



Protecting Your Brand in the New Digital Landscape

Syracuse, New York

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If you own a registered trademark and wish to protect its value, we recommend that you register your mark with the recently created Trademark Clearinghouse.

Rollout of New gTLDs

On June 20, 2011, the Internet Corporation for Assigned Names and Numbers (ICANN) authorized the creation of new top-level domain name extensions (gTLDs), more commonly identified as the letters to the right of a URL – for example, .com and .net. On October 23, 2013, the first twenty newly approved domain name extensions were made available for purchase¹.

To assist trademark owners with the task of monitoring and protecting their brands while new gTLDs are issued, ICANN launched a Trademark Clearinghouse (the "Clearinghouse"). The Clearinghouse is tasked with (i) maintaining a database of authenticated trademark records; and (ii) providing notice and support in connection with pre-launch sunrise and trademark claims services, as further described below.

The Clearinghouse is currently accepting trademark records for verification and inclusion in its database and with the recent roll-out of new gTLDs, it is important for trademark owners interested in the Clearinghouse services to register their marks as soon as possible.

Who Can Register with the Clearinghouse?

Trademark owners with a federal or state registered word mark, a word mark that has been validated through a judicial proceeding, or a trademark that is otherwise protected by statute or treaty may register such mark with the Clearinghouse.

Why Register?

Trademark owners who want notice of potential infringement in connection with the use of a new gTLD and the opportunity to pre-register a domain name that includes their mark should register with the Clearinghouse. The annual cost of the Clearinghouse is \$150.00 per registration². For that fee, a trademark owner is entitled to participate in the pre-launch sunrise services and trademark claims services aimed at protecting second-level domain rights (i.e. everything to left of the dot), as follows:

	Duration	Benefit
Sunrise Services	30 days prior to public launch of new gTLD.	During the sunrise period, a trademark holder may register domain names corresponding to their marks before the names are generally available to the public.
Trademark Claims Service	90 days from the issuance of a new gTLD.	During the trademark claims period, the Clearinghouse will notify a registrant of a conflict with a trademark registered with the Clearinghouse. The trademark owner will receive notice of the attempted registration and, if the registrant proceeds with the domain name registration, the trademark holder may seek administrative relief under the Uniform Rapid Suspension (and other administrative remedies) to protect the owner's trademark rights.

¹A current list of delegated domain names can be found at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

²Multiple year registration options are also available at \$435 for a 3 year registration; \$725 for a 5 year registration.

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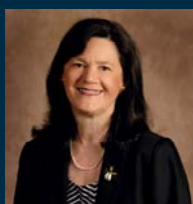
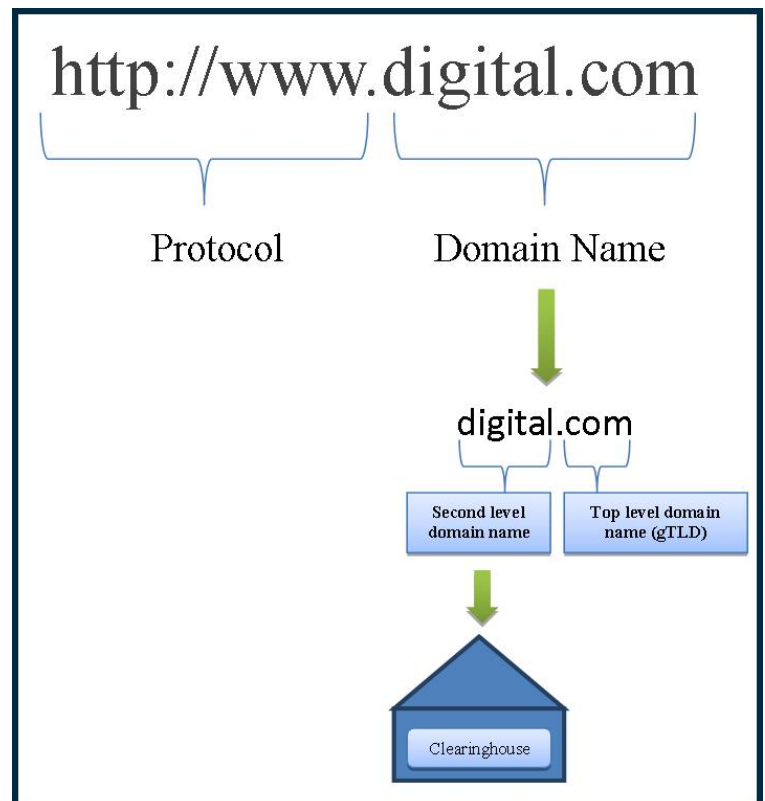
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Clearinghouse Limitations

The Clearinghouse protection does not extend to patents, designs marks, know-how or trade secrets. Trademark registrations that include top level extensions such as “mark.org” or “.mark” as the word mark will not be accepted by the Clearinghouse regardless of whether that mark has been registered or it has been otherwise validated or protected. Inclusion in the Clearinghouse does not create nor is it proof of any substantive trademark right.

For trademark owners, the issuance of new domain name extensions will undoubtedly make the cost of protecting their exclusive use of their registered trademarks more expensive. However, the Clearinghouse serves an important function in providing advance notice to the trademark owner of an application for registration of a domain name utilizing the owner's registered mark and the opportunity to acquire ownership of extensions that would place the owner's mark at the most risk.

For more information on issuance of new gTLD and trademark registrations with the Clearinghouse, please contact Virginia A. Hoveman or Eva K. Wojtalewski.



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