

*Is Your Company Ready for Anything?
Enforcing trademark rights in the new Internet age*

By: Dina Leytes, Griesing Law, Philadelphia, PA

From the earliest days of the Internet, brand owners have taken steps to enforce their trademark rights and prevent bad faith actors from registering domain names that are confusingly similar to their legitimate trademarks. A change to the domain name landscape will require brand owners to revisit their online enforcement strategies. In June 2011, the organization that oversees the world's global internet, the Internet Corporation for Assigned Names and Numbers (ICANN), approved an unprecedented expansion of available domain names by creating a process for private entities to buy their own .anything online space. The first of these new generic top level domains (gTLDs) will start going live later this year.

Until now, the most popular gTLDs included .com, .org and .edu. For an application fee to ICANN of \$185,000 (exclusive of costs related to application preparation and legal advice), private entities have applied to own the characters to the right of the "dot" in a domain name. Over 1,900 new gTLD applications were received by ICANN in the first application round, which is now closed, including brands—.google, .nike, .bmw, and dictionary words—.app, .home, .book.

As a result of this watershed domain name expansion, a third party may seek to register a trademark owner's mark—or confusingly similar variants—to the left of the "dot" for hundreds of new gTLDs. In a difficult economic climate, trademark owners will need to prioritize the most serious cases in order to efficiently manage risk.

The gTLD process envisions several newly-created rights protection mechanisms for trademark owners that are meant to complement the existing Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP was adopted by ICANN following an initiative by the World Intellectual Property Organization (WIPO) and provides an inexpensive, straightforward alternative to litigation for clear cases of cybersquatting. All new gTLDs are required to offer the UDRP. In addition, the Trademark Clearinghouse (TMCH) and Uniform Rapid Suspension System (URS) are important rights protection mechanisms for trademark owners to understand from the outset.

The TMCH is a central repository of authenticated information for word-only trademarks. For a fee, trademark owners may now record with the TMCH nationally or regionally registered word marks, or word marks protected by statute or treaty. When a new gTLD launches, trademark owners that recorded their marks with the TMCH will have the opportunity to register domain names corresponding to those marks before the general public may do so. Additionally, if a third party attempts to register a domain name that is identical to a mark that a trademark owner recorded with the TMCH, the applicant will receive notice providing information about the mark recorded and warning the applicant about the possibility of infringement. The notice will not stop the domain name from being registered, however. If the third party registers the domain name, the trademark owner will be notified of the registration.

As an alternative to the UDRP, trademark owners can utilize the URS, a system that parallels the UDRP, but is distinct in a few key ways. Perhaps the most critical difference is that while a URS filing is less expensive than a UDRP filing, a party prevailing under the URS does not acquire the infringing domain name and may be forced to assert its rights on a repeating basis.



1016 W. Jackson Blvd., Ste. 306
Chicago, IL 60607
Tel: 312.733.7780
www.namwolf.org



GRIESING LAW LLC

Dina Leytes is Griesing Law's Practice Group Chair, Intellectual Property and New Media. Prior to entering private practice, Ms. Leytes worked at WIPO with a focus on key substantive and procedural aspects of domain name disputes pursuant to the UDRP.