

# New Trademark Clearinghouse Offers Protection for Your Trademarks in Cyberspace

by Andrew L. Goldstein

A FREEBORN & PETERS LITIGATION CLIENT ALERT

*“Beginning on March 26, 2013, you will be able to record your trademarks with the Trademark Clearinghouse which will help protect your marks from being registered as a domain name with a new generic Top-Level Domain.”*

**T**here is a new mechanism available for you to protect your valuable trademarks against unauthorized use in cyberspace. Beginning on March 26, 2013, you will be able to record your trademarks with the Trademark Clearinghouse which will help protect your marks from being registered as a domain name with a new generic Top-Level Domain.

A generic Top-Level Domain, or gTLD, consists of the letters that appear to the right of the dot in a domain name. Until recently, there were only a few standard gTLD's, such as “.com”, “.net”, and “.info”. However, the gTLD structure has changed to allow entities to register words as gTLD's, such as “.broker”, “.hotels” and “.furniture”.

The new Trademark Clearinghouse will notify owners who record their trademarks with the Trademark Clearinghouse when a domain name under a new gTLD is filed that is identical to the owner's recorded trademark.



## **Why record your trademarks with the Trademark Clearinghouse?**

If your trademark is recorded with the Trademark Clearinghouse and someone attempts to register a domain name under any gTLD that is identical to your mark, the Trademark Claims Service of the Trademark Clearinghouse will issue a notice to the potential registrant notifying it of your trademark. If the registrant then proceeds with the registration process, you will be notified so that you can take appropriate action. For example, if a new gTLD is “.food” and you register your company’s trademark “ACME” with the Trademark Clearinghouse, you will be notified if someone files an application to register “acme.food” as a domain name.

Another benefit of Trademark Clearinghouse recordation is that those who record their marks will have the benefit of “Sunrise Services.” Sunrise Services allow those who have trademarks registered with the Trademark Clearinghouse to register domains for a specified gTLD that match their trademarks for a period of at least 30 days before the general public. For example, if a new gTLD called “.cars” is issued, companies would be able to register domains corresponding to the trademarks they had recorded with the Trademark Clearinghouse, e.g. “ford.cars” or “cadillac.cars”, before any other entity. “Proof of use” must also be recorded if you desire to use the Sunrise Services. Proof of use consists of: 1) a declaration stating that the trademark is in use; and, 2) a sample, such as an advertisement, a branded product, or some other example, showing that the mark is in use.

## **What trademarks can be recorded with the Trademark Clearinghouse?**

If your trademark is registered with the United States Patent and Trademark Office (“USPTO”), you can record it with the Trademark Clearinghouse (the Trademark Clearinghouse will not record marks that are the subject of a pending application). The Trademark Clearinghouse will also record trademarks that have been validated through a court of law or other judicial proceeding; trademarks protected by a statute or treaty; and, other marks that constitute intellectual property may be recorded in the Trademark Clearinghouse by arrangement with a registry.

The Trademark Clearinghouse’s recordation service is only available for trademarks consisting of textual elements, i.e., letters, words, numerals or typographical characters. Marks consisting solely of design elements cannot be recorded with the Trademark Clearinghouse.

### **What trademarks can be recorded with the Trademark Clearinghouse?**

If your trademark is registered with the United States Patent and Trademark Office (“USPTO”), you can record it with the Trademark Clearinghouse (the Trademark Clearinghouse will not record marks that are the subject of a pending application). The Trademark Clearinghouse will also record trademarks that have been validated through a court of law or other judicial proceeding; trademarks protected by a statute or treaty; and, other marks that constitute intellectual property may be recorded in the Trademark Clearinghouse by arrangement with a registry.

The Trademark Clearinghouse’s recordation service is only available for trademarks consisting of textual elements, i.e., letters, words, numerals or typographical characters. Marks consisting solely of design elements cannot be recorded with the Trademark Clearinghouse.

### **What does it cost to register your trademark with the Trademark Clearinghouse?**

There will be a \$150 filing fee per trademark, per year, with some discounts provided for multi-year recordation. This fee includes recordation in the Trademark Claims Service. However, this fee does not cover Sunrise Services for specific gTLD’s. Those prices will be set by the specific gTLD’s and will likely be approximately \$200 in each gTLD (e.g., registration of one trademark for Sunrise registration across 20 gTLD’s would require fees of \$4,000).

### **What to do now?**

The Trademark Clearinghouse begins accepting recordations on March 26, 2013. You should review your portfolio of trademarks to determine which marks should be recorded with the Trademark Clearinghouse. If you are interested in recording any of your trademarks with the Trademark Clearinghouse, or if you have any questions about the protections afforded by the Trademark Clearinghouse, please contact Andrew L. Goldstein at 312-360-6438 or at [agoldstein@freeborn.com](mailto:agoldstein@freeborn.com).

## ABOUT FREEBORN & PETERS LLP

Freeborn & Peters supports its clients in the following legal disciplines: Litigation; Corporate Law; Real Estate; Bankruptcy and Financial Restructuring; and Government and Regulatory Law. Freeborn & Peters is always looking ahead and seeking to find better ways to serve its clients. It takes a proactive approach to ensure its clients are more informed, prepared and able to achieve greater success – not just now, but also in the future. While the firm serves clients across a very broad range of sectors, it has also pioneered an interdisciplinary approach that serves the specific needs of targeted industries, including food; transportation, including railroads, trucking, and logistics; and insurance and reinsurance.

Freeborn & Peters is a Firm that genuinely lives up to its core values of integrity, caring, effectiveness, teamwork, and commitment, and embodies them through high standards of client service and responsive action. Its lawyers build close and lasting relationships with clients and are driven to help them achieve their legal and business objectives.

For more information, please visit [www.freeborn.com](http://www.freeborn.com).

### CHICAGO

311 South Wacker Drive  
Suite 3000  
Chicago, IL 60606  
(312) 360-6000  
(312) 360-6520 fax

### SPRINGFIELD

217 East Monroe Street  
Suite 202  
Springfield, IL 62701  
(217) 535-1060  
(217) 535-1069 fax

*Disclaimer: This publication is made available for educational purposes only, as well as to provide general information about the law, not specific legal advice. It does not establish an attorney/client relationship between you and Freeborn & Peters LLP, and should not be used as a substitute for competent legal advice from a licensed professional in your state.*

*© 2013 Freeborn & Peters LLP. All rights reserved. Permission is granted to copy and forward all articles and text as long as proper attribution to Freeborn & Peters LLP is provided and this copyright statement is reproduced.*