

Premium Name Application Process for Trademark Holders

Premium Name Trademark Application Rules for .MOBI

This document establishes application Rules for Premium Names in the .MOBI Domain by owners of qualifying trademark rights.

1. Definitions

In these Rules:

Applicant means a trademark owner who, during the Premium Name Trademark Application Period, applies for the registration of a Premium Name in the .MOBI TLD.

Center refers to the World Intellectual Property Organization Arbitration and Mediation Center.

Expert means an individual appointed by the Center to decide upon an application for the registration of a Premium Name in the .MOBI TLD.

Premium Name means a domain name, which the registry has placed on a reserved list of names, and which will be attributed by way of an auction during the auction period determined by the Registry unless it is registered by a successful Applicant in accordance with these Rules.

Premium Name Trademark Application Period refers to the period between September 15, 2006, 12.00 noon GMT and October 13, 2006, 12.00 noon GMT, during which trademark owners can apply to register Premium Names subject to the Premium Name Trademark Registration Conditions.

Premium Name Trademark Registration Conditions refers to the conditions set forth in Paragraph 2 of these Rules (including footnotes) which must be met as a precondition for the registration of a Premium Name during the Premium Name Trademark Application Period.

Registrar means the entity with which a successful Applicant can register a Premium Name.

Registry means dotmobi, the registry operator for the .MOBI TLD.

Trademark includes both a trademark and a service mark.

2. Premium Name Trademark Registration Conditions

(a) In order to be eligible for registration of a Premium Name, an Applicant must prove its compliance with all of the following conditions (including footnotes):

(i) at the time of the application, the Applicant is the holder of a current (non-expired) trademark registration in its name¹; and

(ii) the Premium Name is identical to the textual or word elements of the trademark registration on which the application is based²; and

(iii) the trademark registration on which the application is based is of national effect³, and its relevant textual or word elements have not been disclaimed; and

(iv) the trademark on which the application is based was registered or applied for in the name of the applicant, prior to July 11, 2005, with the trademark authority with which the trademark is registered⁴; and

(v) the trademark has been used by the Applicant or with its consent for a period of at least five years prior to the date of the Premium Name application, provided that such use,

(1) was relevant to advertising, promoting, distributing, offering or selling all or some of the goods or services for which the trademark is registered;

(2) has led relevant sectors of the public to associate the textual or word elements of the trademark with the goods or services for which the trademark is used by the Applicant or with its consent;

(3) took place in at least one of the countries or territories for which the trademark has been registered;

(4) was real, substantial and in good faith, and not merely a means to register a Premium Name.

(b) Compliance with the Premium Name Registration Conditions must be proved by:

(i) originals, or copies certified by the issuing trademark authority, of trademark certificates proving registration in accordance with Paragraph 2(a)(i)-(iv) above; and

(ii) documentary evidence proving use in accordance with Paragraph 2(a)(v) above, subject to the authority of the Expert under

Paragraph 10(c) of these Rules to determine the admissibility, relevance, materiality and weight of such evidence.⁵

3. Communications

(a) Except as otherwise provided in these Rules, any communication required under these Rules shall be made by electronic mail via the Internet.

(b) For the purposes of any communications to the Center, the following addresses should be used:

(i) electronic mail: premium.mobi@wipo.int

(ii) facsimile transmission: +41 22 740 3700

(iii) postal or courier service:

WIPO Arbitration and Mediation Center
34, chemin des Colombettes
1211 Geneva 20
Switzerland

(c) Except as otherwise provided in these Rules, all communications provided for under these Rules shall be deemed to have been made:

(i) if via the Internet, on the date that the communication was transmitted, provided that the date of transmission is verifiable; or

(ii) if delivered by facsimile transmission, on the date shown on the confirmation of transmission; or

(iii) if by postal or courier service, on the date of mailing marked on the receipt.

(d) Except as otherwise provided in these Rules, all time periods calculated under these Rules shall commence on the earliest date that the communication is deemed to have been made in accordance with Paragraph 3(c).

(e) It shall be the responsibility of the sender to retain records of the fact and circumstances of sending, which shall be available for inspection by affected parties and for reporting purposes.

(f) Paper submissions to the Center shall be submitted in three (3) sets, including the original of such submission.

