

Client Alert

July 2013

New Generic Domain Name Extensions Are Set To Be Launched This Year

Trademark Owners Should Act to Register Their Trademarks with the Trademark Clearinghouse

Hundreds of new generic domain name extensions (“NgTLDs”) are set to be launched later this year (i.e., .shop, .services, .reviews, etc.). These extensions will be similar to the familiar .com, .net and other current extensions, and those wishing to obtain domain names with these extensions will be able to start buying the same. There are new safeguards to protect against parties acquiring these new domain names using the registered trademarks of others in an infringing manner. However, in order to take advantage of these new safeguards, brand owners will need to register with the Trademark Clearinghouse.

Registering with the Trademark Clearinghouse will give brand owners two important lines of defense. First, by having their trademarks registered with the Trademark Clearinghouse, brand owners (or their agents) will receive a notification that someone else is trying to register an NgTLD using the brand owner’s trademark for ninety days from the date the NgTLD is rolled out. The applicant for the NgTLD will also be notified that the domain it is trying to register is a registered trademark, which may discourage some registrants from applying for certain domain names. While the applicant will still be able to register the domain name, brand owners (or their agents) will be able to monitor the new domain names and object to any infringing use. Second, if a brand owner’s trademark is registered with the Trademark Clearinghouse, the brand owner will have the first opportunity to register its own trademark in connection with NgTLDs during a specified “Sunrise Period”. If a trademark is not registered with the Trademark Clearinghouse, brand owners will not be able to register their trademarks in connection with any NgTLDs during the Sunrise Period.

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Intellectual Property

It will be important for brand owners to register their main trademarks with the Trademark Clearinghouse in order to afford them the opportunity to register their trademarks in connection with the relevant NgTLDs. This will also give brand owners advance notice of any potential infringements.

For more information regarding this method of trademark protection, or any other intellectual property matter, please contact the Olshan attorney with whom you regularly work or one of Olshan's intellectual property attorneys listed below.

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