Trademark Clearinghouse Allows Trademark Owners to Monitor Registration of Generic Top-Level Domains

Legal Alert

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Jordan A. LaVine, Shareholder, and Elisa N. Bramble, Attorney

Beginning March 26, 2013, trademark owners will be able to register with the Trademark Clearinghouse (TMCH) to receive notifications regarding the proposed use of their trademarks in newly launched generic top-level domains (gTLDs).

The Role of the TMCH in the new gTLD Program

The Clearinghouse will be an important tool for trademark owners as thousands of new gTLDs are released through a program recently implemented to increase competition and diversity among domain names. Since the launch of the gTLD program in 2012, the Internet Corporation for Assigned Names and Numbers (ICANN) has received nearly 2,000 applications for new gTLDs such as .car, .bank, and .realtors. ICANN, the entity responsible for managing domain names across the Internet, is establishing the TMCH to allow trademark owners to monitor applications for new gTLDs and decide when to take additional steps to protect against unauthorized uses of their trademarks.

The TMCH Claims Service and Notifications Regarding New gTLDs

The TMCH will be a database of U.S. and foreign trademarks. Trademark owners who submit their marks to the TMCH and whose marks are successfully verified will receive notification when a gTLD applicant seeks to register a domain name that is an exact match to their trademark(s). Notification is also sent to the gTLD applicant when it attempts to register a domain name that matches a trademark registered with the TMCH. These notifications will be sent as part of the TMCH Trademark Claims Service during the first 60 days that a gTLD registry is open to the general public.

To receive the notifications discussed above, trademark owners must register each of their trademarks. The cost for one year is $150 per mark, which includes the association of up to 10 domain names chosen using TMCH matching rules. Trademark owners must pay additional fees to have additional names associated with their record or for registration for an additional 2 or 4 years.

Potential Limitations of the TMCH Claims Service

While the TMCH will likely serve as a valuable repository of information related to registered trademarks, its benefits are not without limitation. The TMCH will not allow the registration of unregistered trademarks or marks associated with pending trademark applications, and ICANN will only send notifications regarding domain names that are exact matches to the registered trademark. Misspellings by typo-squatters are not included in the TMCH matching rules. Furthermore, the registration of a trademark with the TMCH does not automatically block registration of potentially infringing domain names. Trademark holders seeking to

enforce their rights must resort to normal dispute resolution procedures.

Preparing for TMCH

In preparation for the launch of the TMCH on March 26, consider doing the following:

- Identify your company or organization's most important trademarks.
- Become familiar with the process for registering trademarks with the TMCH.
- Discuss with your attorneys the planned course of action for when you receive notification of an application to register a matching domain name.

As always, we are here to assist with any questions you have and look forward to answering your questions regarding the TMCH practice. For more information regarding the Trademark Clearinghouse or for assistance with the TMCH registration process, please contact one of our trademark attorneys.

ATTORNEYS MENTIONED

Jordan LaVine