



The Internet Corporation for Assigned Names and Numbers

19 November 2013

Mr. Dirk Krischenowski
Founder & CEO
dotBERLIN GmbH & Co.
KG Akazienstrasse 2 10823
Berlin
Germany

Dear Mr. Dirk Krischenowski:

On behalf of the New gTLD Program, thank you for your letter of 28 August 2013 regarding trademarks starting with a “.” (dot).

The language in the Clearinghouse guidelines noted in your letter is based on principles in the Applicant Guidebook. Section 3.7 of the Trademark Clearinghouse in the Guidebook provides:

Registrations that include top level extensions such as “icann.org” or “.icann” as the word mark will not be permitted in the Clearinghouse regardless of whether that mark has been registered or it has been otherwise validated or protected (e.g., if a mark existed for icann.org or .icann, neither will be permitted in the Clearinghouse).

As part of the Applicant Guidebook, this provision was subject to multiple rounds of public comment, and the rationale for the approach was described in the posted analysis of public comments received. See for example (<http://archive.icann.org/en/topics/new-gtlds/summary-analysis-agv6-30may11-en.pdf>):

The Clearinghouse is designed to be a repository for trademarks. To fulfill the objectives of the IRT and the STI, it has been decided that those marks that actually function as trademarks, i.e., indicate source, are those that will be eligible for inclusion. Many safeguards have been established to prevent abuse and to ensure neutral application of validation standards, including objectively verifiable data that the mark does serve a legitimate trademark purpose. It has been successfully argued that TLDs standing alone do not serve the trademark function of source identification. Instead of telling consumers “what” a product is or who makes it, they tell consumers where to get it. Because the TLD, standing alone, does not indicate source, and because allowing marks in the Clearinghouse that include a TLD will increase the

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likelihood of confusion, abuse and gaming, on balance they are excluded. This exclusion will also obviate the need for registration of defensive trademarks in this area.

We understand that various jurisdictions treat these types of marks in different ways: some might grant trademark protection where others would not. Rather than subject marks from different jurisdictions to different treatment in the Trademark Clearinghouse, a uniform approach was adopted that is applicable to all trademarks. Accordingly, there is no intent to discriminate among jurisdictions.

Your letter also references the principle that inclusion in the Clearinghouse does not create new rights, which is consistent with the current approach. The presence of a trademark in the Clearinghouse provides an opportunity to request domain names if eligible during a Sunrise period, and notifications when matching names are registered; it does not create a “right” to a domain name.

The standards to be used for defining which trademarks are eligible for entry into the Clearinghouse have been the subject of much commentary and discussion, leading to the current set of guidelines. As the Clearinghouse processes continue to evolve, the rules may also continue to evolve as appropriate through the multi-stakeholder processes.

We hope this provides clarification and background on this matter, and look forward to your continued participation in the New gTLD Program.

Sincerely,

A handwritten signature in black ink, appearing to read "Christine Willett", written in a cursive style.

Christine A. Willett
Vice President, gTLD Operations