

TLD and Domain Name Practice



www.crowell.com

Washington, DC ■ New York ■ San Francisco ■ Los Angeles ■ Orange County ■ Anchorage ■ London ■ Brussels

Internet Expansion: How to Protect Your Interests

What does Internet expansion mean and how is it happening?

The Internet's naming system is undergoing profound change. The Internet Corporation for Assigned Names and Numbers (ICANN) is enabling a large number of generic top-level domains (gTLDs) to be added to the existing domain name system under a recently-launched global initiative called the "New gTLD Program." These new gTLDs will be in addition to those with which we are all familiar, such as .com, .info, .org, and .gov, as well as country code Top-Level Domains such as .us, .ca, .fr, .uk, and .be. In doing so, ICANN has made it possible for corporations, governments, and organizations to obtain "their own" TLDs, as shown in the following examples:

A city:	.london, .nyc, .paris, etc.
A corporation (brand TLDs):	.dupont, .deloitte, etc.
An industry:	.hotel, .music, .bank, .beauty, etc.
A language-based community:	.arab and عربي.
A "true" generic TLD:	.shop, .web, .app, etc.

It is anticipated that website access and email traffic will greatly expand through the use of many new domain names that will be registered in these new TLDs. This Internet expansion will likely increase the opportunities for commerce, but will also present significant challenges regarding brand protection, online fraud, and abuse.

On June 13, 2012, ICANN published the list of gTLDs that have been applied for as well as the names of the applicants. On December 17, 2012, ICANN announced the order in which the applications are being processed; and according to ICANN's current timeline, the first new gTLD may go live in Q3 of 2013. As a result, the Internet name space will continue to expand as each new TLD launches.

In addition to the present expansion, ICANN has also expressed its intention to organize an additional round for even more new gTLDs (the current round yielded over 1900 applications). ICANN expects this additional round to take place shortly after the current round is "completed", and currently intends preparation to begin for the next round of expansion in late 2013 or early 2014. The Internet space will further evolve as a result of ICANN's successive gTLD rounds.

What are the challenges of this expansion

The introduction of new gTLDs will bring new challenges for brand owners and other organizations, whether they have applied for a gTLD or not.

For example (non-applicants):

- What should you do if a company has applied for a gTLD that impacts or "captures" your industry?

- What should you do if a company has applied for a gTLD that is identical or confusingly similar to your brand or business name?
- When should you consider registering domain names in the new gTLDs?
- Can registration of domain names resembling your own brand or existing domain names (in other TLDs) be blocked in a new gTLD?

For example (applicants):

- If you have applied for a gTLD, and there are other applicants for the same or similar string, what can you legally do to assure your application's success?
- If you have applied for a gTLD, how do you make sure that your TLD is in a position to be launched as soon as possible?
- If you have applied for a gTLD, how can you avoid interference from outsiders, brand holders, or government regulators as you launch and operate the new TLD?

These are only a few of the questions that the introduction of new gTLDs will present. Meeting the challenges will require monitoring the new gTLD process, spotting and analyzing any issues as they develop, considering your strategic options, and navigating the complex world of Internet governance.

What steps should you take?

There is a wide range of actions you may need to consider, from strategies for defending your own application to contesting the applications of others. Brand holders will also want to protect their trademarks and existing domain names in the new Internet space.

The new gTLD system within ICANN provides for participation by applicants, rights holders, community organizations, and governments in the application process. These opportunities include alternative dispute mechanisms with the World Intellectual Property Organisation (WIPO), the International Chamber of Commerce (ICC), and the International Centre for Dispute Resolution (ICDR) for handling disputes with an applicant for a particular gTLD.

Apart from seeking to formally intervene against an application itself, it is also possible for a company to take action outside of ICANN's prescribed challenge system, be that through lobbying efforts or court action.

How can we help?

Crowell & Moring's interdisciplinary team has assisted numerous Fortune 100, CAC 40 and other multinational companies in developing their new gTLD strategy and in preparing their applications for new gTLDs.

We have also developed a program to help monitor the applications. Based on the published list of applications, we have already helped identifying any significant concerns and developed strategic options for addressing those concerns, whether those concerns are from the perspective of an applicant wanting to ensure that its application is approved and a TLD is launched, to the perspective of a non-applicant, who is concerned that a particular new TLD will adversely impact its rights or business.

Crowell & Moring has unique expertise in vindicating the interests of aggrieved parties in the gTLD and domain name sphere. Our firm has been successful in challenging decisions of ICANN, and we have extensive experience in handling domain name disputes, both in courts and through alternative dispute resolution.

