

Legal Update

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ICANN LAUNCHES NEW TRADEMARK CLEARINGHOUSE

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Last year, the Internet Corporation for Assigned Names and Numbers (ICANN) received over 1,900 applications for new generic Top-Level domain (gTLDs). As discussed in our previous [Legal Update](#), the new gTLDs will greatly expand the universe of top-level domains by allowing for generic or geographic designations, such as .bank or .london, and also for brand-specific suffixes, such as .amazon or .google. A complete list of the pending applications for new gTLDs can be found [here](#).

In anticipation of the roll-out of the first of the new gTLDs in the coming months, ICANN has launched the Trademark Clearinghouse. The Trademark Clearinghouse is a centralized, worldwide repository of verified trademark records. Trademark holders may submit qualified trademarks to the Trademark Clearinghouse to assist in protecting their rights across all new gTLDs. The following types of trademarks are eligible for inclusion in the Trademark Clearinghouse: (1) nationally or regionally registered trademarks, (2) unregistered word marks that are court-validated, and (3) trademarks protected under statute or treaty. The fees for recording a trademark with the Trademark Clearinghouse are \$150 for one year, \$435 for three years, or \$725 for five years.

Registering a mark with the Trademark Clearinghouse will provide trademark holders with two benefits: a Sunrise Service and a Trademark Claims Service. All new gTLDs will have a Sunrise – that is, a pre-launch period of at least 30 days before domain names are made available to the general public. The Sunrise Service will enable a trademark holder to register a domain name that matches its trademark in a new gTLD before the general public.

The Trademark Claims Service is a notification service that will warn potential domain name registrants and trademark holders of possible infringement. For 90 days after a new gTLD launches, potential domain name registrants will receive a warning if they attempt to register a domain name that is identical to a trademark that is recorded with the Trademark Clearinghouse. The Trademark Claims Service will not stop the registration. The Trademark Clearinghouse will, however, notify a trademark holder when another party registers a domain name that is identical to its trademark that has been recorded with the Trademark Clearinghouse. The trademark holder can then decide whether to take action against the registration, including use of a new rapid suspension service for clear-cut cases of infringement.

Because the Trademark Claims Service is limited to a domain name that is identical to a trademark in the Trademark Clearinghouse, a trademark holder will not receive any notification if the registered domain name contains even the slightest spelling variation. Moreover, a trademark holder will not receive a notice under Trademark Claims Service more than 90 days after a new gTLD opens, even when the registered domain is identical to a trademark registered with the Trademark Clearinghouse. Given these

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limitations, a trademark owner may well regard the ability to defensively register a trademark as a domain in the Sunrise Period for new gTLDs as the more useful of the two services. Trademark holders should carefully consider the costs and benefits of registering their most valuable registered trademarks with the Trademark Clearinghouse and/or defensively registering them as domain names in new gTLDs that are relevant to their business. Trademark holders may learn more about the Trademark Clearinghouse [here](#).

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