The New TLD Era: Much Ado About Nothing?

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Publications

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As we have previously reported to you (click here to view the article), the internet is 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 know them today include .com, .net and .org – i.e. the term that is to the right of the "dot."

We are now more than mid-way through the 2014 calendar year and many are wondering: Just where is this vast new world of information exchange we had been promised? Where is the purported enforcement nightmare that many had feared? While it may seem like "much ado about nothing" right now, it should be noted that we are still in the early stages of the TLD launch.

New TLD Launch Status:

Currently (as of August 22), 373 TLDs have been introduced to the internet, which seems like a dizzying number compared to the low number of TLDs that previously existed. But, with 1,321 TLDs still proceeding through the new TLD program – believe it or not – we still have a long way to go.

To put this into its proper context, over 1,900 applications had been received by ICANN at the close of the New TLD application period last year, and as of our January 9, 2014 Update (view article here), 80 TLDs were nearing their introduction to the internet. So while there admittedly has not been the dramatic shake-up of the internet that many had predicted, we appear to only be a quarter of the way through the TLD launch process. That said, we have seen some interesting trends and results with the new enforcement mechanisms available to brand owners.

Trademark Clearinghouse (TMCH):

The TMCH announced at the ICANN Singapore meeting in March of this year that over 500,000 Claims Notices had been delivered to

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those who were attempting to register a domain name that matched a trademark recorded with the Trademark Clearinghouse (TMCH). Yes. 500,000. Of those 500,000 Claims Notices, the TMCH claimed a **95% success rate** – i.e., 95% of those who were attempting to register a domain name that matched a trademark recorded with the TMCH abandoned their efforts and did not follow through to registration of that domain name. Yes. 95%. That number is staggering. If true (and we have no reason to doubt the validity of this number), this could help explain why the new TLD era appears to be "much ado about nothing" – i.e., the purported deterrent effect upon cybersquatters has been just that: a deterrent effect.

Uniform Rapid Suspension system (URS):

The URS, a counter-part to the UDRP designed for handling "clear-cut" cases of cybersquatting, is in full swing. While over 100 URS complaints have been filed over its mere 6 months of existence, a handful of complaints have been denied. While the reasons for these denials have varied, fair use considerations is one that appears to stand out, at least in this author's view. We live in a day and age where a vast majority of "trademarked" terms also serve as dictionary or generic terms. Given this, careful consideration should be given to whether a complaint should be filed under the more cost-efficient and streamlined URS policy, under the well-established UDRP Policy, or whether the domain name is a violation under these policies in the first place – i.e., the new TLD era and the new available domain dispute procedures has not obviated the doctrine of fair use under trademark law.

Conclusion:

While many are hanging back to play the "wait and see" game, we have now seen tangible benefits to engaging in proactive measures. With over 373 new TLDs now available and a potential for 1,321 more to come, it is certainly not too late for federal trademark registration owners to take advantage of the TMCH as a proactive enforcement mechanism. In addition, should that federal trademark registration be for a term that is also a defined or generic term, that trademark owner will have the ability to apply for a domain name within a TLD

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that is attractive from a business perspective, which could help prevent another person or entity obtaining the same domain name on a "first-come," "first-serve," "fair-use" basis.

That said, below is the status of the sunrise and trademark claims notification periods as of August 27, 2014:

SUNRISE PERIOD

Sunrise periods for the following TLDs have opened and are scheduled to close on August 30, 2014, after which the trademark claims notification period will begin:

.insure

.accountants

. (Samsung)

.finance

.digital

.okinawa

.ren

Sunrise periods for the following TLDs have opened and are scheduled to close on September 1, 2014, after which the trademark claims notification period will begin:

.republican

Sunrise periods for the following TLDs have opened and are scheduled to close on September 2, 2014, after which the trademark claims notification period will begin:

.bayern

Sunrise periods for the following TLDs have opened and are scheduled to close on September 4, 2014, after which the trademark claims notification period will begin:

.versicherung

Sunrise periods for the following TLDs have opened and are scheduled to close on September 5, 2014, after which the trademark claims notification period will begin:

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.organic

Sunrise periods for the following TLDs have opened and are scheduled to close on September 6, 2014, after which the trademark claims notification period will begin:

.guide

.loans

.church

.life

Sunrise periods for the following TLDs have opened and are scheduled to close on September 10, 2014, after which the trademark claims notification period will begin:

.luxe

.surf

.beer

Sunrise periods for the following TLDs have opened and are scheduled to close on September 13, 2014, after which the trademark claims notification period will begin:

.scot

.place

.direct

Sunrise periods for the following TLDs have opened and are scheduled to close on September 15, 2014, after which the trademark claims notification period will begin:

.saarland

Sunrise periods for the following TLDs have opened and are scheduled to close on September 20, 2014, after which the trademark claims notification period will begin:

.deals

Sunrise periods for the following TLDs have opened and are scheduled to close on September 24, 2014, after which the

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trademark claims notification period will begin:

.soy

Sunrise periods for the following TLDs have opened and are scheduled to close on September 27, 2014, after which the trademark claims notification period will begin:

.city

.attorney

.lawyer

.melbourne

Sunrise periods for the following TLDs have opened and are scheduled to close on October 1, 2014, after which the trademark claims notification period will begin:

.joburg

.durban

.capetown

Sunrise periods for the following TLDs have opened and are scheduled to close on October 11, 2014, after which the trademark claims notification period will begin:

.airforce

.healthcare

.navy

.army

.vet

Sunrise periods for the following TLDs have opened and are scheduled to close on October 18, 2014, after which the trademark claims notification period will begin:

