

Services

Intellectual Property
Trademarks

Brand Owners Should Consider Registering with Trademark Clearinghouse

The generic top-level domain (gTLD) initiative of the Internet Corporation for Assigned Names and Numbers (ICANN) is well under way. This initiative will soon unleash hundreds of new domain name extensions on the Internet, including .tech, .music, .app, .news and many more. Brand owners should consider registering their marks with the Trademark Clearinghouse, which is collecting information to be used for sunrise periods and the trademark claims service. These programs aim to help brand owners protect their rights against infringers in the new online gTLD environment.

An application to register a mark in the Trademark Clearinghouse must be made by a mark owner, its licensee or its agent and must include the following:

Identification of the trademark to be registered (marks consisting solely of designs are not eligible).

Trademark registration number (if mark is not registered, it may be included under some circumstances).

Listing of goods and/or services associated with the registration.

Filing fee (\$150/mark/year, or \$435/mark/three years, or \$725/mark/five years).

For brand owners that also wish to participate in the sunrise periods, the following must also be included:

Declaration of use

Specimens of use

Trademark Owners Can Preregister

The sunrise registration period begins at least 30 days before domain names in each new gTLD are made available to the general public, during which trademark owners can preregister their marks within certain new domains before the general public is allowed to do so. A validated trademark entry in the Trademark Clearinghouse will be the minimum requirement to participate in the sunrise period. Sunrise periods are expected to begin this summer.

When Domain Names Are Similar

The trademark claims service is a notification for all new gTLDs that will inform brand owners that have registered marks with the Trademark Clearinghouse if a third party attempts to register as a domain name an exact mark within the clearinghouse. Parties attempting to register such a domain name will also receive notice of the prior clearinghouse entry and must acknowledge same before completing the registration.

What This Means to You

Companies wishing to have early warning of potentially infringing new domain names – and want to be “first in line” to file important new domain names incorporating their marks – may wish to file with the new Trademark Clearinghouse. Mark owners may also wish to consider conducting ongoing watches of the new domain name extensions as an additional means of being alerted to potentially conflict domains.

Contact Information

For additional information about these or any other intellectual property issues, please contact your Husch Blackwell attorney, Alan Nemes at 314.345.6461 or Arkadia Olson at 314.345.6215.

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