



BB-Online.com

## Protecting your trademarks online

FACTS & FAQs



# — TRADEMARK CLEARINGHOUSE 101 —

## Protecting your trademarks online

The launch of new web addresses, known as generic top level domain names (gTLDs) will greatly expand the domain name system (DNS), offering brands and businesses massively more choice over their web addresses. However, with so many new possibilities on the horizon, concerns have been raised about how brands with trademarks can be best protected during the period of significant change online. As each new TLD is rolled out, the threat to intellectual property is set to increase as the breadth of opportunities for cybersquatting and other potentially infringing activities becomes available. As part of preparations for the launch of new gTLDs, ICANN developed, through its unique processes, mechanisms that enable trademark holders to protect their rights during the DNS expansion.

When a new gTLD is released by ICANN, the verified data in the Trademark Clearinghouse will be used to support two services known as the Sunrise Process and Trademark Claims Process. The Trademark Clearinghouse will play an important role within the new gTLD programme and in the ongoing protections of trademark rights on the internet.

CLEARINGHOUSE



**How will registering trademarks  
with the Trademark Clearinghouse  
protect companies' intellectual  
property?**



The Trademark Clearinghouse functions by being a unique, global repository of authenticated information from trademark (rights) holders and then providing this information in a standard form to the domain name services industry (registries and registrars). The benefits of recording a trademark in the Clearinghouse include access to Sunrise Period registration within each new gTLD and the Trademark Claims service.

1. **Sunrise** is an initial period of at least 30 days before domain names are offered to the general public. Trademark owners can take advantage of the Sunrise Period to safeguard the domain name or names that matches their trademark/s. A Sunrise Period is mandatory for all new gTLDs and having a verified trademark entry in the Clearinghouse is the minimum requirement to participate in this limited pre-registration period. So, to be prepared for “the biggest Sunrise ever”, you must make sure that you enter any trademark that needs protection into the Clearinghouse.

2. The Trademark **Claims service** follows the Sunrise Period. It is a notification service – mandated by ICANN for all new gTLDs – to warn both potential domain name registrants as well as trademark holders (with their marks in the Clearinghouse) of possible infringements.

The service works as follows:

- Potential domain name registrants receive a warning notice prior to registering a domain name that matches a trademark term in the TMCH
- If, after receiving and accepting the notice, the domain name applicant does continue to register the domain name, the trademark holder with a corresponding mark will receive notification of the domain name registration, so they can take any appropriate action should they so wish.

**I want to participate in a Sunrise.  
Does my trademark have to be  
registered in the Trademark  
Clearinghouse?**

REGISTRATION

**Yes** – the only way to register a domain name matching your trademark during a new gTLD Sunrise Period is with the Signed Mark Data (SMD) file. This file is generated by the Clearinghouse and only provided once a trademark record has been verified.



Register !





# Does the Trademark Clearinghouse use a first come first served principle?





**No.** As there is no first come first serve principle in terms of verification of the trademark record by the Clearinghouse, identical terms can co-exist in the Trademark Clearinghouse in the same way as they exist in trademark registries all over the world. For example there can be multiple “Apple” trademarks recorded in the Clearinghouse, provided that they all are registered as current, valid trademarks.

It nevertheless makes sense to submit trademarks to the Clearinghouse as soon as practically possible to make sure that the verification of your trademark occurs before the TLD you might be interested in goes live. To give you an additional peace of mind, the Clearinghouse has created an Early Bird period. This means that the first annual billing period will only start when the first new gTLD goes live.



**What sense does it make  
to record a mark in the  
Clearinghouse  
for multiple years?**



Deciding to record a mark in the Trademark Clearinghouse for multiple years is a matter of peace of mind. No one can be sure how long the roll out of the new Top Level Domains will take and ICANN has stated that it intends open additional TLD rounds in the future. Entering trademarks for more than one year means that businesses only have to go through the registration process once in order to ensure that they can protect their trademarks as new TLDs are released. In addition, a discount is given to trademark holders who enter their trademark record in the Clearinghouse for more than 1 year.

