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## Trademark Clearinghouse and the New gTLDs

The new Generic Top-Level Domain (gTLD) expansion program developed by the Internet Corporation for Assigned Names and Numbers (ICANN) includes a Trademark Clearinghouse (TMCH), which was set to go into effect beginning March 26, 2013. The TMCH will serve as a central registry of nationally or regionally registered trademarks, court-validated marks, and marks protected by statute or treaty. As a repository, the TMCH functions (1) to authenticate contact information and verify mark ownership rights; and (2) to store this information in a single database that may be accessed by gTLD registrars.

All new gTLD registrations require gTLD registrars to use the TMCH data to protect the rights of mark holders. ICANN has established two rights protection mechanisms for use with the TMCH: (1) Sunrise service; and (2) Trademark Claims service.

The Sunrise service enables the owners of marks registered with the TMCH to preemptively register a domain name that is an identical match to a registered mark. Registrars must provide a Sunrise service that creates a 30-day Sunrise registration period after a new gTLD launches but before public registration begins. During the Sunrise period, notice of the new gTLD is provided to TMCH registrants, giving mark holders the opportunity to preemptively register domain names that are identical to their registered marks. After the 30-day Sunrise period, the new gTLD is opened to the public for registration.

Registering a mark with the TMCH also provides (1) a “warning” notice to third parties that register a second level domain name that is identical to a mark registered with the TMCH; and (2) an “alert” to the mark owner whenever a domain name is registered that is identical to the mark the owner has registered with the TMCH. Registrars must provide a Trademark Claims service for at least the first 60 days of public registration for each new gTLD. During this time, the Trademark Claims service provides prospective domain name registrants with notice if the proposed domain name exactly matches a mark that is registered with the TMCH. If the registrant proceeds to register the domain name, the domain name registrar promptly notifies the mark holder of the registration.

Registration of marks with the TMCH is a proactive way to protect registered marks in the rapidly evolving Internet domain space, but the costs and benefits for TMCH registration must be evaluated against the specific and limited benefits offered by the TMCH program. While ICANN advertises the TMCH as enabling trademark protection mechanisms, registering a mark with the TMCH will not prevent a third party from registering a domain name that includes, or is confusingly similar to, a registered mark. As a result, each trademark owner should carefully consider which marks, if any, warrant registration with the TMCH based on a client-specific trademark protection strategy.



*If you have any questions about this Legal Alert, please feel free to contact either of the attorneys listed below or the Sutherland attorney with whom you regularly work.*

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