4. Language of Proceeding

- (a) Unless otherwise determined by the Center or the Expert in exceptional circumstances, the language of the application proceeding shall be English.
- (b) Any trademark certificates in a language other than English, submitted by the Applicant in accordance with Paragraph 2(b)(i), must be accompanied by a certified translation into English. The Expert may order that any other documents, including documents submitted in accordance with Paragraph 2(b)(ii), submitted in a language other than English be accompanied by a complete or partial translation into English.

5. The Application

- (a) During the Premium Name Trademark Application Period, any person or entity may initiate an application proceeding by submitting an application to the Center in accordance with these Rules. An application may not relate to more than one Premium Name.
- (b) The application shall be submitted in hard copy and (except to the extent not available for annexes) in electronic form via the Internet using the Application Form posted by the Center, and in accordance with the Center's submission instructions posted therewith.
- (c) The application shall:
 - (i) request that the application be submitted for decision in accordance with these Rules;
 - (ii) provide the full name, postal and e-mail addresses, and the telephone and telefax numbers of the Applicant and of any representative authorized to act for the Applicant in the application proceeding;
 - (iii) specify the Premium Name that is the subject of the application;
 - (iv) describe the grounds on which the application is made including, in particular, why the Applicant is entitled to register the concerned Premium Name under the Premium Name Trademark Application Conditions set out in Paragraph 2 above.

The above description should not exceed 2,000 words;

- (v) include the following statements:

“The Applicant certifies that the trademark registration forming the basis of this application and potential registration of the concerned Premium Name complies with the Premium Name Trademark Registration Conditions”;

“The Applicant certifies that the information contained in this application is to the best of Applicant’s knowledge complete and accurate, that this application is not being presented for any improper purpose, such as to harass, and that the assertions in this application are warranted under the Premium Name Trademark Application Rules for .MOBI and under applicable law, as it now exists or as it may be extended by good-faith and reasonable argument.”;

(vi) specify the credit card (American Express, Visa or MasterCard), together with the name of the cardholder as it appears on the card, the card number and the card expiration date for purposes of payment of the application fee in accordance with Paragraph 14;

(vii) annex documentary evidence proving compliance with the Premium Name Registration Conditions in accordance with Paragraph 2(b)(i) and (ii), together with a schedule indexing such evidence.

6. Review of Application

(a) The Center shall review the application for formal compliance with these Rules.

(b) If the Center finds the application to be formally deficient, it shall notify the Applicant of the nature of the formal deficiencies identified. The Applicant shall have ten (10) days after such notification within which to correct any such formal deficiencies, failing which the application proceeding will be deemed withdrawn without prejudice to the submission of another application by the Applicant in accordance with these Rules. In such an event, the Center shall notify the Applicant and the Registry of the deemed withdrawal of the application.

7. Multiple Applicants

(a) In the event more than one Applicant submits an application regarding the same Premium Name, the Center shall process all applications independently from one another under these Rules.

(b) If more than one application regarding the same Premium Name is successful, the Registry shall attribute such Premium Name to one of the successful Applicants in accordance with procedures developed by the Registry.

8. Appointment of the Expert

(a) If the Center finds that the application is in formal compliance with these Rules and is satisfied that the application fee has been paid in accordance with Paragraph 14, it shall appoint a single Expert from its published list of Premium Name Experts.

(b) Once the Expert is appointed, the Center shall notify the Applicant of the Expert appointed, and forward the Application to the Expert. The Center shall also publish the name of the Applicant and the concerned Premium Name on a publicly accessible web site.

9. Impartiality and Independence

An Expert shall be impartial and independent from the Applicant and from the Registry and shall have, before accepting appointment, disclosed to the Center any circumstances giving rise to justifiable doubt as to the Expert's impartiality or independence. If, at any stage during the application proceeding, new circumstances arise that could give rise to justifiable doubt as to the impartiality or independence of the Expert, that Expert shall promptly disclose such circumstances to the Center. In such event, the Provider shall have the discretion to appoint a substitute Expert.

10. General Powers of the Expert

(a) The Expert shall conduct the application proceeding in such manner as it considers appropriate in accordance with these Rules.

(b) The Expert shall ensure that the application proceeding takes place with due expedition. It may extend, in exceptional cases, a period of time fixed by these Rules or by the Expert.

(c) The Expert shall determine the admissibility, relevance, materiality and weight of the evidence submitted by the Applicant.

(d) The Expert may, in exceptional circumstances, request or allow the submission of further statements or documents by the Applicant.

(e) There shall be no in-person hearings.

