# TMCH & IDNs
# Webinar

19 June 2013

# Webinar Information

US Toll-free
1-877-941-2059

US Toll
1-480-629-9654

Conference ID
Trademark Clearinghouse
Webinar

+ Q&A session after the presentation

– Phone questions given priority

  – To ask a question dial *1 (star one)
  – To exit the question queue dial *2 (star two)

– Online questions answered as time permits

+ Recordings and slides available after the webinar

Additional information, including International dial-in numbers, can be found at:
http://newgtlds.icann.org/webinars

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# Main Agenda

+ Introduction

+ Basic review of TMCH function

+ TM verification process with focus on IDNs

+ Sunrise and Claims processes

+ Status of IDN projects at ICANN

+ Any other topics/Q&A

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# Basic review of TMCH function

**Antonietta Mangiacotti**
Research Assistant

# Basic review of TMCH function



+ Global database to support rights protection mechanisms

+ Functions:

  – Authenticates information from rights holders all over the world

  – Maintains a centralized database

  – Provides this information to registries and registrars during the domain name registration process

More information can be found at:
http://newgtlds.icann.org/en/about/trademark-clearinghouse

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**Vicky Folens, Deloitte,** Senior Manager | IP & Internet

Services and Strategy –

TM verification process with focus on IDNs

TMCH and IDNs webinar
June 2013

www.trademark-clearinghouse.com

# Agenda

o Are trademarks in non-ASCII accepted by the TMCH?

o Examples of trademarks in various languages

o TMs in Simplified and Traditional Chinese

o Online Databases - Updated

o The Verification Process

o Countries not applying the Nice Classification

# Are trademarks in non-ASCII accepted by the TMCH (IDNs)?

## YES

# Examples of Trademarks

*(for illustrative purpose only)*



Trademark in accordance to the
name of the mark: FINE BORN CHINA

# Examples of Trademarks

*(for illustrative purpose only)*



| Word Mark | PYCCKNN CTAHDAPT ST. PETERSBURG VODKA 1894 |
|---|---|
| Translations | The non-Latin character(s) in the mark transliterates into RUSSKY **STANDARD** and SOOTVETCTVUET STANDARTU RUSSKOY VISSHEGO KACHESTVA, and this means **RUSSIAN STANDARD** and IT CONFORMS TO THE **STANDARD** OF HIGH-QUALITY **RUSSIAN** VODKA in English. The non-Latin wording in the mark translates to "**RUSSIAN STANDARD**" and "IT CONFORMS TO THE **STANDARD** OF HIGH-QUALITY **RUSSIAN** VODKA". |
| Goods and Services | IC 033. US 047 049. G & S: alcoholic beverages, namely, vodka. FIRST USE: 20060919. FIRST USE IN COMMERCE: 20060919 |
| Mark Drawing Code | (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS |
| Design Search | 04.05.25 - Other mythological or legendary animals |

Labels cannot be generated

# Examples of Trademarks

*(for illustrative purpose only)*

(111) *Номер регистрации:* **148680**

(210) *Номер заявки:* **95711233**

(181) *Дата истечения срока действия регистрации:* **06.10.2005**

(220) *Дата подачи заявки:* **06.10.1995**

(151) *Дата регистрации:* **16.12.1996**

(450) *Дата публикации:* **12.02.1998**

(540)

**АБСОЛЮТ**

(732) *Имя правообладателя:*
**В унд С Вин унд Сприт Актиеболаг, Стокгольм (SE)**

(511) *Классы МКТУ и перечень товаров и/или услуг:*
**33 - спиртные напитки.**

# Simplified/Traditional Chinese TMs

*(for illustrative purpose only)*

➢ TMs listed in both **Simplified and Traditional Chinese** on the TM certificate (ex. Hong Kong) will be treated as **two separate records** in the Clearinghouse

香港特別行政區政府知識產權署商標註冊處
Trade Marks Registry, Intellectual Property Department
The Government of the Hong Kong Special Administrative Region

