

## E-ALERT | Intellectual Property Rights

August 30, 2013

### PROTECTING YOUR TRADEMARKS IN NEW gTLDs: WHAT YOU NEED TO KNOW NOW

In the next two months, the first of over 1400 new generic Top Level Domains (to the right of the dot, such as .com or .net) will launch. Trademark owners should act now to enter their key trademark registrations into the Trademark Clearinghouse (“TMCH”). ICANN authorized the creation of the TMCH to provide trademark owners with a more efficient and cost effective way to participate in new gTLD right protection mechanisms. Trademark owners may participate in two of the rights protection mechanisms *only* for those trademark registrations entered into the TMCH.

Sunrise and Trademark Claims. All new gTLD registries must offer a *pre-launch* Sunrise period for at least 30 days and a *post-launch* Trademark Claims process for at least 90 days. A trademark owner must first enter a trademark registration into the TMCH before the trademark owner can rely on that registration to participate in either Sunrise or Trademark Claims.

During Sunrise, a trademark owner may apply for the domain name (to the left of the dot) that matches its registered trademark. Sunrise occurs before the gTLD opens registration to the public so a trademark owner has the first opportunity to register the domain name that matches its registered trademark.

During Trademark Claims, a trademark owner will receive a notice from the TMCH if a third party registers a domain name that matches the owner’s registered trademark. A trademark owner will also receive a notice if the third-party domain name matches a domain name that was the subject of a determination obtained by the trademark owner from a court or Uniform Domain Name Dispute Resolution Policy (“UDRP”) proceeding that the domain name was abusively registered or used.

### HOW COVINGTON CAN HELP

Every company should consider how they want to protect their trademarks in new gTLDs, identify the gTLDs for which they want to participate in Sunrise and Trademark Claims, and identify and enter into the TMCH the key trademark registrations on which they wish to rely for Sunrise and Trademark Claims. Covington’s Intellectual Property Rights group can provide assistance with every aspect of trademark protection in new gTLDs, including:

- Analyze applied-for gTLDs to identify those new gTLDs in which a company should consider trademark protection.
- Based on new gTLDs of interest, identify trademark registrations and “previously abused domains” to be entered into the TMCH to obtain the most protection for the lowest cost.
- Enter trademark registrations and “previously abused domains” into the TMCH. (Covington is the only law firm authorized to act as a TMCH Agent that was involved in drafting the initial TMCH recommendations.)

- Monitor announcements of new gTLD and Sunrise launches, and assist with Sunrise registration.
  - Prepare and file UDRP proceedings to recover abusive domains in existing gTLDs and trigger Trademark Claims in new gTLDs.
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If you have any questions concerning the material discussed in this client alert, please contact the following members of our intellectual property rights practice group:

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This information is not intended as legal advice. Readers should seek specific legal advice before acting with regard to the subjects mentioned herein.

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