We are ready to help you monitor the new gTLD applications and ICANN developments, develop strategic options meeting your business needs, communicate with stakeholders, negotiate with applicants, prepare objections or other formal intervention mechanisms, navigate ICANN's rights protection mechanisms regime (including the Trademark Clearinghouse and Uniform Rapid Suspension), or take other appropriate legal action.

Our experience

- Crowell & Moring assisted in preparation of nearly 100 applications for new TLDs
- Crowell & Moring has been the leader in successfully challenging ICANN's actions regarding the creation of new TLDs
- Crowell & Moring is currently advising many clients (both applicants and non-applicants) regarding options to protect their business interests during the consideration and potential launch of the new TLDs
- Crowell & Moring is presently representing clients in cutting-edge litigation with ICANN
- Crowell & Moring has handled several hundreds of domain name disputes, both on behalf of clients and as arbitrators under WIPO's dispute resolution procedures

New gTLD Program: Post Application Service Offerings

Crowell & Moring LLP is pleased to offer the following services for companies with an interest in ICANN's New gTLD Program. Our services include:

Assessing Applications and Developing An Intervention Strategy

We will review the list of applications and applicants, and analyze whether and how an application may affect the existing rights of a client, whether because of its brands, existing domain names and trademarks or for other reasons, including a consideration of the potential use of the requested TLD as described in the application. We will meet with the client to discuss our analysis and help develop a plan of action for consideration, including recommendations about how to object to or otherwise intervene against an offending application.

Defending Pending Applications

ICANN has developed an elaborate set of dispute resolution procedures for an aggrieved party, depending on the nature and scope of the particular objection.

We will work with applicants who are dealing with objections or potential objections to their applied-for strings. We will help develop a response strategy, given ICANN's different dispute resolution procedures and constituencies, and, if necessary, assert a defense to an objector's intervention.

Intervening Against Pending Applications, Negotiating with Applicants or Governments

Conversely, we can help clients prepare an objection (or take other appropriate intervening legal action), using ICANN's new gTLD framework, ICANN's general accountability processes, or the jurisdiction of other national or international fora. This includes non-applicant rights holders seeking to insure that their interests are not overlooked by ICANN. And this also includes consideration of the role of the world's governments in protecting the interest of its constituents. Short of taking formal legal action, we can also assist clients in negotiating with existing TLD applicants or registry operators to ensure a client's business interests are advanced.

Negotiating and Implementing Contracts

ICANN has published a universal draft template registry agreement for all TLD applicants. Crowell & Moring can review that agreement in light of the practical and business realities of the TLD, negotiate with ICANN (when needed) or other related parties, and assist in the registry agreement implementation process which will include negotiation of additional contracts with third party service providers.

Coordinating TLD Policy Development

Crowell & Moring can assist clients in the selection, articulation, and implementation of policies for their registry, including, but not limited to, the eligibility requirements for domain name registrants and domain name registration in the new gTLD, use expectations, privacy interests, and security concerns, including how to prevent and deal with abuse.

Enforcing Rights holders Interests in the Newly Expanded Internet

In response to significant criticism regarding the increased opportunity for fraud and other abuse, ICANN is developing unique additional rights protection mechanisms to attempt to insulate rights holders from this additional exposure. Crowell & Moring can assist clients with taking advantage of these programs and enforce their rights in the expanded Internet space.

Monitoring ICANN Policy Initiatives and Developments

As has now been widely reported in the mainstream press, ICANN is a unique international organization with plenary control over one of the world's most important resources: the Internet's Domain Name System. As a result, its work impacts virtually all users of the Internet, both corporate and individual. Crowell & Moring, as an industry veteran, can closely monitor the developments that are likely to impact a client's business - whether it's within the next day or the next year - and advise the client on how best to protect its interests in this ever changing landscape.

A Global Team

Our TLD and Domain Name practice is co-chaired by:



Flip Petillion is a partner in the firm's Brussels office. He practices in the Intellectual Property and International Dispute Resolution and groups. His practice has been devoted to IP, IT, Media and Communication for more than 25 years, with a heavy emphasis on IP litigation and counseling for corporate clients in industries such as hardware and software developers, film producers and distributors, advertising agencies, architects, authors and performers, financial institutions, insurance companies, automotive businesses, and diamond traders. Flip is a well recognized arbitrator and panelist with the World Intellectual Property Organization Arbitration and Mediation Center (WIPO) in Geneva, Switzerland, which is a specialized agency of the United Nations. He also serves as an arbitrator and panelist with the National Arbitration Forum (NAF), the Czech Arbitration Court (CAC) and Belgian's Arbitration and Mediation Center (CEPANI). Flip's experience in the area of Internet governance and domain names includes a wide range of major matters, such as representing different "gTLDs" and "ccTlds" on contractual and policy-related issues. Flip has been assisting near to 100 large brand owners in developing both proactive and defensive strategies towards ICANN's New gTLD Program. Flip is part of WIPO's roster of panelists available for appointment under the Legal Rights Objection (LRO) procedure to be administered by the WIPO Center as of 2013. Flip can be reached at fpetillion@crowell.com and +32.2.214.2886.



