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## New Generic Top-Level Domain Names: What Brand Owners Need to Know

On June 13, 2012, the Internet Corporation for Assigned Names and Numbers (ICANN) posted a list of all new generic top-level domain (gTLD) strings along with the names of those who applied for them. The posting of this list marks the expansion of the existing internet infrastructure by increasing the number of gTLDs—the general address extensions that come after the last dot, e.g., .com, .net., .org, etc.—to an almost unlimited number. This Advisory explains the events of, and leading up to, the June 13 “Reveal Day,” and introduces brand owners to several relevant elements of the new gTLD process.

### Background

In June 2011, ICANN, the private nonprofit corporation that manages most top-level domains (TLDs) and IP addresses, approved a program to allow any legal entity to file an application, accompanied by fees totaling \$185,000, to create (and manage) new gTLDs of their choosing. The period to apply for new gTLDs opened on January 12, 2012, and closed on May 31, 2012. On its June 13 “Reveal Day,” ICANN reported that it had received 1,930 applications for new gTLD strings during this application period. A list of all of the newly applied-for gTLDs is available on [ICANN's website](#).

### Public Review Process

ICANN's posting of the newly applied-for gTLDs and the identity of their applicants triggers a number of events in the new gTLD program. These events will include a substantive review of each new gTLD application by ICANN, and several opportunities for public review and comment regarding the new gTLD process. Of particular note, “Reveal Day” starts a 60-day period during which anyone may submit comments to ICANN, and a seven-month period during which non-applicants with certain specified grounds to object will have an opportunity to file a formal objection to any new gTLD application before it is approved. ICANN anticipates that the first new gTLDs will be launched in early 2013.

### The Objection Process

Objections to new gTLDs are to be filed with a dispute resolution service provider (DRSP) approved by ICANN, and not with ICANN itself. ICANN has specified four formal objection grounds and the situation(s) in which each is appropriate:

1. **String Confusion:** When the applied-for gTLD string is confusingly similar to another applied-for gTLD string. The approved DRSP is the International Centre for Dispute Resolution.
2. **Legal Rights:** When the applied-for gTLD string violates the legal rights (e.g., trademark rights) of the objector. The approved DRSP is the World Intellectual Property Organization (WIPO).

For more information or if you have any questions, please contact your Katten Muchin Rosenman LLP attorney or any of the following members of Katten's **Intellectual Property** Practice.

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3. **Limited Public Interest:** When the applied-for gTLD string goes against generally accepted legal norms of morality and public order that are recognized under principles of international law. The approved DRSP is the International Centre for Expertise of the International Chamber of Commerce.
  4. **Community:** When there is substantial opposition to the applied-for gTLD string application from a significant portion of the community that the gTLD string is targeting. The approved DRSP is the International Centre for Expertise of the International Chamber of Commerce.

For trademark owners, the legal rights objection appears to be the most pertinent. Under a legal rights objection, a party may object if “the potential use of the applied-for gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark.” In other words, a legal rights objection would allow a trademark owner to oppose a new gTLD application where the applied-for gTLD would infringe on the trademark owner’s existing rights. The determination of whether an applied-for gTLD infringes the objector’s trademark rights will be made by a panel of experts appointed by the DRSP.

A legal rights objection may be filed with WIPO in Geneva, Switzerland. WIPO’s filing fee for an objection covering one gTLD application, to be heard by a single expert panelist, is \$10,000 per party, which includes a non-refundable case administration fee of \$2,000. If an objection is successful, the prevailing party will be entitled to termination of the gTLD application and a refund of \$8,000 (the expert fee). Monetary damages are not available.

## Trademark Clearinghouse

Another part of the new gTLD program will be the creation of a “Trademark Clearinghouse.” Trademark owners will be able to submit their registered marks for inclusion for a fee estimated to be less than \$150. ICANN has announced that it will be contracting with IBM and Deloitte to create the Clearinghouse. It is anticipated that the Clearinghouse will be ready to accept submissions from trademark owners for a period of three months, starting in October 2012.

The Clearinghouse is intended to serve as a single centralized database of verified information that would enable gTLD operators and registries to better review and assess trademark claims, and allow trademark owners to more easily register second-level domain names under new gTLDs (e.g., YOURNAME.example).

## Trademark Claims

The Clearinghouse would provide “Trademark Claims” notices to participating rights holders when third parties attempt to register domain names matching Clearinghouse records, thus alerting trademark owners to instances of potential infringement. Similarly, any party attempting to register a second-level domain name comprised of a trademark already in the Clearinghouse’s database would receive a Trademark Claim indicating that the proposed second-level domain name is consistent with an existing trademark.

## Sunrise Period

All new gTLD applicants are subject to a mandatory “Sunrise Period” after the launch of their new gTLD. During the Sunrise Period, eligible trademark owners will be given an early opportunity to register second-level domain names under new gTLDs (e.g., YOURNAME.example), before launch of the new gTLD and before registration of such names is made available to the general public.

## New Dispute Resolution Procedures

As part of its attempt to improve protection of intellectual property and other legal rights, ICANN plans to create a new dispute resolution procedure called the Uniform Rapid Suspension System (URS). URS would be intended to offer a quicker, more cost-effective alternative to existing domain name dispute resolution procedures by providing emergency relief to trademark owners in “clear cases of trademark abuse.” URS complaints will be limited to 500 words, and the proposed filing fee is \$300. A successful URS complaint would result in the subject domain name being locked and suspended, however, unlike under the Uniform Domain Name Dispute Resolution Policy (UDRP), the domain name would not be transferred to the complainant.

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## Conclusion

ICANN's new gTLD program is still evolving, but promises to transform and expand the existing internet infrastructure. With these changes, trademark owners will face a number of new challenges and opportunities. It is recommended that all trademark owners review [the list of new gTLD applications](#). Interested parties may have an advantage in protecting their trademarks, obtaining their first choice of domain names, and avoiding future legal action.

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