

February 27, 2013



New gTLD Clearinghouse Will Open March 26, 2013

ICANN (the Internet Corporation for Assigned Names and Numbers) plans to launch the first of the registries associated with the new generic top-level domains (gTLDs) in mid-2013.

In association with the launch, ICANN is establishing a global Trademark Clearinghouse to help protect trademark owners from future domain name infringements involving the new gTLDs. The Clearinghouse is intended to function as the central repository of authenticated registered trademarks – it will eliminate the need for trademark holders to register their marks in many different verification databases as new gTLDs are launched. ICANN will require every new gTLD operator to utilize the Clearinghouse.

The Trademark Clearinghouse will accept registrations starting March 26, 2013. Clearinghouse registrations will primarily be used to support (a) sunrise registrations and (b) rights protection mechanisms.

Sunrise Registrations and Notifications

In order to register a domain name with a new gTLD registry during that registry's "sunrise" period – the set period of time in which trademark registration holders can secure domains ahead of the general public – that trademark must be registered with the Trademark Clearinghouse. To register with the Clearinghouse, applicants will need one of the following:

- A nationally or regionally registered trademark, from any jurisdiction
- Any trademark that has been validated through a court of law or other judicial proceeding
- Any trademark protected by a statute or treaty
- Other marks that constitute intellectual property

In order to register during the sunrise period, applicants must also provide the Clearinghouse "proof of use" of their trademark, such as labels, tags, containers, advertising or marketing materials, photographs, or website links.

In addition, registration with the Clearinghouse will entitle trademark owners to receive notifications when exact match domain name registrations are made in connection with one of the new gTLDs. For entities interested in registering with the Clearinghouse for notification purposes only, it is not necessary to submit proof of use. The notification provision does not prevent registrations or block others from registering trademarks as domain names. This is an important distinction. The Trademark Clearinghouse is not a rights protection mechanism; however, it does allow registrants access to those mechanisms.

Rights Protection Mechanisms

The Trademark Clearinghouse allows Clearinghouse registrants to access the following mechanisms:

1. Uniform Rapid Suspension (URS)

The URS is intended to be cost-effective, expedited process to address issues of trademark infringement and abuse. The URS will involve a short (less than 500 words) form complaint, and successful complaints will result in the suspension of the infringing domain name for the remainder of their term. After suspension ends, the domains become available again for registration.

2. Uniform Dispute Resolution Policy (UDRP)

The UDRP proceeding, similar to that currently available, is designed for disputes concerning identical or confusingly similar to trademarks in which the domain name registrant has no rights, and which have been registered and are being used in bad faith.

3. Post Delegation Dispute Resolution Procedure (PDDRP)

A. Top Level:

The Top Level PDDRP complaint procedure is for strings to the “right of the dot,” in which rights holders have the ability to file a complaint if the gTLD string is identical or confusingly similar to the complainant’s mark and the registry is taking advantage of or impairing the distinctive character or reputation of the rights holder’s mark, or is creating a likelihood of confusion with the rights holder’s mark.

B. Second Level:

The Second Level PDDRP procedure allows rights holders to file complaints against registries who have acted in bad faith in registering infringing domains, or who have a pattern of acting in bad faith with an intent to profit.

4. Registry Restriction Dispute Resolution Procedure (RRDRP)

Finally, the RRDRP is the complaint procedure for community-based gTLDs, for use in situations when the gTLD operator violates the terms of the community-based restrictions in its agreement, and there is measurable harm to the complainant and the community.

Costs and Steps to Take Right Now

The Trademark Clearinghouse will charge \$150 to register a trademark with the Clearinghouse for one year. We recommend that entities interested in taking advantage of the benefits of the Clearinghouse:

1. Review their trademark portfolios and identify marks for inclusion
2. Register with the Clearinghouse
3. Monitor new domain name registrations for abusive registrations, and take advantage of new enforcement mechanisms, like the URS.

Please contact Monica Riva Talley (mtalley@skgf.com) if you would like to register any of your marks with the Clearinghouse, and/or discuss how to navigate the new gTLD landscape.