

Launch Application #2
(Parallel TMCH/Local Trademark Sunrise Launch Program)

Internet Corporation for Assigned Names and Numbers (“**ICANN**”)
12025 Waterfront Drive, Suite 300
Los Angeles, California 90094
Attention: New gTLD Program Staff

RE: Launch Application Request

The Comunidad de Madrid (the Government of the Region of Madrid), Registry Operator for the .madrid TLD, hereby submits for approval the below described launch program (“**ALP**”) pursuant to Section 4.5.2 of the Trademark Clearinghouse Rights Protection Mechanism Requirements (the “**TMCH Requirements**”).

1. Description of the Launch Program

1.1 Overview, mission and status

Through this ALP, the Comunidad de Madrid intends to conduct, in parallel with (i.e. with the same priority as) the end-date Sunrise for TMCH-validated trademarks, an end-date local Sunrise where valid local trademarks with effect in the Region of Madrid even if not registered at the Trademark Clearinghouse (“**TMCH**”) may be allocated with the same priority as those trademarks in the TMCH (i.e. parity with, not priority over TMCH registrations). The territory of the “**Region of Madrid**” (*Comunidad de Madrid*) comprises the 179 Municipalities, including the city of Madrid and its metropolitan area.

This ALP application is independent from (i) the Qualified Launch Program under Section 4.5.1 of the TMCH Requirements (Pioneer Program) that the Comunidad de Madrid intends to conduct (once approved by ICANN) and (ii) the Public Administrations Approved Launch Program application also submitted by the Comunidad de Madrid. To put this new request in due context, we enclose as Annex 1 an overview of the whole Start-Up program, which the Comunidad de Madrid intends to conduct.

1.2 Rationale and legal justification of this ALP

This ALP is substantially similar (in fact, almost identical) to the Parallel Trademark Approved Launch Program applied for by the City of Paris for the .paris TLD, which although it was not formally submitted by ICANN to Public Comment, it was commented on, among others, by the International Trademark Association (INTA) and the Association of European Trade Mark Owners (MARQUES) in their public comments to the .paris Public Administrations Approved Launch Program (<http://forum.icann.org/lists/comments-paris-alp-application-12jun14/>). In essence INTA and MARQUES claimed that the ALP applied for was (i) contrary to the TMCH Requirements; and (ii) unnecessary as the registry operator could restrict the Sunrise Period eligibility to TMCH-validated marks with local effect (i.e. in France, in that case, or in Spain, in the current case), and additionally, run a Limited Registration Period for the trademark holders that were not registered in the TMCH. In view of this, the following must be stressed:

This ALP is not contrary to the Guidebook nor to the TMCH Requirements:

This ALP meets all the requirements of the Guidebook, Specification 7 of the Registry Agreement and the TMCH Requirements, as it expands the rights-protection mechanisms set forth there while fully respecting the minimum requirements established there (and not restricting them in any way).

Paragraph 2.4.1 of the TMCH RPM Requirements state that a Registry Operator must not allocate or register domain names during or in connection with the Sunrise Period except to holders of a validated trademark recorded in the TMCH. In other words, TMCH trademarks have priority over the general public without priority rights. The goal intended by the process leading to the TMCH: **protecting legitimate right holders against competing registrations from non-right holders** (the “general public”). But Specification 7 of the TLD Agreement allows the registry operator to implement *additional* rights protection mechanisms. A holder of a valid Spanish trademark has a clear, objective and undeniable prior right regarding its use as a legitimate .madrid domain-name which cannot be characterized at any right as either “general public” nor “inferior right” with regard to TMCH-validated trademarks in this very concrete context (while it certainly makes sense to limit protection to non-TMCH validated trademarks in global, non-geographically oriented TLDs as validation of such rights in any jurisdiction is unfeasible in practice without a tool such as the TMCH, and this is why it was created).

