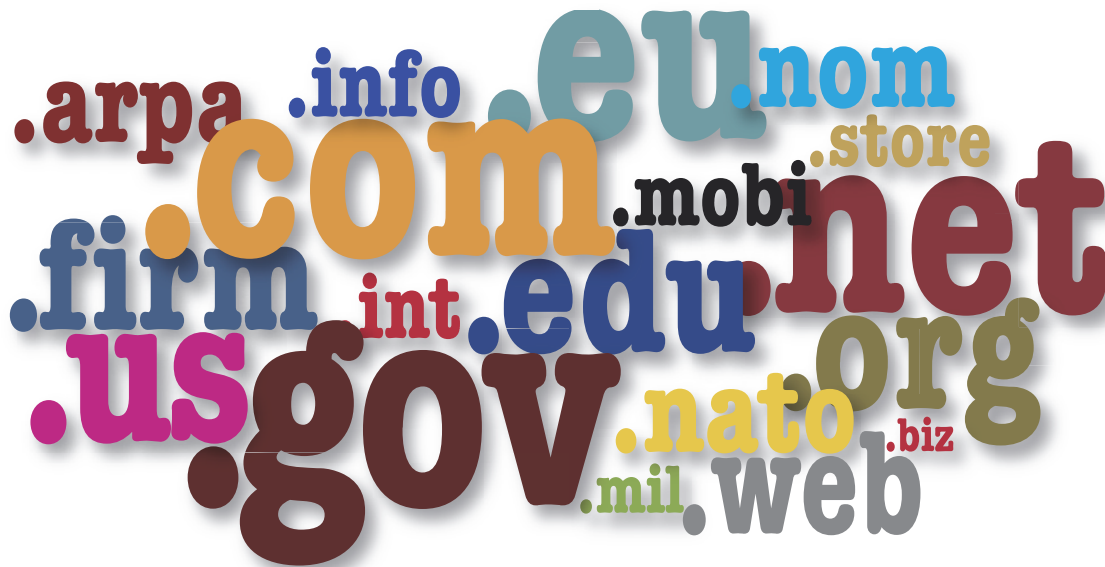


DOT ANYTHING

PROTECTING YOUR BRAND IN THE NEW DOMAIN NAME ERA



Terrence H. Link II and Suzanne K. Ketler Roetzel & Andress

What do *.equipment*, *.tools*, *.farm*, *.build*, *.company*, *.cool*, *.coffee*, and *.guru* have in common? These domain name endings and more than 100 other domain name endings have been approved for use. These new endings are a part of a new domain name era that could change the way businesses and people find products and services on the Internet. Most organizations today use domain name endings with *.com*, *.org*, *.net*, *.info* or *.biz*. These “right of the last dot” domain name endings are commonly known as generic top-level domains or “gTLDs.” These gTLDs are governed by a non-profit entity called the Internet Corporation for Assigned Names and Numbers (ICANN). In 2012, ICANN decided to drastically change the domain name landscape by allowing businesses and other organizations to apply to operate new registrars for domain names ending in new gTLDs of their choice. These new gTLDs may consist of company or brand names (such as *.nike*, *.roetzel*, or *.uslaw*), or they may consist of generic terms (such as *.shoes* or *.law*).

ICANN’s new gTLD program presents significant opportunities and risks for organizations with respect to protecting and maximizing the value of their brands.

Previously, trademark owners had to police only 22 top-level domains for infringing domain names and cybersquatters. With the new gTLDs, trademark owners will now have to monitor hundreds more top-level domains. This article briefly explores ways in which trademark owners can monitor their brands on the new gTLDs and defines actions they can take to protect their brands if infringement arises.

A QUICK RECAP OF THE gTLD APPLICATION PROCESS

ICANN accepted new gTLD applications from January through May 2012. In that period, ICANN received 1,930 applications for 1,409 new gTLDs, including generic terms, geographic terms and brand names, in a variety of languages and scripts. The application process included an evaluation, public comment period, objection procedures, signing a registry agreement, and pre-delegation testing.

As of the date of this article, ICANN has approved for use more than 100 new gTLDs. A complete list of these delegated new gTLDs is available at <http://newgtlds.icann.org/en/program-status/delegated-strings>.

With the time allowed for registering objections to the new gTLDs having run out, trademark owners should be asking themselves two questions. First, how should I monitor new gTLDs for registrations of domain names similar to my trademarks? Second, what should I do when a domain name infringing my registered trademark is registered on a new gTLD?

MONITORING AND BRAND PROTECTION IN THE NEW gTLDs

The Trademark Clearinghouse: ICANN created the Trademark Clearinghouse (“Clearinghouse”) as a brand protection mechanism for trademark owners in connection with new gTLDs. The Clearinghouse is a database, jointly administered by Deloitte and IBM, in which trademark owners can record their federally registered trademarks, court-validated common law marks, or trademarks protected by statute or treaty. Trademarks may be recorded in the Clearinghouse for renewable terms of one, three or five years. The cost to record a mark in the Clearinghouse is \$150 per trademark per year with discounted pricing available based on recording a high volume of trademarks.

A trademark owner must meet other requirements in order to record an eligible trademark with the Clearinghouse. Specifically, the trademark owner must prove current use of the mark by providing one specimen of use and a declaration. In addition, the application for the trademark being recorded must have been filed before June 13, 2012, which is the date on which ICANN made the new gTLD application list public. Moreover, the registration for the trademark being recorded must have issued on or before the date of the registry agreement for the relevant gTLD.

