

2014 Hot Topics: Domain Enforcement and
Brand Protection:

The Rise of the gTLDs

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The New gTLD Program

- Policy development began in 2005.
- Expansion of the pre-existing slate of generic Top-Level Domains.
- Purpose:
 - Enhancement of Competition, innovation and consumer choice through the introduction of new gTLDs, including new internationalized top-level domains.
- Massive Land Grab/Hostage Situation?

Background: ICANN

- ❑ Nonprofit organization responsible for the stable and secure operation of the global domain name system (DNS)
- ❑ Assignment of generic and country code Top-Level Domains.
- ❑ Internet protocol (IP Address) space allocation, protocol identifier assignment and root server system management functions.

ICANN

□ Core values:

- Enhancement of Internet stability and security;
- Respect for creation, innovation and the flow of information;
- Broad inclusion of and participation by affected entities in policy decisions;
- Promoting competition through market mechanisms, including domain registration;
- Transparency in policy development;
- Neutrality, objectivity, integrity and fairness in decision making;
- Rapid response to the needs of the Internet;
- Accountability; and
- The due consideration of recommendations from government or public authorities

Domains

- Top-Level Domains (TLDs)
 - Generic Top-Level Domains (.com, etc.)
 - 7 gTLDs pre-date ICANN: .com, .org, .net, .edu, .int, .gov, .mil
 - (8 if you count .arpa)
 - Country Code Top-Level Domains
 - Two-letter country codes (many pre-date ICANN)
 - E.g., .au, .eu, .de, .us
- Second-Level Domains – to the left of the dot.

Background: TLDs

- **Before:** Since 1985 approximately 22 gTLDs have been launched:

.com, .org, .net, .edu, .int, .gov, .mil, .arpa,
.aero, .museum, .name, .pro, .biz, .coop, .info,
.asia, .cat, .jobs, .mobi, .tel, .travel, and .xxx

- **After:** Thousands of gTLDs, e.g.: .bike, .clothing, .music, .blog, .nike, .xyz, .ninja
- Approximately 1,000 gTLDs will launch this year.

“From a big picture perspective, it signals the beginning of the largest-ever expansion of the Domain Name System; a change that promises to promote global innovation, competition and consumer choice.”

Akram Atallah, president of ICANN's Generic Domains Division

gTLD Players

□ **Registry Operators:**

- Each Top-Level Domain has a corresponding Registry Operator who oversees administration of the TLD, including all Second-Level domains registered therein, pursuant to a **Registry Agreement** with ICANN.

E.g., Donuts, Inc., Radix

□ **Registrars:**

- Over 900 independent third party Registrars interface with Registry Operators and provide Second-Level Domain registration and related services to **Registrants**.

E.g., Networks Solutions, GoDaddy

gTLD Process

- The first application period of the new gTLD program opened on **January 12, 2012**. ICANN received **1,930 applications** for new gTLD strings.
- On December 17, 2012, ICANN held a **draw** to prioritize applications for processing during the initial evaluation and subsequent phases.
- On March 22, 2013, ICANN released the initial evaluation results. Applications that passed the initial evaluation without objections or string contentions are eligible for contracting and subsequent delegation with ICANN.
- The first sunrise took place in late 2013 and the first new gTLD opened for general registration in 2014. ICANN plans to gradually roll out new domains over time to ensure the continued stability of the DNS.
- There are several general types of new gTLDs, which can be characterized as “open” (“generic” or “standard”: e.g., .music and .blog), or “closed” – these include, for example, “Community-based” gTLDs (e.g., .religion) “geographic” gTLDs (e.g., .amazon) and “brand” gTLDs (e.g., .nike).

TLD types

- ❑ **Generic** (.com, .info, .net, .org) - can be used for general purposes.
- ❑ **Sponsored** (.aero, .asia, .cat, .coop, .edu, .gov, .int, .jobs, .mil, .mobi, .tel, .travel, and .xxx) - can only be used by entities engaged within the specific industry.
- ❑ **Generic restricted** (.biz, .name, .pro) - can be used only for a specific purpose.
- ❑ **Infrastructure** (.arpa) - exclusively used to support operationally-critical infrastructural identifier spaces.

