



Office of the Associate General Counsel,
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December 10, 2010

Internet Corporation for Assigned Name and Numbers
International Square
1875 I Street, NW, Suite 501
Washington D.C., 20006

Via Electronic Mail to 5gtld-guide@icann.org

Re: International Business Machines Corporation's response to the Proposed Final New gTLD Applicant Guidebook for the new gTLD (generic top-level domain name) program dated November 12, 2010.

International Business Machines Corporation (IBM) appreciates the opportunity afforded by the Internet Corporation for the Assigned Names and Numbers (ICANN) to comment on the Proposed Final New gTLD Applicant Guidebook for the new gTLD (generic top-level domain name) program dated November 12, 2010.

IBM has limited our response with respect to:

Introduction to the gTLD Application Process to Feature 1.2.1; and
Trademark Clearinghouse to Feature 7.3

Introduction to the gTLD Application Process

Feature 1.2.1: Eligibility

IBM Comments on Feature 1.2.1: IBM notes with appreciation ICANN's decision to not create new rules prohibiting registrars from applying for or operating new gTLD registries. IBM further supports the additional enforcement mechanisms that have been added in lieu of the previously proposed restrictions on cross ownership.

Trademark Clearinghouse

Feature 7.3: Definition

IBM Comments on Feature 1.2: IBM thanks ICANN for responding to earlier requests to clarify the term “substantive examination”. This is an important issue for trademark owners since it is a threshold criterion for availing themselves of the Sunrise Services, the Trademark Clearinghouse and the Uniform Rapid Suspension (“URS”) proceedings. Only trademarks with a valid registration issued by a jurisdiction that conducts a “substantive examination” may use these services.

The definition of substantive examination introduced by ICANN in the Proposed Final DAG is a substantive evaluation upon registration with essentially three elements:

- (i) evaluation on absolute grounds - to ensure that the applied for mark can in fact serve as a trademark;
- (ii) evaluation on relative grounds - to determine if previously filed marks preclude the registration; and
- (iii) evaluation of use - to ensure that the applied for mark is in current use.

As others have already commented over the past few days, IBM feels this definition may be overly restrictive.

IBM conducted an informal survey, and we have documented our research in the chart that follows. It seems that only trademarks registered in the United States, Canada and the Philippines are subject to a substantive examination as defined in the Proposed Final DAG, and that trademarks registered outside these three countries without an eligible counterpart registration (i.e., registered before 26 June 2008) in one of those three countries, would be excluded from participation in the Sunrise Services and the other protections proposed for registered trademarks such as the Trademark Clearinghouse and URS proceedings. For example, most Asian Pacific countries conduct (i) an absolute and (ii) a relative examination, but rarely require (iii) evaluation of use, the Philippines being the only exception. Most European countries conduct (i) an absolute examination, but do not require (ii) relative evaluation or (iii) an evaluation of use. It is also our understanding that European trademark offices have been trending away from conducting both (i) an absolute and (ii) a relative examination. The United Kingdom, for example, eliminated relative examination in 2007.

IBM believes that ICANN did not intend to exclude so many trademarks registered in various jurisdictions outside the United States, Canada, and the Philippines, and respectfully requests that ICANN reconsider this definition of substantive examination such that brand owners which have focused on trademark protection outside of the United States, Canada and the Philippines can avail themselves of these important trademark protection mechanisms.

	Absolute grounds	Relative grounds	Use
China	Yes	Yes	No**
South Korea	Yes	Yes	No**
Hong Kong	Yes	Yes	No**
Australia	Yes	Yes	No
Indonesia	Yes	Yes	No
Japan	Yes	Yes	No
Malaysia	Yes	Yes	No
Singapore	Yes	Yes	No
Thailand	Yes	Yes	No
Vietnam	Yes	Yes	No
CTM	Yes	No*	No**
France	Yes	No*	No**
Germany	Yes	No	No**
Italy	Yes	No	No**
UK	Yes	No*†	No**
Spain	Yes	No*	No**
Israel	Yes	Yes	No
Russia	Yes	Yes	No††
South Africa	Yes	Yes	No
Philippines	Yes	Yes	Yes
USA	Yes	Yes	Yes
Canada	Yes	Yes	Yes

Notes:

*While these systems do not bring ex officio objections on relative grounds, they do search for similar marks and notify the owners of such marks of the new application with a view to ensuring they have the opportunity to file an opposition. Since in European TM law (which is largely harmonized throughout the community) objections on relative grounds can always be waived with the agreement of the owner of the earlier right, the two approaches are considered to be substantively equivalent.

†As of 1 October 2007 the UK trademark registry no longer examines on relative grounds, having adopted a CTM style "notification and opposition" system.

**Marks become subject to revocation if not used for 5 consecutive years, after registration.

††Marks become subject to revocation if not used for 3 consecutive years, after registration.

Respectfully submitted,



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