

Implementation Notes: Trademark Claims Protection for Previously Abused Names

16 July 2013

ICANN has worked with the Trademark Clearinghouse service providers to implement Trademark Claims protection for domain name labels previously found to have been abusively used or registered, as described in the 20 March 2013 [Memorandum on the Trademark Clearinghouse “Strawman Solution.”](#)

The implementation of the proposal will offer the capability for rights holders to add a certain number of domain labels, based on UDRP or court decisions, to a verified trademark record. Up to 50 domain name labels included in such decisions can be mapped to an existing Clearinghouse record for which the trademark has been successfully verified.

1. Submission of Additional Labels

Users will be able to add the appropriate domain labels and the relevant decision information to a verified trademark record via the existing Trademark Clearinghouse user interface. The decision must have been rendered by either an [approved UDRP service provider](#) or a court of law at the national level.

For UDRP decisions, the user will need to provide the following information:

- a. the name of the UDRP provider that rendered the decision;
- b. the reference number for the UDRP case;
- c. the language in which the decision was rendered;
- d. the relevant domain labels (e.g., if a domain name in a case was <icann.org>, the domain label submitted would be <icann>).

A copy of the UDRP decision may also be requested in the event that the relevant information cannot be found online.

For court decisions, the user will need to submit:

- a. the country in which the decision was executed (ISO country code);
- b. the name of the court that rendered the decision;
- c. court decision reference number or other identifier;
- d. the language in which the decision was rendered;
- e. a copy of the court decision;

- f. the relevant domain labels.

2. Verification of Additional Labels

Upon submission of this information, the Trademark Clearinghouse will verify:

- a. the trademark information included in the decision; and
- b. the domain names included in the decision.

To be successfully verified, the trademark cited in a decision must match the trademark in the existing Clearinghouse record (number and jurisdiction), and the domain labels submitted for addition to the record must be included in the decision.

If either: (a) the mark information provided by the user does not correspond to the mark information in the Clearinghouse record; or (b) the labels provided by the user are not included in the decision, the additional labels will not be added to the record.

3. Parameters for Additional Domain Labels

Anywhere between 1 and 50 additional domain name labels may be associated to one Trademark Record. The additional domain labels may be derived from anywhere between 1 and 50 individual decisions. (For example, a user might submit 50 different decisions each including one label, or one decision covering 50 labels, or some combination thereof.) Once 50 additional labels have been associated to the record, no more labels may be added.

The same domain name label may only be used once within one Trademark Record. (There is no benefit to adding the same label more than once; inclusion in the Trademark Claims service already includes the label in notifications.)

Addition of one label to a record by a user does not prevent the same label from being added to different records by a different user. For example, if one user has a decision rendered concerning its “example” mark for the domain name <example.org> and another user has a decision rendered concerning its “example” mark for the domain name <example.info>, both users could add the additional label <example> to their verified Clearinghouse records.

4. Protections for the Additional Labels

Labels that are successfully verified and associated with a Clearinghouse record will be included in the Trademark Claims service, with the relevant decision information included as data elements in the Claims notice provided to registrants.

An example of a Claims notice displaying this information is found as an appendix to this document.

These labels will not be eligible for sunrise service (i.e., the holder does not receive an SMD demonstrating eligibility to register these labels as domain names).

5. Expiration

The labels derived from verified decisions do not expire. Once the Clearinghouse provider has verified that these labels were referred to in a decision, there is no re-verification that has to take place for these labels. However, when the existing record expires, the labels will cease to receive protection.

Appendix: Sample Claims Notice

TRADEMARK NOTICE

You have received this Trademark Notice because you have applied for a domain name that matches at least one trademark record submitted to the Trademark Clearinghouse.

You may or may not be entitled to register the domain name depending on your intended use and whether it is the same or significantly overlaps with the trademarks listed below. Your rights to register this domain name may or may not be protected as noncommercial use or "fair use" by the laws of your country.

Please read the trademark information below carefully, including the trademarks, jurisdictions, and goods and services for which the trademarks are registered. Please be aware that not all jurisdictions review trademark applications closely, so some of the trademark information below may exist in a national or regional registry that does not conduct a thorough or substantive review of trademark rights prior to registration. If you have questions, you may want to consult an attorney or legal expert on trademarks and intellectual property for guidance.

If you continue with this registration, you represent that you have received and you understand this notice and to the best of your knowledge, your registration and use of the requested domain name will not infringe on the trademark rights listed below.

This domain name label has previously been found to be used or registered abusively against the following trademarks according to the referenced decisions:

Case No: D2003-0499
UDRP Provider: WIPO

1. Mark: One Inc.
Jurisdiction: AR
Goods and Services: Bardus populorum circumdabit se cum captiosus populum.
Smert populorum circumdabit se cum captiosus populum qui eis differimus.
Trademark Registrant:
Organization: One SA de CV
Address: La calle
City: La ciudad
State: CD
Postal Code: 34323
Country: AR

Case reference number: 234235

Court name: Supreme Court of Justice of Costa Rica

Court jurisdiction: CR

2. Mark: One

Jurisdiction: ARGENTINA

Goods and Services: Bardus populorum circumdabit se cum captiosus populum.

Smert populorum circumdabit se cum captiosus populum qui eis differimus.

Trademark Registrant:

Organization: One Corporation

Address: La calle

City: La ciudad

State: CD

Postal code: 34323

Country: AR

For more information concerning the records included in this notice, see <link to informational page>.