

INSIGHTS

## Key Trademark Rights Protection Mechanism for New Top-Level Domains Opens March 26, 2013

February 28, 2013

The first of hundreds of new generic top-level domain name (gTLD) registries<sup>1</sup> are expected to launch in the summer of 2013. The Internet Corporation for Assigned Names and Numbers (ICANN), the NGO that regulates the domain name space, published its official [Trademark Clearinghouse \(Clearinghouse\) Guidelines](#) on Feb. 26, 2013, providing details about a key rights protection mechanism for brand owners. The Clearinghouse will "go live" [on Mar. 26, 2013](#) under [Deloitte's oversight](#), and brand owners should be ready to add their key brands to the Clearinghouse soon after the service launches.

### Why Should Trademark Owners Take Action?

The Clearinghouse provides two big benefits to trademark owners. First, brand owners have to record their marks in the Clearinghouse in order to be able to register domain names corresponding to the recorded marks in special early-registration periods ("sunrise" periods) that will be available to qualified trademark owners in all the new gTLDs. Second, there are two notice benefits. Third parties that attempt to register domains in the new gTLD spaces will be warned about the trademark owner's rights in the mark before they can register similar domain names, and so may choose to bypass registering the domain name entirely. If the domain name is registered anyway, the trademark holder or its designated agent is immediately notified.

### How Will It Work?

The Clearinghouse is open to marks that have been registered on a national or international trademark registry<sup>2</sup> and to certain other rights like common-law marks, court-validated marks, marks derived from treaties, etc. but only upon provision of additional proof. Marks that contain a "dot" or period – including marks that include a domain name extension – are not eligible. All trademark owners, even owners of registrations, will need to submit a declaration of use and a sample showing use of the mark. Trademark owners can either submit their own marks to the registry, or have an agent do so on their behalf.

### What Will It Cost?

Costs depend on the number of marks recorded in the Clearinghouse, and how long the renewable Clearinghouse recordation will last. The [complete fee structure](#) is a Byzantine affair, but Clearinghouse costs will be no more than:

- \$150 for one mark, one year
- \$435 for one mark, three years
- \$725 for one mark, five years

**Next steps.**

If you would like to prepare your business for the Clearinghouse launch, please contact the Bracewell & Giuliani attorney with whom you usually work or any of the authors of this update.

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<sup>1</sup> For more background, please see our prior updates [here](#).

<sup>2</sup> Other than an International Registration in the Madrid system without national effect.