.□□□(site)

Sunrise periods for the following TLDs have opened and are scheduled to close on October 25, 2014, after which the trademark claims notification period will begin:

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.mortgage

.□□□□(□market)

.market

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

.paris

.eus

.ryukyu

.physio

.vlaanderen

.brussels

.quebec

.gal

.□□□□(□site)

__(trademark)__

.ovh

.ooo

.bzh

.realtor

.paris

.engineer

.software

.tatar

.auction

TRADEMARK CLAIMS

Sunrise periods in the following TLDs (consisting of characters from the English alphabet) have closed and trademark claims notifications have begun (or will begin shortly):

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.xyz – (through September 2, 2014)

.dating – (through September 2, 2014)

.events – (through September 2, 2014)

.partners – (through September 2, 2014)

.productions – (through September 2, 2014)

.jetzt – (through September 2, 2014)

.trade – (through September 7, 2014)

.webcam – (through September 7, 2014)

.bid – (through September 7, 2014)

.pub – (through September 9, 2014)

.cleaning – (through September 9, 2014)

.community – (through September 9, 2014)

.catering – (through September 9, 2014)

.cards – (through September 9, 2014)

.moda – (through September 16, 2014)

.tools – (through September 16, 2014)

.supplies – (through September 16, 2014)

.industries – (through September 16, 2014)

.supply – (through September 16, 2014)

.parts – (through September 16, 2014)

.nagoya– (through September 21, 2014)

.ink – (through September 22, 2014)

.kaufen – (through September 23, 2014)

.consulting – (through September 23, 2014)

.fish – (through September 23, 2014)

.report – (through September 23, 2014)

.vision – (through September 23, 2014)

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.services – (through September 30, 2014)

.gop – (through September 30, 2014)

.citic – (through October 5, 2014)

.christmas – (through October 6, 2014)

.blackfriday – (through October 6, 2014)

.rocks – (through October 7, 2014)

.gripe – (through October 7, 2014)

.actor – (through October 7, 2014)

.engineering – (through October 7, 2014)

.exchange – (through October 7, 2014)

.capital – (through October 7, 2014)

.globo – (through October 9, 2014)

.wien – (through October 13, 2014)

.bar – (through October 14, 2014)

.associates – (through October 14, 2014)

.rest – (through October 14, 2014)

.lease – (through October 14, 2014)

.media – (through October 14, 2014)

.pictures – (through October 14, 2014)

.moe ("geek") – (through October 20, 2014)

.tokyo – (through October 20, 2014)

.voting – (through October 21, 2014)

.haus – (through October 21, 2014)

.university – (through October 21, 2014)

.toys – (through October 21, 2014)

.town – (through October 21, 2014)

.reisen – (through October 21, 2014)

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.fail – (through October 28, 2014)

.financial – (through October 28, 2014)

.limited – (through October 28, 2014)

.wtf – (through October 28, 2014)

.clinic – (through November 4, 2014)

.surgery – (through November 4, 2014)

.dental – (through November 4, 2014)

.care – (through November 4, 2014)

.clinic – (through November 4, 2014)

.reise – (through November 4, 2014)

.investments – (through November 11, 2014)

.cash – (through November 11, 2014)

.tax – (through November 11, 2014)

.fund – (through November 11, 2014)

.vegas – (through November 13, 2014)

.career – (through November 16, 2014)

.schule – (through November 18, 2014)

.discount – (through November 18, 2014)

.fitness – (through November 18, 2014)

.furniture – (through November 18, 2014)

.bio – (through November 19, 2014)

.archi – (through November 19, 2014)

.koeln – (through November 24, 2014)

.cologne – (through November 24, 2014)

.HIV – (through November 24, 2014)

.black – (through November 24, 2014)

.press – (through November 24, 2014)

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.website – (through November 24, 2014)

.host – (through November 24, 2014)

.claims – (through November 25, 2014)

.gratis – (through November 25, 2014)

.credit – (through November 25, 2014)

.creditcard – (through November 25, 2014)

.hamburg – (through November 26, 2014)

.desi – (through November 28, 2014)

.hiphop – (through December 2, 2014)

.audio – (through December 2, 2014)

.juegos – (through December 2, 2014)

.london – (through December 8, 2014)

.yokohama – (through December 8, 2014)

.meet – (Data unavailable)

.global – (through December 8, 2014)

.vodka – (through December 14, 2014)

.country – (through December 14, 2014)

.fishing – (through December 14, 2014)

.horse – (through December 14, 2014)

.rodeo – (through December 14, 2014)

.cooking – (through December 14, 2014)

.moscow – (through January 4, 2015)

.NYC – (through January 6, 2015)

If any of the above listed TLDs raised your eyebrows or appear to be in line with your business, then we suggest you undergo an evaluation of your trademark portfolio to determine what trademark registrations you should be depositing with the Trademark Clearinghouse. Frost Brown Todd stands ready to assist you with

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this entire process as Frost Brown Todd is an official Trademark Agent with the Trademark Clearinghouse, which allows us to deposit trademark registrations on behalf of our clients and other federal trademark registration holders. We have already handled such deposits for many of our clients and stand ready to assist others with this process. We are also available to discuss appropriate strategies for more complex trademark portfolios and advise as to alternative options that may be available for those brand owners who do not hold federal registrations for common law marks of concern.

Again, it should be noted that this is not a complete list of the new TLDs as more and more TLDs will be delegated and launched throughout 2014 and into 2015. We will continue to update you as additional TLDs are delegated and their respective sunrise periods announced.

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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