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The Time Is Here: Protecting Your Brands against New Top-Level Domain Names

Trademark Alert

The number of top-level domains, which are currently a handful such as .com, .net, .org, .gov, .mil, .edu, .mobi, .jobs, and .xxx will be expanded later this year to well over 1,000, such as .sport, .eco, .berlin, .web, .art, .android, .auto, .cloud, .film, .movie, .wedding, and many others. Some will be wide open, like .com, and others will be restricted to members of a particular group, company, or community.

The application process has been under way since 2012 and ICANN is still processing over 2,000 applications for new top-level domains (gTLD's).

In the past, for certain new domains (i.e. .eu, .asia, and .xxx) there has been a sunrise period to give trademark owners the first opportunity at registering their brands before the new domain is open to the general public. Each sunrise period had its own rules, forms, and paperwork. The prospect of the cost and effort of complying with more than 1,000 different sunrise and objection processes was overwhelming, so ICANN has designated a single central database for registration of trademarks against all gTLD's.

ICANN is setting up a central trademark clearinghouse (TMCH) so that one set of paperwork can be submitted to create a single database of authenticated trademark rights to protect brands. The TMCH will provide a central, one-stop process to prepare to sunrise registration and/or objection to gTLD registrations which conflict with the registered brands for all sunrises. While there are still some unresolved questions, the TMCH is nevertheless set to go live on **March 26, 2013**. Deloitte will be the validator of trademarks and IBM will operate the TMCH.

In addition to facilitating sunrise registration of domain names, the TMCH will also facilitate trademarks claims processes across over 1,000 new top-level domains. The Trademark owner will be notified of any new domain registrations which exactly match its marks in the database. This is important because for domains that are restricted, the Trademark owner may not be able to qualify to register and block a mark during the sunrise, but will still want to know of potentially infringing registrations.

Note that the TMCH does not prevent others from registering your mark unless you have actually purchased the mark during a sunrise period. Nevertheless, it reflects a compromise between ICANN and trademark owners and is the best defense against the roll out of hundreds of new domains.

All trademark owners should be prepared to register their key brands in the TMCH in order to best prepare for the vast expansion of the gTLD space.

For questions on navigating the process, contact **Janet Satterthwaite**, partner in the **Trademark Group** and head of the Domain Names and Cyberpiracy practice.