This ALP fully preserves the legal rights verified by the Trademark Clearinghouse, as it allows holders of such rights (“**Sunrise-Eligible Rights Holders**”) an opportunity to register domain names in the .madrid TLD during the Sunrise period prior to the start of General Registration.

In this regard, this ALP merely expands this opportunity to holders of duly verified local trademarks, who may have not registered their trademarks at the TMCH for various reasons; e.g., not aware of the TMCH or its Services, a perception of the lack of need to register small local brands in the TMCH, as they are only or mostly concerned about the one single TLD of the local area, their lack of interest in Claims Notifications, etc.

By applying for this ALP the Comunidad de Madrid fully complies with Specification 7, which mandates full respect of the minimum, uniform, rights-protection mechanisms while implementing additional mechanisms for such protection of rights (trademarks, in this case). By adding (and not replacing) a trademark-validation mechanism it also fully complies with the Agreement requirements, as also expressly recognized by ICANN’s President and CEO, Fadi Chahadé, also quoting the General Counsel, during ICANN’ Beijing’s Public Forum:

“I want to tell you I confirmed with our general counsel. There is nothing in our agreement – and Amadeu mentioned that – there’s nothing in our agreement that precludes someone from also using other – other databases than the TMCH. So I want to be very clear on that. It’s up to the registry.” (Page 134 of the ICANN transcript.)

Further Assurances:

The above said, we must stress that this APL is not aimed at competing, and much less at unfairly competing, with the TMCH, but rather, as explained above, at not discriminating against valid trademarks in Spain. Accordingly, as described below, the Comunidad de Madrid undertakes:

- To perform its best endeavours to inform all applicants under this category of the existence and advantages of the TMCH, especially if the applicant is interested in registering its local trademark in more than one TLD, and the Claims Notification Services.
- That it will not provide Claims Services to registrants of domain names under this category (they should use the TMCH if interested) in such service).

- That all applications submitted under this category will undergo a thorough validation process (and will incur in a validation fee). As explained below, the validation will follow exactly the same standards and guidelines as those of the TMCH, including the request and assessment of proof of use.
- In case the Applicant chooses to apply for a TMCH registration, the application will be held for a reasonable time in order to allow the provision of the corresponding SMD. In case the Applicant chooses not to apply to the TMCH, the procedure described in this ALP will be followed.
- In addition, a “Re-validation Procedure” for contention sets will be implemented for contention sets, as explained in section 1.7 below.

This ALP is necessary:

Finally, we must stress that contrary to what INTA and MARQUES claim in their public comments to the .paris Public Administration Approved Launch Program, the Launch applied for is necessary. Restricting the Sunrise Period eligibility to TMCH-validated marks with effect in Spain, and additionally, run a Limited Registration Period for the trademark holders that are not registered in the TMCH would lead the Comunidad de Madrid to incur an unacceptable discrimination.

Specifically, the Comunidad de Madrid (the Government of the Region of Madrid), as a public organism, cannot discriminate against any valid trademark in Spain for the mere fact of not being in the TMCH due to any of the above reasons. Such discrimination may not only create a severe political problem to the Comunidad de Madrid but could put the Comunidad de Madrid in danger of breaching a well-established principle of non-discrimination by public administrations against equally valid intellectual property rights. Holders of trademarks with effect in Spain shall, in regards to the protection of industrial property, enjoy the same advantages, the same protection, and the same legal remedy against any infringement of their rights. Thus, registration in the TMCH cannot be imposed upon local trademarks owners as requirement for them to fully enjoy their trademark rights.

