

MEDIA MENTION

David Weslow Comments on Proposed Costs to Protect Trademarks in new gTLDs

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David E. Weslow, a partner in Wiley Rein's Intellectual Property Practice, was interviewed for a January 30, 2013 article in *Bloomberg BNA's Electronic Commerce & Law Report* about the proposed costs to protect trademarks on the Internet as the Internet Corporation for Assigned Names and Numbers (ICANN) prepares to delegate new generic top-level domains (gTLDs).

Under a fee structure announced this month, trademark owners will have to pay a base fee of \$150 per trademark to register each mark for one year with the gTLD program's trademark clearinghouse (TMCH)—which will provide trademark owners with the ability to preemptively register certain domain names and to receive alerts when potentially infringing domain names are registered by third parties. A slight discount will be applied for three and five-year terms. Thus, a company seeking to register 300 trademarks would pay \$45,000 for one year of registrations in the TMCH under the basic plan, or \$217,500 for five years at a discount of \$7,500 per year.

Additional registration fees will be required for "sunrise" or early domain name registrations by trademark owners and, should a trademark owner be alerted by the TMCH to a conflicting third-party domain name registration, further fees and costs will be required to take action against the domain name. ICANN is currently reviewing the TMCH proposal, and is accepting public comments until February 5.

A discount will be applied for trademark owners who use an agent to register in the clearinghouse under an advanced plan involving points, but the vendor fees associated with that option may eclipse

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the discount, Mr. Weslow said in the article. Other cost considerations include whether a brand owner would prefer a one-year plan to a longer-term deal based on the effectiveness of the TMCH service. Addressing whether trademark owners should undertake the expense of multiple year registrations in the TMCH, Mr. Weslow said "A lot of this is an unknown. We just don't know what the benefit is" at this point.