



NEWSLETTER ON PROTECTION FROM CYBERSQUATTING UNDER THE TRADEMARK CLEARINGHOUSE (TMCH)

S ESHWAR CONSULTANTS HOUSE OF CORPORATE & IPR LAWS | 37/57, 53rd Street, 9th
Avenue, Ashok Nagar, Chennai – 600083, India

Primary Contact: N V Saisunder | Contact No: +91 44 42048235 | E-Mail: saisunder@eshwars.com

INTRODUCTION

Today the domain space is one of the most important mediums through which businesses, irrespective of their size publicise their products and services to its various stakeholders. The domain name is the identity of a business in cyber space.

The Internet Corporation for Assigned Names and Numbers (ICANN), the organisation that regulates the domain name space, intends to launch over about 1500 new generic Top-Level Domain Names (New gTLD's) in mid-2013. gTLD is the word that comes after "dot" in a domain name. For eg: some of the new gTLD's that would be launched are ".book", ".shops", ".design", ".cloud", ".web", ".store", ".inc", ".llc", ".online", ".global", ".corp", ".systems", ".tech", ".blog", ".you", etc.,

This newsletter provides a brief insight into the actions that you need to take to protect your trademark from Cybersquatting, as ICANN is setting-up a protection mechanism which will provide an opportunity for trademark holders to protect their marks before anybody squats on their intellectual property.

WHAT IS TRADEMARK CLEARINGHOUSE..?

ICANN is launching Trademark ClearingHouse (“TMCH”), to act as a centralized repository of pre-validated trademarks. Trademark holders are eligible to register their trademark details with TMCH. TMCH will receive and authenticate trademark rights information and will play a vital role in trademark protection during the launch phase of each new gTLD registry. TMCH is being positioned to mitigate the risks of Cybersquatting to help the brand owners to protect their trademark rights in relation to the new gTLD’s that are proposed to be released. It allows brand owners to submit their trademark data into one centralized database, prior to and during the launch of new gTLD’s. The TMCH protects brands in two ways: with a Sunrise Service and a Trademark Claims Service.

- **SUNRISE SERVICE**- This is an initial period of at least 30 days before domain names are offered to the general public. Trademark owners can take advantage of the Sunrise Period to safeguard the domain name that matches their trademark. A Sunrise Period is mandatory for all new gTLD’s and having a validated trademark entry in the TMCH is the minimum requirement to participate in this limited pre-registration period.
- **TRADEMARK CLAIMS SERVICE**- The Trademark Claims Period follows the Sunrise Period and runs for at least the first 60 days after the expiry of the Sunrise Period during the initial operating period of the general registration. During the Trademark Claims Period, anyone attempting to register a domain name matching a mark that is recorded in the TMCH will receive a notification displaying the relevant mark information.

DOCUMENTS REQUIRED FOR REGISTRATION

- The actual process and the exact modalities of the functioning of the TMCH will be made known to the public only on its launch date viz., 26th March 2013. The process is expected to involve the Trademark Holder or Trademark Agent to provide certain documents pertaining to their trademarks to the TMCH.
- Once their information is verified, trademark holders are eligible to register domain names consisting of their marks during the Sunrise Period, if they so desire.
- During both the Sunrise Period and the Trademark Claims Period, the TMCH will notify rights holders when a third party applies for a domain name that matches the rights holder's mark and will warn the domain name applicant of the existence of the trademark.
- If the notified party goes ahead and registers the domain name, the TMCH will send a notice to those trademark holders with matching records in the TMCH database, informing them that someone has registered the domain name.

The eligible trademarks for the TMCH are marks that are:

- (1) registered;*
- (2) protected by statute or treaty;*
- (3) validated by a court or a judicial proceeding; and,*
- (4) those otherwise constitute intellectual property in any jurisdiction, but only upon provision of additional proof.*

Registration of a trademark with the TMCH includes linking up to ten domain names per registration. Trademark Registrations with TMCH can be designated for one (1), three (3) or five (5) years and are (re)validated once per year.

All trademark owners will need to submit a declaration of use and a sample showing use of the mark. The Trademark Clearinghouse may request the trademark holder or trademark agent to submit additional documentary evidence. Some of the indicative documents would be:

- a) *Copy of an official trademark certificate.*
- b) *Assignee Declaration, if applicable.*
- c) *Copy of the renewal request of the trademark, if any (if applicable).*

KEY UPCOMING DATES FOR THE NEW GTLD'S

- **March 26, 2013:** Launch of Trademark Clearinghouse.
- **May 2013:** First new gTLD's are expected to launch, starting with those consisting of non-Latin characters (e.g., .天主教, .شبكة). gTLD's with Latin character strings are expected to launch throughout the second half of 2013.

HOW CAN WE ASSIST YOU IN REGISTERING YOUR TRADEMARKS IN THE TMCH PROGRAM..?

WE AT S ESHWAR CONSULTANTS-

- Can act as your Trademark Agents in order to submit and maintain Trademark Records with the TMCH on your behalf.
- Will receive notifications regarding the Sunrise Services or Trademark Claims Services on your behalf and promptly notify you of any action that is required to be taken in this regard.
- Will advise and assist you in further prosecution and taking necessary steps before appropriate institutions in securing your valuable trademark rights.
- Can compile and prepare information necessary to register with the TMCH, including proofs of use.
- Will assist and closely work with you in developing a rights protection strategy for matters not adequately covered by TMCH procedures and also assist in developing a strategy for monitoring the past initial launch of new gTLD's (since, the TMCH will only provide notification of registration for the first 60 days after the Sunrise Period in each new gTLD).