



March 30, 2010

Dear Sir / Madam,

Re: February 2010 revision of ICANN Trademark Clearinghouse "TMCH"

Further to previous comments of the Arbitration and Mediation Center of the World Intellectual Property Organization (WIPO Center) on various proposals for a TMCH, including most recently on the [STI Report](#), we submit the following. Fundamentally, the presently envisaged scope of use for information held in the TMCH database seems constrained; expanding such scope could see a more adequate degree of protection for existing trademark rights while also minimizing burdens on registration interests.

**Post-launch Trademark Claims should be mandated.**

Limiting the TMCH to use in connection with a Sunrise or Trademark Claims notice *at launch* provides narrow coverage which does not respond to Domain Name System realities. Also, as any scope for post-launch mechanisms is presently at registry discretion, ICANN should consider mandating post-launch Trademark Claims.

**Protection should extend beyond identical matches.**

In terms of implementation, we note the present limitation of providing "identical match" trademark data to registries (*c.f.*, the .ASIA sunrise providing for "mark plus" extended protection). As informed by UDRP cases, identical matches are simply a subset of abusive registrations. As such, limiting the scope of mechanisms to identical matches raises questions of the respective utility of the TMCH for registration interests and trademark owners (noting also differing perceptions of the cost-benefit of defensive registrations). In that light, ICANN should consider mandating the scope of TMCH data used by registries to go beyond identical textual elements.

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Internet Corporation for Assigned Names and Numbers  
4676 Admiralty Way, Suite 330  
Marina del Rey, CA 90292-6601  
United States of America

By email:  
*tm-clear-15feb10@icann.org*

**The scope of mark validation seems to ignore international and national trademark laws and policies.**

The latest TMCH validation concept does not truly address concerns, including of the GAC in its Nairobi Communiqué, regarding treatment of substantive trademark examinations. As best we can see, the statement that “validation could be satisfied either at time of trademark registration, as in some countries, or by subsequent validation by the [TMCH]” seems mostly to repackage the issue.

Any “subsequent validation” (examination) by the TMCH seems to extend beyond merely validating the existence of a (national) trademark registration. Noting that ICANN seems to contemplate some form of challenge/removal process, consideration should at least be given to whether it may rather be appropriate to treat nationally-registered marks as *prima facie* valid.

**Costs should be apportioned among all stakeholders.**

Registration interests, like trademark owners, potentially stand to benefit from a properly designed TMCH including associated rights protection mechanisms. All stakeholders could benefit from a degree of predictability in informed real-time registrations and minimized trademark burdens. To further assist stakeholders in this regard, the TMCH should be run on a non-profit, cost-recovery basis.

**Separating TMCH provider functions.**

We understand that, while not as such resolved, comments on separation of TMCH functions seem to be meeting with support. We welcome further explanation on the scope of such provider separation.

We are posting a copy of this letter on the WIPO website for public information at <http://www.wipo.int/amc/en/domains/resources/icann/>.

Yours sincerely,



Erik Wilbers  
Director

WIPO Arbitration and Mediation Center