New gTLD Application Categories

Type	Description	Examples
Standard or Generic TLD	Open for public registration. No restriction. Primarily generic terms.	.wine, .vin
Community TLD	Restricted to a specific community with a high degree of social awareness. The application must be supported by the community to which it is directed.	.gay, .religion, .hotel
Geographical TLD	Represents a particular city or region. The application must be supported by the local government of the region.	.nyc, .tokyo, .paris
Brand TLD	Organizations can apply for domains incorporating their trademarks and brands.	.nike, .deloitte

Brand TLDs

Wal-Mart Stores, Inc.	.george, .asda, .samsclub, and .walmart.
Gap Inc.	.bananarepublic, .gap, .oldnavy and .piperlime
TJX Cos Inc.	.homegoods, .homesense, .marshalls, .tjmaxx, .tjx, .tkmaxx.
The Home Depot Inc.	.homedepot and .thd
Target Corp.	.target
Staples Inc.	.staples
Dell Inc.	.dell
Macy's Inc.	.macys
Nike, Inc.	.nike
.amazon	Rejected due to opposition from South American nations.

gTLD Application Procedure

- **Timing:** The first application round opened on January 12th, 2012, and ended on April 20th, 2012.
- **Online Application** via the TLD Application System (TAS), which requires online user registration and payment of the corresponding \$185,000.00 evaluation fee per application.
- **Deposit:** Upfront \$5000.00 deposit submitted upon completion of online user registration, and the remaining \$180,000 due with the completed application.

gTLD Application Procedure

- **Administrative Completeness Check** immediately after the close of the application submission period, followed by a public comment period once applications are posted to ICANN's website.
- Evaluators perform due diligence on the comments received, taken into account in determining whether new gTLD applications meet the established criteria for approval.
- **Early Warning Notice:** ICANN Governmental Advisory Committee (GAC) may issue an "Early Warning" notice that the application is potentially unlawful, sensitive or otherwise problematic to one or more member governments. This creates the possibility of future GAC Advice on New gTLDs, or a formal objection.
- Sensitivities include those strings that "refer to particular sectors, such as those subject to national regulation (such as .bank or .pharmacy) or those that describe or are targeted to a population or industry that is vulnerable to online fraud or abuse."
- Upon receipt of a GAC Early Warning, applicants can withdraw their application for a partial refund within 21 days, or continue with the process (which may include meeting with representatives of the relevant governments to address the concern at issue).

gTLD Application Procedure: Initial Evaluation

- ❑ **Background Screening**
- ❑ **String Similarity Reviews:** require a determination that the new gTLD string is not similar to an existing TLD or reserved name, and is not likely to cause security or stability issues for the DNS.
- ❑ **Applicant Review:** requires that the applicant possess sufficient technical, operational and financial capabilities to act as a domain registry.
- ❑ **Extended Evaluation:** Certain applicants that do not pass Initial Evaluation can proceed to an Extended Evaluation upon request. This allows for an additional exchange of information with evaluators to clarify information in the application.
- ❑ **Summary reports** of all evaluations are publicly posted by ICANN.

gTLD Application Procedure: Formal Objection & Dispute Resolution

- **Timing.** The period for filing formal objections with the Dispute Resolution Providers (DRSPs) begins upon ICANN's posting the list of completed applications, and closes approximately two weeks following the end of the Initial Evaluation period. Applicants facing a formal objection can file a response.
- **Fee.** At the time an objection is filed, the objector is required to pay a filing fee in the amount set and published by the relevant DRSP. ICANN estimates the range of \$1,000 to \$5,000 per party per proceeding. If the filing fee is not paid, the DRSP will dismiss the objection without prejudice.
- **Advance Payment of Costs** is also directly payable to the DRSP in an amount estimated to cover the cost of the proceeding. The prevailing party will have its advance payment refunded at the conclusion of the proceeding, while non-prevailing party will not be refunded. ICANN estimates that proceedings conducted on a fixed fee basis will incur costs ranging from \$2,000 to \$8,000 or more per proceeding, while hourly rate based proceedings will likely range from \$32,000 to \$56,000 for a single member panel, and between \$70,000 and \$122,000 for a three-member panel. Costs will likely be lower for panels conducted without written submissions beyond the objection, and where there is no hearing.
- **Multiple Objections.** An application can be subject to multiple formal objection filings. In that case, an applicant must prevail in all dispute resolution proceedings in order for the application to proceed to the next stage in the process.

gTLD Application Procedure: String Contention

- ❑ **String Contention Sets.** Groups of applied-for gTLD strings which are identical or similar to one another are called string contention sets.
- ❑ Where there is more than one qualified application for the same or similar gTLD string, creating a likelihood of user confusion, the parties will typically enter into informal discussions, prior to resolution via formal process.
- ❑ Where an application is identified as part of a contention set, formal string contention resolution procedures will not commence until all applications in the contention set have completed evaluations and dispute resolution, if any.
- ❑ Once string contention resolution proceeds (usu. by Community Priority Evaluation or by agreement) the prevailing applicant(s) will proceed toward delegation of the applied-for gTLDs.

