



The Internet Corporation for Assigned Names and Numbers

19 November 2014

Emilie Dessens
Domainoo
49 rue de Richelieu
75001 Paris
France

Subject: Labels without accent for trademarks with accents

Dear Emilie Dessens:

Thank you for your letter of 28 October 2014, and your previous letter of 20 March 2014. We appreciate Domainoo's input on this topic, and we have posted your letters to the New gTLD correspondence page (see <http://www.icann.org/en/news/correspondence/dessens-to-chehade-20mar14-en.pdf>; <https://www.icann.org/resources/correspondence/dessens-to-chehade-2014-10-28-en>).

The Trademark Clearinghouse (TMCH) records and verifies trademark information as it is issued by the relevant jurisdictions. The Clearinghouse procedures were developed based on extensive stakeholder consideration and discussion in the development of the New gTLD Program. A key principle in these discussions was that the Clearinghouse should be a repository to support existing trademark rights, but should not expand or create new rights.

In the case noted in your letter regarding identical trademarks with and without accents in the TMCH, we would like to clarify that in cases where a mark holder has trademarks both with and without an accent, the mark holder may enter these marks as separate records in the TMCH and would correspondingly be eligible for the relevant services on both records.

We note that there are in some cases difficulties in establishing proof of use for both marks. In line with the principle of protecting existing rights, the standards for verification of proof of use are in place to ensure that the protection supported by the TMCH record is based on a matching trademark record issued by the jurisdiction.

With regard to how accents are treated in domain name registrations, we wish to clarify that character variant policies are currently established and applied at the registry level. If a registry has established an IDN variant policy for its TLD, the registry has the ability to apply this policy during the Sunrise period (see Section 2.4.2 of the Rights Protection Mechanism Requirements



(<http://newgtlds.icann.org/en/about/trademark-clearinghouse/rpm-requirements-30sep13-en.pdf>):

If Registry Operator has implemented IDN variant registration policies for the TLD, Registry Operator MAY allocate or register IDN variant labels generated from a label included in a valid SMD file during the Sunrise Period, provided that (i) such IDN variant registration policies are based on the Registry Operator's published IDN tables for the TLD and (ii) such policies are imposed consistently in the Sunrise Period, any Limited Registration Period, any Launch Program and during General Registration.

For example, a registry with policy that considered "e" as a variant character to "é" could allocate the labels contained in the SMD file issued by the TMCH, as well as additional domain labels considered matches by applying the IDN variant policy.

For information on specific TLDs' registration and launch policies, we encourage you to visit the TLD Startup Information page of the New gTLD microsite (<http://newgtlds.icann.org/en/program-status/sunrise-claims-periods>).

I would also like to encourage you to participate in several reviews of the New gTLD Program that are upcoming, focusing on rights protection. The input based on the experience described in your letter will be helpful to assessing the effectiveness of the rights protection mechanisms built into the Program, and considering future modifications. Some background on these reviews is available in the draft Work Plan at <https://www.icann.org/news/announcement-3-2014-09-22-en>.

Thank you for your communication and your interest in the New gTLD Program. If you have any further questions, please do not hesitate to contact the Customer Service Center at newgtld@icann.org.

Sincerely,

A handwritten signature in black ink, appearing to read "Karen Lentz", written over a light blue horizontal line.

Karen Lentz
Director, Operations & Policy Research