Recordation with the Clearinghouse provides a trademark owner with two primary benefits. First, it allows the trademark owner to participate in the “sunrise period” for registering domain names on a new gTLD of interest. The sunrise period allows the trademark owner a period of 30 days before the new gTLD becomes generally available to the public in which to register domain names corresponding to its mark. However, to participate in the sunrise period the trademark owner must have recorded its trademark with the Clearinghouse before the beginning of the sunrise period for the gTLD in question. To make this easier for trademark owners, ICANN requires each registry to provide 30 days advance notice prior to the start of the sunrise period for a gTLD.

The second primary benefit of recording a trademark with the Clearinghouse is that a trademark owner receives notification if another party registers a domain name on the relevant gTLD that is identical to the owner’s registered mark. For at least 90 days after the sunrise period of a gTLD, domain name applicants on that gTLD will receive notice if their applied-for domain is identical to a trademark recorded in the Clearinghouse. If so, and if the applicant proceeds to register the domain name anyway, the trademark owner will be notified of the registration. If desired, the trademark owner can take one or more of the enforcement actions detailed in the next section.

The recordation of a trademark in the Clearinghouse is not a requirement for bringing enforcement proceedings and a decision not to record with the Clearinghouse cannot be used against a trademark owner in an enforcement action.

The Clearinghouse has received criticism because the benefits afforded to a trademark owner who records a trademark with the Clearinghouse do not extend to misspellings, plurals, or other closely similar terms. An exact match to the recorded trademark is required, although the Clearinghouse does offer trademark owners

the ability to connect their recorded trademarks to a certain number of “abused domain names” consisting of misspellings, plurals, or other closely similar terms. In order to qualify as an “abused domain name,” the domain name must either be the subject of a legal proceeding, or fall under ICANN’s Uniform Domain Name Dispute Resolution Policy, discussed below.

Use of Domain Name Watch Services:

If a trademark owner does not wish to record its trademarks with the Clearinghouse, and instead simply wants to be aware of potentially conflicting domain names being registered on one or more new gTLDs, a private domain name watch service may be more useful and cost-effective. Employment of a watch service typically costs the same, or less than, registration with the Clearinghouse, and provides notice for a year or more – well beyond the 90-day post sunrise period as provided by the Clearinghouse.

ENFORCEMENT ACTIONS IN THE NEW gTLDs

Trademark owners have various enforcement strategies available to them under ICANN’s new gTLD program in the event they learn of infringements.

Post-Delegation Dispute Resolution Procedure: After the launch of a new gTLD registry, a trademark owner may bring a Post-Delegation Dispute Resolution Procedure (“PDDRP”) against the operator of the new gTLD, if that operator is causing harm. The PDDRP addresses the gTLD operator’s complicity in trademark infringement. Before bringing the action, an aggrieved party must notify the operator and seek amicable resolution.

Uniform Domain Name Dispute Resolution Policy: After a new gTLD is launched and registration of domain names on it begins, a trademark owner may bring a Uniform Domain Name Dispute Resolution Policy (“UDRP”) proceeding against an infringing domain name being registered on the new gTLD. This proceeding, which requires that the offending domain name be registered in “bad faith,” is the same type of proceeding that is currently available for infringing domain names on the old gTLDs such as .com and .org. Remedies in a UDRP proceeding are limited to transfer of the infringing domain name to the trademark owner. Monetary damages are not available.

Uniform Rapid Suspension System: After a new gTLD registry is launched and registration of domain names on the registry is underway, a Uniform Rapid Suspension (“URS”) action is available to

trademark owners for enforcement of their rights. The URS is a quicker and less expensive version of the UDRP proceeding. The URS action differs from the UDRP proceeding in that it results only in the temporary suspension of the offending domain name, rather than a transfer of it to the trademark owner. While a trademark need not be recorded in the Clearinghouse in order to use this procedure, the trademark must be of a type that is eligible for inclusion in the Clearinghouse, and the trademark owner must be able to provide proof of use of the mark if it is not included in the Clearinghouse.

CONCLUSION

ICANN has yet to announce a new application period for additional new gTLDs and it is too early to determine whether the new gTLDs will affect how businesses and individuals use the internet. Even so, businesses that do not develop registration, monitoring and enforcement strategies for the new gTLD program may miss an opportunity to strengthen the value of their brands by utilizing the new gTLDs themselves, or, failing that, may find themselves spending significant dollars to try to wrestle their brands back from cybersquatters or other third parties who have secured the brands as domain names.



Terrence H. Link II of Roetzel & Andress LPA regularly serves as outside corporate and trademark counsel to clients ranging from owners of closely held businesses to large, publicly traded corporations. He advises business owners, corporate executives, and in-house attorneys with respect to a variety of corporate, M&A, intellectual property, trademark, technology, licensing, internet, and domain name matters.



Suzanne K. Ketter, Ph.D. of Roetzel & Andress LPA focuses her practice on trademark prosecution both domestically and internationally. She has significant experience in managing large and complex international trademark portfolios, as well as in counseling clients on all aspects of trademark protection, trademark enforcement, and branding strategy. She represents clients in a variety of trademark infringement, trade dress infringement, and copyright infringement matters as well.