



Re: Comments on “New gTLD Program: Trademark Clearinghouse Explanatory Memorandum: Implementing the Proof of Use Verification.”

As a threshold matter, we note that the ICANN requirement for trademark owners to provide evidence of use in order to participate in Sunrise registration processes exceeds the registration examination practices of the vast majority of jurisdictions worldwide; as such, inclusion (or not) in the Clearinghouse has no bearing on trademark office determinations, or trademark owners’ underlying rights.

Please find below our suggestions for improvements to ICANN’s implementation of the Clearinghouse:

- The definition of “word marks” should be clarified to include the textual elements of marks consisting of stylized text or design/logo plus text. (This would recognize registration principles of national trademark offices, and was employed for the ICM Sunrise.)
- What ICANN intends to capture/address by “other marks that constitute intellectual property” should be clarified. (This was added in the April 2011 discussion draft AGB, without explanation.)
- It should be made clear that the proposed “list of accepted samples” is non-exclusive/merely illustrative. (We believe this is implicit in the proposal, and would only require confirmation of the already present underlying intention.)
- We believe that, as with the declaration of use, a renewal declaration should only be required every 5 years. (A majority of trademark offices operate on a 10-year renewal basis.)
- ICANN should only permit the Clearinghouse to seek any renewal fees once the first new gTLD registry goes live, i.e., the fee should be waived prior to delegation and “go live”. (This will benefit the Clearinghouse provider by avoiding a flood of last-minute trademark data deposits.)
- We would support ICANN’s encouragement for the Clearinghouse to provide a bulk upload function. (This is more efficient for both the Clearinghouse provider and trademark owners.)
- ICANN should commence discussions on a lightweight procedure for appealing any refusal to record a mark in the Clearinghouse, and also for any rejection of declarations/evidence of use.
 - ICANN should consider whether a refusal to register a mark into the Clearinghouse, a rejection of a declaration/evidence of use, and any appeals should be made public.

- We believe that if an opposition/challenge proceeding in a national or regional office would result (by the respective national/regional office) in revocation/invalidation of a previously Clearinghouse-validated mark, that mark should be removed from the Clearinghouse, and no longer be able to form the basis for Sunrise registrations or IP Claims. (This would merely extend the underlying principle of the existing, narrowly-tailored Sunrise Dispute Resolution Policy (SDRP) presently contemplated in AGB § 6.2.4.)

We would also support the opening of a public comment period on ICANN's 13 April 2012 Draft Implementation Model (which, along with the AGB, is the principle document underlying the present Explanatory Memorandum).

We also understand there is ongoing discussion on a proposed alternative Clearinghouse/Sunrise/IP Claims model. We look forward to ICANN's clarification on the relationship of this proposal to the current Draft Implementation Model and the present Explanatory Memorandum.

Thank you for your consideration of the above suggestions; please do not hesitate to contact us if we can be of further assistance.

Yours sincerely,

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