

TYPES NOT MAPPED YET March 27, 2013 | TTR not mapped yet | Mark Sableman

Clearinghouse opens for protecting brands on new top-level domains

Within a few months, Internet domain names will explode with the creation of hundreds of new top-level domains worldwide. Brand owners therefore need to prevent their trademarks from getting burned in that explosion. A new trademark protection procedure for doing so opens up today, Tuesday, March 26, 2013.

ICANN, the Internet domain name authority, has been working for several years to allow many new generic top-level domains. The new domains, now in the final approval process, will include new international domains in non-Western alphabets, branded domains (dot-brand), and new generic domains like dot-auto and dot-bank.

The new domains are designed in part to remedy the supply/demand imbalance in top-level domains that created the dot-com land rush 20 years ago. Of course, there will now be land rushes for many of the new domains. Sophisticated companies already had one expensive and clumsy chance to protect their brands by formally disputing new domain applications.

But this week, a new simplified procedure, open to all, allows any trademark owner to seek to protect his or her marks from improper use in connection with the new domains. (This process, by the way, is different from the process for blocking trademarks on the .xxx domain. That process was limited to a single domain but got a lot of attention a year ago; this new process covers much more and is probably more important to most brand owners.)

The process will be handled by a new entity, the Trademark Clearinghouse, which will collect and maintain verified trademark data. Owners of marks verified by the Trademark Clearinghouse will be able to use one or both of its trademark protection tools:

Sunrise period. Before new domains are offered to the general public, verified trademark owners will be allowed to register their trademarks on the domains within a sunrise period of at least 30 days. Let's say your brand is "HOT" used for potatoes, and you want to register on the new "dot-potato" domain. By registering with the Clearinghouse, you'll be given advance notice of when the dot-potato domain opens up, and you'll have the opportunity before the general public to register hot.potato.

Trademark Claims Service. Clearinghouse-verified trademark owners will also get notifications when others seek to register their brands on the new domains. If your mark is "HOT," you may get notices when other applicants seek to register it on the "dot-foods" and "dot-weather" domains. You may decide to let hot.weather go through, but to challenge hot.foods. The early notice will facilitate your ability to make that challenge.

Verification will be available online and in multiple languages, but there will be fees to verify your trademark rights. You'll need to have a registered trademark or other legally validated mark, and to participate in the sunrise part of the program, you need to prove use of your mark.

As always with domain names, nothing is really simple. Despite the Trademark Clearinghouse procedures, there are still many ways that trademark owners may get burned.

First, registration with the Clearinghouse alone won't prevent any of your marks from being registered on the new domains; you'll have to register on the new domain yourself during the sunrise period or fight another applicant legally to prevent its registration of your mark.

Second, the Clearinghouse procedure only covers exact marks and certain close versions. It won't help with variations, misspellings, and compound words using your mark as one of the elements. (It will cover words within word+design marks where the words predominate.) For this and other reasons, use of the Trademark



Clearinghouse, though useful, should be only a part of your company's broader trademark monitoring and protection plan.

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