# The New TLD Era: Status Update – What Have We Seen and What Should We Expect?

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As we have previously reported, the internet is in the process of expanding to include hundreds of new top-level-domains (TLDs), the management of which is delegated to the internet's governing body, ICANN. Examples of TLDs (as we are likely most familiar with) include .com, .net, and .org – i.e. the term that is to the right of the "dot." We are now more than halfway through the new TLD launch and many are still left to wonder: Where is this vast new world of information exchange we had been promised? Where is the purported enforcement nightmare many had feared? While it may still be too early to tell, there is some interesting data to look at.

## New TLD Launch Status: Overview

As of September 4, 2015, 744 new TLDs have been introduced to the internet – a dizzying number compared to the handful of TLDs that previously existed. Compare that, however, to the number of corresponding registered domain names: as of September 13, 2015, new "open" TLDs (those that are not restricted by industry or owned by brand owners) accounted for over 11 million registered domain names, while the traditional "open" TLDs, such as .com, .net, and .org, accounted for over 143 million registered domains names. While we still have a ways to go in the new TLD launch – with 596 new TLDs left to be processed and introduced to the internet – it appears that the traditional TLDs are still the most attractive TLDs for domain owners. Will that trend remain? Most likely, yes – but we can expect to see a continued rise in new TLD domain name registrations.

- **Trademark Clearinghouse (TMCH): The Numbers**

  To the best of our knowledge, the TMCH has not made any subsequent announcements regarding its purported broad sweeping deterrent effect since the ICANN Singapore meeting in March of 2014 where it had claimed that over 500,000 claims notices had been issued during attempts to register domain names that matched a trademark recorded with the TMCH, with 95% of those attempts having been abandoned. While some have called these numbers into question and/or referenced these numbers as “optimistic”, most maintain that the TMCH is having its desired deterrent effect although its effect may be hard to quantify.

From a numbers perspective, what we do know is that the TMCH claims to have received nearly 40,000 trademark submissions and delivered over 180,000 claims notifications to trademark holders as of August 4, 2015. These claims notifications differ from those contemplated in the above paragraph – the 500,000 number having corresponded to the alert one receives when trying to register a domain name that matches a trademark deposited in the TMCH (while the 180,000 number corresponds to the notice sent to the trademark holder after that domain name has registered). That said, with over 11 million domain name registrations in the new “open” TLDs, 180,000 claims notifications appears to be a very low number. Is this because the warning received during the registration process leads to an abandonment of registration efforts, or because the once feared enforcement nightmare is turning out to be more akin to slight inconvenience? Without updated information from the TMCH, it is difficult to say.

- **Domain Disputes: The Numbers**

We have not seen a dramatic increase in domain dispute filings. The URS for example, which was created to handle “clear-cut” cases of domain name infringement in the new TLDs, has been in full swing for just over 2 years now. While approximately 360 URS claims have been filed with the National Arbitration Forum (NAF), this is a mere fraction of a percentage of the 180,000+ claims notifications sent by the TMCH.

Interestingly, 291 URS claims were decided in favor of the complainant and just over 20 claims were denied. While the reasons for these denials have varied, fair use considerations continue to stand out (e.g., a redirect can be considered a “tribute” and thereby fair use) and panelists are taking the “clear and convincing” evidentiary standard of the URS quite seriously and denying claims for failure to meet that burden (e.g., failure to establish rights in an unregistered mark). As such, filing a UDRP should still be considered whenever the evidence is not clear and convincing on its face and/or it would take more than 500 words to make the case (a procedural limitation of the URS).

That said, we have not seen a dramatic increase with UDRP filings either. WIPO’s UDRP caseload for 2014 consisted of just 3.9% (227 cases) relating to domain name registrations in new TLDs. When compare to the 65.2% of case based upon domain names registered in the .com TLD alone, the number of UDRP filings against new TLD domain name registrations appears to be a drop in the bucket, particularly when you consider that over 500 new TLDs had become operational by the end of 2014. In looking at WIPO statistics for the year to date, this discrepancy is holding steady, with UDRP filings against .com domain names accounting for over 70% of its caseload to date.

