

## Attention Brand Owners! The Application Period for New Generic Top-Level Domain Names is Now Open

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In spite of last-minute pressure from the U.S. Department of Commerce and the Federal Trade Commission about the program's inadequate protections for trademark owners, consumers and law enforcement agencies, the Internet Corporation for Assigned Names and Numbers ("ICANN") opened the application period for new generic top-level domain names ("gTLDs") on January 12, 2012. The public can now apply to register new domain spaces (like .COM or .NET) for almost any term, such as .BANK, .ENERGY, .TECH or .YOURBRAND. It is being predicted that there is declared interest in at least 100 new gTLDs and expectations of between 300 and 1000 new gTLD applications.

More details about the application process are included in our earlier update. Please note that there are two important deadlines for applicants. First, applicants need to register for the online application system (and provide a registration fee of \$5,000) by March 29, 2012. Second, full applications (with a filing fee of \$180,000) must be submitted by April 12, 2012. Applications require a lot of information, and will take considerable time to prepare. If you are going to apply, start now – if you wait until the last minute, you may not be able to finish.

Brand owners that are not interested in applying for a new gTLD will not be able to sit the process out entirely. First, it is important to monitor new applications to be sure that no third party has applied for a gTLD that incorporates your brands. Second, it will be important to decide which of the new gTLDs, if any, in which you will want to apply for second-level domain names for defensive purposes (like yourbrand.ENERGY) or particularly monitor for second-level domain infringements. The costs for wide-ranging defensive second-level registrations could be considerable.

Various stake-holders continue to be concerned about the launch of an unlimited number of gTLDs. As recently as January 9, The Association for National Advertisers has suggested that ICANN adopt a "do not sell" list which would afford brand owners an opportunity to list their registered trademarks on a temporary "do not sell" list, free of charge. In addition to trademark and law-enforcement concerns, other key open issues relate to the mechanics by which the governments in ICANN's Government Advisory Committee can object to gTLD applications, the timing of a second round of new gTLD applications, and ICANN's selection of a provider to run the "Trademark Clearinghouse" which would be a central repository for information to be authenticated, stored, and disseminated, pertaining to the rights of trademark holders." Indeed, there are many issues to be resolved but one thing is clear – ICANN's new gTLD program is moving forward and brand owners large and small should be taking note.

If you are interested in applying for a new gTLD or in developing a defensive strategy to protect your company, please contact any of the authors of this update or the Bracewell & Giuliani attorney with whom you usually work.

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