商標記錄
Trade Mark Records

| | |
|---|---|
| [111] 商標編號:<br>Trade Mark No.: | 300977662 |
| 狀況:<br>Status: | Registered |
| [540] 商標:<br>Mark: | 殼牌 壳牌<br>(A) 殼牌<br>(B) 壳牌 |
| [550] 商標種類:<br>Mark Type: | Ordinary |
| 一系列商標:<br>Series Mark: | Yes |
| [730] 擁有人<br>姓名／名稱、地址:<br>Owner's Name,<br>Address: | Shell Brands International AG<br>Baarermatte,<br>6340 Baar,<br>SWITZERLAND |
| [740/<br>750] 擁有人的送達地址:<br>Owner's Address<br>for Service: | ROUSE LEGAL<br>18/F., Golden Centre,<br>188 Des Voeux Road Central,<br>Hong Kong |
| 代理人地址:<br>Agent's Address: | 18/F., Golden Centre,<br>188 Des Voeux Road Central,<br>Hong Kong |

# Examples of Trademarks

*(for illustrative purpose only)*

**540 Mark**

人头马

**531 International Classification of the Figurative Elements of Marks (Vienna Classification) - VCL(6)**
28.03.00

**561 Transliteration of the mark**
REN TOU MA.

Protection provided for: 人头马

Not for the transliteration of the mark

# Online Database Update

## In which language should you submit the information to the Clearinghouse?

➢ **List of online database is provided on www.trademark-clearinghouse.com**

➢ **If the jurisdiction does not have an official online database -→ copy of the trademark certificate should be provided.**

➢ **Trademark Name,Detailed description of goods and services, Name and address of the Holder should be submitted in the language as provided on the TM certificate.**
   **(certified translation for the detailed description and name and address of the holder  is accepted as well)**

# Online Database Update

## In which language should you submit the information to the Clearinghouse?

➤ Detailed description in Japanese

➤ Name and Address of Holder in Japanese (holder can be mentioned in ENGLISH in the TMCH as well)

# Verification Process

➢ "**Four eyes process**"- two verifications per TM record

➢ Verification of the accuracy and completeness of the information provided and compliance with the eligibility requirements

➢ Verification of the following items which should be an exact match with the information provided on the TM certificate:

- Jurisdiction
- Registration Number
- Name of the Trademark (eligibility requirements-no dots accepted, matching with certificate…)
- Registration Date
- Nice classification number (Description of Goods and Services)
- Detailed Description of Goods and Services

- Type of Holder (Owner, Licensee, Assignee)
- Name of Holder
- Address of Holder (street, postal code, city, country)
- For Sunrise Eligibility: Signed Declaration of Proof of Use
- For Sunrise Eligibility: Acceptable Proof of Use

# Verification Process

➢ **In the event that the TM or Proof of use is incorrect →
recorrection process in initiated, trademark record is verified
again**

➢ **Reasons that initiate a re-correction process:**

- Name of the mark is incorrect
- Registraton number is incorrect
- Jurisdiction is incorrect
- Name of the holder is incorrect and no documentary evidence has been provided
- Address of the holder is incorrect and no documentery evidence  has been provided
- Copy of the TM certificate is not provided
- Registration date is incorrect
- Description of goods and services are incorrect
- Detailed description of goods and services
- Sample of proof of use is insufficient
- Declaration of proof  of use is not signed or dated

# Number of trademarks (IDNs)

➤ **Currently about 100 trademark records in the TMCH (Japanese, Chinese, Arabic, Russian,…..)**

- Cyrillic: 18

- Japanese: 7

- Chinese: 49

- Arabic: 13

- Hebrew: 2

# Countries not following the Nice Classification

➢ **"N.A." is applicable** for the Nice classification in the Interface (description of goods and services) for TMs registered in one of the below listed countries:

