

ALERTS

Internet & Technology Law Alert - The Trademark Clearinghouse: Safeguard Your Trademark Online

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The imminent launch of the new gTLD (generic top level domain) program will greatly expand current availability of domain names, offering brands and businesses more choices for promoting themselves online. In the coming years, an unlimited number of new second level domains will become available, often on a first-come, first-served basis. The first batch of new gTLDs will include nearly 1,400 new top-level domains including .computer, .insurance, .nyc, .sucks, and others. This program raises significant concerns about how trademark owners can best protect their rights on the Internet, especially as it relates to new opportunities for cybersquatting, brand misappropriation, and the availability of controversial gTLDs like .sucks.

[gTLDs Example](#)

What is the Trademark Clearinghouse?

As part of the new gTLD launch, the Trademark Clearinghouse has been created so that trademark owners can proactively record their trademarks in a centralized, global repository to help protect their brand online. The benefits of the Trademark Clearinghouse include:

- 1. Early new gTLD Registration:** Sunrise services will provide trademark holders with an advance opportunity of at least 30 days to register domain names corresponding to their trademarks registered with the Clearinghouse, before others have an opportunity to register them. These registrations may be defensive, or registered as part of a plan to utilize a new web address corresponding with a trademark.
- 2. Notification of Potential Infringement:** The Trademark Claims period follows the Sunrise phase and will run for at least 90 days after the opening of public domain name registration. During the claims period, anyone attempting to register a domain name matching a trademark that is registered with the Clearinghouse will receive a notification regarding the relevant trademark information. If the notified applicant moves forward with seeking registration, the Clearinghouse will notify the registered trademark holder that someone is seeking registration of a domain name matching their trademark. Upon receiving this notification, the trademark owner can decide whether to challenge registration of the domain name.

Costs

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Various factors affect the fees charged by the Clearinghouse, including the number of years the trademark is registered with the Clearinghouse, the number of marks to be registered and whether a trademark owner registers through an authorized agent. Given the diverse cost considerations, trademark owners are advised to consult with one of our attorneys regarding cost estimates.

Timing

With the launch of the first new gTLDs expected in the fall of 2013, now is the time to begin registering your trademark with the Clearinghouse. Acceptance of Clearinghouse applications may take three weeks or longer, so it is best to begin the Clearinghouse registration process immediately. This will help ensure that you have submitted your request with ample time for your records to be validated before the first round of new gTLDs become available.

The Clearinghouse will be accepting one year, three year, and five year registrations. The Clearinghouse registration begins when the first new gTLD goes live, so there is no downside to submitting your marks early.

For more information about the Trademark Clearinghouse and protecting trademarks, please contact the Barnes & Thornburg attorney with whom you work, a member of the firm's Internet & Technology Group, or the group's chair, David A. W. Wong, at (317) 231-7238 or at dwong@btlaw.com. You can also visit us online at www.btlaw.com.

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