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To the attention of: Fadi Chehadé, CEO
Sent by post and email: newgtld@icann.org
Subject: Labels without accent for trademarks with accents (é,è,ë,ê,à...)

Paris, March 20th 2014

Dear Fadi Chehadé,

Domainoo, as a French domain name provider for big companies, is facing a big issue concerning TMCH labels authorized for trademarks with accents (umlaut, acute accent ...).

Concerned by the intellectual rights protection for our clients, we have advised them and sent many TMCH orders to protect their trademarks.

In fact, the proof of use imposed by TMCH which must be strictly identical to the trademark have really complicated inscriptions. Because of the proof of use, and even if a trademark holder owned two identical trademarks with and without accents, in many cases, only the one with accent was admissible and then recorded at the TMCH (ex: Château ABC).

By trying to order DPML option or send Sunrise registration orders, we have been told that French trademarks with accents were not allowed to ask for the equivalent domain name or label without accent. Donuts and other Registries therefore strictly accept TMCH labels during Sunrise phases or for their options as DPML; which prevent our clients to benefit from these services while the purpose of TMCH and DPML is to protect their intellectual property rights.

This is a big issue for French companies. Until TMCH was created, all previous Sunrise Periods have accepted these trademarks to lock or register domain names without accents (trademark Moët used to protect moët.xxx for example).

I think that ICANN and new Registries are very proud to promote IDNs; what is very useful for Russia, China, and Arabic countries which have totally different characters. But for other countries, like France, which use Latin characters, web users are not ready to use IDNs... nobody knows that they exist in France, apart people working on the Internet. IDNs in France are only used for defensive purpose, complementary to the registration of the same domain name without accent.

Big French companies, as LVMH and MHCS associated to this letter, are now facing a very uncomfortable position; being unable to protect their trademarks correctly: they cannot make



defensive registration during Sunrise Periods or benefit from DPML. Their purpose in making the effort to pay TMCH was though to protect their trademarks!

France is not an exception with its specific characters! Many other trademark holders in Europe will have or are already facing this problem.

We are aware that ICANN changed its rules in November concerning the “.” in a trademark, so maybe it will be possible to change the rules for trademarks with specific national characters so that they can benefit from labels for the same word without specific characters.

Thank you in advance for your attention and your efforts so that our customers can receive a real protection of their accentuated trademarks: **our goal is to add in the list of TMCH's labels the equivalent, without accent, of a term with accent** (é, è, ë and ê are always “translated” by “e” on the web).

Best regards
Emilie DESSENS, president

Some interesting WIPO decisions illustrating our purpose

1/ Umlaut

D2000-1540

As to the absence of the *umlaut* over the letter "o" in the domain name, in the view of this Administrative Panel there is likely to be confusion in the minds of English speaking people because there is no umlaut on letters in the alphabet as used in the English language. Furthermore, many users of the Internet use English language keyboards which treat "ö" as a symbol rather than a letter and they are likely to ignore the umlaut.

2010-1210

En premier lieu, les noms de domaine litigieux sont identiques, ou semblables, au point de prêter à confusion, aux marques du Requéant. Visant plusieurs décisions antérieures des Commissions administratives, le Requéant fait valoir que l'incorporation dans un nom de domaine d'une marque dans son intégralité peut être suffisante pour établir l'identité ou la similarité requise par les Principes directeurs et que le risque de confusion n'est pas écarté par l'ajout du terme générique "hôtels" ni davantage par celui d'accents circonflexes dont la présence "augmente la ressemblance intellectuelle sans modifier les ressemblances visuelles et phonétiques" avec les marques en cause (rappelant en outre que l'extension n'a pas à être prise en cause).



2/ Acute accent

2011-1627

^[1] None of the disputed domain names contains the apostrophe, acute accent or circumflex comprised in the Trade Marks. It is however trite that, for the purposes of the first limb under the Policy, the addition or omission of punctuation marks does not have any bearing as regards the question of confusing similarity.

DAU2004-0006

‘The trademark is included in its entirety into the domain name under dispute with the exception of the acute accent on the second ‘e’. This omission is due to a technical reason because, as every body knows it is not possible to register a domain name with accents. An exhaustive history of previous cases states that the registration as a domain name of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant’s registered trademark.’

2003-0594

The panel finds that the Complainant’s well-known trademark is identical with the trade name Kelemata S. p. A. Furthermore, the disputed domain name is confusingly similar to the Complainant’s trademark and is, by virtue only of the omission of an acute accent not identical. The Panel notes that so far, it is for technical reasons a necessity to omit the acute accent in a domain name. The domain name must therefore be considered identical with the trademark KELEMATA. The panel holds that the Complainant has established element (i) of the Policy’s Paragraph 4(a).