## New TLD Launch Status: Concluding Comments

As to the overall impact of the new TLD era, the jury is still out. While many have now concluded one of two extremes – that either the new TLD launch has fallen on its face or that the worst is yet to come – we believe these numbers, while not dramatic, reveal the need to continue to take a pragmatic approach to trademark protection and domain name enforcement. While it is clear that the sky isn’t falling, infringement is in fact occurring and there are nearly 600 more TLDs to come.

Thus, the TMCH may still prove advantageous for a number of reasons. First, we could find no data to definitively conclude whether the TMCH is or is not having a deterrent effect. Thus, the question comes down to what makes sense for your business. For those of you on the fence, you may want to reconsider depositing your federal trademark registrations if you are either (i) in a highly targeted industry for domain infringers, such as fashion, retail, and financial, or (ii) the trademark owner of a dictionary word that is used arbitrarily or suggestively. Second, a deposit with the TMCH allows a trademark owner to obtain domain names within TLDs before they open for general availability, which could help prevent another person or entity obtaining the same domain name on a “first-come,” “first-serve,” “fair-use” basis – particularly if that TLD is attractive from a business perspective. Lastly, the new TLD launch is far from over. With nearly 600 more TLDs on the horizon, there is no way for us to conclude with any amount of certainty whether these number trends outlined above will remain steady, increase, or decrease.

## New TLD Launch Status: The Sunrise Continues

Below is the status of the sunrise periods as of September 15, 2015. If any of these TLDs are of interest or concern to you, please contact us to discuss your options:

**SUNRISE PERIOD**

**Sunrise periods for the following TLDs have opened and are scheduled to close on September 17, 2015, after which the trademark claims notification period will begin:**

.rent

**Sunrise periods for the following TLDs have opened and are scheduled to close on September 18, 2015, after which the trademark claims notification period will begin:**

.miami

**Sunrise periods for the following TLDs have opened and are scheduled to close on September 22, 2015, after which the trademark claims notification period will begin:**

.sakura

.jprs

**Sunrise periods for the following TLDs have opened and are scheduled to close on September 28, 2015, after which the trademark claims notification period will begin:**

.abogado

.law

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 1, 2015, after which the trademark claims notification period will begin:**

.sex

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 3, 2015, after which the trademark claims notification period will begin:**

.film

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 4, 2015, after which the trademark claims notification period will begin:**

.krd

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 5, 2015, after which the trademark claims notification period will begin:**

.game

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 6, 2015, after which the trademark claims notification period will begin:**

.corsica

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 10, 2015, after which the trademark claims notification period will begin:.**

.study

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 17, 2015, after which the trademark claims notification period will begin:**

.studio

.live

**Sunrise periods for the following TLDs have opened and are scheduled to close on October 22, 2015, after which the trademark claims notification period will begin:**

.SRL

**Sunrise periods for the following TLDs have opened and are scheduled to close on November 6, 2015, after which the trademark claims notification period will begin:**

.pohl

.allfinanz

**Sunrise periods for the following TLDs have opened and are scheduled to close on November 9, 2015, after which the trademark claims notification period will begin:**

.swiss

**Sunrise periods for the following TLDs have opened and are scheduled to close on November 28, 2015, after which the trademark claims notification period will begin:**

.gdn

**The following TLDs are awaiting launch of their respective sunrise periods:**

.SRL

.earth

.kyoto

.spreadbetting

.cfd

.trading

.forex

.broker

.family

.cloud

.bible

Please note:  We rely on the World Intellectual Property Organization and the Trademark Clearinghouse for our information.  Sometimes these two resources provide conflicting information as to Sunrise periods and Trademark Claims Notifications periods.  While we do our best to reconcile any differing information when this situation arises, we are unable to guarantee the accuracy of these resources. If there is a particular TLD of interest to you, please let us know so we can vet the specific information with that particular TLD registry directly.

For more information about this legal update, please contact Samantha M. Quimby or any attorney in Frost Brown Todd's Intellectual Property Law and Litigation practice.






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