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Registration with ICANN's Trademark Clearinghouse a Necessity for Securing a ".college"

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The ".college" top-level Internet domain will soon be available to institutions of higher education ("IHEs"). IHEs with federally registered trademarks can take advantage of the upcoming "Sunrise Period" and secure their ".college" domain as soon as possible. The Sunrise period runs from March 17, 2015, to April 17, 2015. However, to register for a ".college" domain during the Sunrise Period, the IHE must first register their trademark with the Trademark Clearinghouse operated by the Internet Corporation for Assigned Names and Numbers ("ICANN").

Accordingly, the action is needed to ensure an IHE can register ".college" domains that correspond with its trademarks. Ownership of a trademark does not automatically grant the right to a ".college" domain with that trademark. Rather, domain names will be given out on a "first-come-first-served" basis, and only word marks are eligible for registration with the Clearinghouse, which will not accept designs or logos.

During the Sunrise Period, only trademark holders who have taken the step of registering their mark with the Trademark Clearinghouse will be able to purchase a ".college" domain. The domain must be identical to the trademark. For example, if an IHE's trademark is "ABC College" it can only seek to register the domain "ABCCollege.college" during the Sunrise Period, and not "ABC.college." Registration for a domain during the Sunrise Period also requires certain legal filings to be uploaded to the Clearinghouse's systems, including a declaration of use and a sample of proof of use of a trademark.

Registration with the Trademark Clearinghouse also provides protection to the holder of a mark during the "Trademark Claims Period," which is estimated to run for 90 days after ".college" opens for general availability. During the Trademark Claims Period, if a party is attempting to register a domain name matching a mark in the Clearinghouse, the party will receive notification of the existing mark. If the party then goes on to register the domain despite this notice, the trademark owner will receive notification from the Clearinghouse of the registration. The trademark owner would then need to seek legal recourse against the domain name holder. It should be noted that the benefits of the Trademark Claims Period are available to marks registered with the Trademark Clearinghouse, irrespective of whether the holder of the mark registers a ".college" domain. However, in order to receive notice during the Trademark Claims Period the mark registered must be identical to the trademark owner's mark.

Following the Sunrise Period, there is a “landrush period” running from April 20, 2015, to September 20, 2015. During this time, IHEs that own “.edu” domains can seek to register for a “.college” domain. To take advantage of the “landrush” it is not required that the IHE have a federally registered trademark, but domains will be given out on a first-come, first served basis.

From September 21, 2015, through September 28, 2015, the “early access period” will run, during which anyone can register for a “.college” domain and prices will vary depending on the day (becoming lower each day). The “early access period” thus allows any entity or individual (even those without federally registered trademarks or “.edu” domains) willing to pay a higher price to secure a “.college” domain to do so as soon as the “landrush” period ends. Beginning on September 29, 2015, the “.college” domain will be open for general availability.

In sum, to ensure registration of an IHE’s trademarks with a “.college” domain during the Sunrise Period, pre-registration of a trademark with the Clearinghouse is a necessary first step. When the Sunrise Period ends, there will be no guarantee that IHEs will be able to obtain “.college” domains which correspond to their trademarks, and any other entity may register for a corresponding domain.

Please note that this advisory is a general overview of the requirements to obtain “.college” domains. A number of other top-level domains that may be of interest to educational intuitions are also available, including “.school”, “.university” and “.institute”. If you have any questions regarding this matter or need assistance with registering a federally registered trademark with the Trademark Clearinghouse, please feel free to contact Karen Levin at 516-296-9110 or via email at klevin@cullenanddykman.com, Jennifer McLaughlin at 516-357-3713 or via email at jmclaughlin@cullenanddykman.com, Ariel Ronneburger at 516-296-9182 or via email at aronneburger@cullenanddykman.com, or Cynthia Thomas at 526-357-3853 or via email at cthomas@cullenanddykman.com.

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