John I. Stewart, Jr. is a partner in the firm's Washington, DC, office, where he has practiced Communications, Copyright, and Technology law since 1975. John heads the Firm's Technology, Media, and Telecommunications sector of the Intellectual Property Group. His current practice encompasses intellectual property, Internet, and telecommunications matters. An early participant in the developing law of e-commerce (having represented emerging online businesses, B2B exchanges, and a variety of companies and organizations expanding into Internet operations in the 1990s), he continues to counsel clients on law and technology issues. His work has included negotiating technology partnerships and licenses, advising on global privacy law compliance, negotiating online content and software development agreements, negotiating IT agreements, building open source licensing programs, and counseling on Website liability issues. John is also a member of the firm's privacy group, which has assisted a large number of companies in the adoption and implementation of regional and global compliance programs, designed to achieve and maintain compliance with applicable data protection laws. John can be reached at jstewart@crowell.com and 202.624.2685

Members of the TLD and Domain Name practice include:

Dickerson M. Downing is a partner in the firm's New York, with over 25 years of experience in trademark, copyright and trade secret law as well as other areas of intellectual property law. He has successfully brought and defended cases for trademark, trade dress and copyright infringement, false advertising, trade secret violations and related causes of action in courts throughout the United States for a variety of corporate clients. He has been involved in the seizure of infringing goods, the detainment of infringing goods by the United States Customs Office and in the successful action to prevent the sale of imported "gray market" goods in the United States. He is skilled in protecting trademark rights and preventing infringement on the internet. He also has handled numerous adversary proceedings before the Trademark Trial and Appeal Board. Dick can be reached at ddowning@crowell.com and 212.895.4212.



Terence P. ("Terry") Ross is a partner in the Washington, D.C. office of Crowell & Moring. Terry's practice is concentrated on the trial of civil lawsuits, particularly those involving intellectual property, media and technology. He has represented clients in numerous high-profile cases, particularly in the application of the intellectual property laws to the Internet and e-commerce. Terry has broad experience in various types of intellectual property disputes, including patent and copyright infringement; trade secret and unfair competition litigation; and trademark/trade name disputes. In particular, he represents a number of media companies and other content providers who publish (at least in part) on the Internet. Terry's experience at both the trial and appellate levels is extensive. He has had a principal role in several dozen jury or bench trials and arbitrations. In addition, Terry has made oral arguments to the Supreme Court of Virginia, the United States Court of Appeals for the District of Columbia Circuit, the United States Court of Appeals for the Second Circuit, the United States Court of Appeals for the Fourth Circuit, and the United States Court of Appeals for the Ninth Circuit. Terry can be reached at tross@crowell.com and 202.624.2645.



John L. Murino is a counsel in the firm's Washington, D.C. office, where he practices in the International Dispute Resolution and Intellectual Property groups. John's practice primarily involves complex civil litigation and international arbitrations representing clients in a variety of industries including technology and media. He also is active in counseling clients regarding various Internet governance, First Amendment, and international business related issues. John's recent counseling experience includes advising Internet registry service providers on various issues related to organization, implementation, and contract compliance and monitoring; advising corporations in their efforts to apply for, secure, and operate top level domains; and advising parties in their efforts to intervene or otherwise protect their interests in the ever expanding world of online commerce. John's recent arbitration and litigation experience includes representing an Internet registry services company in a dispute under the ICC Rules of Arbitration against ICANN, arising out of a breach of contract claim involving the sTLD <.jobs>; and representing an Internet registry services company in a dispute under the ICDR International Arbitration Rules against ICANN arising out of ICANN's improper refusal to award the sTLD <.xxx>. John can be reached at jmurino@crowell.com and 202.624.2663.



William J. Sauers is a counsel in the firm's Washington, DC office, where he practices in the Intellectual Property Group, focusing on patent, trademark, and copyright infringement litigation, intellectual property portfolio management, counseling, and licensing, as well as trademark prosecution and clearance, and domain name disputes. Bill has litigated patent, trademark, and copyright disputes before district courts, the U.S. Patent and Trademark Office's Trademark Trial and Appeal Board, the U.S. International Trade Commission, and the World Intellectual Property Organization. His counseling work has involved assisting both large and small clients with the creation and implementation of intellectual property protection and procurement programs such as trademark registration and enforcement programs. Bill can be reached at wsauers@crowell.com and 202.624.2746.



