

The Medium

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Insane in the Do-main: The New gTLDs and the Trademark Clearinghouse



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ICANN (the entity that essentially controls the worldwide domain name system) is in the final stages of processing approximately 1,900 applications for new gTLDs (generic Top Level Domains – like ".com") many of which are expected to come online in 2013. Some of these applications are private brands, like .ford and .audi, while some generic gTLDs will likely only be used only by the owner – e.g. Safeway and Walmart have both applied to own .grocery. Many are also non-english names, and/or in non-western script, like (Samsung).

[Click here](#) to view the whole list.

Excluding all the private and esoteric new domains, that still leaves 1,000+ non-private, new, english-language gTLDs, including, to name a few: **.eco, .bank, .hotel, .apartments, .app, .porn, .art, .beer, .wtf, .sucks, .lawyer, .doctor, .engineer, .soccer, .university, .gay, .dog, .forsale, .education, .giving, .hockey, .mba, .medical, .school, .science, .sex, .soccer, .sports, .technology** – and the list really does go on and on (and on).

Businesses and other organizations may want their own trademarked names and brands registered as domains under the new gTLDs, or may wish to prevent their trademarks from being registered. For example, a famous brand like Adidas® may wish to register ADIDAS.shoes or ADIDAS.soccer, but prevent registrations with negative connotations.

The Trademark Clearinghouse

For registered trademark owners, a complex priority system has been created by ICANN to facilitate some limited protection of registered trademark rights in the brave new gTLD world. Using this priority system requires a trademark owner to submit its registered trademarks for "pre-clearance" through a new international agency called "The Trademark Clearinghouse" ("TMCH"). Note that generally only the word elements of registered trademarks can benefit from this priority system.

Submitting your registered mark to the TMCH achieves two goals. First, it gives you priority to obtain a domain name registration for your exact trademark in any new gTLD's "sunrise period" (i.e. before the general public can grab domain names in that new gTLD). This of course only applies when the trademark owner wants to register a new domain name. Using our example, Adidas would benefit from priority registration for ADIDAS.soccer if it submitted its trademark to the TMCH.

The second function of the TMCH is to give notices regarding pre-cleared trademarks in its system, where someone other than the trademark owner is obtaining a domain name matching the trademark owner's mark. In this case, a person attempting to register ADIDAS.shoes would receive a notice, and Adidas would simultaneously get a notice of the attempt to register the ADIDAS mark as a domain name. This notice only occurs during the initial 60 day "trademarks rights period" following the sunrise period, after a new gTLD opens up for registration of domain names.

Next Steps

Should the average business give a .crap about this? Even with TMCH registration, you will still be on your own for all costs of new domains, or to stop infringers. However, if you do perceive the new gTLDs could be important marketing tools for your business, the sunrise period priority will be a useful advantage to get the domain names you

want to enhance your brand. Also, knowing where your trademark is being registered as a domain name by others is good market intelligence, even if you choose to take no action to stop it.

- Do you have a federally registered trade-mark? If in doubt, contact us, or your trade-mark agent to confirm this.
- Consider the risks: what would happen if an exact match of that registered trade-mark was registered in a domain name, under one of the new gTLDs. Consider your industry and the generic domain names that correspond to that industry.
- If you decide that additional protection is warranted in light of the risks, contact us to review your marks, and the costs and benefits of using the TMCH.
- Our IP&T Group can assist to submit your mark to the TMCH.
- We can also assist to monitor the launch of specific domains that you have identified, and establish a notification system for the sunrise period and trademark rights period for those domains.

Contact one of our professionals in our experienced [Intellectual Property & Technology Group](#) for more information on how gTLDs may impact you.

This email is sent on behalf of Field Law's Intellectual Property & Technology Group. For more information on our services and contacts, please see our [webpage](#).

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