Every Brand Owner Needs to Click This Link: ICANN Reveals List of 1,930 Applications For Generic Top-Level Domain Names (gTLDs)

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Attorney Articles

The Internet Corporation for Assigned Names and Numbers ("ICANN") this morning released the list of 1,930 generic top-level domain names ("gTLDs") that entrepreneurs and others have applied to create and operate on the Internet. About its much-anticipated announcement, ICANN said this "will mark the next phase in one of the most significant developments in the history of the Internet."

Some key statistics:

- 1846 are "standard"; 84 are community-based;
- 66 are for geographic names;
- 116 are for internationalized domain names (IDNs) in non-Latin scripts;
- 60 countries are represented;
- 751 applications are in competition with other applications for identical or similar gTLDs; and
- 911 are from North America; 675 from Europe; 303 from Asia Pacific; 24 from Latin America; and 17 from Africa.

A gTLD is the part of the domain name to the right of the "dot." The most well-known gTLD is .com; others include .org, .net, and country code TLDs like .uk and .fr. Earlier this year, ICANN began accepting applications to turn any combination of three or more letters, in almost any alphabet, into a gTLD. The applications were confidential, however, so apart from some publicly-announced applications, no one knew what the gTLDs would be.

Now, after a technical glitch and resulting two-month delay, the moment that ICANN is calling "Reveal Day" is upon us. So while it is likely more than six months before any of the new gTLDs will launch, others will be delayed for years, and some will never launch, today is the day that every brand owner should be asking the same question: is someone trying to turn my brand, product, or industry name into a gTLD?

The full list is online at http://newgtlds.icann.org/en/program-status/application-results/strings-1200utc-13jun12-en

Go ahead and click through to it. Once you have had a first look through the list, come back here for some further information and options for next steps.

We'll wait.

Welcome back. Is there an application for .yourbrand, .yourproduct, or .yourindustry – or something else that is concerning? Some of the interesting generic

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applications include: .app, .beauty, .computer, .data, .doctor, .eco, .fashion, .food, .green, .hotel, .law, .med, .ngo, .restaurant, .site, .store, .style, .tech, and .website. Brand applications include: .calvinklein, .chrysler, .delta, .google, .mcdonalds, .oldnavy, and .target. There are many applications for gTLDs in texts other than Latin, including .[shopping], .[site], .[mobile], and .[fashion] in Chinese text, and .[bazaar], .[arab], and .[catholic] in Arabic text. There are also applications for non-Latin letter equivalents of ".com" in at least six scripts, including Arabic, Chinese, Cyrillic, Devanagari, Hebrew, and Japanese.

Depending on what you found, there are some different next steps to consider. Unfortunately, they are far from perfect. The timeframe for action includes a comment period that closes in 60 days.

Submit An "Application Comment"

The first opportunity to object to a problematic gTLD is with an "Application Comment" weighing in on the merits of the application. The deadline for submitting such a comment to ICANN is August 12, 2012 (60 days from Reveal Day).

While anyone is allowed to submit an Application Comment, the allowable subject matter is rather limited. It will only be possible to comment on the public portions of the application: the applied-for gTLD, the identity of the applicant, the "Mission & Purpose"of the gTLD, its approach to protection of "geographic names," and limited technical aspects of how the gTLD will be operated. The scope of potential objections is further limited to topics that are not addressed by the "formal" objections procedures discussed below. Most importantly, this means that an Application Comment is not meant for raising the issue that would concern brand owners the most: that a third party is applying to register its brand as a gTLD.

ICANN-Created Formal Objections: Existing Legal Rights Objection, Community Objection, and Limited Public Interest Objection

To consider the claims of trademark owners, ICANN has established a type of arbitration proceeding called an Existing Legal Rights Objection ("ELRO") that will be handled by the World Intellectual Property Office ("WIPO"). A trademark owner can use an ELRO to object that an applied-for gTLD infringes its trademark rights. While the objection deadline has not been finally determined, WIPO states that the "filing window" opens today and "is anticipated to be seven months." If successful, an ELRO would prevent the gTLD from registering. But it is a far from perfect option.

The procedure will be very limited. Each side will file a 20-page brief. A hearing might be held "in extraordinary circumstances," but a decision will generally be made on the briefs alone.