1.3 Eligibility and Name Selection

- a) “**Local Trademarks**”. Owners of registered trademarks with effect in Spain, granted on or before 2 May 2014, and in force at the time of registration of the domain name. In this ALP, “**Local Trademarks**” include the 3 following types of trademarks:

- (i) Spanish trademarks registered at the Spanish Patent and Trademark Office (*Oficina Española de Patentes y Marcas*, “OEPM” <http://sitadex.oepm.es/Localizador/buscarDenominacion.jsp>);
 - (ii) EU Community Trademarks registered at the Office for Harmonization of the Internal Market, “OHIM” <https://oami.europa.eu/ohimportal/en/trade-marks>, and
 - (iii) WIPO International trademarks designating and in force in Spain according to the Madrid system (<http://sitadex.oepm.es/Localizador/buscarDenominacion.jsp>).
- b) “GI”. Managing councils (*Consejos Reguladores*) of Spanish geographical Indications recognized by International treaties, EU regulations (Reg. (EC) No 510/2006, and subsequent and related Regulations), and Spanish legislation derived from them.

These requirements are in addition to the local nexus (i.e. local presence) and other general requirements applicable to all .madrid registrations, as set forth in the .madrid General Registration Policy. No other requirements (e.g. trademark class) will apply.

1.4 Validation procedure

Applications under this category will be individually and thoroughly validated by the Registry Operator via its specialized agents. The validation will follow the same standards and guidelines as those of the TMCH, including the request and assessment of proof of use. Self-declaration will not be enough.

a) Validation of Local Trademarks

(i) Verification of registration data and status in Public Online Databases:

Local Trademarks will be individually verified with the aid of OEPM’s database, available at <http://sitadex.oepm.es/Localizador/buscarDenominacion.jsp>. This search tool gives access to the Spanish Patent and Trademark Office official trademark database, which contains all three types of Local Trademarks eligible under this program (i.e. Spanish trademarks, EU Community Trademarks, and International trademarks designating Spain).

(ii) Proof of Use:

The applicant will be required to provide evidence of the use of its Local Trademark in connection with a bona fide offering for sale of goods or services. A submission for verification of Proof of Use must contain two elements, specifically:

- A signed Proof of Use Declaration, with identical content than that required by the TMCH available at www.trademark-clearinghouse.com/downloads; and
- A single sample of proof of use as described in http://trademark-clearinghouse.com/sites/default/files/files/downloads/how-to/TMCH_How_to_submit-proof_of-use%20_v1-0.pdf.

Verification of proof of use by the Registry Operator will be required to qualify for participation in this ALP. Such verification will follow the same Guidelines as those of the TMCH.

- b) Validation of GI: Geographical Indications will be individually verified with the aid of the *DOOR Database*, <http://ec.europa.eu/agriculture/quality/door/list.html>, the official database maintained by the European Commission and containing all EU PDOs, PGIs and TSGs, searchable by country (and hence, containing all the Spanish ones) for those created under EU Regulations, and the one maintained by the *Ministerio de Agricultura, Alimentación y Medio Ambiente* (Spanish Government <http://www.magrama.gob.es/es/alimentacion/temas/calidad-agroalimentaria/calidad-diferenciada/dop/default.aspx>) for those GI established under Spanish legislation.

1.5 Priority

Applications eligible under this parallel TMCH/Local Trademark Sunrise Period category will be allocated with less priority than eligible applications under the Public Administrations Approved Launch Program (pending ICANN's approval), but with priority over any other applications.

1.6 Contention Resolution within this category

Should there be more than one eligible application for the same domain in this parallel TMCH/Local Trademark Sunrise Period category, the applications based on a trademark with legal effects in Spain, as defined in 1.3 (a) above), whether registered at the TMCH or not, will have priority over applications based on Trademarks with legal effect in foreign jurisdiction only.

If there is more than one eligible application for the same name applied by either: (i) different owners of Local Trademarks, or (ii) exclusively by owners of non-Local Trademarks, the application based on the oldest registered trademark will prevail.

No other contention resolution criteria (like allocation based on a first-come first served basis, or taking into account the class of goods and services of the Trademark Record) will apply.

For the purposes of Contention Resolution, the geographical Indications referred to in 1.3 (b) above, will be treated as Local Trademarks.

1.7 Additional Validation in case of contention

In order to provide further assurances that the proposed ALP's only goal is not to disenfranchise a number of valid and eligible trademark holders who may be unaware or, or uninterested in, the TMCH services and in no case a tool to allow second-class validation for dubious trademarks, the Registry Operator offers an Additional Validation guarantee.

