

INTERNET & TECHNOLOGY LAW

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The DotCom Shake-Up: How Will You Protect Your Rights in the New Imminent Domain Name Release?

The Internet Corporation for Assigned Names and Numbers, often referred to as ICANN, has now released its list of 1,930 applications for proposed new generic Top-Level Domain Names (“New gTLDs”). A list of the New gTLDs and the respective applicants is [available here](#). Much speculation has been made about how these New gTLDs, if successful, will impact the Internet. Brand owners and others are advised to be diligent in preventing others from securing any New gTLDs that may adversely affect their rights.

As expected, many of the applications seek registration of New gTLDs that correspond with generic terms such as .business, .city, .computer and .beer. Still, numerous other applications include domains that correspond with brand names, such as .google, .hbo, and .ferrari. In many cases, more than one applicant has sought registration of the same New gTLD. Additionally, some of the New gTLDs requested, undoubtedly correspond with trademarks belonging to others.

To address potential disputes over New gTLD applications, ICANN offers several types of pre-delegation dispute resolution procedures to address objections to registration, including:

1. Legal Rights Objections;
2. Community Objections;
3. String Confusion Objections (objections based on confusing similarity to existing top level domains such as .com or .info); and
4. Limited Public Interest Objections (for example, objections based on human or civil rights); and
5. Intergovernmental Organization objections

Prior to ICANN’s approval of a New gTLD, third parties will have an opportunity to file a formal objection to a proposed application on the above-stated grounds. Currently, the objection filing window is anticipated to be seven months, from June 13, 2012 to Jan. 13, 2013.

HIGHLIGHTS

1,930 new personalized top level domain name applications announced today by ICANN

Companies would be well advised to review and assess potential issues with new domain names prior to their registration

Barnes & Thornburg can advise on virtually all issues related to the New gTLD program

Most objections will likely consist of Legal Rights Objections and Community Objections.

Legal Rights Objections

Brand owners are strongly encouraged to review the list of New gTLD applications to help identify potential legal rights violations. If a potential violation is identified, brand owners can initiate an arbitration proceeding requesting that an independent panel determine whether an applicant's potential use of the applied-for New gTLD would be likely to infringe the brand owner's trademark rights. To address any such concerns, brand owners may seek to prevent the registration of applied for gTLDs that:

- (i) take unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark;
- (ii) unjustifiably impair the distinctive character or the reputation of the objector's mark; or
- (iii) otherwise create an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark.

Community Objections

Established institutions that are associated with clearly delineated community may also have a basis to object to New gTLD applications. To prevail, an objector must demonstrate there is a substantial opposition to registration of that New gTLD by the community and that the use of the New gTLD will cause a material detriment to the rights or legitimate interests of its associated community and the broader Internet community.

Barnes & Thornburg regularly assists clients in protecting their valuable digital properties such as domain names. In particular, Barnes & Thornburg can provide assistance in key areas such as:

- Identification and assessment of potentially infringing or otherwise problematic New gTLD applications;
- Providing advice and strategies for addressing infringing or otherwise problematic New gTLD applications;
- Filing and managing formal Objections, Responses to Objections, and other possible litigation seeking to prevent or allow the registration of New gTLDs;
- Providing counsel and managing Rights Protection Mechanisms (RPMs) to address post-delegation concerns caused by the use and registration of New gTLDs by others; and
- Providing comprehensive brand protection and brand strategy advice in light of the New gTLD program.

For more information or if you have questions about this topic, please contact the Barnes & Thornburg attorney with whom you work, a member of the firm's Internet & Technology Group, or the Group's chair, David A. W. Wong, at 317-231-7238 or dwong@btlaw.com.

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