

Public Comments – TMCH Implementation Documentation

Explanatory Memorandum: Implementing the Matching Rules

Section 2, ICANN recognises that trademarks may include elements that are not capable of being represented in the DNS, including colours, punctuation, and design elements such as graphical images. The implementation document on matching rules refers to section 6.1.5 of the Applicant Guidebook stating that according to “Identical Match” rules, the domain name shall consist of the “complete and identical textual elements of the mark”. However, the document is not clear on whether the TMCH is going to accept figurative (text with graphical representations) or semi-figurative marks (stylised letters). Are they considered to be “word marks” and, therefore, eligible marks for inclusion in the TMCH? If yes, which method is the TMCH validator going to use in order to perform the conversion? If figurative or semi-figurative marks are included, the validator will need to have a well-defined and comprehensive set of rules in order to validate the textual component of the mark so as not to create inconsistent results. This implementation document on matching rules does not detail all such rules, therefore further clarification is required. Further, an additional document recently published by ICANN (TMCH Requirements Document) refers to “Text marks” on page 5 and the definition of a “Text mark” in relation to word marks, semi-figurative and figurative marks containing text is not clear.

Section 3.1, Rule b) only certain example special characters contained within a trademark are spelled out with appropriate words describing them (@ and &). The document addresses the need for deciding which languages should be supported, if one or more translations are possible and through which method.

Section 3.2., four possible methods are considered:

- Option 2 considers applying a standard set of languages (6 UN languages, ie. Arabic, Chinese, English, French, Russian and Spanish. However this option would potentially lead to excluded countries / languages being dissatisfied about the lack of coverage in their own jurisdictions / languages. It would therefore potentially undermine ICANN’s efforts to remain globally neutral. Furthermore, the language table used shows the English translation of the symbol @ to “AT”. However, the translations of the rest of UN languages are not the direct translation of the symbol @ in their own countries, but rather use direct translations of the English “AT”. Therefore, the rest of translations have potentially lost the meaning of the symbol @ in their territories.
- Option 3 suggests providing a canonical translation(s) of the symbol in the jurisdiction where the trademark is registered. However, which authoritative

reference is ICANN going to use? In some countries e.g. Italy, there is no official translation and the common use of the symbol @ translates to “snail”.

- Option 4 enables the right holder to choose the most appropriate language(s) for translation of @ and & on a per-record basis. This is not cost-effective and will cause too many identical matches.

ICANN recommends a combination of 3 and 4, however the problems discussed above (if using the list of canonical translations) still remains unsolved. The document indicates (page 7) that “a canonical translation list of jurisdictions and available translations will be developed and posted at the TMCH website”. However, if we take the example of a Community Trademark, the trademark owner would be entitled to 33 official languages. According to the rules, the trademark owner would be able to choose among all of the 33 translations, potentially creating too many identical matches.

Explanatory Memorandum: Implementing the Proof of Use Verification

In the **background** section, ICANN specifies that where a trademark is nationally or regionally registered, verification of proof of use by the TMCH is required for sunrise domain registration eligibility. In contrast, proof of use is not required for court-validated and statute/treaty protected marks. Nevertheless, there is no apparent reason why a court-validated mark should be exempt from the proof of use requirement. A mark could have been validated by a court decades previously, and no proof of use will be required. Consequently it may be possible that this mark could now be abandoned or out of the market and yet, still be eligible for inclusion without the obligation to demonstrate proof of use. Has ICANN thoroughly considered such cases?

Section 2.4, renewal of proof of use: all TMCH records require an annual renewal, but the re-verification of proof of use and submission of a new sample will be required once every 5 years. What is the rationale for the disparity in renewal periods?