

## ***Dot Landrush – ICANN Releases List of TLD Applications***

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*Previously published on [www.mondaq.com](http://www.mondaq.com)*

On June 13, 2012, the Internet Corporation for Assigned Names and Numbers (ICANN), the organization with the technical and policy-making responsibility for the domain name system, released the list of over 1,900 applications it received for new sponsored generic Top-Level Domains (gTLDs). This anticipated, but delayed, announcement follows ICANN's 2008 decision to expand the domain name system, despite the concerns of trade-mark owners.

A domain name consists of at least two components organized in hierarchical fields separated by a dot. The top-level domain (TLD) is located to the right of the dot. The second level domain, often referred to as the "host", is located to the left of the dot. For example, in `blakes.com`, `BLAKES` is the host and `<.com>` is the TLD. The two main types of TLDs are generic TLDs or gTLDs, (e.g., `<.com>`, `<.org>`, `<.net>`) and country code TLDs, or ccTLDs (e.g., `<.ca>`). The letters ".ca" are known as "strings". There are currently 22 gTLDs in the domain name system, and approximately 250 ccTLDs. Until now, ICANN had restricted the number of gTLDs.

The program adopted by ICANN will considerably liberalize gTLDs and will result in a significant expansion of the number of gTLDs available for use. Under the program, businesses, governments and others may choose and administer their own unique gTLDs, provided they meet certain requirements. For instance, applicants must demonstrate that they have sufficient technological and operational capabilities to ensure the proper use of the new gTLD, among other conditions. Applicants must also pay a US\$185,000 initial application fee and it has been estimated that the total fees associated with the application and evaluation process, together with operational costs and legal fees, could run as high as US\$1-million over a one- to two-year period.

The new gTLDs may include any word or phrase of three to 63 characters. They may also be in non-Roman characters, such as Chinese and Arabic. The list of applications released by ICANN features a wide range of terms including brands, geographic locations, such as `<.miami>` and `<.london>`, and generic terms such as `<.ski>`, `<.lawyer>` and `<.show>`. The list can be accessed on <http://newgtlds.icann.org>

There appears to be no pre-determined limit on the number of new gTLDs and ICANN has reaffirmed its commitment to opening a second round of applications for new gTLDs once applications from the first round are processed.

The introduction of new gTLDs will present many challenges for trade-mark owners and will undoubtedly result in further opportunities for cybersquatting. Brand owners should survey the list of potential new gTLDs to identify those that:

- may conflict with their trade-mark rights;
- may be relevant to their industry or business; or
- have been applied for by competitors.

Information regarding the applications will assist in deciding whether further steps are warranted, such as providing comments or filing a formal objection.

The first possible step in an objection process is submitting an "Application Comment", weighing on the merits of an application. The deadline for submitting such comments to ICANN is August 12, 2012.

Comments submitted are directed to an evaluation panel and will be reviewed and considered as part of the application evaluation process. Comments can be directed to one of the four objection grounds, which are discussed in further detail below. However, such comments will not be considered as a "formal objection" and will not, by themselves, block an application from being evaluated. Other comments which are available to be made as part of the Application Comments include comments regarding the service provider or the applicant of the gTLD, and comments directed toward the technical, operational, or financial capability of the applicant.

The most important thing to know about the Application Comment process is that it is not meant to address the issue of greatest concern to brand owners, namely a third party applying to register its trade-mark, or a confusingly similar trade-mark, as a gTLD. Those types of objections should be raised through the formal objection process.

The formal objection process is an independent dispute resolution process designed to protect certain interests and rights. The process provides for formal objections during the evaluation of the applications and allows a party with standing to have its objections considered before a panel of qualified experts.

A formal objection may only be raised on one of the following four enumerated grounds:

**1. String Confusion Objection.** This objection relates to an allegation that the string for a proposed gTLD is confusingly similar to the string of an existing gTLD or another sought-after gTLD in the same round of applications. Standing to object on this basis is limited to the operator of an existing gTLD operator or a gTLD applicant in the current round.

**2. Legal Rights Objection.** This objection relates to an allegation that the applied-for gTLD string infringes the existing legal rights of the objector, for example, rights to a trade-mark. The legal standing to raise this objection is limited to a rights holder. A rights holder is not defined and may include a licensee of a trade-mark.

**3. Limited Public Interest Objection.** This objection relates to an allegation that the applied-for gTLD string is contrary to generally accepted legal norms of morality and public order that are recognized under principles of international law. Although anyone may raise this objection, objectors are subject to what ICANN refers to a "quick-look" procedure, designed to identify and eliminate frivolous and abusive objections.

**4. Community Objection.** A community objection is an objection from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted. Standing to raise this objection is limited to established institutions associated with clearly delineated communities. The community named by the objection must be a community strongly associated with the applied-for gTLD string in the application that is the subject matter of the objection. The objector will be required to prove that it is both an established institution and that it has an ongoing relationship with the clearly delineated community.

The process for resolving a formal objection follows an adversarial arbitration model. Both the objector and the applicant will be allowed to file written submissions arguing their position and an in-person hearing may be required.

This period for objections is now open. Although ICANN has not indicated when the window will close, it has indicated that it will remain open for approximately seven months (i.e., until January 2013). ICANN presently anticipates that the initial evaluation process will be concluded by January 2013, with an expectation that the first-approved gTLDs will go live sometime in 2013. However, brand owners should not wait to object if they are concerned about a particular gTLD application.

***For more information, please contact:***



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