gTLD Application Procedure: Legal Rights Objections

- Prior to ICANN's approval of a new gTLD, third parties had the opportunity to file a formal objection to an application on several grounds, including, for trademark owners and Intergovernmental Organizations (IGOs), on the basis of a "**Legal Rights Objection**" (LRO).
- When such an objection is filed, an independent panel (comprised of one or three experts) determines whether the applicant's potential use of the applied-for gTLD would be likely to infringe an objector's rights.
- The objection filing window for the first round of the new gTLD program commenced on June 13, 2012 and closed on March 13, 2013. In this round of new gTLD applications, objectors filed sixty-nine (69) compliant objections with the WIPO Center.
- **Section 3.5.2 of the ICANN Applicant Guidebook** deals with LROs. It states that an independent panel will determine whether the potential use of the applied-for gTLD by the applicant:
 - (i) takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trademark or service mark ("mark") or IGO name or acronym, or
 - (ii) unjustifiably impairs the distinctive character or the reputation of the objector's mark or IGO name or acronym, or
 - (iii) otherwise creates an impermissible likelihood of confusion between the applied-for gTLD and the objector's mark or IGO name or acronym.

gTLD Application Procedure: Legal Rights Objections

- **Procedure.** The panel will ordinarily determine the merits of the objection based solely on the parties' pleadings, and may make reference to a range of non-exclusive consideration factors, depending upon whether the objection is based upon either trademark rights or rights in the name of acronym of an Intergovernmental Organization.
- **Decisions.** The resulting expert determinations may be viewed at the WIPO Center's LRO pages: <http://www.wipo.int/amc/en/domains/lro/>
- **Cost.** For a case involving an objection to one application (i.e., for one gTLD) to be decided by one expert, the fee payable upon filing is \$10,000 for each party (this includes a non-refundable \$2,000 case administration fee), subject to a refund of the expert fee (\$8,000) to the prevailing party. Different fee arrangements apply to three-member panels and to possible consolidation scenarios.
- **Other Objection Based Procedures.** ICANN offers three other types of pre-delegation objection-based dispute resolution procedures which are not administered by WIPO, namely, "**String Confusion Objection**," "**Limited Public Interest Objection**," and "**Community Objection**."

gTLD Application Procedure: Community Priority Evaluation

- Independent string contention analysis selected by community-based applicant based on four stringent criteria scored from 0-4.
 - Criterion #1: Community Establishment
 - Criterion #2: Nexus between Proposed String and Community
 - Criterion #3: Registration Policies
 - Criterion #4: Community Endorsement

- Only community-based applicants are eligible to participate in a community priority evaluation.

- A qualified community application eliminates all directly contending standard applications.

gTLD Application Procedure: Auction

- **When:** While most cases of contention are resolved by community priority evaluation or by voluntary agreement among applicants, there is an auction procedure which resolves disputes not resolved by other means.
- **Exception:** Auction will not take place in order to resolve contention in the case of applications for geographic names. In such cases, applications are suspended pending resolution by the applicants. Auctions will, however, take place in the case where an application for a geographic name is in a contention set with applications for similar strings that have not been identified as geographic names.
- **Ascending Clock Auction.** Auctioneer increases the prices associated with applications within a contention set during successive auction rounds, and the applicants indicate their willingness to pay the elevated prices. All rounds have a **start-of-round price** and an **end-of-round price**, announced before the start of each round. Applicants successively leave the auction as the prices rise, until no direct contentions remain, at which point the auction concludes and the applicants are left to pay the resulting prices for their applications.