Michael Kao is a counsel in Crowell & Moring's Los Angeles office and is a member of the firm's Litigation Group. His practice focuses on civil litigation with particular emphases on unfair competition, internet, and intellectual property matters. Mike has experience in the management and trial of litigation matters in state and federal courts, as well as in arbitration and other ADR proceedings. He has also successfully argued before the California Court of Appeal. Mike can be reached at mkao@crowell.com and 213.443.5557.



Jan Janssen is an associate at the Brussels office of Crowell & Moring since 2008. Jan's legal practice focuses on IP and IT. Jan practices in national and international dispute resolution with a special focus on intellectual property and information technology. Jan's practice primarily involves complex litigation, (international) arbitrations in a variety of industries including fashion, media, postal services, technology and telecommunications. Jan also provides contractual advice and assists clients in protecting, managing and enforcing their intellectual property rights, including in transactional matters, such as distribution, agency, licensing, technology transfer, software development, outsourcing and service level agreements. Jan has been involved in the assistance of various large brand owners in developing both proactive and defensive strategies towards ICANN's New gTLD Program. He also has ample experience in trademark and domain name litigation, including UDRP proceedings with WIPO, NAF, CAC and CEPANI. Jan is fluent in English, French and Dutch. Jan can be reached at jjanssen@crowell.com and +32.2.214.2852.



Jonathan J. Anastasia is an associate in Crowell & Moring's New York office. He is a member of the firm's Intellectual Property Group, with a focus on patent litigation, trademark prosecution, and rendering opinions on patent infringement, validity, and enforceability. He is also a member of the firm's Litigation Group. Jonathan graduated from the United States Military Academy at West Point in 2001 with a Bachelor of Science in Systems Engineering. He received his Juris Doctor from Brooklyn Law School in 2009. While in law school, Jonathan interned with the New York City Corporation Counsel in the Special Federal Litigation Division and as a judicial intern to the Honorable Denis R. Hurley, United States District Court for the Eastern District of New York. Jonathan can be reached at janastasia@crowell.com and 212.803.4059.



Mary R. Bram is an associate in the firm's Washington, DC office and focuses her practice primarily on the preparation and prosecution of patent applications. Mary has experience with chemical engineering technologies, petroleum chemistry, organic chemistry, pharmaceutical chemistry, polymer chemistry, and construction materials. She also assists in foreign prosecution and the preparation of freedom to operate, validity, and infringement opinions. Prior to law school, Mary worked at a small intellectual property law firm where she drafted numerous applications in the mechanical arts and participated in copyright infringement litigation matters. Additionally, she drafted applications relating to magnetorheological fluids and nanoparticles. She was also an intern at the United States Patent & Trademark Office. Prior to joining Crowell & Moring, Mary was an extern with a U.S. Navy Judge Advocate General Corps' prosecution office. Her responsibilities as an extern included conducting legal research, drafting memoranda, drafting motions, drafting stipulations of fact, and interviewing witnesses. She can be reached at mbram@crowell.com and 202.624.2871.



Emily Alban is an associate in the firm's Washington, DC, office, where she practices in the International Dispute Resolution group. Emily's practice primarily involves international arbitrations representing clients in industries including technology, energy, mining, and hospitality. Emily's recent arbitration experience includes representing an Internet registry services company in a dispute under the ICC Rules of Arbitration against the Internet Corporation for Assigned Names and Numbers (ICANN) arising out of a breach of contract claim involving the sTLD <.jobs> and representing an Internet registry services company in a dispute under the ICDR International Arbitration Rules against ICANN arising out of ICANN's improper refusal to award the sTLD <.xxx>. Emily can be reached at ealban@crowell.com and 202.624.2718.



Miklos Mudrony is an associate in Crowell & Moring's Brussels office and a member of the firm's Antitrust and European Practice Group. His practice focuses on anti-trust and general regulatory law with a particular emphasis on the consumer goods and technology industry. In addition, he is also assisting clients with their application in the context of their gTLD application and responsible for the project management of such applications. Before joining Crowell & Moring, Miklos worked as a senior associate with an international law firm in Frankfurt am Main, Germany. He is admitted to the Frankfurt Bar and fluent in English and German. Miklos can be reached at mmudrony@crowell.com and +32.2.282.4082.



Diego Noesen is an associate at the Brussels office of Crowell & Moring. Diego's legal practice focuses on IP, IT and competition law. He is assisting in national and international dispute resolution with a special focus on intellectual property and information technology. Diego has been involved in the preparation of several gTLD applications for brand holders and he has been working on the preparation of strategies related to domain and domain name litigation. Diego is fluent in English, French and Dutch. Diego can be reached at dnoesen@crowell.com and +32.2.214.2872.