*Afghanistan, Albania, Andorra, Bahamas, Belize, Bhutan, Brunei, Burkina Faso, Burma/Myanmar, Cameroon, Canada, Cape Verde, Central African Republic, Chad, Comoros, Congo, Cote d'Ivoire, Dominican Republic, East Timor, Equatorial Guinea, Eritrea, Fiji, Gabon, Gambia, Guinea-Bissau, Laos, Liberia, Maldives, Mali, Marshall Islands, Mauritania, Micronesia, Moldova, Nauru, Niger, Oman, Palau, Papua New Guinea, Somalia, Tanzania, Togo, Tuvalu, Vanuatu, Vatican City*

# Sunrise and Claims processes

**Karen Lentz**
Operations & Policy Research Director

# Sunrise Process

+ Trademark holders can register domain names before they are offered to the general public.

+ The domain name registered must correspond to their mark in the Clearinghouse.

+ New gTLD registries are required to offer a Sunrise period of at least 30 days.

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# Claims Process

+ Runs for at least the first 90 days of an initial operating period of general registration.

+ Includes Trademark Claims Notice:

  – When registering a domain name that matches theirs, the registrant will be shown a claims notice that has to be acknowledged before proceeding.

  – A notice is then sent to the trademark holder when someone has registered a domain name matching their record in the clearinghouse.

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# IDN Variants & TMCH



+ Options reviewed and discussed by the community when it came to implementing the Clearinghouse:

1) To implement one set of variant rules and apply it to all the trademarks in the Clearinghouse

2) To implement the variant rules defined by each registry individually

3) Continue to allow for implementation of variant rules at the registry level

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# IDN Variants & RPM Requirements



+ Registry implements variants in line with current practices

+ Allocation may occur after sunrise

+ Discussion on RPM requirements are ongoing

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# Status of IDN projects at ICANN
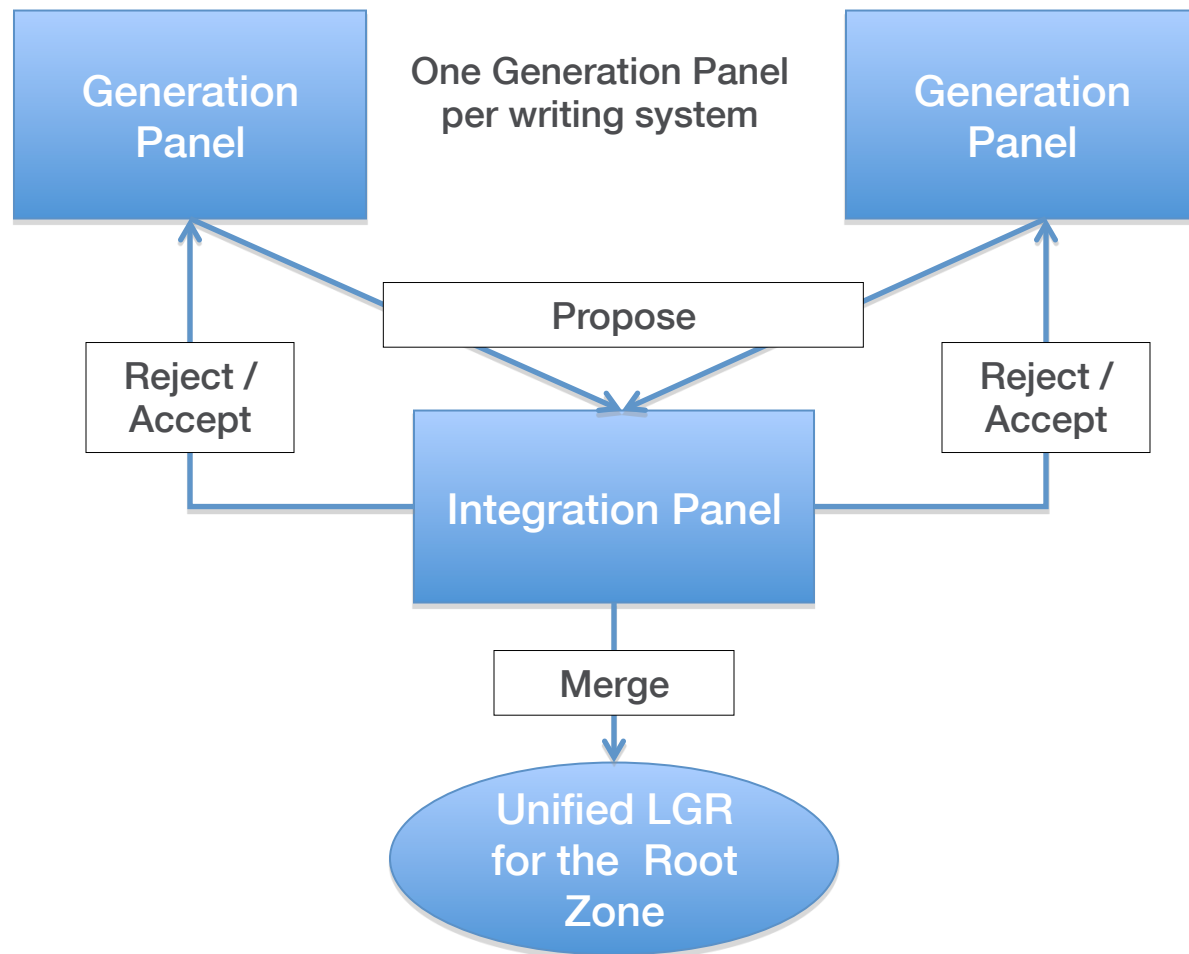
**Naela Sarras**
Manager, IDN TLDs