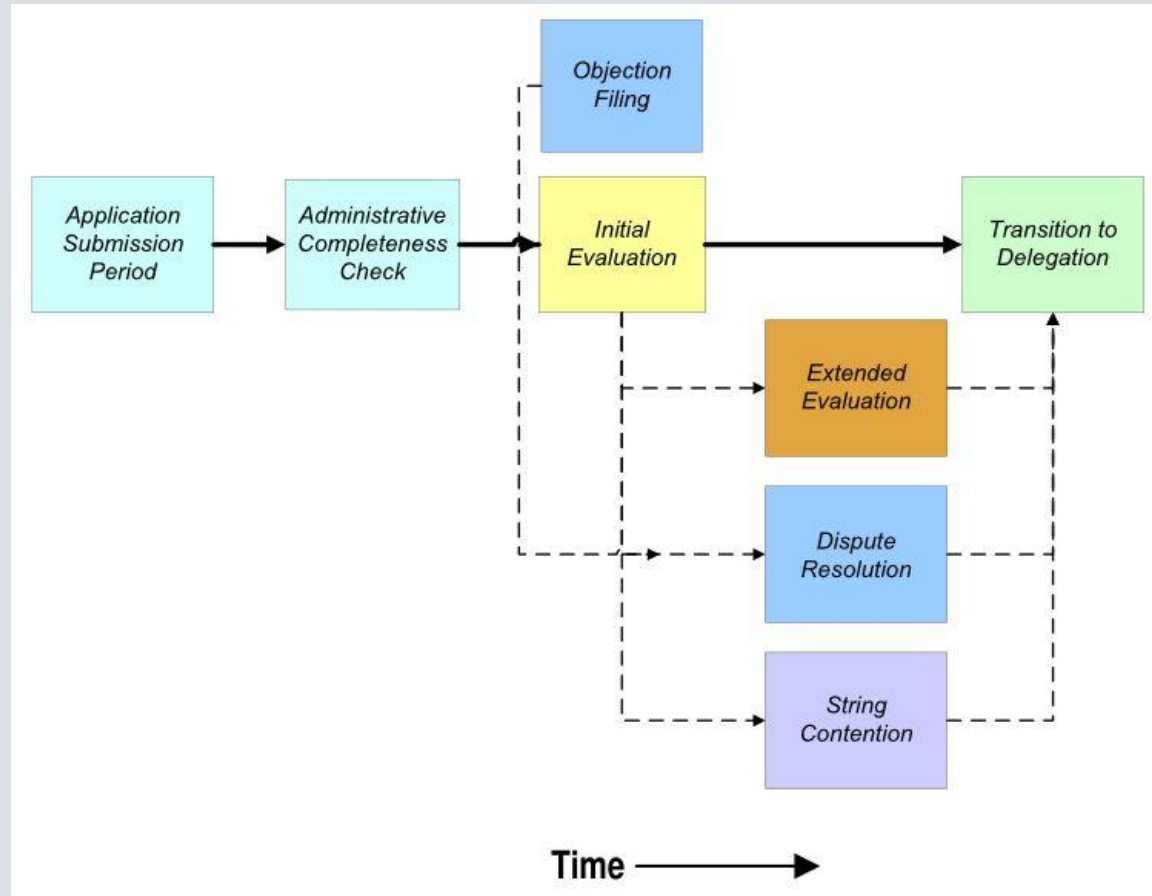
gTLD Application Procedure: Auction

- ❑ **Encrypted bidding.** All auctions are conducted on the Internet, with encrypted bids placed using special software.
- ❑ **Legally Binding Offer.** At the end of each round, bids become legally binding offers to secure the relevant string at a price up to the respective bid amount.
- ❑ Bids that are less than the end-of-round price are treated as **exit bids** for the amount specified. **Proxy bids** can be placed which are higher than the end-of-round price, which bids are then carried over to the next bidding round. A bidding deposit is required for all participating applicants.
- ❑ The winning bidder is required to pay the full amount of the final sales price within 20 business days of the end of the auction, and must execute the required registry agreement within 90 days of the end of the auction.

gTLD Application Procedure: Delegation

- **Registry Agreement.** Once an application has successfully passed all the evaluation steps, the applicant is required to sign a Registry Agreement with ICANN. Under the agreement, there are two fees: (a) a fixed fee of \$6,250 per calendar quarter; (b) and a transaction fee of \$0.25. The latter does not apply until and unless more than 50,000 transactions have occurred in the TLD during any quarterly period.
- **Technical Test.** Applicants must execute a Registry Agreement with ICANN and complete a pre-delegation technical test to validate their application information before initiation of delegation of the gTLD into the DNS root zone. This includes completion of registry technical set-up and satisfactory performance in a series of technical tests. If the applicant fails the pre-delegation testing, ICANN may elect to terminate the Registry Agreement, at its discretion.
- **Application Timeframe.** In the most favorable scenarios, ICANN estimates the overall application process to take roughly nine (9) months, but in the event of an Extended Evaluation or formal objection, etc., the application period can greatly increase, potentially upwards of 20 months.

gTLD Application Procedure



Launch phases

- **Sunrise** (start date/end date) – TM owners registered with the TMCH may obtain priority registration for gTLDs incorporating their marks.
 - A “Start-Date Sunrise” provides for a 30-day minimum period prior to opening up second-level gTLD registration to the general public. Award domains on a first-come first-served basis.
 - “End-Date Sunrise” provides at least 60 days prior to the opening of general registration. In the event of competing applications, the “End-Date Sunrise” systems resolve the conflict by way of domain auction at the conclusion of the sunrise period.
 - Otherwise, disputes over competing sunrise applications are resolved under the terms of service for each individual registry operator.
 - The price for second-level domains generally increases in the general registration period subsequent to the sunrise period, especially for “premium” domains in high demand.
- **Landrush** – Period following Sunrise. Rules vary by Registry Operator. Usually not restricted to brand owners. Domains usually offered for higher price than during sunrise. First-come, first-served or auction basis.
- **General Launch** – Open to general public following Sunrise and Landrush periods. Claim notification services for first 90 days.

