

May 15, 2011

Mr. Peter Dengate Thrush
Chairman of the Board of Directors
Mr. Rod Beckstrom
President and CEO
ICANN
4676 Admiralty Way, Suite 330
Marina del Ray, CA 90292

Re: Definition Of Trademarks With Global Figurative Mark Examples

To the ICANN DAG Review Committee,

In accordance with the GAC's definition of trademarks that are "protected by a statute or treaty". Both word marks and figurative trademarks must be included in the DAG. Sections 2.2.1, 3.2.13.2.3 need to be amended to include figurative registered trademarks.

Both UDRP panels and WIPO (who will handle any NEW GTLD Applicant trademark contentions) hold the view that; in dealing with figurative marks, panels argue that figurative elements may be ignored and the analysis then proceeds to compare the non-figurative text with the domain name. Even if the text of the mark and the domain are not identical, panels regularly opine that there can still be confusing similarity if the dominant textual element of the figurative trademark is reproduced.

UDRP panels applying the above guidelines frequently cite *Borges, S.A., Tanio, S.A.U. v. James English (Borges.com)*. Borges stated that "it is open to a Panel to make a finding

under the first element of the Policy, based on the "dominant [word] elements" of a mark." The decision argues that considering the figurative elements would "always place the owners of such marks at a significant disadvantage" and "[t]he terms of the Policy include no such limitation against owners of such marks."

The Borges panel concluded that "the more distinctive or particular the textual elements of the trademark, the greater the likelihood of it being identical or confusingly similar." In the stroke of a pen, §4(a)(i) was rewritten and figurative marks carry the same weight and identity as word marks.

The ICANN GAC "Government Advisory Committee" will always favor the initiatives of trademark holders as, the countries which they represent, have granted such trademark rights.

The GAC noted in its Nairobi communiqué the recommendations of the Special Trade Marks Issues Review Team further clarified the inclusive nature of all trademarks "protected by a statute or treaty" as set forth below.

The GAC Chair stated in his letter dated 10 March 2010 to the ICANN Chair regarding DAGv3 "that it is important to ensure that intellectual property rights are properly respected in the new gTLD space consistent with national and international law and standards".

The GAC expects that the proposed Trademark Clearing House should be made available to all trademark owners, irrespective of the legal regime they operate under.

Therefore, the developed UDRP/WIPO panel precedent and the clearly inclusive intention of the GAC towards both figurative trademarks and word marks leave ICANN with a clear directive to include both legally recognized forms of trademarks in the DAG and the ICANN Trademark Clearinghouse.

Respectfully Submitted,

Matt Harper
Managing Partner
Global Digital LLC
1100 Glendon Ave.
17th Floor
Los Angeles, CA.
90024

V. 805 208 6455 UTC -8
F. 310 689 7272

2.2.1 One entity will authenticate registrations ensuring the word marks qualify as registered or are court-validated word marks or word marks that are protected by statute or treaty. This entity would also be asked to validate ensure that proof of use of marks that are from jurisdictions that do not conduct substantive review before registration is provided, which can be demonstrated by furnishing a signed declaration and one specimen of current use.

3.2 The proposed standards for inclusion in the Clearinghouse are:

3.2.1 Nationally or multi-nationally registered word marks and FIGURATIVE marks from all jurisdictions (including from countries where there is no substantive review)..

3.2.2 Any word mark that has been validated through a court of law or other judicial proceeding.

3.2.3 Any word mark and FIGURATIVE marks protected by a statute or treaty

Global Examples Of Figurative Trademarks



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