

Protecting Your Brands in the New gTLDs
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The landscape of the Internet is beginning to change rapidly with the launch of hundreds of new gTLDs. A gTLD (generic top-level domain name) is the top-level domain name of an internet address that identifies it generically as associated with some domain class, such as .com, .net, .org, .gov, and .edu. Trademark owners are likely to have their company or brand name registered as a second-level domain in conjunction with a gTLD such as IBM.com. IBM is the second-level domain and .com is the top-level domain. Until recently there were approximately 24 top-level domains in which businesses and individuals could register their chosen names. But over 1,300 new gTLDs have been approved to launch beginning in late 2013 and continuing over the next several years.

These new suffixes represent various subjects, industries, hobbies and geographic locations such as .shop, .coffee, .app and .berlin. Many see this as the opening of a new internet frontier providing more choice, diversity and competition in domain name presence. The .com domain has become very crowded, making it difficult for new businesses to register their names and establish a brand-identifying presence in this top-level domain environment.

Business owners may wish to take advantage of promoting their brands in the new industry specific gTLDs, such as IBM.computer. But for trademark owners it also opens new avenues for cybersquatting. Businesses must now adopt strategies to protect their trademarks from registration by others as second-level domains in new gTLDs related to their particular industry.

The Internet Corporation for Assigned Names and Numbers (ICANN) has developed the Trademark Clearinghouse (TMCH) as a rights protection mechanism for trademark owners. The TMCH will allow brand owners to register their trademark ownership information into a centralized database. The TMCH will then authenticate and store the information and, eventually, disseminate it to all new gTLD registries for use in connection with the “Sunrise Service” and the “Trademark Claims Service” described below. Brand owners will be required to submit their trademark information (such as U.S. or other country registration data) to the TMCH in order to participate in these rights protection mechanisms. There is no stated deadline by which brand owners need to register with the TMCH, and the verification system will be available on an ongoing basis as new gTLDs are approved. However, trademark owners will want to register prior to the Sunrise Period for gTLDs of concern, as described below.

The first advantage of the TMCH is the Sunrise Service, the right to acquire second-level domains for trademarks in new gTLDs during the sunrise period – the 30-day period after a new gTLD launches. Trademark owners registered with the TMCH may purchase second-level domain names for the new gTLD before the name is made available to the general public. For many companies, this will be a defensive registration, to prevent cybersquatters, competitors, or innocent parties from obtaining domain names that infringe or cause other problems. For example, a restaurant franchise may want to register its primary mark in the .restaurant or .food gTLD, and a wide variety of companies, especially those that have been targeted by abusive derogatory websites, may want to register defensively in the .sucks gTLD. To take advantage of this period, a trademark owner must provide evidence of use of the relevant trademark.

The second advantage of the TMCH is the Trademark Claims Service. During the first 90 days (or longer, depending on specific gTLD policies) following the sunrise period, the trademark owner will be notified when any third-party seeks to register a second-level domain name identical (or nearly identical) to a mark registered with the TMCH in any of the new gTLDs. During that process, the registry also notifies the gTLD registrant about the trademark owner's rights in the mark. The trademark owner will then be able to enforce its trademark rights through the new Uniform Rapid Suspension System (URS). The URS complements the existing Uniform Domain-Name Dispute Resolution Policy (UDRP) by offering a cost-effective, expedited procedure for rights holders experiencing clear cases of infringement.

Trademark holders may submit their registration applications directly to the TMCH or through authorized agents. The filing fees associated with registration will vary, depending on the registration method and fee structure selected by the brand owner but, in most cases, registration with the TMCH will carry a filing fee of \$150 per mark for a one-year period, \$435 for a three-year period, and \$725 for a five-year period. The three-year period is recommended because the launch of the new gTLDs will not be completed within the next year.

Brand owners should strategically analyze their trademark portfolios to determine which marks may benefit from the services the TMCH offers. Most experts are recommending that companies look to register only exact matches of their core trademarks in registries where there is a close correlation between the brand and the TLD. For example, financial institutions should consider registering in TLDs such as .bank, .loan(s), and .mortgage. Breweries may wish to register in the .beer gTLD. Identifying these kinds of close matches is not too difficult because only a portion of the new gTLD's are industry specific and open to the public. In addition, brand owners should plan to submit any trademark for which they desire a Sunrise registration. The list of new gTLD's that have launched to date may be found at <http://newgtlds.icann.org/en/program-status/delegated-strings>. The list of gTLD's that have been approved for later launch dates may be found at <http://www.newgtlds.com/new-gtld-list/>. Rights holders may also wish to monitor the gTLDs once they go live and consider utilizing the URS or other dispute resolution procedures to bring claims against domain name registrants or abusive registry operators.

It remains to be seen whether these new gTLDs will be embraced by the business community. It will take time to build awareness and acceptance among Internet users. Some suffixes will thrive and others will fail, and only time will tell whether any new domain address will ever be as valuable as .com. But internet habits will be changing and brand owners are wise to get involved now in domain acquisition planning from both a defensive and offensive perspective.