

IP Briefing

Trademark Sunrise options

Background

The ICANN application guidebook Registry Agreement covers in Specification 7 various mandatory rights protection mechanisms. In its reference to the Trademark Clearinghouse, a mandatory Sunrise period for trademark holders is mentioned. Sunrise gives qualifying trademark owners a window of priority registration of second-level names. The period of Sunrise must be for at least 30 days (but may be longer). However the exact policy is left up to the new registry. This Briefing covers the following policy issues:

- Strategies to favour good faith trademarks
- Options for legitimate competing Sunrise claims
- Relevance of the Trademark Clearing House.

Strategies to favour good faith trademarks

The basic rules of the Sunrise period are up to each Registry and can be adjusted to favour legitimate trademarks and reduce the number of legitimate competing claims, as well as addressing the issue of bad faith Sunrise applicants. Such rules include the following.

Rule	Example	Note
1. Priority phase 1 only for trademarks of certain age and in use, then a later phase 2 for other trademarks	.asia	Favours trademarks already in use and acts against bad faith applications.
2. Priority phase 1 only for trademarks relevant to the community or industry, then a later phase 2 for other trademarks	.mobi	Helps maintain a more relevant set of registrants. Could be extended to geography.
3. Sunrise dispute resolution procedure (MANDATORY)	.info	An objection-based dispute resolution process – often using a third-party provider such as the WIPO Arbitration and Mediation Center .

Options for legitimate competing Sunrise claims

Even with one of the above basic strategies, there may still be competing legitimate trademarks. A policy is needed to decide who gets the name.

Option	Example	Note
1. first-come first-served	.eu	This is clear and simple but it does front-load all the applications and favours companies operating in the local language of the registry.
2. auction	.co	Deepest pocket wins. This may be the owner who wants to USE the name rather than OWN it defensively.
3. sealed-bid auction		Allows rights owners to place a fixed value on the name. May avoid inflated prices and appearance of exploitation.
4. Community priority (industry, geographic etc.)		The targeted industry or community get priority. Geographic priority would be relevant for a .city TLD.
5. Live registrant priority	.xxx	Applicants wanting a live website get priority over those registering defensively
6. oldest trademark wins		May weed out a speculative recent trademark registration but could have unforeseen effects giving priority to an older bad faith mark or the lapsed national seniority of an EU Community Trade Mark. Could result in a dying brand being given priority over a younger more vibrant one.
7. Mutual destruction.		If two legitimate parties apply for the domain name, neither gets it. It goes into a never-to-be-sold category unless one gives consent to the other.

Relevance of the Trademark Clearing House

The Trademark Clearing House (TMCH) is a database of registered trademarks optionally populated for a fee by the trademark owner. It is operated as a stand-alone service by a third party outside of ICANN. Qualifying trademarks need to show:

- a word mark registration any where in the world and its corresponding registration number (full details in the Application Guidebook)
- a declaration that the registration is true and correct
- evidence of use such as a PDF of an advertisement or screen-shot (if the owner wants to use their TMCH entry for Sunrise).

For Sunrise, at a minimum, the Registry:

- must accept as valid any Sunrise applicant that refers to their trademark that has been accepted into the TMCH, as long as the Sunrise application complies with the rules relevant to the registry (e.g. is in the targeted industry).
- must notify the trademark owner in the TMCH if there is an identical match during the Sunrise.

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