

Client Alert: New Global Top-Level Domains (gTLDs)

As we advised in October 2011, the Internet Corporation for Assigned Names and Numbers (“ICANN”) recently approved a program to greatly expand the number of generic top-level domains (“gTLDs”) (e.g., .com, .org, etc.) to allow companies, organizations, and institutions to obtain gTLDs for their own brands and industry-related generic terms (e.g., .mcdonalds, .restaurant, .toyota, .auto, etc.), and operate as the domain name registrar for their own gTLDs.

On April 12, 2012, the day that was supposed to be the last day to submit applications for the new gTLDs, ICANN took the application system down because it learned that a glitch in the system allowed users to view other users’ file names and user names. The application system has been down since that date. As of May 2, 2012, ICANN had not set a date to reopen the application system or reveal the applications for new gTLDs. At the time ICANN took the system offline, there were 1,268 registered application system users. Of these, there were approximately 455 instances where a file name and the associated user name might have been viewed by another applicant. 105 applicants might have had file names and user names viewed by another applicant. 50 applicants might have viewed file names and user names from one or more other applicants.

Each registered user in the application system can apply for up to 50 new gTLDs. Estimates suggest there will be between 1,500 and 3,000 applications for new gTLDs filed by the application deadline.

We will send another update once ICANN reveals the dates that the application system will reopen and that it will reveal the applications for the new gTLDs. Once the application system reopens, ICANN anticipates that it will be open for at least five business days before the application period ends.

Once the ICANN reveals the applications for the new gTLDs, companies and individuals will have approximately seven months to object to applications for gTLDs that infringe their trademark or other legal rights, even if they have not applied for a new gTLD. The four possible grounds of objection are as follows:

- Legal rights - the gTLD infringes the legal rights of an owner of a registered or unregistered trademark;
- String confusion - the gTLD is confusingly similar to an existing gTLD or an applied-for gTLD in the same round of applications;
- Community objection - there is substantial opposition to the new gTLD from a significant portion of the community to which the gTLD may be targeted (e.g., .restaurant); and
- Limited public interest objection - the gTLD is contrary to generally accepted legal norms of morality.

A 60-day public comment period will also open once ICANN posts the applications for the new gTLDs. The purpose of the public comments is to bring relevant information and issues about filed applications to the attention of the application evaluators. Application comments are relevant to determining whether applications meet established criteria, while formal objections concern matters outside of the evaluation. Public comments will not be considered as formal objections.

We are available to:

- Review the list of applied-for gTLDs published by ICANN to determine if any of them infringes your trademark rights or falls within one of the applicable objections above;
- Provide advice on the best course of action in the event that a gTLD of interest has been applied for;
- Prepare and file objections to applied-for gTLDs; and
- Prepare and submit public comments.

ICANN has also adopted the following protection measures to be implemented once the gTLD application process has been completed:

- A “Trademark Clearinghouse” to serve as a central repository for information on authenticated trademark rights that will be valid across all new gTLDs;
- “Sunrise Periods,” supported by the Trademark Clearinghouse, that allow eligible trademark owners an opportunity to register domain names in each new gTLD before they become available to the general public;
- A “Trademark Claims” service, supported by the Trademark Clearinghouse, used during the first 60 days of a new gTLD launch that will provide notice to potential domain name registrants of existing trademark rights;
- A “Uniform Rapid Suspension Procedure” that allows trademark owners to quickly suspend the operation of infringing domain names; and
- A “Trademark Post-Delegation Dispute Resolution Procedure,” which is similar to a Uniform Dispute Resolution Policy (“UDRP”) proceeding.

For Further Information and Assistance

The Trademark & Copyright Department at Cantor Colburn LLP stands ready to answer any questions you may have about the new gTLDs and provide specific advice and guidance on the objection process following the publication of the list of applied-for gTLDs. Please do not hesitate to contact us if you would like us to review the published list of gTLD applications for possible conflicts with your trademark rights, or if we can be of any further assistance.

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Please note that each situation has its own unique circumstances and ramifications. This Client Alert is for informational purposes only and is not legal advice.