

Domain Update.



I. READY ...

On 26 March 2013, the virtual Trademark Clearinghouse (TMCH) will open its doors. ICANN, the competent body for the launch of approx. 1,400 possible new generic Top-Level Domains (gTLDs) ranging from “.academy” to “.zone” has initiated for trademark owners the so-called Trademark Clearinghouse. It will be operated by the auditing firm Deloitte. Trademark owners shall benefit of two advantages when registering, on the one hand participation in every sunrise period for the new gTLDs and on the other hand an information service on third parties applying for an identical domain name.

Nowadays, sunrise periods are a common part of any introduction of a new TLD. Sunrise periods provide trademark owners with the opportunity to register domain names identical with their trademarks – prior to registration by anybody else. Considering the number of possible new gTLDs, one registration with the Trademark Clearinghouse is supposed to be sufficient for all possible sunrise periods. Therefore, it will not be necessary to monitor each sunrise period and, in particular, not to register own trademarks for every single sunrise period. Only the registration with the Trademark Clearinghouse is necessary and – as far as the trademark is already subject to use requirement – a formalized proof of use.

ICANN has ensured that the operator of any new gTLD has to inform trademark owners for a period of at least 60 days about identical domain names. This is an informative notice only (so-called Trademark Claims Notification).

II. ... STEADY ...

Registration with the Trademark Clearinghouse appears advisable at least for important trademarks. However, it incurs costs. The official fees of Deloitte are USD 145 per year, USD 435 for three years and USD 725 for five years of registration with the Trademark Clearinghouse per trademark. Renewal per year costs USD 145.

As the registration will have to be conducted via a registrar or domain name manager, these costs will have to be added. There is no difference between the registration for sunrise periods and for so-called Trademark Claims Notifications.

Registered trademarks, trademarks acquired through use (the existence of which has already been confirmed by a court) or registered geographical indications may be registered. Restrictions apply for certain spellings. For instance, a trademark must not include a dot.

If necessary, use has to be proven by providing a respective declaration as well as labels or the like. This process has to be repeated every five years. Mere use as a domain name or on business cards will not be sufficient.

Sunrise periods will last for at least 30 days and a notification will be sent out thirty days in advance. Trademark Claims Notifications shall be available without proving use. The minimum time will be 60 days after opening of each TLD.

But note: Registration does not automatically mean that a certain domain name will actually be acquired. It is a mere information in advance and simplification of the registration process which otherwise would have to be repeated for every single TLD. Also, only exactly identical domain names will be notified. A later registration with the Trademark Clearinghouse will be possible.

III. ... GO!

If you are ready, try to negotiate a good price with your registrar/domain name manager and keep in mind that they might try to make a good offer more expensive, e.g. by applying high yearly renewal fees. If you are not ready yet, register your trademarks later with the Trademark Clearinghouse. Until now, no opening date has been announced for any of the new gTLDs and no sunrise period will start immediately.

If you have any questions or if you require more detailed information, please do not hesitate to contact us.

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