

## Protecting Trade-marks in the New gTLDs

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Trade-mark owners should act now to protect their trade-mark rights online.

As early as April 2013, new top level domain names ("gTLDs") will be available. New domain names will no longer be limited to names ending in .COM and .CA. The proposed new gTLDs include everything from .AAA (applied for by the American Automobile Association) to .ZULU (applied for by Top Level Domain Holdings Limited and intended to serve the Zulu nation). There are also numerous applications for new gTLDs that do not use Latin characters.

The new gTLDs create potential opportunities for trade-mark owners to expand the use of their brands on the Internet. They also exponentially increase the risks of trade-mark infringement across many of the new gTLDs.

Trade-mark owners should now consider whether to register domain names in any of the new gTLDs in order to secure rights and prevent appropriation by third parties. Furthermore, trade-mark owners should also decide whether they want to register their trade-mark rights in the newly created Trademark Clearinghouse.

### SHOULD YOU REGISTER IN THE NEW gTLDs?

Registering domain names that incorporate your trade-mark and variations of your trade-mark effectively prevents others from registering those names and trying to use them to divert traffic from your website. Pursuing this strategy will, however, require initial expenditures of time, diligence and costs in seeking out and registering all of the domain names in the various gTLDs that would be most attractive to cybersquatters. Further, the annual domain name registration costs are currently unknown and are at the discretion of each gTLD registry. This strategy will also require that you continue to monitor the release of new gTLDs and register your additional domain names as necessary. The first round of new gTLDs is expected to be released in April 2013.

### SHOULD YOU USE THE TRADEMARK CLEARINGHOUSE?

A second protection mechanism that will be available to trade-mark owners beginning **March 26, 2013** is the newly created Trademark Clearinghouse. This will be a central repository where owners can register their trade-mark rights and is intended to protect trade-marks in two ways:

- First, the registration of a trade-mark with the Clearinghouse gives the owner rights to pre-register domain names in new gTLDs 30 days (the "sunrise" period) before the gTLD is available to the rest of the public. An additional prerequisite to sunrise eligibility is that the trade-mark must be in use and a suitable specimen of use be filed with the Clearinghouse.
- Second, once a trade-mark is registered with the Clearinghouse, a domain name applicant will get a warning notice when attempting to register a domain name that matches that trade-mark. If the applicant continues to register the domain name, the trade-mark owner will be notified of the registration and will be able to take any appropriate actions including filing a complaint under the Uniform Dispute Resolution Policy (UDRP) and/or filing a complaint under the Uniform Rapid Suspension (URS) procedure. The fees for registering a trade-mark with the Clearinghouse are approximately US\$150 per year and registrations can be made for one, three or five years.

Although the rules seem to be constantly changing, the preventive benefits of registering crucial trade-marks in the Trademarks Clearinghouse seem to be advantageous enough to justify the costs. Please contact any of the IP professionals at Heenan Blaikie to obtain further information regarding the options for protecting your trade-marks in the new gTLD program.

## Heenan Blaikie

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Today, the firm is over 575 lawyers and professionals strong and still growing. We strive to become partners in our clients' businesses, ensuring that our legal advice addresses their preoccupations and priorities. We seek to constantly adjust the scope of our services to better serve our clients' legal needs.

Our clients range in size and sophistication from start-ups to the largest public companies, as well as health care and social services institutions, schools and universities, and numerous government entities. We also represent international clients seeking to protect and expand their interests in Canada.

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