Expense

- Registry Operator application filing fee:
\$185,000.00

- Additional Expenses:
 - Lawyers,
 - Research,
 - Traveling to ICANN conferences
 - Administrative expense

Total cost: (Potentially) approximately \$1 million

Hot gTLDs

- .photography
- .clothing
- .xyz
- .club
- .trust
- .guru
- .website

Risks to Brand Owners and Consumers

- Competition
- Initial Interest Confusion
- Fraud
- Cybersquatting/Typosquatting
- Phishing/Malware
- String Collision
- Registry Operator instability and insecurity

Trademark Law

- Issue: Obligation to Police
- Problem: How to Enforce?

Safeguards

- **Trademark Clearinghouse (TMCH)** - Centralized database of verified trademarks intended as a rights protection mechanism for trademark owners as part of the new gTLD program. Trademarks that are registered, court-validated, or protected by statute/treaty can apply to register in the TMCH. Trademark owners can submit their data to the database during the gTLD launch phases.
- **Eligibility:** The TMCH will only accept and verify the following intellectual property rights:
 - (i) nationally or regionally or registered trademarks;
 - (ii) court-validated marks; and
 - (iii) marks protected by statute or treaty.
- Trademarks must have national effect and be registered at the time they are submitted for verification.
- TMs registered by a city, state, province, or sub-national region are expressly ineligible for registration in the TMCH.
- For marks protected by statute or treaty, the relevant statute or treaty must be in effect at the time the mark is submitted to the Clearinghouse for inclusion. Such marks may include geographical indications and designations of origin.
- In addition to marks recognized by statute or treaty, GIs which are registered as a certification mark are likewise eligible for TMCH in certain instances.
- See Trademark Clearinghouse Guidelines, available at: http://www.trademark-clearinghouse.com/sites/default/files/files/downloads/TMCH%20guidelines%20v1.0%20_1.pdf

Safeguards, cont'd.

- **Claim Notification Service** - TMCH registrants receive notice of identical third party applications, and applicants receive a warning notice that their applied-for second-level gTLD is a match with a mark contained in the TMCH database. If the applicant nevertheless proceeds, the TMCH registrant is notified and can take appropriate action if it would like to do so.
- **Blocking Domain Registrations** - Include trademarks and their variations. Blocking domains prevent third parties from obtaining registration of an identical domain, but are not usable to drive traffic to the brand owner. Donuts, Inc., for example, offers a Donuts Protected Marks List, in which brand owners can add their trademark-related terms and have them blocked from registration at the second level in all Donuts operated top-level domains (which currently include .coffee and .cab, and may in the future include .wine and .vin). This program is somewhat more cost effective than many other blocking domain registration services offered by other registry operators.
- **Issue:** One drawback of the Sunrise, blocking registration and claims services is that they all only apply in the case of an **exact match** (or hyphenated match in the case of multiple word marks, e.g., <veuve-clicquot.wine>). This leaves huge vulnerabilities to brand owners in terms of misspellings or variations of trademarks potentially being registered as gTLDs outside of these protection mechanisms.

Domain Dispute Resolution prior to the New gTLDs

- **Anticybersquatting Consumer Protection Act (ACPA)**, 15 U.S.C. § 1125(d): One can achieve cancellation or transfer of a domain where the registrant was found to be registering, trafficking in, or using a domain name confusingly similar to, or dilutive of another's trademark or personal name, with bad faith intent to profit.
- **Uniform Domain-Name Dispute-Resolution Policy (UDRP)**: All registrars follow the Uniform Domain-Name Dispute-Resolution Policy (UDRP), introduced in 1991. Under the policy, most types of trademark-based domain-name disputes must be resolved by agreement, court action, or arbitration, before a registrar will cancel, suspend, or transfer a domain name. Disputes alleged to arise from abusive registrations of domain names (for example, cybersquatting) may be addressed by expedited administrative proceedings that the holder of trademark rights initiates by filing a complaint with an approved dispute-resolution service provider.