The substantive rules that ELRO panels will consider are sparse and subjective, so it is difficult to say how a panel would decide any particular objection. But, significantly, the rules do seem to say that an ELRO will not likely succeed against an applicant that has its own legitimate rights in a string.

Since more than one party may have rights to the same mark – i.e., in different parts of the world or for different goods and services – this is a real concern. If Company A had rights in the ACME trademark for tires, but Company B had rights in the ACME mark for toasters, and Company B applied for the .acme gTLD for legitimate purposes, Company A's ELRO against Company B's application might not succeed. The fact that Company A began using the mark first probably would

not matter. In short, an ELRO may only be a good option for objecting to applications that have been filed in bad faith – for example, by parties whose motivation is to trade on a brand owner's mark.

ICANN's other two formal remedies, which will be handled by the International Chamber of Commerce ("ICC"), are even more narrow. A Community Objection may be made only by a party representing a community of people whose name is used in the gTLD. An application to register a gTLD that is the name of an ethnic group, for example, could be objected to by a community organization speaking on behalf of that group.

A Limited Public Interest Objection may be brought on the grounds that the applied-for gTLD is "contrary to general principles of international law for morality and public order," where "[e]xamples of instruments containing such general principles include" the Universal Declaration of Human Rights and the Convention on the Elimination of All Forms of Discrimination Against Women.

As with the ELRO, the deadline to file one of these types of objections has not been set, but the ICC predicts it will be seven months from today.

Litigation In Federal or State Court?

Since the remedies provided by ICANN for objecting to a new gTLD application are so limited, could federal or state court litigation be a better option for brand owners who find their trademarks in applied-for new gTLDs? In theory, a brand owner might have claims against a gTLD applicant for trademark infringement, dilution, or unfair competition. The strength of any such claim would depend on the facts, but there could be several advantages over the ICANN remedies. A brand owner would have the opportunity to develop the case through discovery, for example. Also, any prior competing rights of the applicant would probably be given consideration, but may not be as dispositive as it seems they will be in an ELRO.

The Trademark Clearinghouse: Protect Your Brand in The Second Level of The New gTLDs

If no one has applied to register your brand as a gTLD, or filed any other gTLD application that is worth objecting to directly, consider yourself lucky. But you are not out of the woods yet. The next question is how to register, or keep someone else from registering, your brand as a second-level domain name in the new gTLDs – as in yourbrand.anything. In that regard, ICANN is implementing a Trademark Clearinghouse.

Many of the details are not yet determined and may change as ICANN completes the division of gTLD applications into four batches. However, we know that owners of registered trademarks, who provide evidence of their registrations and evidence of the actual use of their marks, can obtain Trademark Clearinghouse registrations that afford two benefits: notification of identical second-level domain name registrations and the opportunity to file efficient sunrise period applications for second-level domains. The filing fee is expected to be less than $150 per trademark, and the deadline to file an application for clearinghouse registration, while not yet determined, is currently predicted to be in January, 2013.

Unfortunately, the notification system does not block applications by others. It is more like a trademark watch service. If a third party applies to register a second-level domain name that is "identical" to your recorded mark, it will receive a notice of your rights. If the third party proceeds with the domain name registration despite having received that notice, you will be notified of the domain name

registration. Trademark owners will have to use one of several domain name dispute resolution mechanisms to contest second-level domain names that they find problematic – and they can only do so after the second-level domain name has registered.

The only way to prevent someone else from registering your brand as a second-level domain in the new gTLDs will be the old-fashioned way – to preemptively register it yourself. The Clearinghouse, at least, offers a method for efficiently registering a lot of domain names at once, and before members of the public who do not own the same trademark for other products or in a different jurisdiction will have the chance to do so. The process is not finalized, but it appears that brand owners may be able to file one sunrise period application based on a Trademark Clearinghouse registration and have it extend to all of the gTLDs in which they are eligible to register – hundreds of different registries.

The fact that all of these preemptive registrations will mean money for gTLD operators and registrars without providing much real benefit to the brand owners, or perhaps, much social utility generally, is a legitimate criticism of ICANN and the system it has set up. But it is also probably a moot point. The new gTLD world is here, and brand owners need to protect their brands in it. That starts with one little click.

Dorsey & Whitney's Trademark, Copyright, Advertising, and Brand Management Group has been assisting clients in filing new gTLD applications and would be pleased to assist your company in protecting its rights in the new gTLD world. If you have any questions, please contact one of our trademark attorneys.

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