

Trademark Owners Alert: An Anything but 'Free' Free for All | Lane Powell

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The new generic top-level domains (“gTLDs”) are coming, and it is time for trademark owners to review their online strategies. Over the last several months, Internet Corporation for Assigned Names and Numbers (“ICANN”) has been accepting applications from around the world from individuals and companies that would like to take advantage of owning the next gTLDs. Some of the new domains that have been reserved include company and brand names such as .Abbott or .Amex, as well as more descriptive domains such as .book, .clothing, .flowers, .pharmacy, which are just a few examples. Operators of the new gTLDs will be responsible for implementing protection mechanisms to assist trademark owners in protecting and policing their trademarks against nefarious domain name registrants. As part of the mechanism, the Trademark Clearinghouse will open its electronic doors for submission of trademark data into one centralized database for all gTLDs. This will include submission of information that can be used for both the Sunrise periods and for filing subsequent trademark claims. Registration is required to take advantage of the Sunrise period that allows for trademark owners to have priority in a pre-registration period for multiple gTLDs. In addition, for a period of 60 days, trademark owners will have the option of receiving notification if any third party attempts to register a domain name that matches a submitted trademark.

Marks that may be submitted include those that are registered either nationally or regionally (multi-national), are court validated, or marks that are protected by statute or treaty. U.S. State registrations will not be accepted, nor will pending federal trademark applications. In addition to very detailed submission of the trademark registration particulars, if the mark owner wants to establish the ability to file during the Sunrise period, they will also need to submit a declaration of use. The filing fees have been established and vary depending upon whether the trademark owner or a recognized agent is filing the submissions, and depending upon the length of time designated. Currently, there are options for one-, three- and five-year periods, with the prices ranging from \$150 for one year, up to \$725 for five years. Once filed, the Clearinghouse will validate the submissions on a yearly basis.

Now is a great time to review domain portfolios to consider whether to register domain names in the new gTLDs, qualify for the Sunrise provisions of the new domains, or prepare for an onslaught of new brand protection against the inevitable cybersquatters.

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