

gTLD "Trademark Clearinghouse" Opens for Registration March 26, 2013

February 26, 2013

The Internet Corporation for Assigned Names and Numbers (ICANN) announced yesterday that the "Trademark Clearinghouse" associated with ICANN's new generic top-level domain (gTLD) program will begin accepting trademark recordations on March 26, 2013. Recordation in the Trademark Clearinghouse will be required to qualify for certain of the new trademark protection mechanisms associated with the gTLD program.

There are approximately 1,900 gTLD applications now pending with ICANN for over 1,400 new gTLDs such as .bank, .love, .online, .music and .web. Roughly 500 gTLDs are the subject of competing applications, and roughly one third of the applications are for . brands. It is widely anticipated that new gTLDs will begin to "go live" in the third quarter of this year.

ICANN has created a number of mandatory trademark protection mechanisms as part of the gTLD program. gTLD applicants may implement additional enhanced trademark protection mechanisms, and ICANN may yet expand the mandatory trademark protection mechanisms, but implementation of at least the following three new mechanisms is mandatory:

1. A "Trademark Claims" service – providing notice to would-be domain name registrants of corresponding trademark rights, and to relevant trademark owners if such domain names are registered;
2. A "Sunrise" registration period of at least 30 days, allowing eligible trademark owners to obtain pre-launch domain name registrations; and

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3. The "Uniform Rapid Suspension" procedure, providing a means for obtaining the suspension of infringing domain names without the necessity of initiating a court action for cybersquatting.

To qualify for the Trademark Claims service and Sunrise registrations, a trademark owner must first record relevant trademarks in the Trademark Clearinghouse; in addition, to qualify for Sunrise registrations, a trademark owner must "validate" the mark by submitting proof of use to the Clearinghouse. Eligible trademarks for the Trademark Clearinghouse are marks that are: (1) registered; (2) protected by statute or treaty; (3) validated by a court or a judicial proceeding; and (4) "otherwise constitutes intellectual property" in any jurisdiction. In addition, only typed format ("word") marks and the textual elements of design marks may be recorded with the Trademark Clearinghouse. Submissions start at \$150 per mark per year, with discounts available under certain circumstances when marks are registered in bulk.

Although the scope of impact that new gTLDs will have on Internet commerce and search engines is not yet clear, this immense new landscape of potential trademark infringements raises serious concerns for trademark owners. Given the number of new gTLDs that will be going "live" in the next one to two years, trademark owners should carefully review their portfolios to identify marks to be recorded in the Clearinghouse. In addition, brand owners should be developing or refining trademark protection strategies and protocols in relation to new gTLDs—such as identifying which of the applied-for gTLD strings presents the highest risks, establishing targeted strategies for defensive registrations and setting appropriate budgets for combatting infringement.