

March 11, 2013

## Protect Your Trademark Online: Global Trademark Clearinghouse to Begin Accepting Submissions

On March 26, 2013, the Internet Corporation for Assigned Names and Numbers (ICANN) will begin to allow trademark owners to submit their marks for inclusion in a newly created Trademark Clearinghouse, which is intended to serve as a single centralized database of verified information that will enable trademark holders throughout the world to better protect their rights on the Internet. This follow-up to "[New Generic Top-Level Domain Names: What Brand Owners Need to Know](#)" (June 15, 2012) introduces brand owners (and their licensees, assignees and agents) to several key elements of the Trademark Clearinghouse submission process, and describes the primary benefits that the Trademark Clearinghouse promises to provide to trademark rights holders.

### Background

ICANN, the private nonprofit corporation that manages most top-level domains (TLDs) and IP addresses, developed the Trademark Clearinghouse (in connection with Deloitte and IBM) as part of its new generic Top-Level Domain (New gTLD) Program. Generally speaking, the New gTLD Program allows any legal entity to file an application to create a new gTLD—the general domain name address extensions that come after the last dot (such as .com, .net., .org)—and, as a result, has the potential to significantly expand the existing Internet infrastructure by increasing the number of gTLDs to an almost unlimited amount (and simultaneously expanding the potential for online trademark infringement). Amid this expansion, the Trademark Clearinghouse was created to protect trademark rights holders by permitting them to more easily register second-level domain names under new gTLDs (e.g., YOURNAME.example), and to allow gTLD operators and registries to better review and assess trademark claims.

### The Submission Process

The Trademark Clearinghouse will initially accept and verify for registration (1) nationally or regionally (i.e., multi-nationally) registered trademarks; (2) court-validated marks; and (3) marks protected by statute or treaty. Trademarks that are the subjects of pending applications or are inactive or invalid may not be registered.

Although the specific type of information and documentation required to verify a trademark record will vary depending on the type of mark, the Trademark Clearinghouse will generally require trademark rights holders to submit information regarding the mark itself, details about any applicable registration, court reference numbers or other documentation evidencing rights, the goods and/or services covered and the corresponding Nice classification(s), the country(ies) in which the mark is protected, the name and contact information of the trademark rights holder, and, for purposes of obtaining applicable Sunrise Services, certain verification of proof of use of the mark, which may include a signed declaration and specimen(s) of trademark use (e.g., labels, tags, containers, advertising and marketing materials). All trademark submissions will be subject to verification by Deloitte Enterprise Risk Services.

For more information, or if you have any questions, please contact your Katten Muchin Rosenman LLP attorney or any of the following members of Katten's **Intellectual Property Practice**.

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This verified trademark data will support the two primary benefits that the Trademark Clearinghouse promises to provide to trademark rights holders: Sunrise Services and “Trademark Claims” for all new gTLDs. The cost charged by ICANN for making a submission to the Trademark Clearinghouse will vary from US\$95 to US\$150 per year for a single mark, with discounted fees available to trademark rights holders who seek registration for three years (US\$435) or five years (US\$725). The Trademark Clearinghouse’s submission guidelines and basic fee structure are available for download at its [official website](#).

## Sunrise Services

By registering a trademark with the Trademark Clearinghouse, a trademark rights holder will be permitted to register second-level domain names under new gTLDs (e.g., YOURNAME.example) during a “Sunrise” period of at least thirty (30) days before registration of such names is made available to the general public. All new gTLD applicants are subject to this mandatory “Sunrise” period after the registration of the new gTLD with a registry. Access to “Sunrise” registration will provide trademark rights holders with a relatively low-cost means by which to obtain some level of control of, and some ability to safeguard, second-level domain names comprised of their trademarks.

## Trademark Claims

Registering a trademark with the Trademark Clearinghouse will also entitle a rights holder to a “Trademark Claims” service following the “Sunrise” period. This “Trademark Claims” service will extend for at least the first sixty (60) days after a new gTLD is open for registration with the general public. At the outset, the “Trademark Claims” service will provide a warning of potential infringement to any third party attempting to register a domain name that matches a trademark registered with the Trademark Clearinghouse. In the event that the third party proceeds to register the domain name despite such a notice, the “Trademark Claims” service would send an automated notification to the trademark holder alerting it to the potential infringement. Although the Trademark Clearinghouse will not bar registration of the potentially infringing domain name, the “Trademark Claims” notice will expeditiously inform the rights holder and enable it to consider whether to take action.

As a practical matter, the “Trademark Claims” service will only identify identical matches to eligible trademarks. In other words, “Trademark Claims” notices will only be generated if the domain name label consists of the complete and identical textual elements of the trademark registered with the Trademark Clearinghouse. As a result, even a domain name containing a plural version of the mark would not be considered an identical match. Typos and “trademark + generic term” domain name labels also would not be considered identical matches. To the extent a trademark contains any special character that cannot be represented in a domain name, e.g., “@” or “!,” such character may be either omitted, replaced by hyphens, or spelled out with appropriate words of the official language(s) of the country/jurisdiction in which the mark is protected. Accordingly, if a trademark rights holder is interested in obtaining additional protection against the use and registration of infringing domain names, it may wish to work with legal counsel and use a private domain name watching service.

## Conclusion

The launch of the Trademark Clearinghouse marks a phase of ICANN’s New gTLD Program that would appear to be particularly significant to brand owners and licensees. In view of the numerous ways in which the New gTLD Program promises to alter the existing Internet infrastructure, trademark rights holders may wish to consider the benefits of early registration with the Trademark Clearinghouse and work with counsel to develop other cost-effective strategies to protect their trademarks and other valuable intellectual property rights.

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