

## So Long, .com!

### The New gTLDs Are Almost Here. Will You Be Ready?

The first new generic Top-Level Domains (“gTLDs”) are expected to launch any day now—triggering what many predict will be the most significant transformation of the Internet since its inception. For decades, “.com” reigned supreme among gTLDs (Internet speak for the suffix of a domain name). However, the current list of available alternatives will soon grow exponentially. Over the next few years, nearly 1,500 new gTLDs will flood the Internet—covering everything from industry-based terms (.casino, .ski, .money) to geographic designations (.vegas, .nyc, .tokyo) to brand names (.nike, .jeep, .nfl). We will even see the first gTLDs with non-Latin scripts, like .сайт (Russian for “website”).

### Why should I care about the new gTLDs?

Proponents regard the new gTLDs as the solution to an increasingly overcrowded Internet, which has forced some companies to pay astronomical sums for domains in the secondary market. In contrast, critics view the new gTLDs as breeding grounds for cybersquatting activity, resulting in increased enforcement costs for trademark owners. For better or worse, we can all agree that early action may mean the difference between thriving and surviving in this shifting Internet environment.

### How can the Trademark Clearinghouse protect my brand?

In an effort to placate concerned trademark owners, the Internet’s governing body (Internet Corporation for Assigned Names and Numbers or “ICANN”) established the Trademark Clearinghouse (“TMCH”), a central database designed to verify and store information regarding nationally and multi-nationally registered trademarks. Among other benefits, trademark owners who record their marks with the TMCH will have the opportunity to pre-register domain names before each new gTLD is released to the general public. In addition, once a gTLD is publicly released, the TMCH will notify trademark owners about potentially infringing registrations. Of course, the TMCH will only benefit trademark owners who record *prior* to the launch of pertinent gTLDs.

### What should I do to prepare for the new gTLDs?

- ☑ **Identify Your Core Brands.** A critical first step in preparing for the new gTLDs is identifying your core brands. Carefully review your trademark portfolio and identify which marks are the most valuable to your company and/or particularly susceptible to infringing activity.
- ☑ **Record with the TMCH.** If you own federal registrations for your core brands, consider recording them with the TMCH to capitalize on early registration and usurp potential

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cybersquatters. The TMCH charges an annual fee of approximately \$150 per mark for its services. If you own a large trademark portfolio, you should also consider engaging a trademark agent—either directly or through your intellectual property counsel. Trademark agents are highly knowledgeable about the recordation process and are exempt from certain restrictions imposed by the TMCH. Most importantly, trademark agents will ensure that your marks are properly verified and notify you when pertinent gTLDs launch.

- ☑ **Develop a Game Plan for Pre-Registration.** Trademark owners will have the opportunity to pre-register domain names containing their recorded marks during the 30-day sunrise period preceding the public launch of each new gTLD. In advance of these sunrise periods, identify which new gTLDs are relevant to your business and develop a list of preferred domain names for pre-registration. This list should include domain names that you want to protect from third-party registration (e.g., yourbrand.sucks).
- ☑ **Implement Procedures for Managing Notifications.** For 90 days following each new gTLD launch, trademark owners will be notified whenever a third party registers a domain name containing their recorded marks. Make sure you have clear procedures in place for evaluating these notifications and taking enforcement action when necessary.
- ☑ **Investigate Additional Tools for Brand Protection.** Some of your most valuable brands may not be registered at the federal level—making them ineligible for recordation with the TMCH. As a result, you may need to investigate alternative means of monitoring and protecting your brand on the Internet, for example, through trademark watch services.
- ☑ **Stay Informed.** The full rollout of new gTLDs will take years to accomplish. During that time, there will undoubtedly be modifications to the current processes and procedures. Make sure you are apprised of any significant developments that could impact your business.

If you need additional information about the new gTLDs or need assistance recording your marks with the TMCH, please contact an attorney in Brownstein Hyatt Farber Schreck's Intellectual Property and Technology group.

*This document is intended to provide you with general information regarding the new gTLDs . The contents of this document are not intended to provide specific legal advice. If you have any questions about the contents of this document or if you need legal advice as to an issue, please contact one of the attorneys listed or your regular Brownstein Hyatt Farber Schreck, LLP attorney. This communication may be considered advertising in some jurisdictions.*

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