

CLIENT ALERT

ICANN Reveals List Of Potential New Top-Level Domain Names

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On June 13, 2012, the [Internet Corporation for Assigned Names and Numbers \("ICANN"\)](#) – the nonprofit corporation that is responsible for managing critical parts of the Internet infrastructure – publicly released a listing of approximately 1,900 new generic top-level domain names ("gTLDs") that may be approved for use as early as March 2013. Every business and organization that utilizes the Internet should review this listing and consider whether it must take action to protect itself as this dramatic expansion of gTLDs goes forward.

The Domain Name System helps Internet users to navigate the Internet. Every domain name ends with a TLD, such as ".com" or ".org." There currently are only twenty-two gTLDs. But this limited universe of gTLDs is set for dramatic expansion.

ICANN has instituted a new and controversial program that liberalizes the gTLD approval process and will result in a significant expansion of the number of gTLDs in use. Under this new program, entrepreneurs, businesses, governments, and communities around the world now have the opportunity to apply to establish a new gTLD of their own choosing. Thus, the community of stamp collectors could obtain approval for ".stampcollecting." Or, the Widget Corporation could obtain approval for a new gTLD, ".widget." By the May 30, 2012 deadline, ICANN had received applications for more than 1,900 new gTLDs.

Whether or not a business or organization applied for a new gTLD, it must pay close attention to the newly released listing of applied-for gTLDs for two reasons. First, an applied-for gTLD may be identical to or confusingly similar to its own trade name or one of its trade marks. Second, an applied-for gTLD that reflects a generic term, such as ".food," may pose a competitive threat to its business. If a business or organization is concerned about an applied-for gTLD, there are avenues available to obtain relief. These applications for new gTLDs will not automatically be approved by ICANN. They will be subject to a rigorous review process that will afford concerned businesses and organizations opportunities to stop an application, but they must act expeditiously.

Redress Available

There are at least four avenues that any concerned business or organization may pursue to stop a specific applied-for gTLD from being approved.

The Comment Period

Each application for a new gTLD must undergo an "Initial Evaluation." During this process, various aspects of an application will be reviewed by at least five independent "Evaluation Panels" appointed by ICANN. These include the String Similarity Panel (which reviews applied-for gTLDs for similarity to existing gTLDs); the DNS Stability Panel (which reviews applications for technical issues that may impact the stability of the Internet); the Technical & Operational Capability Panel (which considers the ability of the applicant to operate a gTLD); the Financial Capability Panel (which reviews an applicant's financial ability to operate a gTLD); and the Registry Services Panel (which reviews an applicant's proposed registry services). Each application must be

approved by each of these Evaluation Panels in order to pass the Initial Evaluation and be "posted" for possible award of a new gTLD.

As part of its review, each Evaluation Panel must consider any public comments received. Accordingly, the first opportunity for any concerned business or organization to seek redress lies in filing a comment on a specific application with the appropriate Evaluation Panel. Within a short period of time after public release of the listing of applied-for new gTLDs, a 60-day comment period will open. During this window, any party may submit comments on any application on the basis of any of four grounds:

1. "String Confusion" – that an applied-for gTLD is confusingly similar to an existing gTLD or another application.
2. "Legal Right" – that an applied-for gTLD infringes a legal right of an objector.
3. "Public Interest" – that an applied-for gTLD is contrary to generally accepted legal norms of morality and public order.
4. "Community Opposition" – that a community-based gTLD is opposed by a significant portion of the community.

This 60-day deadline is strict. Comments received after the deadline will not be considered by an Evaluation Panel.¹

Formal Objection

All applications that pass the Initial Evaluation will be "posted" and will remain open for a period of approximately seven months. During this period, anyone with "standing" may submit a formal objection to an applied-for gTLD which will then be considered by a panel of qualified experts from an independent Dispute Resolution Service Provider ("DRSP"). This presents a second opportunity for any concerned business or organization to seek redress.

