

Domain Update.



I. READY, STEADY, GO!

For a long time, everyone was talking about the new generic Top-Level Domains (gTLDs). In April 2012, we reported that the applications started. Already in June 2012, more than 1,900 applications were published and in March 2013, our newsletter reported on the details regarding the newly established Trademark Clearinghouse for the new gTLDs.

“SHABAKA” (شبكة) appears to be the first new gTLD which actually went “live”. This gTLD may be translated from Arabic to “.web” or “.internet”. Further, this TLD represents the first worldwide “internationalized domain name” (IDN) in Arabic. We will see the extent of interest for this gTLD.

II. SECOND ROUND OF DONUTS

Donuts, Inc., a company incorporated only for the purpose of registering new gTLDs, has now made available their first gTLDs and a second set of seven gTLDs are to follow on 3 December 2013:

26 November 2013	3 December 2013
*.bike	*.camera
*.clothing	*.lighting
*.guru	*.equipment
*.holdings	*.graphics
*.plumbing	*.estate
*.singles	*.gallery
*.ventures	*.photography

The 60 day sunrise period lasts until 29 January 2014 and 31 January 2014 respectively. Afterwards, the land rush period for the new gTLDs will make them available for everybody. According to Donuts' website www.donuts.co they have already found further registrars for various new gTLDs.

III. HOW TO TAKE PART

Whoever wishes to register trademarks as domain names under the new gTLDs may now file its trademarks with the Trademark Clearinghouse (TMCH, www.trademark-clearinghouse.com). This will ensure that the trademark owner will be alerted to the actual start of any sunrise period for a new gTLD. The trademark owner will then be able to register a domain name during the sunrise period. The application for a second level domain (e.g. **brand**.camera) during the sunrise period will have to be filed separately. Identical applications of third parties for the same domain name will be notified to the trademark owner.

The final costs for an application with the TMCH depend on the profit margin of the respective domain service provider to be added to the official fees. The official fees for registering a trademark with the TMCH per trademark have to be paid to Deloitte¹ as competent "broker". The fees are 245 USD for one year, 435 USD for three years and 725 USD for five years. A renewal for one year will cost 145 USD.

Registered trademarks, trademarks acquired by use (the existence of which has been confirmed by a Court) or registered geographic appellations of origin can be filed with the TMCH. A special spelling and special characters are excluded. The use of a trademark – as far as relevant – has to be evidenced by a respective declaration, product labels etc. The evidence has to be renewed every five years.

A reduced alternative application with the TMCH is the Trademark Claims Notification. The effect is that the trademark owner will be alerted to possible identical applications of third parties.

¹ Deloitte Enterprise Risk Services

IV. BLOCKING OF DOMAIN NAMES

Rumour has it that Donuts, holding applications for more than 300 new gTLDs, will offer a kind of “blocking service”. In consideration of a certain fee, domain names identical with certain trademarks (e.g. “**brand**.camera”) registered with the Domains Protected Marks List (DPML) will be blocked. However, also the blocking trademark owner will not be able to use the domain name. The only advantage is that no third party can register and use the domain name. Donuts’ exact prices for this service are yet unknown. Different offers of domain service providers suggest that for a five year blocking service for all Donuts’ gTLDs about 3,000 USD might have to be paid. Again, it will be worthwhile to compare different offers of different domain service providers. From a commercial point of view it may only make sense to block gTLDs for the future in a few cases. It seems recommendable to await which relevance the new gTLDs will obtain in the future.

We will be happy to advise on next steps to be taken in this context.

Your contacts:



Dr. Martin Viefhues
Attorney-at-Law/Managing Director
Certified Specialist in
Intellectual Property Law
T +49 (0)221 27758-212
viefhues@jonas-lawyers.com



Katja Grabienski
Attorney-at-Law/Associated Partner
Certified Specialist in
Intellectual Property Law
T +49 (0)221 27758-218
grabienski@jonas-lawyers.com

JONAS Rechtsanwaltsgesellschaft mbH
Hohenstaufenring 62 . 50674 Cologne . Germany
Tel. +49 (0)221 27758-0 . Fax +49 (0)221 27758-1
info@jonas-lawyers.com . www.jonas-lawyers.com

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