



New gTLD Program: Trademark Clearinghouse Explanatory Memorandum: Implementing the Proof of Use Verification

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Since the approval of the New gTLD Program, ICANN has undertaken an open, inclusive and transparent implementation process to address stakeholder concerns, including the protection of intellectual property and community interests, consumer protection, and DNS stability.

When the community raised a set of new gTLD “over-arching issues,” ICANN in each case convened teams of experts in the relevant fields to develop sets of solutions. In a manner unique to the ICANN model, solutions were recommended, discussed by the broader Internet community, and approved by the Board for additional review as part of the draft Applicant Guidebook.

Teams of recognized experts were convened in the areas of intellectual property, consumer protection, DNS market economics, registry operations, linguistics and internationalized domain names, and root server stability. This multi-year public participation process included consultations with governments, businesses, NGOs, law enforcement, and the at-large Internet community.

The Board formed the Implementation Recommendation Team (IRT) comprised of 18 intellectual property experts to develop specific rights protection mechanisms for new gTLDs. The IRT final recommendations were reviewed by a cross-constituency based (Special Trademark Issues or STI) team to provide a multi-stakeholder consensus view. These combined efforts produced an enhanced set of trademark protections for new gTLDs that have been further improved through the participation of many in the broader Internet community, including a number of national governments via participation in ICANN’s Governmental Advisory Committee.

The implementation model introduces significant new rights protection mechanisms that are not available in the current space. These include the Trademark Clearinghouse, a single database of authenticated registered trademarks will provide data to support trademark claims and sunrise services. The Clearinghouse will be operated by a third party under license or agreement with ICANN and replaces the need for trademark holders to register in many databases as new gTLDs are launched. ICANN will require that every new gTLD operator utilize the Clearinghouse and conduct both a Trademark Claims and a Sunrise Process.

Key Points

- Proof of use is required to qualify for participation in the Sunrise domain name registration processes. The requirement is intended to ensure that only holders of marks that demonstrate “use” are given this extraordinary exclusionary right in order to prevent abuses and provide equal treatment to all rights holders.
- This requirement is intended to benefit trademark holders in that it helps a trademark holder that has truly used its mark to identify and distinguish its products or services from others.
- A key requirement is for the Clearinghouse to serve rights holders from all regions of the world. A single process for verifying rights data is designed to be accessible to prospective users in all regions. The process for verifying proof of use incorporates a signed declaration of use and a single sample of current use.
- There are a number of ways to satisfy the requirement for proof of use that will be accepted by the Clearinghouse. The requirements are intended to be flexible to accommodate practices from multiple jurisdictions.

Background

The sunrise period is a requirement for all new gTLD registry operators. This provides an opportunity to eligible rights holders to request desired domain names before they are generally available to be registered by the public.

Clearinghouse data will support the sunrise periods offered by new gTLD registries. As provided in section 3.2 of the gTLD Applicant Guidebook, the Clearinghouse will include: (i) nationally or regionally registered word marks from all jurisdictions, (ii) any word mark that has been validated through a court of law or other judicial proceeding, (iii) any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion, and (iv) other marks that constitute intellectual property.

The proof of use requirement relates only to the sunrise period. It does not relate to entry into the Trademark Clearinghouse or for the Trademark Claims rights protection mechanism. All trademarks meeting the specified criteria for inclusion, regardless of whether there is evidence that the mark is used, are eligible for inclusion in the Clearinghouse. Additionally, registries are required to honor all trademarks in the mandatory Trademark Claims process, regardless of whether there is proof of use.

Where a trademark is a nationally or regionally registered, verification of proof of use by the Clearinghouse is required for sunrise domain registration eligibility, as shown below:

| | Rights are not verified | Rights are verified | Rights are verified with proof of use |
|--|-------------------------|---------------------|---------------------------------------|
| Recorded in Clearinghouse | Not eligible | Eligible | Eligible |
| Participation in Trademark Claims service | Not eligible | Eligible | Eligible |
| Eligibility for Sunrise domain name registration | Not eligible | Not eligible | Eligible |

Where a trademark holder wishes to demonstrate use of a trademark to establish eligibility to participate in Sunrise registration processes, the Clearinghouse will verify proof of use associated with a trademark record. This memorandum describes that process.

1. Objectives of the Proof of Use Requirement

A key goal in requiring proof of use for sunrise protection is to ensure that only holders of marks that are being used, and thus distinguishing themselves over others, are given the extraordinary exclusionary right provided with this protection mechanism (i.e., eligibility for advance registration of domain names in the initial phase of a new gTLD startup).¹

As noted by the World Intellectual Property Organization (WIPO), “a trademark is a distinctive sign which identifies certain goods or services as those produced or provided by a specific person or enterprise... The system helps consumers identify and purchase a product or service because its nature and quality, indicated by its unique trademark, meets their needs.”²

The true source-identifying function of a trademark does not exist if the mark is not used. Hence, when viewing trademark rights in connection with rights protection mechanisms in the New gTLD Program, use must play a central role. Proof of use is intended to ensure that all registered trademarks receiving the same type of advantage from a particular rights protection mechanism are evaluated at the same level. There will be no disparity of treatment or requirement based on the jurisdiction in which the mark is registered.