The same four grounds set out above for the comment process form the only grounds for filing a formal objection. The basis for standing and the designated DRSP for each class of objection are as follows:

1. "String Confusion" – any existing gTLD operator or applicant for a gTLD may object based on a likelihood of confusion with all objections being resolved by the International Centre for Dispute Resolution.
2. "Legal Right" – any "rightholder" may object with all objections being resolved by the World Intellectual Property Organization.
3. "Public Interest" – anyone may object on the grounds of public interest with all objections being resolved by the International Center of Expertise of the International Chamber of Commerce.
4. "Community" – any established institution within a clearly defined community may object and all objections will be resolved by the International Center of Expertise of the International Chamber of Commerce.

The process for resolving a formal objection follows an adversarial arbitration model. Both the objector and applicant will be allowed to file written submissions arguing their positions and an in-person hearing may be required. Full details for filing an objection may be found in Section 3.2 of ICANN's *Applicant Guidebook*.²

The Independent Objector

ICANN has also appointed an "Independent Objector" ("IO") to file objections on behalf of the public interest. The IO does not act on behalf of any individual person or entity and has complete discretion to file or not file any particular objection to any

applied-for gTLD. The IO, however, may only file two types of objections – a public interest objection and a community objection. The IO may not file an objection on the same grounds as one already filed.

The Governmental Advisory Committee

ICANN has formed the Governmental Advisory Committee to provide advice to ICANN when its activities raise governmental concerns. GAC members can raise concerns about any applied-for new gTLD. The GAC, as a whole, will then consider those concerns and may agree to provide advice to ICANN on that particular application. Such advice may take one of three forms:

- Advice that an application should not proceed in which case there arises a presumption at ICANN that the application should not be approved.
- Advice that there are concerns about an application in which case ICANN will enter into discussions with GAC as to that application.
- Advice that an application should not proceed unless remediated in which case there arises a presumption at ICANN that the application should be remediated, if possible.

The GAC provides yet another opportunity for a concerned business or organization to seek redress. If a specific application potentially violates national law (such as a violation of the Lanham Act), a concerned business or organization may report its concern to the GAC representative for its nation and ask that its concern be submitted to the GAC.

What Every Business That Relies On The Internet Must Do Now

Here is what every business and organization needs to do in response to ICANN's release of the listing of applied-for new gTLDs:

- Review the listing to determine if any applied-for gTLD is a source of concern. Included in this review should be all brand management constituencies, including marketing, sales, website administration and in-house trademark counsel.
- If there is a concern with respect to any applied-for gTLD, consider pursuing one or more of the avenues for redress discussed above. In particular, gauge the level of concern if the application were to be granted and the applied-for gTLD came into use. If the concern is limited, it might suffice to submit comments to the appropriate Evaluation Panel. If the concern is more serious, it may be important to follow such comments with a formal objection and to seek assistance from the IO or GAC.
- Once a concerned business or organization decides to seek relief, it must act expeditiously, as there are strict deadlines. Moreover, do not try to "go it alone." Seek assistance from counsel experienced with ICANN and the procedures for redress available under the new gTLD program.

ICANN's expansion of gTLDs presents both significant opportunities and significant challenges to business and organizations that utilize the Internet. Businesses and organizations must be vigilant and determine whether any particular applied-for gTLD presents a concern. If such a concern exists, there are actions that they can take to stop the approval of a specific applied-for gTLD, but they must act expeditiously with the assistance of informed counsel.

[Click here for more information on ICANN's release of gTLDs.](#)

¹ At this time, the formal procedure for submitting a comment to an Evaluation Panel has not been issued by ICANN. It is anticipated that it will be released at the same time ICANN announces the opening of the 60-day comment period.

² The *Applicant Guidebook* may be found at <http://newgtlds.icann.org/en/applicants/agb>.

This information was also published as an expert analysis column in [Law360](#).

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