CLIENT ALERTS & INSIGHTS

Protecting Your Valuable Trademark Rights Under The New Internet Regime For Generic Top Level Domains

MARCH 1, 2012

The application window for new generic top level domains ("gTLD") launched on January 12, 2012. Administered by the Internet Corporation for Assigned Names and Numbers ("ICANN"), this program provides companies with the opportunity to assert dominance over branding by, in effect, running their own registry. No longer must companies rely on a ".com" address to sell their products. Now, they can operate a site with an address unique to the product they are selling using a customized gTLD. For example, a purveyor of sunglasses might create a ".sunglasses" site for the sale or promotion of its products. To apply for a new gTLD, a company must first register in ICANN's online system no later than March 29, 2012. However, because multiple companies may utilize the same product name for similar or differing products, it is important to recognize that only one company will succeed in registering each new gTLD. As an expected result, the application and registration process, and its administration by ICANN, will in many cases be lengthy and expensive.

For those companies who do not wish to expend the monetary resources for a new gTLDs, a few methods exist to ensure that their trademark rights are adequately acknowledged in this new gTLD process.

First, beginning in early May 2012, public application information will be posted to ICANN's website. This provides companies with an opportunity to review and monitor new gTLD applications for potential trademark infringement. Second, in October 2012, ICANN will announce specific details and procedures that will allow trademark owners to file their registered trademarks with the Trademark Clearinghouse. After authenticating and validating the filed registration, the Trademark Clearinghouse will review the new gTLD applications and provide notice to the applicants in situations where the new gTLD may infringe upon the rights of a company that has filed its trademark registrations with the Trademark Clearinghouse. Similarly, once a new gTLD registration has been issued, the Trademark Clearinghouse will provide applicable trademark registration holders who previously filed with the Trademark Clearinghouse of notice of the new gTLD issuance where such issuance is relevant to the rights of the trademark registration holder.

While the introduction and launch of new gTLDs represents a significant change in the internet structure as it is currently known, companies do not have to spend vast sums to protect their intellectual property rights under the new system. Staying aware of, and pursuing, the proactive methods stated above, particularly with the assistance of experienced legal counsel, should provide a cost-effective alternative.

Additional Information

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