## Deloitte, IBM and CHIP (hereinafter “the Clearinghouse” the opportunity to provide feedback on the Rights Protection Mechanism (RPM) Review Draft Report. Our comments are provided as follows:

## Trademark Clearinghouse

### What were the challenges, if any, in terms of satisfying the requirements for trademark inclusion into the Clearinghouse?

The Clearinghouse noticed that there were a series of recurrent errors made by trademark holders in satisfying the requirements for trademark inclusion into the Clearinghouse. Most of these errors appeared to be related to misunderstandings of the Clearinghouse requirements. In order to address this issue, the Clearinghouse conducted several webinars with the aim of clarifying what the common errors were during the submission of records to the Clearinghouse as well as the correct application of the eligibility requirements.

The Clearinghouse believes that, although trademark holders encountered different challenges in terms of satisfying the requirements of the Clearinghouse, the Clearinghouse has always been eager to address these issues either by providing additional guidance whenever the Clearinghouse Guidelines were misunderstood or by escalating the issues to ICANN whenever the Clearinghouse felt the Clearinghouse Guidelines were not adequate anymore and needed to be adjusted to serve better the trademark holders and reflect the current situation.

### Were there any challenges related to marks from specific jurisdictions in relation to the Clearinghouse guidelines?

It could be that trademark holders faced issues when submitting trademarks from a specific jurisdictions due to the fact that the Clearinghouse is a global system and that its requirements have been unified to avoid favoring or imposing a more burdensome process for certain jurisdictions. The Clearinghouse has however put intensive efforts in the provision of educative webinars, tailored customer support and explicit comments when setting a mark on an incorrect status to clarify the information required.

In addition, the verification services are provided by a global team. These verification agents are based in different countries throughout the world.

### Was the verification process successful in restricting non-eligible trademarks?

### What factors could be considered to make the trademark verification process more effective?

### What factors could be considered to make the process of updating Clearinghouse records more effective?

### Did the Clearinghouse structure successfully balance implementation of the service with data misuse concerns?

We have no knowledge of TMCH data misuse. Our tiered structure of trademark owners-TMCH-TMDB-registry-registrar seems to provide appropriate protection against data misuse.

Combined with the fact that the Clearinghouse database was not made searchable and accessible to prevent data misuse concerns has however led to other issues. The Clearinghouse is not allowed to answer requests coming from trademark holders eager to know whether their trademark is in the Clearinghouse, often the case for global companies who want to know if one of their entities already submitted one of their trademarks to the Clearinghouse. The Clearinghouse is not allowed to answer trademark holders wanting to know whether a trademark identical to theirs is present in the Clearinghouse. These requests are usually made by trademark holders who want to know if there might a chance of a competing sunrise application by another trademark holder.

To address these issues the Clearinghouse would like to explore the option to implement a publicly available online “query tool”. In order to determine which information may be publicly available, the parties running the Clearinghouse would like to sit together with an advisory working group as appointed by ICANN to ensure that all right and interest are maintained.

### Do the Clearinghouse benefits outweigh the concerns about distribution of data?

The Clearinghouse believes that, until now, its benefits outweigh the original concerns related to the distribution of data. No complaints have been addressed to the Clearinghouse concerning the distribution of data. The rate of renewals of the trademark records seems to indicate that those who have submitted their trademarks in the Clearinghouse trust the Clearinghouse enough to submit their data again.

### Were any issues identified relating to misuse of Clearinghouse data?

### Was the proof of use requirement helpful in meeting the goals of a creating a standard that accommodates practices from multiple jurisdictions?

The Clearinghouse believes that the implementation and application of the standards regarding the acceptance of the proof of use were successful in accommodating practices from multiple jurisdictions and in treating all jurisdictions equally. By following strictly the verification process and requirements, the verification agents of the Clearinghouse have ensured consistent verification of the proof of use – irrespective of the jurisdiction in which the trademarks are registered. In addition, the proof of use acceptance requirements are in no means linked to the country or jurisdiction in which the trademark is registered. Similarly to the submission of trademarks, the Clearinghouse has provided educative webinars and additional assistance through the customer support in order to clarify the eligibility requirements for the proof of use.