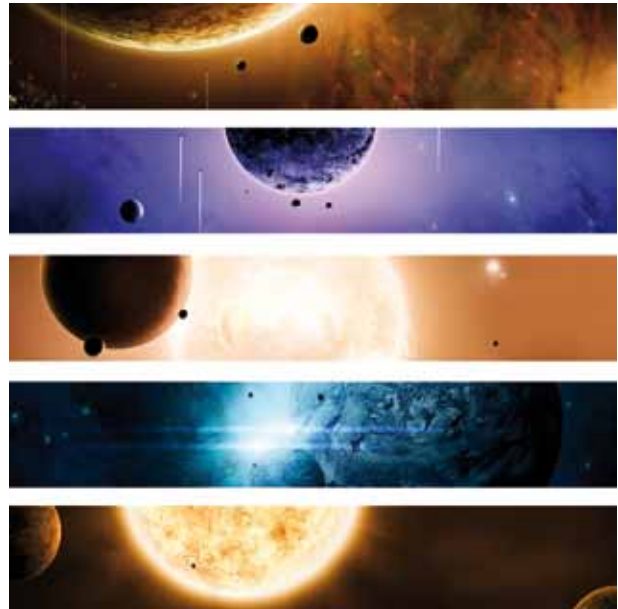
Future rounds of the new gTLD programme – including TMCH involvement – have not been confirmed. However, as TMCH was created specifically by ICANN as the only authorised and universal means to protect their trademarks during the new gTLD rollout, we expect that we will continue to support the new gTLD initiative if future rounds take place.






**Will all Sunrise periods  
for the new gTLDs  
operate in the  
same way?**

The Trademark Clearinghouse does not have any authority to decide how the Sunrise Service will operate for each new gTLD. Decisions about how each Sunrise period will work are made by the individual domain registries. The role of the Clearinghouse is to be an authoritative source of verified data to support the relevant processes.



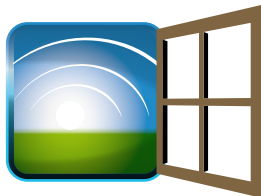


A close-up photograph of a hand wearing a black leather glove, with the index finger pointing towards a laptop keyboard. The keyboard is silver and black, and the background is a blurred blue surface.

**What options will a trademark owner have when challenging a domain name registration if someone tries to register a new web address using a company's trademark?**



**Sunrise** services allow trademark holders an advance opportunity to register domain names corresponding to their marks – either defensively or with a view to exploiting a valuable new web address - before new names are made available to the public. New gTLD registries are required to offer a Sunrise period of at least 30 days.



The Trademark **Claims** period follows Sunrise and runs for at least 90 days after the opening of general registration. During the Trademark



Claims period, anyone attempting to register a domain name matching a mark that is recorded in the Trademark Clearinghouse will receive a notification displaying the relevant mark information.

If the notified party goes ahead and registers the domain name, the Trademark Clearinghouse will send a notice to the one or more trademark holders with matching records in the Clearinghouse, informing them that someone has registered the domain name.



Additional protections are also available to rights owners, but these are limited to reacting to a domain name registration once registered. In order to take advantage of the global rights protection mechanisms built into ICANN's new gTLD programme launch, submissions to the Trademark Clearinghouse are necessary.

Post launch, additional options include:

### **Uniform Domain-Name Dispute-Resolution Policy (UDRP)**

The UDRP is a dispute resolution mechanism for trademark owners to resolve clear cases of bad-faith, abusive registration and use of domain names – or when domain names are confusingly similar to a trademark or service mark in which the complainant has rights. To prevail in a UDRP complaint, the complainant must further demonstrate that the domain name registrant has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith. In the event of a successful claim, the infringing domain name registration is transferred to the complainant's control.

## Uniform Rapid Suspension (URS)

Uniform Rapid Suspension (URS) is a rights protection mechanism that complements the existing UDRP by offering a lower-cost, faster path to relief for rights holders experiencing the most clear-cut cases of infringement. Implemented for cases of unambiguous trademark abuse, under the URS, the only remedy is the temporary suspension of a domain name for the duration of the registration period - which may be extended by the prevailing complainant for one year, at commercial rates.

Inclusion in the Trademark Clearinghouse is not proof of any right, nor does it create any legal rights. Failure to submit trademarks into the Clearinghouse should not be perceived to be a lack of vigilance by rights holders or a waiver of any rights, nor can any negative influence be drawn from such failure.



**Can the Trademark Clearinghouse  
register domain names for you in a  
new gTLD?**

Domain names themselves cannot be registered with the Trademark Clearinghouse directly.

Domain names are registered in a registry and through a domain name registrar, who will manage this process. However, Sunrise registrations require a recorded mark in the Clearinghouse.

## **Can the Trademark Clearinghouse be used to register a new TLD?**

The applications for top level domains (e.g. .food, .scotland) closed last year. ICANN has indicated an intent to open up additional new rounds of TLDs but the timing for this is very uncertain and may be a long time away.





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CLEARINGHOUSE

