IP Alert: Protect Your Rights as New gTLDs Prepare to Launch, Trademark Clearinghouse Opens March 26, 2013

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By Richard S. Stockton and Victoria R.M. Webb

ICANN, the governing body of the Internet that is overseeing the rollout of new generic Top Level Domains (gTLDs), will launch its Trademark Clearinghouse on March 26, 2013. There are two gTLD-related services available to brand owners who register marks with the Clearinghouse:

- **Sunrise Period Registration Eligibility:** Participating brand owners will have the opportunity to register domain names under new gTLDs (*e.g.*, "*brand*.app") that match the text of their Clearinghouse-registered marks during mandatory "sunrise" periods (*i.e.*, before the general public); and
- **Limited Registration Notification:** During a "trademark claims" period of at least 60 days following the sunrise period, the Clearinghouse will notify a potential registrant of a domain name under a new gTLD if the domain name corresponds to a Clearinghouse-registered mark, and the Clearinghouse will notify the corresponding brand owner if the domain name is in fact registered.

Thus, the Clearinghouse is not a rights protection mechanism *per se*, as Clearinghouse registration will not prohibit registration of domain names matching the mark. Moreover, the services are triggered only by "identical matches," meaning that, for example, registration of "*brrand*.app" during the trademark claims period would not trigger notification to the corresponding owner of the Clearinghouse-registered mark "BRAND."

The Clearinghouse registration process requires submission of trademark information along with a fee. Generally speaking, the fee is $150 to register one mark for one year, $435 for three years and $725 for five years, although bulk

registrations may result in discounts. If sunrise services are desired, proof of use of the trademark will also be required. Eligible trademarks include not only nationally- and regionally-registered marks, but also court-validated common law marks and marks protected by statute or treaty. Additional registration and fee information is available at the Trademark Clearinghouse site.

We recommend that brand owners register any marks of interest with the Clearinghouse sooner rather than later as the first new gTLDs are likely to be rolled out within the next four to six months.

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