



Intellectual Property Law Alert

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New generic top level domains are here to stay — what can brand owners do to protect their portfolio's value in this new era?

A change is underway that has the potential to significantly impact how we use and do business through the Internet, with the launch of hundreds of new generic Top Level Domain (gTLD) names and hundreds more expected. Now is the time for brand owners to take important steps to protect their trademark portfolio.

Background

The Internet Corporation for Assigned Names and Numbers (ICANN) was established in 1998, with only eight domain names, including the familiar .edu, .gov, and .org. ICANN has since had two successful application rounds. The first in 2000, introducing .biz, .info and .museum; and in 2004, introducing .asia, .xxx, and .travel. Beginning in 2005, ICANN began development of a program policy that allows for the nearly unlimited establishment of new gTLDs. The gTLD program launched in January 2012 and hit the ground running, accepting 1,930 applications for new top-level domains. The ICANN website shows a list of [all new gTLD applications and status](#).

Many applicants were technology giants, such as Google, Amazon and Microsoft. Other heavily represented applicants were companies formed for the purpose of acquiring gTLDs and companies with an existing history of specialized domain name acquisition. There are three primary categories of new gTLDs: brand owners, generic terms and geographic names. Of these new gTLDs, many are language-specific and use non-English characters.

ICANN evaluates all applications and almost 1,775 have already passed Initial Evaluation. Once an application passes Initial Evaluation, the applicant will sign a Registry Agreement, and begin pre-delegation testing. Since November 2013, 282 applicants have signed Registry Agreements, and nearly 175 new gTLDs have cleared pre-delegation testing and been officially delegated; i.e., approved for launch. This number climbs weekly as ICANN works through the rest of the some 870 applications that have passed evaluation or are not subject to objections. Following are a few examples of gTLDs that have been delegated.

- .clothing
- .democrat
- .technology
- .singles
- .contractors
- .reviews
- .ventures
- .center
- .careers
- .bar
- .construction
- .luxury
- .bid
- .berlin
- .nyc



A complete list is on the [ICANN website](#). Once a launch date is set for a registry, the registry operator is required to implement the protection mechanisms set forth by ICANN to assist trademark owners in protecting their rights throughout the launch period.

Protection mechanisms

Trademark owners should be aware of proactive and reactive protection mechanisms they can use to effectively protect their trademark portfolios. ICANN has anticipated trademark owners' concerns about preventing the use of registered trademarks to the left of the dot, known as second-level domains, setting forth mechanisms to protect their rights by preventing unauthorized registration of their marks as second-level domains within the new gTLDs.

The Trademark Clearinghouse – proactive measures

ICANN established the Trademark Clearinghouse (TMCH) as a centralized repository for global trademark data to ensure the ongoing protection of trademark owners' rights worldwide. The TMCH is responsible for (i) verifying word-only trademark records filed by trademark owners and (ii) maintaining a database of verified trademark records. Recording trademarks in the TMCH is important because verified trademarks are eligible for the following two services:

Sunrise Services: Before the general public can seek to register second-level domains, all new registry operators must conduct a Sunrise period of at least 30 days. During this Sunrise period, the trademark owner has the opportunity to register domain names that match its trademark in the new gTLD before that gTLD becomes available to the general public.

Trademark Claims Services: The Claims Services period follows the Sunrise period and is required to last for at least the first 60 days of general registration. During this time, a potential domain name registrant will receive a warning if the proposed domain name is an identical match with a trademark record within the TMCH database. If the potential domain name registrant continues with the registration, the owner of the trademark will receive a notification concerning that domain name registration, which allows the owner to take the appropriate action expeditiously.

It is important to understand that only those rights holders who use the TMCH can benefit from both Sunrise and Trademark Claims Services; a mark owner who does not take advantage will not be eligible for the benefits of Sunrise and Trademark Claims Services. Only a trademark owner or a TMCH registered agent acting on behalf of the trademark owner can register a mark with the TMCH and take advantage of these proactive measures. Porter Wright is a TMCH registered agent.

ICANN clears new gTLDs to launch daily, and many of these gTLDs are currently accepting Sunrise registration or are scheduled to commence with the Sunrise period. [Read a list of current Sunrise periods](#). The assistance of a registered TMCH agent is helpful because trademark holders will not be actively notified of Sunrise periods by ICANN, the TMCH or registry operators, so careful monitoring of the launch, Sunrise periods and Trademark Claims periods for all new gTLDs will be necessary over the course of several years.

Mark owners may find it advantageous to retain a TMCH registered agent to assist them with submitting trademark information to the TMCH for registration. There are many nuances to filing a trademark record in the TMCH, which allows for more efficient record filings. The rules regarding filing are being modified continuously as the program develops and users must keep current and monitor the program closely to provide the most up-to-date information.

Dispute resolutions procedures – reactive measures

In addition to the TMCH protection mechanisms, ICANN has set up the Uniform Rapid Suspension (URS) system in addition to its already established Uniform Domain Name Dispute-Resolution Policy (UDRP).

URS – URS is designed to offer a very rapid relief mechanism for trademark holders to combat cybersquatting and other forms of trademark infringement by domain name registrants across all new gTLDs. This system is designed to be resolved in weeks and offers less expensive and faster responses than the existing UDRP system. The URS is more useful in cases of clear-cut infringement, where there are no disputes of material fact. The remedy in a successful URS complaint will result in the suspension of the challenged name, unlike in UDRP cases where the complainant gets control of the domain name for the duration of registration.

UDRP – UDRP is an established dispute resolution mechanism for trademark owners to resolve clear cases of bad faith, abusive registration and use of domain names. Complainants also can use this process when domain names are confusingly similar to their trademarks or service marks. Infringing domain names are then transferred to successful complainants' control. This method has proven effective previously, but the costs are much higher and results are less



certain compared with the proactive measures incorporated by ICANN through the TMCH Trademark Claims period and the URS procedure.

The URS and UDRP are useful in circumstances where registration has already occurred; they are intended to be reactive as opposed to proactive measures. Each action has its own benefits and associated costs. These methods should not be relied upon solely to combat the launch of the new gTLDs, but if use of these procedures is necessary, Porter Wright has experienced attorneys who can access and leverage these methods to effectively disable and recover infringing domain names.

Strategic planning to protect your trademark portfolio

As new gTLDs are launched daily and ICANN continues to clear new gTLDs for launch, it is imperative that trademark holders establish and implement strategic plans for monitoring and policing the gTLDs for infringement. It is impossible to predict the full implications of these new gTLDs; however, it is important to think about protection now, while the costs are relatively low.

Porter Wright attorneys can create and implement strategic plans to protect your trademark portfolio in this rapidly expanding Internet era, with:

- Pre- launch planning
 - o Evaluate existing domain holdings and brand protection strategies
 - o Evaluate trademark portfolio and create target lists for TMCH filings
 - o Plan and implement participation in the TMCH
 - o Review potential new gTLDs and advise of their potential implications to your brand; this process includes not only gTLDs that are relevant and opportunistic to your brand, but also those that could be used to disparage and tarnish your brand, such as .fail, .grip, or .sucks
 - o Adapt new or current domain name enforcement strategies to encompass new gTLDs
- Post- launch planning
 - o Implement domain name enforcement strategies to encompass new gTLDs
 - o Register second-level domain names in new gTLDs that are important to your brand
 - o Disable or recover infringing domain names through traditional dispute resolution mechanisms and those offered by ICANN

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