

Legal Update

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New Generic Top-Level Domains Require Brand Owners' Attention

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On June 13, 2012, the Internet Corporation for Assigned Names and Numbers (ICANN) released a list of 1,930 applications for new generic Top-Level domains (gTLDs). The new gTLDs will allow registrants to replace “.com” and other familiar top-level domains with a generic or geographic designation, such as .baseball or .newyork, or a brand-specific suffix, such as .amazon or .apple.

Although many businesses might not be willing to incur the \$185,000 application fee and \$25,000 annual renewal fee for their own gTLD, trademark owners should still monitor gTLD applications for conflicts with existing trademarks. The list of applications for the new gTLD strings can be found on the [ICANN website](#).

The release of the applications began a 60-day comment period that will run through August 12, 2012, during which time anyone can submit comments regarding any application to be considered by ICANN evaluation panels. This may offer an opportunity to raise obvious concerns without incurring the expense of filing a more formal objection.

There is also a seven-month window to file formal objections based on one or more of the following four grounds: (1) the applied-for string is confusingly similar to another applied-for string or an existing gTLD, (2) the applied-for string infringes trademark or other legal rights (such as the right of publicity), (3) the applied-for string is contrary to the public interest, meaning “generally accepted legal norms of morality and public order,” and (4) there is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string is targeted. Objections based on trademark rights will be decided by determining whether the use of the applied-for gTLD would take unfair advantage of, or unjustifiably impair, the distinctive character or the reputation of the objecting party’s trademark or service mark or would otherwise create an impermissible likelihood of confusion.

ICANN will also implement a “Trademark Clearinghouse” that will allow trademark owners to register their marks in one place and be alerted whenever anyone else attempts to register their marks at the second level of any of the new gTLDs.

If all goes according to plan, the new gTLDs should see the light of day sometime in early 2013. Once the objection period is over, brand owners may have few options other than costly litigation to remedy trademark infringement. Brand owners should therefore be proactive in protecting their rights and seek

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the advice of legal counsel for further information and assistance in navigating the ICANN objection process or pursuing trademark claims in other forums.

FVLD publishes updates on legal issues and summaries of legal topics for its clients and friends. They are merely informational and do not constitute legal advice. We welcome comments or questions. If we can be of assistance, please call or write Glenn Rice, 312.701.6895 grice@fvldlaw.com, Seth Stern 312.701.6837 sstern@fvldlaw.com, or your regular FVLD contact.

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