

# **The New Generic Top Level Domains (gTLDs) – Current Issues & Ongoing Trademark Concerns**

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# Snapshot of the Current gTLD Space

The original gTLDs: .mil, .gov, .edu, .com, .org, .int, .arpa, .net

***1998: ICANN formed***

2000: seven new gTLDs introduced:

.aero, .biz, .coop, .info, .museum, .name, .pro

2004: seven additional gTLDs approved:

.asia, .cat, .jobs, .mobi, .tel, .post, .travel (.xxx in 2011)

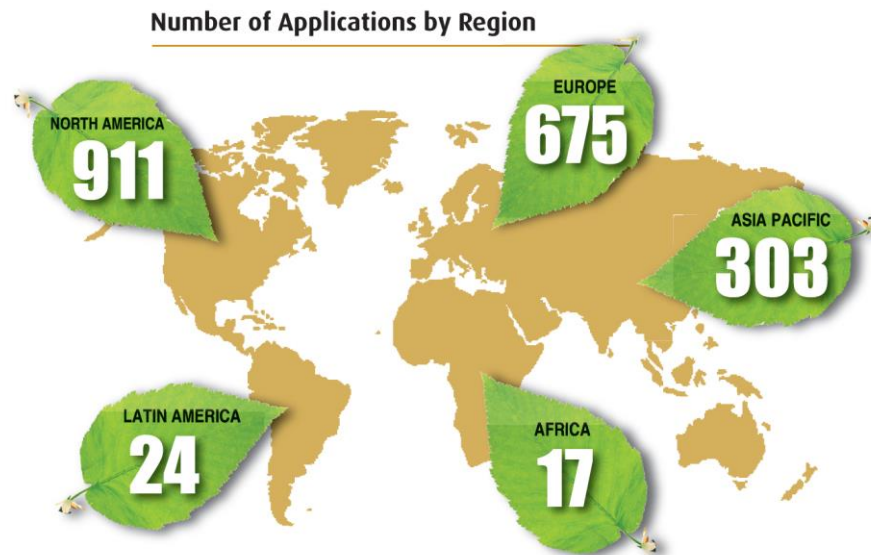
***June 2008: ICANN Board approves new gTLD program***

***Sept 2012:***

- Registrations across all TLDs exceed 246 million (12% increase over 2011)
- Registrations in .com alone number 105 million

# Snapshot of the New gTLD Program

- Launched Jan 2012; applications closed April 2012
- 1930 applications received (28 since withdrawn)
- 116 were for internationalized domain names (non-Latin script)



- 637 (33%) applications were for/by brands
- 36 of the Fortune 100 companies applied (Coca Cola (Interbrand #1) and Facebook did not)
- Google applied for 101; Amazon for 76



# Four Grounds for Formal Objections to New gTLD Applications

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- Rights-holders: **Legal Rights** objection
- Existing gTLD registry or another applicant: **String Confusion** objection
- Anyone or ICANN's independent objector (I/O): **Limited Public Interest** grounds (public international law norms)
- I/O or Targeted Community: **Community** objections

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Each ground has different dispute resolution service providers

- WIPO for legal rights
- ICDR for string confusion
- ICC for limited public interest & community

Governments can also intervene:

- **"Early Warnings" (242 received)**
- **Government Advisory Committee (GAC) Advice** to ICANN Board (**expected after April 2013**)

# Selected Examples of Objections Filed

## Legal Rights:

- *.delmonte; .music; .mail; .merck*

## Community:

- *.amazon; .architect; .bank; .charity; .gay; .hotels; .patagonia*

## Limited Public Interest:

- *.health; .healthcare; .med*

## String Confusion

- *.cam; .company; .new; .network* (by Verisign)
- *.cars; .games; .kids* (by other new gTLD applicants)

# Three Concluding Observations

## I. ICANN AS RELUCTANT LEGAL REGULATOR: THE IMPORTATION OF SUBSTANTIVE TRADEMARK LAW INTO DOMAIN NAME MANAGEMENT:

Legal rights objection:

- Applied-for gTLD *takes unfair advantage of or unjustifiably impairs distinctive character or reputation of a mark, or otherwise causes impermissible likelihood of confusion*
- Non-exhaustive factors resemble US-style infringement analysis, including *appearance, sound & meaning, and likelihood of confusion as to source, sponsorship, affiliation or endorsement*

The “open” vs “closed” generic string debate: should ICANN decide what “generic” means?

## II. MORE DISPUTE RESOLUTION FORUM SHIFTING TO PRIVATE ARBITRATION OVER TRADITIONAL LITIGATION (FOR SECOND LEVEL DOMAINS ANYWAY)

The new *Uniform Rapid Suspension* (URS) System

- Same substantive grounds as current Uniform Dispute Resolution Policy (UDRP)
- Differences lie in burden of proof and remedies
- Cheaper and faster than UDRP
- Supplements but does not displace/replace UDRP

Determination of legal rights and other formal objections done through private arbitration



### **III. POSSIBLE THAT WHILE ENFORCEMENT COSTS WILL INCREASE, NEW GTLDS MAY NOT LEAD TO EXPONENTIALLY-INCREASED CYBERSQUATTING**

- Nature and types of new gTLDs could dilute effect of cybersquatting
- Innovative business models and more effective direct means of engaging consumers/customers could develop

# Policy Development at ICANN: the Price of Consensus & Multi-Stakeholderism

## ICANN Multi-Stakeholder Model

