

## ICANN's Trademark Clearinghouse: What You Need to Know and How Katten Can Help

Even in the current Internet landscape of only 23 generic top-level domains (gTLDs)—including .com, .net, .org and a handful of others—many organizations find that protecting against domain name infringement is quite a challenge. The Internet Corporation for Assigned Names and Numbers (ICANN) is currently considering applications to add up to 1,400 new gTLDs to the Internet landscape, with some gTLDs opening for domain name registrations beginning as early as mid-October 2013. In order to be prepared for this rapid expansion of the domain name space, companies should be giving serious thought to how they will continue to protect their brands in this new and evolving environment.

Against this backdrop, ICANN has devised a Trademark Clearinghouse (TMCH), one of the key new gTLD enforcement tools for brand owners, which will serve as a repository for information regarding trademark rights. The TMCH will accept, authenticate and verify any registered trademarks, marks protected by statute or treaty, or court-validated marks as well as any other marks that constitute intellectual property rights that can be represented within the technical limitations of the Domain Name System. In exchange, brand owners will receive two significant benefits:

- Brand owners will be able to register domain names that match their trademarks during a minimum 30-day “sunrise period” before any gTLD in which they would otherwise be eligible to register is launched to the public; and
- Brand owners will receive, for a minimum 90-day period after the gTLD is launched, notification when third parties register domain names that match their trademarks and notification for up to 50 domain labels per mark registered in the TMCH that were found to be the subject of abusive registrations under court proceedings (e.g., the Anticybersquatting Consumer Protection Act (ACPA) or the Uniform Domain-Name Dispute-Resolution Policy (UDRP)).

### Katten's Trademark Clearinghouse Services

Companies may find it sound strategy to register the trademarks for their core brands in the TMCH so that they have access to both the Trademark Claims and the sunrise services. They may also wish to consider completing select sunrise registrations, at least within new gTLDs that are relevant to products or industries. A complete list of the new gTLDs, along with their application status, can be found [on ICANN's website](#).

Katten's Internet and Trademark Portfolio practitioners can provide a full range of services to brand owners navigating this changing landscape. In particular, Katten offers a one-stop solution to TMCH needs, from counseling and strategy to registration of marks to follow-up enforcement efforts. Our specific services include:

- Providing customized training about ICANN's Trademark Clearinghouse and the new gTLD regime to legal departments, marketing teams, information systems and technical personnel, executives, vendors and others with responsibilities that touch on brand protection;
- Assessing an organization's complete trademark portfolio to determine which marks should be submitted to the TMCH, advising on the collection of documents required for TMCH submission, and developing time lines and budgets for registration;
- Submitting trademarks to the TMCH directly, as a registered TMCH agent;
- Monitoring sunrise periods and completing sunrise registrations;
- Reviewing active new gTLDs and assessing them for relevance to key products, geographic reach and critical markets; and
- Reviewing, analyzing and recommending modifications to enforcement strategies.

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Katten's Internet and Trademark Portfolio attorneys are recognized leaders on cutting-edge Internet issues such as ICANN's new gTLD program, having been actively engaged with ICANN since 2008 and, combined, having attended more than 20 ICANN meetings around the world. Clients have sought our expertise in drafting, prosecuting and protecting hundreds of new gTLD applications, as well as in developing online brand protection strategies that can evolve with the new Internet landscape.

Our clients include global leaders in numerous industries, including retail and apparel, media, communications, educational services, financial services, consumer products, food and beverage, hospitality and technology. In addition, our relationships with government and industry leaders, and our unique team experienced with ICANN's policy development process and ICANN's ecosystem, position us to serve as strong advocates for brand owner interests in the development of global Internet and domain name policy.

For more information regarding how to prepare for the upcoming changes to the Internet through use of the Trademark Clearinghouse, contact:

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