Software & Information Industry Association
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SIIA

SIIA MEMBER ALERT:

WHAT YOU NEED TO DO TO PROTECT YOUR BRAND

TRADEMARK CLEARINGHOUSE TO LAUNCH ON MARCH 26TH

The domain name world is facing drastic changes, and next week, trademark holders will face their first major hurdle in the effort to protect their brands.

What's Changing? There are presently 20 Top Level Domain Names ("TLDs") in operation (like .com, .net, .edu and .org). However, as early as this summer, the international body that oversees the Internet domain name system, called ICANN, is expected to authorize the introduction of many new TLDs (like .software, .inc, .app, and .cloud). Once this happens the registries that will operate these TLDs can begin to accept registrations for second-level domain names. A second-level domain name is the text to the right of the "www" and to left of the TLD and can be anything -- including your company's valuable trademarks. (For example, in www.siia.net, "siia" is the second-level domain name.)

Why Should I Be Concerned? The expansion of new domain names will likely lead to trademark infringement and cybersquatting -- registering a trademark as a domain name with the bad faith intent of selling it to its rightful owner. To prevent this, trademark holders will want to take steps to register their brands on these new TLDs and to fend off cybersquatters and infringers who may try to register their trademarked brands.

What Is Being Done To Address These Concerns? At the insistence of SIIA and other groups representing brand owners, ICANN created a new tool called the Trademark Clearinghouse. It will officially launch on March 26th.

What Is The Trademark Clearinghouse? The Clearinghouse is a database that is intended to make it easy for trademark owners to prevent and track potentially infringing second-level-domain-name registrations. The Clearinghouse will accept nationally or regionally registered trademarks, but not state-registered marks.

Why Record Your Marks With The Clearinghouse? The Clearinghouse will help brand owners prevent cybersquatting and trademark infringement by offering two services to trademark holders. Only those trademarks that are recorded in the Clearinghouse will be eligible for the protection afforded by these two valuable services.

(1) The Sunrise service: This service allows trademark owners to register domain names corresponding to their trademarks at least 30 days before a new TLD is

launched. Once the TLD is launched anyone can attempt to register any domain name with that new TLD.

(2) The Trademark Claims service: This service runs for at least 90 days after the TLD is launched. During this period, if someone attempts to register a domain name that matches a trademark that has been recorded in the Clearinghouse, that person will be notified and provided with information about the trademark. If that person goes ahead and registers the domain name anyway, the Clearinghouse will send a notice to any trademark owner whose mark is registered in the Clearinghouse to let them know that someone has registered a domain name that matches the recorded trademark.

How Much Will It Cost? There are two types of fee structures: (1) a basic fee structure, which requires payment by credit card and ranges from $150 for a one-year registration to $725 for a five-year registration; or (2) an advanced fee structure, with fees as low as $95 per registration, intended for large volume registrants and requires setting up a pre-payment account.

What Should I Do Now? As a first step in protecting your brands, it is essential that that you record your trademarked brands in the Trademark Clearinghouse as soon after March 26th as possible.

What Happens Next? After you've recorded your marks in the Clearinghouse, the next step is to wait until ICANN authorizes the launch of the first new TLDs. This is likely to occur this fall. You will want to use the Sunrise and Trademark Claims services and take other steps to monitor and enforce your rights to fend off those who may attempt to use your marks on any new TLD. Watch for future SIIA alerts on this topic.

For More Information: Click on the topic to link to more information.

- ICANN's Program to Expand the Number of Domain Names
- Trademark Clearinghouse FAQs
- Trademark Clearinghouse Guidelines
- Information about the Sunrise and Trademark Claims Services
- Trademark Clearinghouse Fees

Still Have Questions About the Clearinghouse or Other Domain Name Issues? Contact Keith Kupferschmid, General Counsel and SVP, Intellectual Property for SIIA at (202) 789-4442 or keithk@siia.net.