

New gTLD Updates: Important Information for All Trademark Owners

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Whether you are a new gTLD applicant or not, the new launch will have implications for your company's trademark enforcement efforts. The following highlights fast approaching dates of interest, including details regarding the launch of the Trademark Clearinghouse, which will be integral to protecting trademarks in connection with the introduction of new gTLDs expected this spring.

Key Upcoming Dates for the New gTLD Program

- **March 13:** Current deadline to file formal objections to gTLD applications including: Legal Rights Objections; Community Objections; String Confusion Objections; and Public Interest Objections, as explained in our prior [article](#).
- **March 23:** ICANN is expected to release its first evaluation results for pending gTLD applications. A list of all current applications being considered can be found on the [ICANN website](#).
- **March 26:** Launch of Trademark Clearinghouse. See below for details.
- **May 2013:** First new gTLDs are expected to launch, starting with those consisting of non-Latin characters (e.g., .天主教, .شبكة). gTLDs with Latin character strings are expected to launch throughout the second half of 2013.

Protections Available Through The Trademark Clearinghouse

The ICANN Registry Agreement requires all new gTLD operators to implement certain Sunrise and Trademark Claims services during the initial launch periods for each new gTLD, which are designed to protect trademark owners' rights. The Trademark Clearinghouse will facilitate such programs.

Sunrise Services. The Sunrise Period gives eligible trademark owners the opportunity to register their trademarks as second level domain names in new gTLDs, prior to registrations by the general public. The Sunrise period for new gTLDs must be at least 30 days.

Trademark Claims. The Trademark Claims services will alert trademark owners when a third party applies to register a second level domain name that is an identical match to the trademark owner's mark contained in the Trademark Clearinghouse database. The applicant for a domain name will also receive a notice and be required to certify that it has a good faith belief that its use of the

domain name will not infringe upon the rights of the trademark owner prior to registration of the domain name. New gTLD operators must offer the Trademark Claims services for at least the first 60 days in which secondary domain names are offered for sale to the general public.

Trademark Clearinghouse Registration

The Trademark Clearinghouse ([TMCH](#)) will launch on March 26, and serve as a centralized database of trademark ownership data, which will be used by all new gTLD operators during the mandatory Sunrise and Trademark Claims periods.

In order to take advantage of the Sunrise and Trademark Claims periods, a trademark owner **must register** its trademarks with the TMCH.

The TMCH will accept and verify the following intellectual property rights:

1. Nationally or regionally (i.e., multi-nationally) registered trademarks
2. Court-validated marks
3. Marks protected by statute or treaty
4. Other types of marks upon the request of registries

To be eligible, a trademark registration must have at least national effect, and must be registered at the time it is submitted for verification. In order to take advantage of the Sunrise Period, trademark owners must also submit a declaration that the mark is in use and provide proof of use of the mark.

The following will **not** be eligible for registration with the TMCH:

1. Trademark applications
2. Trademarks registered by a city, state, or province of sub-national region
3. International trademark applications made via the Madrid system unless the underlying basic trademark registration has national effect
4. Registered marks that were subject to successful invalidation, cancellation, opposition, or rectification proceedings
5. Any intellectual property rights which cannot be represented within the technical limitations of the Domain Name System (i.e., patents and designs, etc.)

What will Registration in the Trademark Clearinghouse Cost?

Registration may be made in 1-year, 3-year, or 5-year periods, with registration fees starting at \$145 a year for a one year registration^[1]. By registering one's trademark, the TMCH automatically generates a list of matching domain names based on ICANN's Domain Name Matching Rules. Up to 10 domain names are included in the price of a trademark registration, with a small charge for additional domain names. A registration period expires on the anniversary of the calendar day prior to the date of initial registration, and must thereafter be renewed. In addition, trademark owners who supply trademark registrations as the basis of the TMCH registration must submit information to

the TMCH regarding any change in status of the trademark registration, including renewals and cancellations.

Early bird registration will take place before the sunrise period of the first new gTLD. Trademarks registered during the early bird period will not expire on the anniversary of the registration date, but rather the first anniversary of the day prior to the date the first gTLD starts their sunrise period.

There are no extra fees for opting in or out of Sunrise services or Trademark Claims notifications.

What is a Trademark Owner To Do Next?

It's a new era so plan and manage your trademark rights protection program accordingly! The first new gTLDs are expected to launch in May and will continue to be released at a rate of about 20 per week. All trademark owners should develop a comprehensive strategy (offensive, defensive, or both) for the upcoming launch of new gTLDs including:

- Review your trademark portfolios to identify primary and secondary trademarks that you may wish to register with the TMCH
 - Many new gTLDs propose restricting second level domain registrations to those in particular geographic locations or industries, so consider such limitations in deciding which trademark registrations to record with the TMCH
- Compile and prepare information necessary to register with the TMCH, including proofs of use
- Review and analyze new gTLDs to determine where the registration of second level domains during the Sunrise Period may benefit current or future business and marketing plans
- Develop a rights protection strategy for matters not adequately covered by TMCH procedures
 - The TMCH only provides notification regarding applied for domains that are identical matches to trademarks registered with the TMCH—broader enforcement and pre-emptive secondary domain name registrations may be desirable
 - The TMCH will only provide notification of registration for the first 60 days after the Sunrise period in each gTLD--develop a strategy for monitoring past the initial launch of gTLDs
- Budget for new costs associated with the enforcement strategy

For More Information

Please contact [Andrea Calvaruso](#) in our New York office to protect your organization's rights via Public Comments, Trademark Clearinghouse submissions, or Formal Objections before ICANN-approved dispute resolution providers.

[1] Slightly discounted rates are available to trademark owners and agents who register trademark rights with the TMCH in bulk (over 3,000 registrations in one year).