

Legal Impacts of New gTLDs

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How should brand owners approach new gTLDs from a brand protection perspective?

- controversial re potential for infringement – substantial expansion, difficult to control and monitor
- rights protection a big issue
- owners can
 - register their own brand
 - can help eliminate counterfeit sites e.g. banks
 - expensive and commitment
 - one may not be enough e.g. LVMH Group
 - second level domains e.g. EMI.music, harrypotter.movie
 - » difficult to register all
 - need protection and monitoring strategy in place

What protection mechanisms are available in relation to the new gTLDs?

A. Objection Based Process

1. New gTLD Dispute Resolution Procedure

- String confusion objection
 - » confusingly similar to existing top-level domain or another string
- Existing legal rights objection
 - » infringe existing rights
- Limited public interest objection
 - » morality / public order
- Community Objection
 - » significant portion of the community targeted
- Objection to application of new gTLD to be filed within Objection Filing period

What protection mechanisms are available in relation to the new gTLDs?

2. Uniform Rapid Suspension System

- identical to complainant's registered mark IN USE
- registrant no legitimate right
- domain registered in bad faith
 - » for purpose of selling, renting or transferring to TM owner
 - » prevent owner from using
 - » disrupting business of competitor
 - » intentionally attract commercial gain by creating likelihood of confusion

What protection mechanisms are available in relation to the new gTLDs?

- will suspend / lock once complaint is filed
- short response time – 14 days
- one Examiner only selected by URS provider
- defence
 - » generic / descriptive
 - » tribute or in criticism – fair use
 - » written agreement
 - » not abusive
 - » holding large portfolio – not necessarily bad faith
 - » sale of traffic – not – not necessarily bad faith

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B. Rights Protection Mechanism

- all gTLD registrants must have in place a rights-protection mechanism for second-level registrations – at least
 - Trade Marks Claims service
 - Sunrise process
- use Trademark Clearing House during pre-launch period of initial launch period

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C. Trademark Clearinghouse

- Centralized register / database for storage and authentication of trademark information
- TM owners can register their TMs
 - word marks only
 - registered nationally or regionally or validated by court
 - evidence of use
 - » declaration of use
 - » one example of use
 - declaration information is true and need to keep update
- Pay Fee
- Clearinghouse will review and authenticate information
 - check register
 - check evidence of use

What protection mechanisms are available in relation to the new gTLDs?

1. Support Trademark Claims Service

- provide notice to applicants re scope of registered rights if identical match
- applicants need to file statement
 - » received notice of registered mark
 - » understood notice
 - » to best knowledge will not infringe
- if registered, notice to TM owner on Clearinghouse on identical match

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2. Sunrise Service

- at least 30 days during pre-launch – notice to all TM holders in Clearinghouse if someone seeks sunrise registration identical to their mark
- can challenge under Sunrise Dispute Resolution Procedure
 - » registrant did not hold TM registration
 - » domain name not identical to registrant's mark
 - » mark not effective

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D. Post Delegation Dispute Mechanism

- address systemic abuse by gTLD Registry operators
e.g. profiting from registering infringing domain names

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Thank you for your participation!
Any Questions?