

28 August 2013

Ms. Christine Willett  
Vice President, New gTLD Program  
ICANN  
12025 Waterfront Drive, Suite 300  
Los Angeles, CA 90094

**Re: Trademarks starting with a “.” (dot)**

Dear Christine,

we are a group of individual gTLD applicants that are owners of a valid and registered trademark that start with a “.” (dot) such as .ART or .BERLIN.

Such trademarks are excluded of being accepted by the Trademark Clearinghouse according to the TMCH guidelines:

*2.2.5. Exceptions*

*As provided in the gTLD Applicant Guidebook, the following registered trademarks will not be accepted by the Clearinghouse.*

- A registered trademark that includes a top level extension, for example, trademarks such as “icann.org” or “.icann”*
- Any registered trademark starting with or containing a “dot” (.) (e.g., the trademark “deloitte.” as below will not be accepted)*

*2.3.4. Exceptions*

*The following, even if court-validated, will not be accepted by the Clearinghouse:*

- Any court validated trademark mark starting with a “dot” (.) or containing a “dot” (.);*

A rationale for these exceptions was not published and can not be derived from the Applicant Guidebook (Version 04 June 2012) on page 292/293 and 296::

*3.2 The standards for inclusion in the Clearinghouse are:*

*3.2.1 Nationally or regionally registered word marks from all jurisdictions.*

*3.2.2 Any word mark that has been validated through a court of law or other judicial proceeding.*

*3.2.3 Any word mark protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion.*

*3.2.4 Other marks that constitute intellectual property.*

*3.2.5 Protections afforded to trademark registrations do not extend to applications for registrations, marks within any opposition period or registered marks that were the subject of successful invalidation, cancellation or rectification proceedings.*

*6.1.5 The Trademark Clearinghouse Database will be structured to report to registries when registrants are attempting to register a domain name that is considered an “Identical Match” with the mark in the Clearinghouse. “Identical Match” means that the domain name consists of the complete and identical textual elements of the mark. In this regard: (a) spaces contained within a mark that are either replaced by hyphens (and vice versa) or omitted; (b) only certain special characters contained within a trademark are spelled out with appropriate words describing it (@ and &); (c) punctuation or special characters contained within a mark that are unable to be used in a second-level domain name may either be (i) omitted or (ii) replaced by spaces, hyphens or underscores and still be considered identical matches; and (d) no plural and no “marks contained” would qualify for inclusion.*

We do not understand how this 3.2 and 6.1.5 provision was translated later on into what can be found in the TMCH-Guidelines in 2.2.5. and 2.3.4..

We are concerned about the exceptions as they discriminate, without any reason or right, between those with and without a “.” (dot). We think this treatment is unfair and lacks any rationale. Furthermore it creates exactly such kind of new legal right for those trademarks without a “.” (dot) that the TMCH was never intended to create.

We also want to make you aware of new developments and facts in this regard:

1. The United States Patent and Trademark Office (USPTO.gov) has proposed that certain new dot-brand gTLDs could be eligible for registration as trademarks  
[http://www.uspto.gov/trademarks/notices/gTLDExamGuideDraft\\_8\\_7\\_13\\_public.doc](http://www.uspto.gov/trademarks/notices/gTLDExamGuideDraft_8_7_13_public.doc)
2. Recent WIPO decisions in Legal Rights Objections (LROs) determined that “.” (dot) trademarks , even for strings that had been considered generic, are valid. For instance, in the decision on .GMBH (Case No. LR02013-0052) the panel determined: “The Panel determines that Objector acquired and has used its mark in good faith.”
3. In the recent decision Image Online Design, Inc. vs. ICANN it was stated that “The USPTO's prior stance on the function of TLDs as generally not being source indicating is a relic of an essentially exclusive “.com” era, which is rapidly coming to an end.”  
Source 1: <http://www.icann.org/en/news/litigation/iod-v-icann/complaint-17oct12-en.pdf>  
Source 2: <http://www.icann.org/en/news/litigation/iod-v-icann/order-granting-motion-dismiss-07feb13-en.pdf>
4. The Office for Harmonization in the Internal Market (Trade Marks and Designs) counts 396 trademarks starting with a “.” (dot) and 9,406 trademarks ending with a “.” (dot) from all together 31,042 trademarks containing a “.” (dot) at any position in the trademark (starts with, ends with or just contains).

Based on the facts above we

- request a rationale why trademarks with a “.” (dot) are excluded from the TMCH,
- state that excluding trademarks with a “.” (dot) from the TMCH is discriminatory and unfair,
- state that excluding trademarks with a “.” (dot) from the TMCH creates new rights,

- state that excluding trademarks with a “.” (dot) from the TMCH is not in line with the Applicant Guidebook, and

therefore request to remove the provisions in the TMCH-Guidelines in 2.2.5. and 2.3.4. in order to allow trademarks with a “.” (dot) to be accepted as any other regular trademark.

Kind regards,

Dirk Krischenowski

Supported by

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cc: NGPC, IPC, Akram Attala