

CLIENT ALERT

Companies May Begin to Protect Their Online Presence Anew: Trademark Clearinghouse Now Available For New gTLDs

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As of March 26, 2013, trademark owners may submit their trademarks for inclusion in the "Trademark Clearinghouse," which may be a valuable tool for minimizing the potential for abuse resulting from the imminent expansion in the number of generic Top Level Domains (gTLDs). Inclusion in the Clearinghouse will give the mark owner the opportunity to register the mark in each new gTLD before the general public and will provide other notice benefits as well.

The Internet Corporation for Assigned Names and Numbers (ICANN) is involved in a process that will greatly expand the number of gTLDs. Currently there are around twenty active gTLDs, of which ".com" is the best known. Soon new gTLDs will be implemented and hundreds more may follow. To address some of the concerns regarding the correspondingly expanded potential for trademark abuse, ICANN has authorized the establishment of a Trademark Clearinghouse to allow trademark owners to submit their trademarks into a centralized database for verification.

Inclusion in the Trademark Clearinghouse will convey potential benefits in two ways:

1. *Sunrise Registration Benefits* – eligible trademark owners will be given the opportunity to register their trademarks as domain names in each new gTLD Registry for a period of no less than 30 days prior to the opening of the Registry to the public, thus preventing cybersquatters from purchasing those marks; and
2. *Trademark Claims Period* – for the first 90 days of general registration in each new gTLD following the public launch, anyone attempting to register a domain name matching a mark in the Clearinghouse will receive a notification of the owner's rights. This notification must be acknowledged by the applicant before the registration can proceed. If the domain name is registered, the owner then receives a notice of the registration and can take appropriate action.

Four types of marks are eligible for inclusion in the Clearinghouse: 1) nationally or regionally registered word marks; 2) word marks that have been validated through a court of law or other judicial proceeding; 3) word marks protected by statute or treaty; and 4) other marks recorded in the Clearinghouse by arrangement with a registry.

To qualify for verification, a trademark owner must first have validated its trademark: he must submit verifiable information supporting its claim of ownership. In addition, if the trademark owner wishes to take advantage of the Sunrise Registration benefits and register domain names itself, it will be required to submit proof of actual use of the mark, consisting of both a Declaration of Use and a specimen reflecting the use.

Our View

The protections provided by the Trademark Clearinghouse are far from perfect from a trademark holder's perspective. The validation and the verification only work for identical matches. However, the Trademark Clearinghouse has the advantage of being mandatory for all new gTLDs and a single validation of a trademark could be used for all new gTLDs. All trademark holders

should at least give consideration to submitting their most important trademarks for validation into the Trademark Clearinghouse in order to take advantage of the potential protections it may offer in the new Internet environment.

For more information, please contact the professional(s) listed below, or your regular Crowell & Moring contact.

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