

## ICANN Deadline Fast Approaching for Objections to New Top-Level Domains

The deadline is fast approaching for third parties to object to any of the nearly 2,000 new generic top-level domains currently under review by the Internet Corporation for Assigned Names and Numbers (ICANN) for potential launch later this year. Trademark owners and other interested organizations have until March 13, 2013 to participate in ICANN's formal objection process.

In 2012, ICANN officially began the process of expanding the internet domain space to include over one thousand new generic top-level domains (gTLDs). By the time the applications period closed in May 2012, ICANN had received over 1,900 applications for new gTLDs. Applied-for strings include brand-based domains, such as .abc, .marriott, and .xerox; concept- and industry-themed domains, such as .insurance, .health, .tech, .wine, and .green; and city and community domains, such as .nyc and .paris.<sup>1</sup> Although ICANN's review process is well underway, trademark owners and others who might wish to object to any of the applied-for domains still have the opportunity to use ICANN's formal objection process to protect their rights and weigh in on which gTLDs will be approved for launch. The deadline for filing objections is March 13, 2013.

Under ICANN's objection procedures, third parties may object to a proposed new gTLD on several grounds:

- **Legal rights:** The applied-for string infringes the existing legal rights of the objector.
- **String confusion:** The applied-for string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications.
- **Community:** The applied-for string is contrary to generally accepted legal norms of morality and public order that are recognized under principles of international law.
- **Limited public interest objection:** There is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted.<sup>2</sup>

Participating in ICANN's objection process is especially important for trademark owners and other intellectual property rights holders. If such action has not already been taken, trademark owners should determine whether any of the applied-for domains are confusingly similar or otherwise harmful to their existing brands and, if so, should file a legal rights objection. Filing a legal rights objection triggers a dispute resolution process administered by the World Intellectual Property Organization (WIPO).<sup>3</sup> A WIPO panel will determine whether potential use of the applied-for domain (i) "takes unfair advantage of the distinctive character or the reputation of the objector's" trademark or service mark; (ii) "unjustifiably impairs the distinctive character or the reputation of the objector's mark;" or (iii) "otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark." If the panel determines any of these three criteria are met, the application will be withdrawn and the gTLD at issue will not proceed to launch.

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<sup>1</sup> ICANN's list of all gTLD strings that were applied for during the January 12, 2012-May 30, 2012 application window may be viewed [here](#).

<sup>2</sup> The objection process is further explained in ICANN's Applicant Guidebook, available [here](#).

<sup>3</sup> WIPO filing [fees](#) for legal rights objections start at \$10,000 per objection. Further information about legal rights objections is available on WIPO's [website](#).

Organizations also may submit informal comments regarding any applied-for gTLD through ICANN's website.<sup>4</sup> Although these comments will not be evaluated by an independent panel (as are formal objections), they will be viewable to the public and others during the application evaluation process. For gTLDs that do not directly implicate an organization's legal rights, submitting comments may be an easy and economical alternative to filing a formal objection.

To discuss filing an objection to an applied-for gTLD, to prepare for the next phase in the new gTLD process, or to develop an intellectual property strategy that encompasses the new gTLDs, please contact your usual Ropes & Gray attorney or the attorneys listed below.

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<sup>4</sup> See <https://gtldcomment.icann.org/comments-feedback/applicationcomment/login>. Although the comments period closed September 26, 2012, ICANN is accepting comments throughout the duration of the new gTLD process. Those comments will remain viewable to the public and others, but will not necessarily be forwarded to ICANN's application evaluation panels.