



## ABSTRACT

### **1000+ NEW GTLDS CLEARINGHOUSE AND DISPUTE RESOLUTION**

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The New generic Top Level Domains Program was launched in June 2011, with the objective to enhance competition and consumer choice. 1930 applications for new gTLDs were submitted, of which around 600 will be open for registration. Amongst others, the following strings have been applied as open Registries: .shop, .online, .store, .app, .law, .mail, .fashion, .luxury.

Several brand owners opted to submit one or more applications for “closed” Top Level Domains corresponding to their trademarks, aimed at protecting and enhancing their IP rights by creating a secure online location that could be recognized by their consumers as a reliable source of information and safe environment to purchase goods and services. Some of the trademark owners also applied for “closed generic” Top Level Domains, i.e. Top Level Domains constituted of generic terms but not open to any third party registration.

In view of the launch of such a considerable number of new gTLDs, start-up and post-launch right protection mechanisms (“RPMs”) will be provided to support trademark owners in the protection of their IP rights.

In particular, during the initial phases for registration in the new TLDs, every Registry of a New gTLD shall provide two services, namely the Sunrise period and the Trademark Claims service. Both the services will be supported by the Trademark Clearinghouse, that will authenticate and validate the trademarks recorded in the Clearinghouse and will serve as a verified database to provide information to the new gTLD Registries to support all the pre-launch rights protection measures.

The Sunrise Period will be offered for a minimum of 30 day during the pre-launch phase. In such a phase, all new TLD Registries will be required to provide brand owners the option to register their marks as domain names before a new gTLD goes live. In addition, a notice will be provided to all trademark holders in the Clearinghouse if a third party obtains a sunrise registration for a second-level domain name identical to the trademark. The Trademark Claims service will be provided for a minimum of 90 days after the opening of general registration. Registries will provide both notices to potential registrants of a second level domain name identical to a trademark recorded in the Trademark Clearinghouse and to the trademark owners when a domain name identical to the recorded trademark is registered by a third party, notwithstanding the above notice.

After the Registries go live, two new trademark right dispute resolution procedures will allow trademark holders to challenge infringement of trademark rights, i.e. i) the Uniform Rapid Suspension Procedure (URS), an expedited complaint procedure, with requirements similar to the UDRP but aimed only at the suspension of the disputed domain name, and ii) the Trademark Post-Delegation Dispute Resolution Procedure, that will allow brand owners to report the infringement of their trademarks by a Registry at the Top Level Domain, when a Registry has registered a confusingly similar TLD and engages in abusive conduct, and - at a second level domain - if the Registry intentionally permits third parties to register infringing second-level domain names.



In light of the challenges posed by the 1000+ new generic Top Level Domains, the trademark holders shall therefore adopt an enhanced strategy to protect their IP rights on line, both availing of the above new right protection mechanisms and of possible selective defensive registrations during Sunrise phases in the new TLDs of interest, and of the “traditional” tools available such as i) monitoring registrations of domain names identical or similar to their trademarks and ii) reclaim activities via the UDRP procedure, which will still be applicable also to all the New TLDs, or via Court actions.