### What were the challenges, if any, in terms of satisfying the proof of use requirement?

The Clearinghouse has witnessed challenges for the trademark holders in terms of satisfying the proof of use requirement, mainly in submitting the sample of proof of use. The first challenge faced by trademark holders was the exact match requirements according to which the sample of proof must contain the complete name of the registered trademark as recorded in the trademark records and as verified and determined correct. Specifically when the trademark name includes special characters such as accents or hyphen on the sample of proof of use which are not present in the trademark name in the trademark certificate. Another similar issue was faced by companies having registered a trademark name corresponding to their company name and being unable to submit a sample of proof of use containing the trademark name only and not followed by the legal form of the company.

Some trademark holders were facing issues as well when submitting a sample of use because of the fact that their trademarks were not yet commercialized while already registered. This situation often led to trademark holders not being able to submit a proof of use or not willing to submit a proof of use due to confidentiality reasons. However, as the Clearinghouse allows a later submission of proof of use, this issue can be solved easily by waiting for the commercialization of the mark. This nevertheless means that in some cases trademark holders could potentially miss a sunrise they were interested in.

The Clearinghouse has however made efforts helping trademark holders understanding the proof of use eligibility requirements by organizing educative webinars and by providing detailed comments targeted to the specificities of the case analyzed. The Clearinghouse has also provided guidance with regard to the type of proof of use accepted (e.g. marketing materials, press releases, etc.) This has helped trademark holders looking for the right sample of proof of use select which sample might best meet the proof of use eligibility requirements. In addition, the fact that trademark holders can correct their proof of use several times has helped trademark holders satisfying the proof of use requirements and getting their proof of use verified.

### Was the proof of use requirement successful in restricting the Sunrise period to Sunrise-eligible rights holders?

### What factors could be considered to make this process more effective?

The Clearinghouse has received in the first months of implementation several questions from trademark holders concerning the proof of use verification, mainly about the acceptance of sample of use and about the declaration template. However, the Clearinghouse believes that by answering questions of customers both via the customer support tool and the hotline, the trademark holders’ questions were answered. The Clearinghouse is noticing a significant decrease of questions concerning the proof of use verification and acceptance process.

The Clearinghouse believes that the process fulfils trademark holders’ expectations in terms of efficiency by giving to trademark holders several attempts to correct the proof of use, by providing explicit comments for helping holders to correct their proof of use and by providing intensive customer support services.

### Should the verification standards in the Clearinghouse Guidelines be adjusted in one or more areas?

### Could verification standards used by the Clearinghouse be adjusted to better serve rights holders in all global regions?

### To the extent that gaming is occurring, could this be prevented by modification to the verification standards?

The Clearinghouse believes that the proof of use requirement as well as the annual re-verification of trademark records contributes to the diminution of the risk of gaming. In addition to this, the Clearinghouse has already escalated to ICANN several trademark records that it believed were attempts of gaming. The Clearinghouse has further communicated to ICANN a memorandum concerning issues it has seen in relation to gaming attempts in order to ask ICANN to provide the Clearinghouse with additional guidance.

## Sunrise Period

### How effective is the Sunrise period for protecting intellectual property rights?

### Are the Start-Date Sunrise and End-Date Sunrise alternatives useful?

### What were the challenges, if any, in terms of registering a domain name during the Sunrise period?

### What factors can be addressed to make Sunrise processes more effective?

### Did having a set of Sunrise minimum requirements across TLDs provide for increased efficiencies in registration processes? Were there advantages and disadvantages to the required Sunrise for rights holders? For Registry Operators?

### Did the use of SMD files help streamline the process? Were there any technical issues encountered, if so, what were they?