Whenever a TMCH registration and a Local Trademark validated by the Registry Operator are in contention (i.e. apply for the same domain name), the holder of the Local Trademark will be requested to register the trademark within the TMCH (following the standard TMCH validation procedure). The Registry Operator and/or its service providers may assist in this procedure (as the Registry Operator will already have gathered this information to carry out the internal validation process).

The specific process will be as follows:

- a) The Registry Operator will inform the parties involved (TMCH validated trademark holder and non-TMCH validated local trademark holder) about the situation of contention and, moreover, will inform the non-TMCH validated local trademark holder about the need to conduct a re-validation process by having its trademark validated by the TMCH.

- b) If the non-TMCH validated local trademark holder refuses to conduct such a re-validation process (i.e. refuses to submit its trademark to the TMCH through the standard TMCH validation procedure), then the contention will be immediately decided in favour of the TMCH validated trademark owner.
- c) Otherwise, the local trademark holder will submit the local trademark to the Trademark Clearinghouse through the standard TMCH validation procedure. The local trademark holder will pay and bear the costs of the TMCH validation fees.

It will be up to the applicant to submit the trademark to the TMCH directly (i.e. via TMCH web interface) or through a TMCH accredited agent (freely chosen by the applicant). If required by the applicant, the Registry Operator and its service providers will assist the applicant in this process, either with the online procedure or providing a list of accredited TMCH agents.

During the re-validation process (i.e. while the trademark is being verified by the TMCH), the contention set will remain on hold until a final decision is made by the TMCH.

If the trademark is validated by the TMCH, the dispute resolution criteria referred to in this Launch Application will apply. If the trademark is not validated by the TMCH, the contention will be decided in favour of the TMCH validated trademark holder.

The Comunidad de Madrid firmly believes that this re-validation is in fact unnecessary due to the high standards that will be applied to its own validation process, but offers nevertheless this solution to dissipate doubts third parties could have about the procedure, especially in a global environment where local legislation and different languages may present some barriers to complete assessment. While this provides an additional guarantee that no “differently validated” trademark may prevail over one which followed the standard TMCH procedure, it still allows at the same time the majority of those non-conflicting local trademarks having not chosen the TMCH to enjoy what local law mandates: equal value for trademarks.

1.8 Duration

This ALP will last at least sixty (60) calendar days and it will run in parallel with the rest of the Launch Phases (see Annex 1).

1.9 Sunrise Dispute Resolution Policy

Allocations and rejections of domain names under this parallel TMCH/Local Trademark Sunrise Period category will be able to be challenged through the Sunrise Dispute Resolution Policy (“**SDRP**”) developed by the Comunidad de Madrid (attached as **Annex 2**).

2. Final Assurances

The Comunidad de Madrid (Registry Operator) acknowledges and agrees that the Launch Application described above is a true and correct description of the Comunidad de Madrid’s launch program. The Comunidad de Madrid agrees that if the Comunidad de Madrid makes any changes to the Launch Application (whether before or after the Launch Application has been approved), it will promptly provide ICANN with a revised description of the Launch Application.

The Comunidad de Madrid acknowledges and agrees that in the event that any of the information contained in the Launch Application becomes untrue (including after ICANN has approved the Launch Application), any approval granted by ICANN to the Comunidad de Madrid for the Launch Application shall immediately expire, and the Comunidad de Madrid shall immediately cease accepting registrations or allocations under the Approved Launch Program.

Enclosed:

Annex 1: CDM-puntoMadrid-ALP2-Overview-att1.pdf

Annex 2: CDM-puntoMadrid-ALP2-Sunrise-Dispute-Resolution-Policy-att2.pdf

Submitted by: Mr. José Martínez Nicolás

Position: Primary Application Contact

Date Noted: 17 September 2014

Date Amended: 23 October 2014

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