



Cantor Colburn Client Alert:

First New Generic Top-Level Domains (“gTLDs”) Set to Launch

As we have previously reported, the Internet Corporation for Assigned Names and Numbers (“ICANN”) has been rolling out a program to greatly expand the number of generic top-level domains (“gTLDs”). This program will allow companies, organizations, and individuals to own gTLDs for their brands and industry-related terms and operate as the domain name registrar. More than 1900 applications for more than 1400 new gTLDs were submitted to ICANN.

We are writing to advise that the registries for the first of these new gTLDs are set to launch their Sunrise domain name registration periods.

New gTLDs Going Live

Donuts, a company founded by executives with long-standing experience in domain name registry and registrar operations, applied to register more than 300 new gTLDs, and eventually expect more than 200 of these to go live. On or about October 29, 2013, Donuts plans to launch the Sunrise registration periods for the following gTLDs: .CAMERA, .LIGHTING, .CLOTHING, .SINGLES, .EQUIPMENT, .VENTURES, .GURU, .VOYAGE, and .HOLDINGS. The Sunrise period for each of these gTLDs will last for 60 days.

In addition, new gTLDs known as Internationalized Domain Names (“IDNs”) have been cleared to proceed to delegation, and will soon be launching their Sunrise periods. The new IDNs are as follows:

- شبكة – Arabic for “web/network”; registry: International Domain Registry Pty. Ltd.
- онлайн – Cyrillic for “online”; registry: CORE Association
- сайт – Cyrillic for “site”; registry: CORE Association
- 游戏 – Chinese for “game(s)”; registry: Spring Fields, LLC

The individual IDN registries will determine the languages allowed to be registered by the public as second-level domain names (to the left of the dot). For the Arabic IDN, the registry will allow only Arabic characters as second-level domains. For the Cyrillic IDN extensions, the registry will allow Cyrillic, Latin, and Arabic extensions. For the Chinese IDN, the registry (affiliated with Donuts) has not yet published which languages will be allowed as second-level domains. It is unclear whether the Sunrise periods for these IDNs will be 30 or 60 days.

Trademark owners who have their trademarks registered with the Trademark Clearinghouse (“TMCH”) and have a valid Signed Mark Data file (“SMD”) issued by the TMCH should be eligible to participate in the Sunrise periods for the new gTLDs listed above. This means that during the Sunrise periods, such trademark holders can register domain names in the new gTLD registries that exactly match what they have registered with the TMCH, before domain name



registration is opened to the general public, on a first-come first-serve basis. Currently, it takes at least one month to register a mark with the TMCH. Accordingly, if owners of trademarks have not yet registered their core marks with the TMCH, and if the opportunity to participate in the initial Sunrise periods is important, we strongly encourage trademark owners to obtain their TMCH registrations now.

Trademark Clearinghouse (“TMCH”)

As our prior Client Alerts have discussed, the TMCH is a central database established as part of ICANN’s new gTLD program, and holds verified trademark ownership information. There are two important benefits to registering trademarks with the TMCH. The first benefit is the right to participate in new gTLD Sunrise periods, as described above. The second benefit is the Trademark Claims Service. During the first 90 days that the general public can register domain names under new gTLD registries, owners of marks registered with the TMCH and potential domain name registrants will receive trademark claims notices that proposed domain name registrations exactly match trademarks registered in the TMCH. These notices may (or may not) act as deterrents to potential cybersquatters and will provide “early warnings” to trademark owners of attempted cybersquatting.

To be eligible for inclusion in the TMCH database and obtain both of the primary benefits described above, a mark must be (1) in use and (2) registered in any country, validated by a court, protected by a statute or treaty, or otherwise verified. The TMCH has one-year, three-year, and five-year terms for registration of marks. Since the opening of the TMCH, more than 13,000 marks have been filed and most trademark owners have opted to apply for three-year terms. Trademark owners should ensure that the marks they register with the TMCH will not expire in the country where the mark is registered during the TMCH term. The clock for TMCH registrations eligible to participate in Sunrise periods starts running when the first new gTLD registry goes live. There is no deadline to register trademarks with the TMCH.

Other Rights Protection Mechanisms (“RPMs”)

Trademark owners who have registered with the TMCH are also eligible to participate in the Domain Protected Marks List (“DPML”) launched by Donuts. With just one DPML registration fee, trademark owners can register exact mark second-level domain names across all of Donuts’ new gTLDs for a five-year term. Such domain name registrations will not be active and are just for the purpose of blocking third parties from registering domain names. However, a DPML block on a domain name can be overridden at any time, and the domain name can be registered by a trademark owner with Sunrise rights to that domain name. A list of Donuts gTLDs may be viewed at http://www.donuts.co/news/files/donuts_tld_application_list.pdf. Other entities that have applied for a large number of gTLDs may also offer similar services.

In addition to the RPMs discussed above, through which trademark owners can protect their marks, further RPMs include the existing and familiar Uniform Domain Name Dispute Resolution Policy (“UDRP”), the new Uniform Rapid Suspension System (“URS”) that is



intended to be quicker and cheaper than a UDRP proceeding, and other RPMs intended to address registries that are complicit in trademark infringement with domain name registrants, including the Post-Delegation Dispute Resolution Procedure (“PDDRP”), the Registry Restrictions Dispute Resolution Procedure (“RRDRP”), and the Public Interest Commitments Dispute Resolution Procedure (“PICDRP”). Trademark owners can also consider sending a demand letter or a Digital Millennium Copyright Act takedown notice, or filing a lawsuit in court.

Trademark Enforcement Strategy

With the potential expansion of the 22 existing gTLDs to more than 600 over the next several years, trademark owners should budget and strategize now on how best to protect their marks during this expansion. A first step could be to register with the TMCH. A second step could be to register TMCH marks with the DPML. A third step could be to keep a close eye on new gTLDs that are launching, in order to participate in Sunrise periods that are relevant to a trademark owner’s business and geographic interests. Trademark owners should also consider initiating or expanding domain name watch services to make sure that they cover domain name registrations across all of the new gTLDs.

For Further Information and Assistance

The Trademark & Copyright Department at Cantor Colburn LLP stands ready to answer any questions you may have about the new gTLDs program, the TMCH, and other RPMs, including providing strategic advice on which marks to register with the TMCH, registering defensive domain names in the new gTLD registries, watching for abusive registrations, and initiating domain name dispute proceedings. If you would like to register marks with the TMCH, we can suggest third-party vendors to prepare and file the necessary applications and to docket resulting TMCH registrations for potential renewals.

Please do not hesitate to contact us if we can be of further assistance.

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Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.