11. Expert Decisions

- (a) The Expert shall determine whether the Applicant complies with the Premium Name Trademark Registration Conditions and is eligible to register the concerned Premium Name. The Expert's decision is of an administrative nature and shall be final.
- (b) The Expert shall render its decision on the basis of the statements and documents submitted and in accordance with these Rules and any rules and principles of law that it deems applicable. The Expert may, in its sole discretion, consult relevant intellectual property offices and their online databases in the context of reaching its decision.
- (c) In the absence of exceptional circumstances, the Expert shall forward its decision on the application to the Center within fourteen (14) days of its appointment pursuant to Paragraph 8.
- (d) The Expert's decision shall be in writing, summarize the reasons on which it is based, indicate the date on which it was rendered, and identify the name of the Expert.

12. Communication of Decision

- (a) The Center shall communicate the decision to the Applicant and the Registry. If the Applicant prevails, the Registry shall communicate to the Applicant information concerning the attribution of the concerned Premium Name in accordance with its procedures.
- (b) The Center shall publish the outcome of the Application together with the name of the Applicant and the concerned Premium Name on a publicly accessible web site.

13. Termination of Application Proceeding

- (a) If the Applicant notifies the Center of its intention to withdraw the application, the Center shall terminate the application proceeding. Such notification must be submitted in hard copy signed by the Applicant.
- (b) If it becomes unnecessary or impossible to continue the application proceeding for any other reason, the Center, or, after its appointment, the Expert shall terminate the application proceeding.

14. Fees

(a) The filing of an application is subject to the payment of a non-refundable application fee in the amount of USD 1,500. This fee is to be paid by credit card, at the time of the submission of the application in accordance with Paragraph 5(c)(vi).

(b) If the Center is not satisfied that the application fee has been paid within ten (10) days of the filing of the application, the Center will dismiss the application on the basis of the Applicant's failure to pay the application fee.

(c) In case of any termination of the application proceeding in accordance with these Rules, any fees paid by the Applicant in accordance with this Paragraph shall be deemed forfeited, except if the termination occurs before the appointment of an Expert, in which case the Center shall withhold a processing fee in the amount of USD 500 and refund the balance of the application fee paid by the Applicant.

15. Exclusion of Liability

(a) Except in the case of deliberate wrongdoing, the Center or the Expert shall not be liable to the Applicant or to the Registry for any act or omission in connection with any application proceeding under these Rules.

(b) The Registry shall not be liable as a result of any decision rendered by the Expert.

16. Amendments

The version of these Rules in effect at the time of the submission of the application to the Center shall apply to the application proceeding commenced thereby. The Registry reserves the right to modify the Rules at any time in consultation with the Center.

¹ The trademark registration must be in the name of the Applicant. A trademark license will not be considered sufficient, nor will a registration in the supplemental register of the United States Patent and Trademark Office. Unregistered trademarks, or other rights in distinctive signs (such as trade names, personal names, geographical indications, etc.), do not meet the Premium Name Trademark Application Conditions.

² Identity will be deemed to exist also where there is a space between the textual or word elements of the trademark (e.g., "service mark") and, in the Premium Name, a hyphen is

used or the elements are combined (e.g., <service-mark.mobi> or <servicemark.mobi>). Identity will also be deemed to exist when special characters in the trademark, such as ~ @ # \$ % ^ & * () + = < > { } [] | \ / , spaces, and punctuation (such as : ; “ ‘ , . ?), are, in the Premium Name, eliminated entirely (no space), replaced with hyphens within a domain name, or transcribed in a conventionally accepted way. A trademark registration for “Service & Mark” will be considered identical with <servicemark.mobi>, <service-mark.mobi>, or <serviceandmark.mobi>. If the trademark contains letters which contain additional elements that for technical reasons cannot be reproduced in the Premium Name, such as ä, é or ñ, the letters concerned must, in the Premium Name, be reproduced without these elements (such as a, e, n), or must be replaced by conventionally accepted spellings (such as ae for ä). In all other respects, the Premium Name must be identical to the textual or word elements of the trademark.

³ For instance, European Community trademarks meet the condition of national effect, but United States state trademarks do not.

⁴ The trademark must have been registered in the name of the Applicant on or before July 11, 2005. It will also be considered sufficient if the Applicant had applied for the trademark before that date, provided that the trademark is registered by the time of the Premium Name application.

⁵ Such evidence may, for example, consist of consumer surveys, sales reports, advertising and promotion reports, reports of successful enforcement of the trademark, etc.