To invoke the policy, a trademark owner either files a complaint in a court of proper jurisdiction against the domain-name holder (or where appropriate an in-rem action concerning the domain name) or, in cases of abusive registration, submit a complaint to an approved dispute-resolution service provider.

The Uniform Domain-Name Dispute-Resolution Policy (UDRP) is available at:
<https://www.icann.org/resources/pages/policy-2012-02-25-en>.

For a list of approved dispute-resolution service providers, go to:
<https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>

Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") are available at:
<https://www.icann.org/resources/pages/rules-be-2012-02-25-en>

Newly available procedures under the New gTLD program:

Legal Rights Objection (LRO):

- ❑ **Pre-delegation procedure.** When such an objection is filed, an independent panel comprised of one to three experts determines whether the applicant's potential use of the applied-for gTLD would be likely to infringe an objector's rights.
- ❑ **Cost.** For a case involving an objection to one application (i.e., for one gTLD) to be decided by one expert, the fee payable upon filing is \$10,000 for each party (this includes a non-refundable \$2,000 case administration fee), subject to a refund of the expert fee (\$8,000) to the prevailing party. Different fee arrangements apply to three-member panels and to possible consolidation scenarios.
- ❑ **Provider.** The WIPO Arbitration and Mediation Center was appointed by ICANN as the exclusive provider of dispute resolution services for trademark-based "pre-delegation" Legal Rights Objections (LRO) under the ICANN New gTLD Program. The WIPO Center's administration of cases in this first round came to a close with the notification of the last of the expert determinations in September 2013.
- ❑ ICANN offers three other types of pre-delegation objection-based dispute resolution procedures which are not administered by WIPO, namely, "**String Confusion Objection**," "**Limited Public Interest Objection**," and "**Community Objection**."

Uniform Rapid Suspension (URS) Procedures

- **Basics:** Cheaper, often more expedient process for rights holders experiencing clear-cut cases of infringement caused by domain name registrations, than that of UDRP. Not intended for use in proceedings with open questions of fact or more involved legal scenarios. Higher burden of proof for complainants. The URS also includes a range of additional registrant defenses over an extended time period.
- **Remedy:** temporary suspension of a domain name for the remainder of the registration period (which may be extended by a prevailing complainant for one year for a fee). Thus, UDRP remains the primary vehicle for canceling or transferring of domains.
- **Procedure:** A URS complaint must first be submitted directly to an Approved URS Provider. The URS proceedings will be conducted pursuant to the approved URS Procedure. Once the complaint passes administrative review, the registry operator must lock the disputed second-level domain name(s) within 24 hours of notification by the URS Provider. If a URS proceeding ultimately results in a suspension, the registry operator must implement the suspension, and take any other actions set forth in the URS Procedure.
- **Locking/Suspension.** ICANN ensures that the registry operator timely locks, and if applicable suspends, the relevant second-level domain name(s). If the registry operator does not lock the second-level domain name, the URS Service Provider may submit a domain lock report via the URS Form.

Uniform Rapid Suspension (URS) Procedures

- **Enforcement.** If the prevailing complainant in the URS proceeding believes that the registry operator is not properly suspending a second-level domain name or not performing any other actions described in the procedure, the Complainant may submit a URS enforcement complaint form to ICANN via the URS Form.
- **Appeal.** Should a panel deny a URS complaint, the URS proceeding is terminated without prejudice for the complainant to proceed with an action under the UDRP or in a court of competent jurisdiction. A panel may also deem a URS complaint “abusive” which may result in a complainant being barred from utilizing the URS for a period of time.
- **N/A** - The URS process is not available to any ccTLD (such as .us, .de, .uk, etc.) or to any of the following gTLDs: .aero, .arpa, .asia, .biz, .cat, .com, .coop, .edu, .gov, .jobs, .info, .int, .mil, .mobi, .museum, .name, .net, .org, .post, .pro, .tel, .travel, and .xxx.
- URS Technical requirements and Rule are available at:
<http://newgtlds.icann.org/en/applicants/urs>

Domain Dispute Resolution, cont'd.

- UDRP v. URS: Advantages/Disadvantages:
 - Remedies (Cancellation/transfer v. Suspension)
 - Trademark Value Considerations
 - Filing Fee (\$1,300-5,000 v. \$375-500)
 - Time to Decision (6-8 wks v. 3-4 wks)

- UDRP remains the preferred avenue of enforcement in the era of the New gTLDs.

- QUESTION: Does the TM owner wish to put the domain to productive use?