¹ See additional discussion of this requirement at See discussion of this requirement at <http://archive.icann.org/en/topics/new-gtlds/trademark-protections-evidence-use-07jun11-en.pdf>.

² See <http://www.wipo.int/trademarks/en/trademarks.html>

The requirement for proof of use is neither intended to be nor thought to be either a burden or an obstacle. Rather, the requirement is intended to benefit trademark holders in that it helps a trademark holder that has truly used its mark to identify and distinguish its products or services from others.³

The information contained in this memo is intended to provide transparency into the implementation of the community-developed requirements and to generate additional feedback that should be taken into account.

2. Implementation of the Proof of Use Requirement

For verification of minimum sunrise eligibility by the Clearinghouse, the rights holder shall be required to provide evidence of use of the mark in connection with the bona fide offering for sale of goods or services prior to application for inclusion in the Clearinghouse.

A submission for verification of proof of use must contain two elements:

- a) a signed Declaration of Use, and
- b) a single sample of current use.

These are described below.

It is recognized that use requirements for trademarks vary across jurisdictions. However, consistent procedures and rules must be applied by the Clearinghouse regardless of the jurisdiction where a trademark was issued. This helps ensure that rights holders from all regions are asked to follow the same process.

2.1 Role of Clearinghouse in Verifying Proof of Use

As described above, a key requirement is for the Clearinghouse to serve rights holders from all regions of the world. The processes and requirements designed for verifying rights data must be accessible to and communicated to prospective users in all regions.

The role of the Clearinghouse is to administer a database of rights information, rather than to make legal determinations on certain rights. A process that draws upon a clearly communicated set of rules and minimizes subjective reviews by the Clearinghouse will serve these goals and will also help to minimize the costs for Clearinghouse users.

2.2 Declaration of Use

The first component of proof of use is a signed declaration by the rights holder. The Clearinghouse will use a standard form for the Declaration of Use.

³ Currently, there is not envisioned to be an additional fee for verification of proof of use.

While all parties submitting records into the Clearinghouse will make a declaration concerning the accuracy and completeness of the data submitted, an additional form of declaration specifically concerning the proof of use documentation will be required where a record is validated for proof of use. The Declaration of Use is the following:

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.

2.3 Sample of Use

The range of samples accepted to support verification of proof of use by the Clearinghouse is intended to be flexible to accommodate practices from multiple jurisdictions.

In establishing the list of accepted samples, the guiding principle that has been used is that a sample should 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.* In considering the suggestions generated for acceptable samples of use, this principle has guided the development process.

Accordingly, examples of acceptable evidence would include items from either of the following categories:

- a. Labels, tags, or containers from a product. This provides a physical indication that a product is available for use or access by consumers.
- b. Advertising and marketing materials (including brochures, pamphlets, catalogues, product manuals, displays or signage, press releases, screen shots, or social media marketing materials). This is meant to show that the rights holder is communicating to consumers that a product or service has a particular source.

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

Examples of samples that would not be accepted as proof of use include:

- a. Inclusion of a mark in a domain name. Registration of a domain name does not provide an indication that there is a good or service being offered to consumers.
- b. Email messages. Private communications do not provide evidence of a product or service generally available to consumers.
- c. Licenses to use a mark or applications for business licenses that include the mark as part of the business name. These would provide an indication that an entity is preparing to use the mark, but does not constitute a demonstration that the mark is being used.
- c. Business cards. Business cards for an individual do not provide an indication that there is a good or service being offered to consumers in connection with the trademark.

The sample submitted must contain the trademark being validated for use. The Clearinghouse will not assume the role of making determinations on the scope of rights associated with a recorded trademark or the labels it can generate.

2.4 Renewal of Proof of Use

All Clearinghouse records will require an annual renewal. For those records that have been verified for proof of use, the annual renewal for the record will not require submission of a new sample. However, re-verification of the proof of use, including a renewed Declaration of Use (indicating that the mark is still in current use) and submission of a current sample of use, will be required once every five (5) years to maintain sunrise eligibility.

If re-verification does not occur or is unsuccessful, there is no retroactive effect: existing domain names that were registered based on the Clearinghouse record during previous sunrise periods would be maintained; however, the rights holder would not have the ability to register new names during sunrises until the proof of use was successfully re-verified.

2.5 Challenges to Verification of Proof of Use

It is expected that parties may wish to raise challenges concerning either the Clearinghouse verification of proof of use or a registry's use of Clearinghouse information in a sunrise period. Mechanisms for consideration of such challenges are being developed and will be published in the context of dispute resolution procedures for the Clearinghouse.

3. Conclusion

Requiring proof of use to take advantage of sunrise protection is an important element of this protection and has been designed to be a minimal imposition on the trademark holder. Requiring a showing of use helps ensure that only holders of marks that are being used, and thus distinguishing themselves over others, are given the extraordinary exclusionary right provided with this mechanism. As described above, this is an important step in guarding against abuse, protecting trademark holders, maintaining an even playing field, and keeping trademark protection costs low.