

10-31-2012

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Recommended Citation

Raja, Amer. "New gTLDs, New Problems." *Intellectual Property Brief* 4, no. 1 (2012): 59-60.

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Keywords

gTLD Applicant Guidebook, generic top-level domain, ICANN, trademark owners, domain names

NEW gTLDs, NEW PROBLEMS

by Amer Raja

The following blog post was originally published on www.ipbrief.net on June 16, 2012.

Last week, the Wall Street Journal reported that, while 91% of attorneys responsible for protecting trademarks were aware of the new gTLD system, only 36% of them had actually read the gTLD Applicant Guidebook in anticipation of new trademark concerns. The study, conducted by Melbourne IT Digital Preparedness Services, attempted to gauge the “knowledge, preparedness, and resource plans” of trademark attorneys across the United States. While these statistics may not have come as a shock to some, the disparity in levels of preparation will undoubtedly impact brand owners. For those attorneys unfamiliar with the gTLD Applicant Guidebook, a long process of dissecting rules and remedy procedures lay ahead; on the other hand, while other attorneys may be familiar with the gTLD Applicant Guidebook they may nevertheless face issues with navigating the murky ICANN rules.

The new gTLD program will “revolutionize” the web according to the Internet Corporation for Assigned Names and Numbers (ICANN). gTLD’s or “generic top-level domains” are the string of letters that follow the second “dot.” There are currently twenty-two current top-level domains on the internet, such as “.com” and “.net.” The new gTLD program aims to drastically enhance the web-browsing experience by increasing the number of top-level domains and is envisioned as a means for structuring and organizing the Internet.

The gTLD has been the subject of a great deal of discussion over the past few years, including those held in a couple of IP Brief blogs. However, it was not until this past week that ICANN closed the application period and finally revealed the 1,930 applications for gTLD’s that various businesses and organizations had submitted. Some of these proposed top-level domains merely reflected

brand names like “.samsung,” while others, such as “.radio,” sought to open up registration to all members of the public even remotely interested in radio stations. The next stage in the gTLD program will consist of ICANN reviewing the 1,930 applications and entertaining comments and objections about certain TLDs. While many of the applications that were submitted involved the same gTLD string, there are roughly 1,000 unique proposed domains; this means that ICANN will have a long and arduous task ahead as it attempts to determine which gTLDs to roll out in 2013. This also means that ICANN and trademark owners will butt heads now, more than ever before, over the gTLD system as claims of an anticompetitive practices increase. Trademark owners, however, will likely focus much of their attention on two issues in particular – open registries and disparaging gTLDs.

Trademark owners need to be especially cautious of gTLD applications that are aimed at creating “open registries.” Although ICANN is just gearing up to review gTLD applications, it is imperative that brand owners stay ahead of the curve and/or comment on gTLDs that may be harmful to the industry or individual consumer. An “open registry” allows individuals unofficially associated with a certain term/group, or members of the public at large to register domain names under a gTLD. “Open registries” pose a significant threat to trademark owners in particular, because the propensity for cybersquatting and abuse is far greater in a less regulated TLD. Depending on the number of generic open registries that survive the ICANN application review period, a large number of brand owners may end up filing defensive registrations.

Related to the “open registry” problem, trademark owners will likely need to pay a great

deal of attention towards registries that involve disparaging terms or terms that may tarnish the reputation of a business or mark. For instance, registries that contain adult content may allow individuals to register domain names that contain trademarks. Even assuming that some of these registries are restricted (i.e. there is either a screening or qualifying process involved), certain registries like “.sucks” and “.adult” would nevertheless be a problem for many brand owners. As a result, many trademark owners will likely need to be very quick to defensively register domain names in order to avoid the expense of filing complaints against many individuals. In the end, however, it appears that brand owners will likely end up bearing the brunt of the new gTLD system’s risks, since they will either need to defensively register domain names or have to deal with far more cybersquatters.

However, all is not lost; trademark attorneys can save their clients some major costs just by reading the gTLD Applicant Guidebook well before the eve of the new trademarks debut. ICANN, INTA, and the IPC have worked diligently over the past months to try to create a system whereby trademark owners can reduce their costs in dealing with the new gTLD system. Although many trademark attorneys were underprepared for the “.com” boom in the 1990’s and only registered one or two domains on behalf of their clients, such a lapse in preparation this time around will likely result in inexcusable expenses and may cause certain firms to lose business. While the Applicant Guidebook does not provide the whole picture with regards to protecting trademarks in the new gTLD system, it does provide a good enough background for attorneys to better serve their clients in the long run.