



Program Title

The New Top-Level Domains: Guidance for the Business Lawyer

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ICANN's New gTLD Program: The Next Steps

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Application Process— Where Are We Now?

- New gTLD program, approved in 2008, opens for applications January 12, 2012.
- Applications are \$185,000 (plus the costs of running a registry and escrow in case of failure)
- It is anticipated that there will be over 1000 applications, but ICANN will only process batches of approximately 500 at a time.
- Full details at <http://newgtlds.icann.org/>

Application Process— Where Are We Now?

■ Timeline

- January 12, 2012 – April 12, 2012: Application period for new TLDs.
- End of April through May: Period for commenting on applications, including GAC Advice or Warnings
- May 1, 2012 – December 1, 2012: Period for filing objections to new gTLD applications.
- January 2013 Earliest time a new gTLD – one with no objections filed – could be approved and delegated to a registry.

Application Process— Where Are We Now?

■ Options:

- Try to file an application (though time is possibly too short to complete an application)
- Submit public comments
- Prepare a Challenge
- Develop a defensive strategy, including a budget, for rights protection
- Do nothing

Who Is Applying and Why?

- There are lists of people watching “dot something” TM registrations (and non-English equivalents), but <http://www.newgtldsite.com/new-gtld-list/> says there are 83 credible applicants to date.
- Many believe the “wild card” is the number of .brand applicants.
- Most brand owners who are thinking about applying report feeling pressure to do so, not actively desiring a .brand presence.

Who Is Applying and Why?

- A preference is given for “community” TLDs in the application process, thus many applicants are claiming a community
- Some “group” TLDs, like “.shop” could face significant resistance from retail stores who do not want to be forced to register a domain name in the .shop TLD.

Potential Challenges

- After the Public Comment period, where application details are made public, parties actively opposed to an application may formally object.
- Good information on Challenges available from ICANN at:
<http://dakar42.icann.org/meetings/dakar2011/presentation-app-evaluation-new-gtld-27oct11-en.pdf>

Potential Challenges

- There are four grounds on which to object to an application:
 - String Confusion – *string causes confusion [International Centre for Dispute Resolution]*
 - Legal Rights – *infringement of the objector's rights [Arbitration and Mediation Centre of the World Intellectual Property Organization]*
 - Limited Public Interest – *violates principles of int'l law [Centre for Expertise of the International Chamber of Commerce]*
 - Community – *misappropriation of a community label [Centre for Expertise of the International Chamber of Commerce]*
- The Governmental Advisory Council may also make recommendations (may primarily geographic in nature)

Potential Challenges

- Relatively little information is available, though WIPO and the ICDRC have released their fees and rules: objection is likely to cost \$10,000+ per objection.
- <http://www.icann.org/en/topics/new-gtlds/draft-wipo-rules-28may10-en.pdf>
- <http://www.icann.org/en/topics/new-gtlds/draft-wipo-fees-28may10-en.pdf>
- <http://www.icann.org/en/topics/new-gtlds/draft-icdr-rules-clean-19sep11-en.pdf>
- <http://www.icann.org/en/topics/new-gtlds/draft-icdr-fees-clean-19sep11-en.pdf>

Rights Protection Mechanisms

- Post-delegation Rights Protection Mechanisms include:
 - Trademark Clearinghouse
 - Uniform Rapid Suspension System
 - Post Delegation Dispute Resolution Policy
 - Registry Restrictions Dispute Resolution Policy
 - Uniform Domain Name Dispute Resolution Policy (incumbent)

Rights Protection Mechanisms

- Trademark Clearinghouse (TMCH)
 - Trademark holders voluntarily submit their marks into the TMCH
 - The TMCH will validate the TM data, including proof of use, and may assist registries with specialized screening requirements.
 - New gTLDs are required to offer sunrise periods to protect IP, by allowing rights holders to pre-register or pre-block names that correspond to their marks.

Rights Protection Mechanisms

- Trademark Clearinghouse (TMCH)
 - Registrants registering a domain name that matches a string the TMCH will be notified of the match before finalizing the registration
 - Participation in the TMCH will be required to take advantage of these benefits.
 - Both TM holders and Registries will likely pay the fees required to maintain the TMCH.
 - TMCH is expected to open in Sept 2012.
Provider to be announced February 2012.

Rights Protection Mechanisms

- Uniform Rapid Suspension System
 - Similar to Uniform Domain Name Dispute Resolution Policy but supposed to be faster and for clearer cases.
 - Single member panels
 - Respondent pays to respond if more than 14 domain names.
 - Appeal is possible.
 - Idea was to be cheaper, but as the URS only "adds to" the UDRP, it's unlikely at this point.

Rights Protection Mechanisms

- Post Delegation Dispute Resolution Policy
 - Complainant can “go after” a Registry that appears to be systematically promoting cybersquatting.
 - Actions must be more than circumstantial
 - This policy is still under serious consideration.

Rights Protection Mechanisms

- Registry Restrictions Dispute Resolution Policy
 - Policy was designed to allow graduated and/or recommended sanctions against a Registry that strayed from its promised "roots."
 - Example: the .hotel TLD no longer requires applicants to be a hotel/accomodations provider.

Rights Protection Mechanisms

- Uniform Domain Name Dispute Resolution Policy (incumbent)
 - The only tested policy.
 - No changes to be made until at least the new gTLD program is underway.

Considerations

- Will your company/client apply for a .brand? (It may be too late to find someone to draft the application at this point).
- How will your company/client monitor new TLDs?
- Which new TLDs will your company/client be on the lookout for?
 - Competitors
 - "Categories" like .shop or .bank
 - Suppliers or related words (example: .eco if the brand is associated with green initiatives)

Considerations

- What is the budget for acquiring new domain names?
- What will you do with them?
 - Redirect
 - Park
 - Develop as alternative
 - Develop and transition
 - Wait to see what others do (particularly with SEO)
- Will your company or client participate in the TMCH? For which marks? Do you need to start gathering data?

Considerations

- What is your client's/company's rights protection strategy and is there a budget for it?
 - Buy up names
 - Defensively register/block
 - Ignore until some defined level of conflict
 - Utilize UDRP/URS
 - Some combination (as decided by whom?)

Thank you

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