# Phase 4 of the IDN Variant TLD Program
## Implementation Projects

+ Program's last phase includes the following projects:

  – Project 2.2: Implementation of the IDN Root Zone LGR Procedure, representing the actual development of the Label Generation Rules for IDNA Labels for the Root Zone

  – Project 7: Updating the gTLD Applicant Guidebook and IDN ccTLD Process to incorporate the Label Generation Rules in the respective evaluation processes and account for recommendations from the Report on User Experience Implications of Active Variant TLDs study

  – Project 8: Following the completion of Project 7, updating ICANN/IANA processes and systems to implement the changes specified in the new gTLD and IDN ccTLD Programs to support IDN variant TLDs

  – Project 1: Finalizing the LGR tool format specification

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# Project 2.2: Implementing the IDN Root Zone LGR Procedure

+ Populate the code point repertoire and the Label Generation Rules for IDNA labels for the root zone

+ Provide Utility and Coverage for additional scripts and languages while minimizing the risk to root zone as shared resource

+ Automate the application of IDN Root LGR

**Generation Panel**

One Generation Panel per writing system

**Generation Panel**

Propose

Reject / Accept

Reject / Accept

**Integration Panel**

Merge

**Unified LGR for the Root Zone**

Call for Subject Matter Experts for the IDN Root Zone LGR Integration Panel and Advisors to All Panels:
http://www.icann.org/en/news/announcements/announcement-3-06jun13-en.htm

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# Webinar: Internationalized Domain Name (IDN) Variant TLD Program Update

**Date**: 27 June 2013

**Time**: 23:00 – 00:00 UTC (4:00pm – 5:00pm PDT)

**Adobe Connect**: http://icann.adobeconnect.com/idnvarianttld/

+ Intended to provide a status update of the Program and current IDN Variant TLD Projects, as well as to address questions around the prerequisites for implementation of IDN Variant TLDs and upcoming community involvement

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# Thank You & Questions?

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**US Toll:** 1-480-629-9654

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**Conference ID:** Trademark
Clearinghouse Webinar

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+ Questions submitted in the Questions & Comments pod answered as time permits

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