

February 20, 2013

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Dot Anything: Generic Top-Level Domains Update

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On January 12, 2012, ICANN, the authority responsible for management of the internet domain name system, launched the new, expanded, gTLD program, which we reported on [here](#). As implementation moves forward, we want to keep you apprised of important developments.

The Basics

A top-level domain name (“TLD”) refers to the suffix that appears at the end of the domain name. To date, TLDs have been limited to a subset of 22 generic TLDs (or “gTLDs,” *e.g.*, .com, .org and more recently .xxx) and country code TLDs and were available to be registered by only select domain name registrars.

With the launch of the gTLD program, for the first time, any party was able to apply for any new gTLD. The new gTLD program allows applicants to register four kinds of generic names as gTLDs:

- generic word TLDs (*e.g.*, .web, .home)
- corporate TLDs (*e.g.*, .brand)
- community TLDs (*e.g.*, .redcross, .amnesty)
- geographic TLDs (*e.g.*, .nyc)

The ability to register new gTLDs presents enormous potential. Not only will successful new gTLD operators gain registration of the TLD name, they will be able to register, and confer registration of all domain names falling under that new gTLD, *i.e.* “second-level” domain names (example.web). The gTLD owner will in effect become its own registrar. This has been a source of both excitement and concern for brand owners.

What New gTLDs Can We Expect to See?

The gTLD program has attracted overwhelming interest. At the close of the first application window on May 30, 2012, ICANN had received almost 2,000 applications for new gTLDs – a number well beyond initial forecasts.

Proposed new gTLDs include .bank, .cloud, .news, .football, .london, .melbourne, many well-known trademarks, as well as generic names represented in Arabic and Mandarin script.

A full list of the new gTLD applications is available at the [ICANN website](#).

Currently, it is possible for third parties to lodge a formal objection to registration of proposed new gTLDs, including where a proposed gTLD infringes a third party’s trademark rights. The deadline for filing objections has recently been extended to **March 13, 2013**.

K&L Gates can assist with all aspects of the new gTLD objection process.

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Trademark Clearinghouse Developments

One of the key features of the new gTLD program is a “Trademark Clearinghouse,” or centralized database of trademarks, which will be used as the basis for protecting trademarks at the second level of new gTLDs (the word before the .gTLD). For all new gTLDs, brand owners who register their trademarks in the Trademark Clearinghouse will have a first right to register at the second level during an initial “sunrise period.” Brand owners will also receive notification when a third party registers a trademark at the second level of a new gTLD and have access to a new uniform rapid suspension (“URS”) process to suspend a domain name that is infringing a trademark.

ICANN has appointed Deloitte and IBM to operate the Trademark Clearinghouse. They have proposed an annual fee of \$150 per submitted mark, with discounts for large-scale or multi-year submissions.

Once the program is implemented, any trademark owner may submit its trademarks for inclusion in the Trademark Clearinghouse, provided that the trademark is capable of being represented textually within the technical limitations of the domain name system. In practice, only word marks which are registered at the national level, or internationally, such as through the Madrid Protocol or at OHIM in the EU, or have been recognized by a Court are likely to be accepted into inclusion in the Trademark Clearinghouse.

ICANN is still working with stakeholders to finalize the precise rules which will govern the Trademark Clearinghouse, including which domain name variations will be considered to conflict with protected trademarks. The latest round of public consultation on the Trademark Clearinghouse implementation documents concluded on February 5, 2013.

While considerable debate has surrounded whether the Trademark Clearinghouse goes far enough to protect intellectual property rights, the new mechanism is likely to be an important new tool to many brand owners wishing to prevent abusive domain name registration. What is less known at the moment is whether brand owners will be swamped by infringing registrations by domain name squatters or whether the new gTLDs will be a storm in a teacup.

Some brand owners may decide to challenge operators of infringing websites only where the content of those websites represents a true risk to their brands and let the marginal registrations of their brand anything slide. Others may wish to prevent all registrations of their brands in any gTLD. Only time will tell. We, however, will be available to assist both types of clients.

At this stage, ICANN has not set a launch date for the Trademark Clearinghouse, but it is anticipated that the service will not commence until at least March 2013.

We will report again as soon as these details are finalized.

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