### Is there an appropriate balance of registry discretion to reserve names from registration and the inclusion of names in the required RPMs? Should additional considerations be applied around registry allocation practices and their interaction with the required RPMs?

### Were Limited Registration Periods a useful part of registry launch processes?

### What were the challenges, if any, in terms of registering domain names during Limited Registration Periods?

### Did registries find that registrants took advantage of Limited Registration periods?

### Was the QLP useful for registries in launching and promoting their TLDs? What were the challenges, if any, in terms of operating a QLP? What factors, if any, would make it more effective?

### Did the QLP succeed in maintaining safeguards against intellectual property infringement? Were any intellectual property infringement issues noted with regard to names issued as part of a QLP?

### Are there similar programs that could be built into TLD Startup processes that would support registry startup while maintaining safeguards against intellectual property infringement?

### How useful was the SDRP in resolving disputes?

### What were the most common types of disputes?

### What were the challenges, if any, in using the SDRP?

### What factors could be addressed to make Sunrise processes more effective?

## Trademark Claims

### Is the Claims notice an effective form of communication?

### For those with registrant/customer interactions, what has been the customer response to Claims notices?

### Were any technical issues identified relating to the Claims service?

### Is there any other piece of information that should be included in the Claims notice?

### How helpful is it to have the Trademark Notice in English and in the language of the registrant’s registration agreement? Should additional language considerations be applied?

### How could the Claims service be improved?

### How useful are extended Claims services?

### What were the challenges, if any, in terms of extended Claims services?

### How effective is the inclusion of previously abused labels in protecting against trademark abuse and infringement?

### Should the standards for verification of previously abused labels be modified?

Based on the comments provided to the Clearinghouse, the standards for verifying previously abused labels could be improved. According to the current Clearinghouse Guidelines for abused labels based on UDRP cases, the name of the trademark, the registration number and jurisdiction in which the trademark is registered as well as the name of the UDRP provider and the reference number of the case are required in order to perform the verification of the case. The verification agents of the Clearinghouse verify the information submitted to the Clearinghouse against the copy of the case, generally available on the website of the relevant UDRP provider. However in many cases, the registration number and the jurisdiction in which the trademark is registered are not mentioned in the UDRP case. The verification agents usually then request the original complaint or the addendum of the case that mentions the registration number of the trademark and the jurisdiction along with the name of the trademark. The Clearinghouse has received several of complaints from trademark holders concerning the fact that they were not in possession anymore of the UDRP case in which the trademark name, the registration number of the trademark and the name of the jurisdiction in which the trademark is registered are mentioned. This meant that the Clearinghouse was prevented from completing the verification process. The trademark holders were therefore unable to add the abused labels to their trademark records. The Clearinghouse henceforth believes that, due to this strict verification criteria, the possibility to add previously abused labels is not functioning in the way it was designed, namely to help trademark holders adding previously abused labels linked to their trademarks as they are unable to meet the high eligibility requirements. This is especially the case when the link between the UDRP case and the trademark recorded in the Clearinghouse can be done, without finding the explicitly mentioned three requirements of verification as explained in the guidelines. For instance, the decisions rendered by the National Arbitration Forum concern mostly trademarks registered in the United States whereas the jurisdiction is not explicitly mentioned in the decision.

### How clear is the Notice of Registered Names to the trademark holder? Is there any other piece of information that should be included in the Notice of Registered Name?

Several trademark holders have contacted the Clearinghouse after receiving a Notice of Registered Names asking for guidance. As the Clearinghouse is not allowed to give legal advice, the Clearinghouse had to limit itself to indicate the existence of other RPM mechanisms, such as the URS. The Clearinghouse believes that it might be an added value to foresee an indicative list of the options available to the trademark holders in the Notice of Registered Names or to insert a link to an ICANN website providing such information.

### Is the Notice of Registered Names received in a timely manner?

### Did the Notice of Registered Names help trademark holders decide on next steps?