Post-Delegation Dispute Resolution Procedure (PDDRP)

- Designed by ICANN, the PDDRP is a higher-level rights protection mechanism and an administrative alternative to court action regarding registries. PDDRP is intended to allow trademark owners to address certain scenarios where a registry operator's operation or use of a domain leads to or supports trademark infringement, either on the top level or second level.
- **Types.** There are three types of PDDRP: the Trademark PDDRP, the Registration Restrictions PDDRP, and the Public Interest Commitments PDDRP. The WIPO Center has been appointed as a provider for the Trademark PDDRP.
- **Burden.** Under the PDDRP, trademark owners are required to demonstrate, by clear and convincing evidence: (1) affirmative conduct by a registry at the top level that infringes a trademark; and/or (2) at the second level, affirmative conduct by a registry that amounts to a substantial pattern or practice of specific bad-faith intent by the registry to profit from the sale of domain names that infringe trademark rights.
- **Safe Harbor.** The PDDRP as set out by ICANN states that a registry operator is not liable under the PDDRP solely because infringing names are in its registry, or because the registry operator knows infringing names are in its registry, or if it did not monitor names registered in its registry.
- Information pertaining to the Post-Delegation Dispute Resolution Procedure is available at: <http://www.wipo.int/amc/en/domains/tmpddrp/>

gTLD Flashpoints

- **.eco** – Environmental Coalition v. highest bidder.
- **.hotel** – Owned by HOTEL Top-Level Domain S.a.r.l. (Luxemburg)
 - Intended exclusively to serve the global Hotel Community.
- **.bike** – 1st cybersquatting UDRP under the new gTLD program.
 - *Canyon Bicycles GmbH v. Domains By Proxy, LLC / Rob van Eck*, WIPO Case No. D2014-0206
- **.clothing**
- **.wine**

gTLD Flashpoints: .wine/.vin

- On June 13, 2012, three separate entities: Afilias Limited, Donuts, Inc. (under the applicant name of its subsidiary, June Station, LLC) and Famous Four Media Limited (under the applicant name of dot Wine Limited) each applied to become registry operator for the “.wine” generic Top Level Domain (gTLD). Donuts also applied for the gTLD “.vin” (under the applicant name Holly Shadow, LLC).
- Applicants foresee significant potential breadth of coverage for online wine information, services and resources.
- Ongoing disagreement between the U.S. and Australian governments on the one hand, and the EU and GI interests on the other hand, over whether there is sufficient protection for GIs in new .wine and .vin gTLDs.

