplified, one traditional), one SMD with one mark having two labels, or two SMD files?

A: As only one trademark can be recorded in a trademark record and SMD files are linked to a trademark record, these will be provided in two separate SMD files if both are recorded and verified by the Clearinghouse.

Q: Can verification/change occur to data in the Trademark Clearinghouse after an SMD has been issued? If so, is the initial SMD revoked and a new SMD issued?

A: When changes are made to the record, the SMD file is indeed revoked and a new SMD file is issued.

Q: In your example from Hong Kong, which referenced both simplified and traditional Chinese trademarks – do the output SMDs indicate that these two SMDs are inter-related?

A: Currently, no. As there are two different trademark records, there will be two different SMD files.

Sunrise and Claims Processes

Q: On the second level, what is the procedure where there is a trademark registered with the Trademark Clearinghouse but that is a generic word?

A: It is the role of the trademark offices to determine whether a trademark may be issued according to the laws of that jurisdiction. The Clearinghouse does not make any legal determination, but records rights that have been issued by the various jurisdictions. To the extent that another party wishes to challenge the issuance of a trademark or the registration of a domain name, processes exist outside of the Clearinghouse for this.

Q: With variants and Trademark Claims, may a registry query both original label and variant label? Or must it check the original and all possible variants?

A: The registry is required to check whether a name is subject to a claim before they register any name during the claims period. Depending on what the registry's policy is, if there is a label that would generate several variants, the registry would check all of those labels. The registry may have a policy that blocks registration of the variant labels, in which case the blocked labels would not need to be checked since they are not being registered as domain names.

Q: If a registry adopts the relevant variant table and implements its variant management policy, does it still mean that the registry can only allow a trademark's variant characters registered in a priority registration period AFTER the Sunrise period? Has the requirement changed?

A: The draft RPM Requirements published on 6 April 2013 provided that the registry could apply its variants matching according to its IDN tables in the registry, but in the case of the sunrise, it would do the allocation of those names once the sunrise had concluded. ICANN is now reviewing some of the comments to this draft concerning whether the registry should be able to apply some of those matches during the sunrise period based on applying its IDN table. This is under consideration.

Q: Is it correct that for the Trademark+50 provision in the Strawman proposal, it is 50 names per mark per Clearinghouse entry, meaning that for a mark that is registered in N jurisdictions, there may be 50 x N additional entries?

A: This concerns the capacity to add up to 50 domain name labels to each Clearinghouse record based on a previous adjudication that the names have been abusive to a verified trademark record. In other words, names that were previously determined to infringe the verified mark in the Clearinghouse. A mark registered in one jurisdiction is a different Clearinghouse record than the mark registered in a different jurisdiction.

Q: How will Whois data be matched with the Trademark Clearinghouse? We will apply for a domain in ASCII. Will it be matched with a Japanese language based registrant in the Clearinghouse? How will Whois data provided in ASCII be verified?

A: When it comes to the registry processing the domain name registration and populating the Whois record for that, the SMD issued by the Clearinghouse will be presented by the rights holder to the registry. That on its own is sufficient for the registry to be able to process that registration if it matches the domain name labels that are in the SMD file. It is not a requirement for the registry to establish matching between the information in the Clearinghouse record and Whois record for the domain name, but that is something that

registries may choose to do as an additional verification. In other words, the option is available, but not required. It is up to the registry.

Q: How can registries gain access to the testing environment? When will the testing environment be open?

A: As currently drafted, the parties have access to the testing environment once the registry agreement is signed. The testing platform is still under development. It is in everyone's interest to provide as much testing time as possible; on testing dates, we are working closely with the Clearinghouse service providers on the timeline and will share those dates as soon as possible.