



Speak Now? Sunrise Periods Closing on New gTLDs

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On January 21, 2014, the Internet Corporation for Assigned Names and Numbers (ICANN) announced that it has "delegated" more than 100 new generic Top Level Domains (gTLDs), or roughly five times the total number of gTLDs in existence just a few months prior. In December 2013, the 30-day "sunrise" periods opened for the first wave of these new gTLDs, and with those sunrise periods now closing, trademark owners must make potentially difficult decisions as to whether and how they will protect their marks under these new gTLDs.

"Top Level Domain" (TLD) generally refers to the right-most string within a domain name – for example, .com. Some are "ccTLDs," and are country-specific (e.g. .uk? for United Kingdom). Others are gTLDs, and comprise three or more letters. Until recently, there were 22 gTLDs in existence, the most common being .com, .org, .edu, and .gov. In 2011, however, ICANN voted to allow third party "applications" to introduce new gTLDs. Two and a half years later, the first of these new gTLDs are being rolled out.

As a practical matter, trademark owners who previously (and in some cases, defensively) registered the domains incorporating their marks within the more common *older* gTLDs will need to consider whether to do likewise within any of the new gTLDs. Should a photography business, for instance, register its mark under the new gTLD .camera? Should it register the same mark under .gallery? And, if a third party using the same mark, perhaps in a different jurisdiction, registers either of these domains, how will that affect its business?

Fortunately, there are multiple means by which trademark owners may seek to protect their marks as new gTLDs are introduced. One such means is registration. To the extent the photography business possesses a trademark that is nationally or regionally registered (in any jurisdiction), or that falls into other defined categories of protected marks, the business may register domains incorporating that mark within the new gTLDs during the gTLDs' respective "sunrise" periods. These periods have already begun to close, however, for the first wave of new gTLDs. On February 1, 2014, the sunrise periods will close on the following gTLDs: .camera, .equipment, .estate, .gallery, .graphics, .photography and

.lighting. One week later, the sunrise periods will close on another set of new gTLDs, including .technology and .construction.

A current chart of sunrise claims periods, including closing dates, can be found [here](#).

If a trademark owner fails (or declines) to register a domain within a particular gTLD prior to the end of that gTLD's sunrise period, the owner is not necessarily precluded from registering the domain thereafter. However, after the close of the sunrise period, domains may be registered by third parties who *do not* possess corresponding registered or protected trademarks. Registration during the sunrise period, in other words, offers trademark owners "dibs" on any domains incorporating their marks.

A trademark owner that does not wish to register a domain in a particular gTLD, but wishes to protect its brand, may still do so by registering its marks with the Trademark Clearinghouse. Registration with the Trademark Clearinghouse carries an annual per mark fee, but provides a monitoring and notification "Claims" service whereby the trademark owner is notified if a third party registers a domain in a new gTLD that incorporates the owner's registered mark. The owner may then have the opportunity to take action to prevent the third party registration. ICANN's FAQs regarding the Trademark Clearinghouse are available [here](#).

Trademark owners are encouraged to review the list of delegated gTLDs, both now and on an ongoing basis (given that ICANN will continue to review applications and delegate additional gTLDs on a rolling basis), and to consider potential domain registrations, as well as registration of its trademarks with the Trademark Clearinghouse. Trademark owners are further encouraged to review the sunrise periods and to avail themselves of opportunities to register particularly important domains before they become publicly available.

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