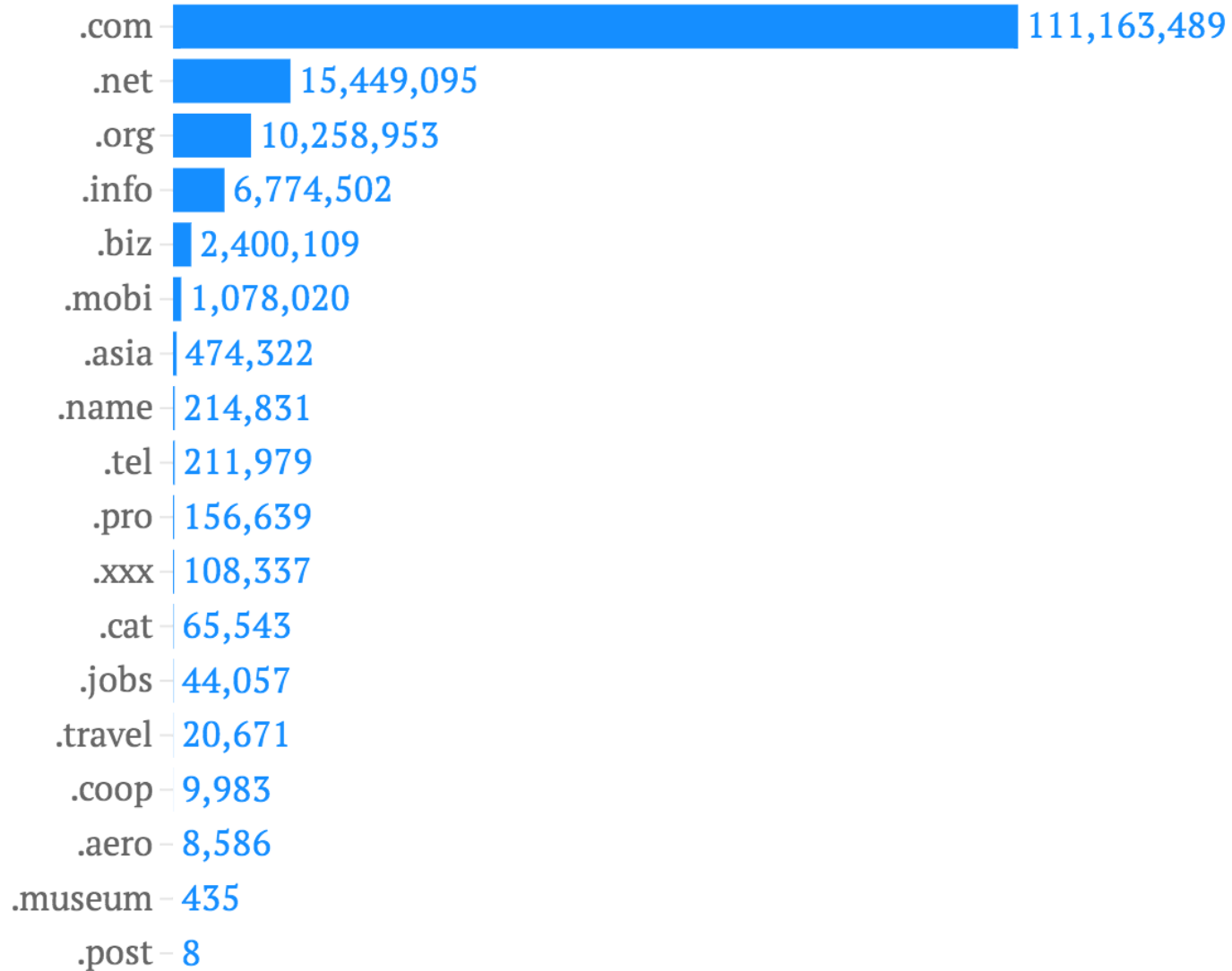
Problems for GI Interests: .wine/.vin

- ❑ Wine trade groups concerns: counterfeiting and cybersquatting
- ❑ Lobbied ICANN to reject the proposed .wine and .vin gTLDs, until ICANN incorporates additional safeguards for geographic and origin names at the second level.
- ❑ Position: A system of safeguards should protect geographical indications such as “Napa Valley” and “Champagne” in the same way as protection is afforded to trademark owners, as reflected in the 1995 WTO Agreement on Trade Related Aspects of Intellectual Property (TRIPS). This includes remedies against passing off, and other false or misleading use of a GI.
- ❑ Article 22(1) of the World Trade Organization's 1995 Agreement on Trade Related Aspects of Intellectual Property (TRIPS) defines geographical indications as: *indications which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given **quality, reputation or other characteristic of the good is essentially attributable to its geographic origin.***
- ❑ Article 23 of TRIPS specifically requires members to provide remedies against the misuse of geographical indications for wines and spirits.

Problems for GI Interests: .wine/.vin

- The TRIPS-related argument for added protection is similar to arguments raised by the International Olympic Committee and the Red Cross/Red Crescent, that due to international treaties, they should also be blocked from third-party registration in domains under the new gTLD program. Both groups likewise pushed for, and ultimately obtained, added protections in new gTLDs.
- GIs are registerable through the Trademark Clearinghouse (“TMCH”) as long as they are registered or otherwise protected by statute or by treaty at the time of TMCH registration.
- GI interests: TMCH framework places significant resource burdens for monitoring and enforcement on members of the wine industry, as opposed to the domain registrars who control access to these domains and who are most effectively and proximally situated to police the registry.
- Interested parties continue to negotiate regarding safeguards, but ICANN has approved the .wine and .vin gTLD applications for launch.

Registrations per top level domain, April 2013



gTLDs: A Look Ahead

- ICANN's goal is to launch subsequent gTLD application rounds ASAP, taking into account the lessons learned and changes needed after the first round, which was initially anticipated to occur within one year of the close of the most recent application submission period.
- ICANN will defer delegations in the second application round until such time as it can determine that the first round delegations will not jeopardize the security or stability of the DNS root zone.
- ICANN's ultimate goal will be to establish an ongoing, systemized, long-term procedure for the application and delegation of new gTLDs.

Who CARES?

- ❑ Trust – Everyone still wants **.com**
- ❑ Adoption – Internet URLs giving way to other forms of Internet use - e.g., apps.
- ❑ Direct Navigation issue - People rarely type in full web addresses, but more often use search engines instead. Increasingly, tiny URLs (e.g., bit.ly) are favored.

What can be done?

- Review trademark portfolios and prioritize protection based on strength and exclusivity of the mark in light of the particular:
 - Good and Services of interest; and
 - Geographical regions of interest

- Determine optimal avenue of enforcement based on budget and objectives.

- Review emerging gTLDs to identify ones of potential concern.

QUESTIONS?

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