

PUBLICATION

Q & A: ICANN's Global Trademark Clearinghouse

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The Internet Corporation for Assigned Names and Numbers (ICANN), the body tasked with coordinating and preserving global Internet stability, is embarking on its largest expansion ever of the domain name system. Last week, on March 26, ICANN launched a global Trademark Clearinghouse (Clearinghouse) as part of its generic Top Level Domain (gTLD) program. The newly-formed Clearinghouse will dramatically change the landscape of our domain name system, creating thousands of new domain names in addition to those existing gTLDs (that is, the words that appear to the right of the "dot" in a domain name). Currently-available gTLDs that you may be familiar with include .com, .org, .biz, and .net, but ICANN has already received over a thousand applications for new gTLDs, such as .baby, .food, .law, and more.

1. Why Register With The Clearinghouse?

Registration with the Clearinghouse is not mandatory, but may provide trademark holders with additional safeguards against cybersquatting, counterfeiting and other types of infringement as new gTLDs go live. Registration with the Clearinghouse also provides trademark owners with access to two new services: the Sunrise Service and the Trademark Claims Service.

- *The Sunrise Service*

The Sunrise Service allows Clearinghouse registrants an opportunity to register domain names for their trademarks before a new gTLD launches to the general public. During these Sunrise periods, trademark holders who have registered a trademark with the Clearinghouse will have at least 30 days before names are generally available to the public in which to register their mark(s) with the new gTLD. These Sunrise periods occur on a rolling basis as new gTLDs are introduced.

- *The Trademark Claims Service*

The Trademark Claims Service follows the Sunrise period, and runs for a period of at least 90 days after a new gTLD opens for general registration. During this period, if a third party attempts to register a domain name that is identical to a trademark registered with the Clearinghouse, that third party will receive a warning notification with the registered trademark information. If, after receiving the notice, the third party registers the disputed domain name, the Clearinghouse registrant will receive notice that someone has registered a domain name that is identical to his Clearinghouse trademark record. The notice to third parties serves as actual notice of possible infringement, which may be used as evidence of that party's bad faith in registering the domain name in any resultant litigation.

2. Who May Seek Clearinghouse Protection?

Four types of word marks are eligible for inclusion in the Clearinghouse:

- nationally or regionally (that is, multi-nationally, such as CTM registrations) registered word marks from all jurisdictions;
- word marks that have been validated through a court of law or other judicial proceeding;

- word marks protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion; and
- other marks that constitute intellectual property.

Certain marks are ineligible for registration with the Clearinghouse, including, but not limited to, trademark applications, trademark registrations issued by a city, state, province or sub-national region, and registered marks that were subject to successful invalidation, cancellation, opposition or rectification proceedings.

3. How Do I Register A Trademark With The Clearinghouse?

The Clearinghouse began accepting applications for registration on March 26. Trademark holders may now submit their trademark data to <http://www.trademark-clearinghouse.com/> before any new gTLD registries launch. To register, trademark holders (or their agents) will need to provide certain information related to an eligible trademark. This information includes, without limitation: the name of the mark, registration number, registration date, jurisdiction, a detailed description of goods and services, the status of the trademark holder, and contact information for the trademark holder, among other information. The Clearinghouse reviews this data to determine whether the mark is eligible for protection, and may request additional documentary evidence if it determines the submitted trademark data is incomplete or incorrect.

If the trademark holder wishes to opt in for the Sunrise Service when submitting a trademark for registration with the Clearinghouse, he must also submit proof of use of the mark. This proof of use must have two elements: (1) a signed declaration of use, and (2) a sample showing the mark in use (such as a product label or marketing materials).

4. How Much Does It Cost To Register?

Under the basic fee structure, trademark registrations with the Clearinghouse can be designated for one, three, or five years. The costs for such registrations are: \$150 per mark for one year; \$435 per mark for three years; and \$725 per mark for five years. The basic fee structure requires payment by credit card and is limited to 10 trademark registrations per card. There are no additional fees for opting in or out of the Sunrise and/or Trademark Claims Services.

There is also an advanced fee structure for users who set up a prepayment account. The Clearinghouse also offers discounted pricing to trademark holders based on the volume of marks registered or renewed.

5. Is The Clearinghouse For Me?

Registration with the Clearinghouse will not necessarily prevent cybersquatting or other trademark infringement and does not guarantee that you will automatically get your trademark as a domain name in all new gTLDs. However, with the launch of the Clearinghouse, ICANN has added another weapon to the arsenal of trademark holders in policing their marks. Taking advantage of these new safeguards may be a worthwhile way to protect the value of your brands. Our intellectual property team is available to discuss whether Clearinghouse registration is right for you.

If you have any questions or need further information, please contact a member of our Intellectual Property Group.