1000+ new gTLDs.

Clearinghouse and Dispute Resolution

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ICANN, a not for profit corporation based in California, has liberalised in 2011 the current gTLD namespace of 22 generic Top Level Domain names and about 270 country codes TLDs - allowing any organisation to apply for their own gTLD registry.

- 1930 applications were received (81 have since then have been withdrawn), of which 1409 unique strings, 230 with multiple applicants and 116 Internationalized Domain Names.

- By 2014: ... 1000+ new gTLD registries
## Initial New gTLD Statistics from 13 June 2012

<table>
<thead>
<tr>
<th>gTLDs</th>
<th>Current</th>
<th>Applications</th>
</tr>
</thead>
<tbody>
<tr>
<td>Africa</td>
<td>0</td>
<td>17</td>
</tr>
<tr>
<td>Asia/Pacific</td>
<td>1</td>
<td>303</td>
</tr>
<tr>
<td>Europe</td>
<td>5</td>
<td>675</td>
</tr>
<tr>
<td>Latin America/Caribbean</td>
<td>0</td>
<td>24</td>
</tr>
<tr>
<td>North America</td>
<td>15</td>
<td>911</td>
</tr>
</tbody>
</table>

GEOGRAPHIC STRINGS

- Among others, .ABUDHABI, .ALSACE, .AMSTERDAM, .BARCELONA, .BAYERN, .BERLIN, .BOSTON, .BRUSSELS, .BUDAPEST, .CATALONIA, .DUBAI, .DURBAN, .HAMBURG, .HELSINKI, .ISTANBUL, .KYOTO, .LONDON, .MADRID, .MELBOURNE, .MIAMI, .MOSCOW, .NYC, .OSAKA, .PARIS, .QUEBEC, .RIO, .ROMA, .STOCKHOLM, .SWISS, .SYDNEY, .TIROL, .TOKYO, .WALES, .MOCKBA (MOSCOW), .PYC (RUSSIAN COMMUNITY), (ABU DHABI), 广东 (GUANDONG), 广州 (GUANGZHOU)
Among others, .APP, .ART, .BABY, .BARGAINS, .BOUTIQUE, .CAREERS, .CARS, .CHANNEL, .CLOTHING, .COMPANY, .DEAL, .EAT, .FASHION, .FILM, .FOOD, .GREEN, .HOTEL, .INC, .INSURANCE, .LAW, .LEASE, .LUXURY, .MEDIA, .MOBILE, .MUSIC, .NEWS, .ONLINE, .PHOTOS, .PIZZA, .SALE, .SHOES, .SHOP, .STORE, .THEATER, .WEB, .在线 ("online" in Chinese), بازار ("bazaar" in Arabic), コム ("com" in Japanese), Сайт ("site" in Cyrillic)
Among others, .ALFAROMEO, .ALSTOM, .AMAZON, .AUDI, .BARCLAYS, .BBC, .BOSCH, .BUGATTI, .CALVIN KLEIN, .CANALPLUS, .CANON, .CARTIER, .CHEVROLET, .CHLOE, .COACH, .CIALIS, .CLUB MED, .DELMONTE, .DELOITTE, .ERICSSON, .FERRARI, .FERRERO, .FIAT, .GOOGLE, .GUCCI, .HOTMAIL, .HONDA, .HYUNDAI, .JAGUAR, .KERASTASE, .KINDER, .LAMBORGHINI, .LANCIA, .LANCASTER, .LANCOME, .LEGO, .LOREAL, .MCDONALDS, .MERCK, .MICROSOFT, .MITSUBISHI, .NEWHOLLAND, .NIKE, .NIKON, .NOKIA, .OMEGA, .PANASONIC, .PANERAI, .PHILIPS, .RICHEMONT, .SAMSUNG, .SANOFI, .SKYPE, .SYMANTEC, .SONY, .TOYOTA, .VIRGIN, .VISA, .VOLKSWAGEN, .VOLVO, .YAHOO.
MOST APPLIED FOR STRINGS:

- .app (13)
- .home, .inc (11)
- .art (10)
- .blog, .shop, .llc, .book (9)
- .design (8)
- .mail, .news, .hotel, .store, .web, .love, .cloud, .ltd (7)
### New Generic Top-Level Domains

**NEW GTLD CURRENT APPLICATION STATUS**

Search gTLD applications

**FILTER RESULTS**

<table>
<thead>
<tr>
<th>Type</th>
<th>Application Status</th>
<th>Updates</th>
<th>Objections</th>
<th>GAC EW</th>
<th>String Similarities</th>
<th>PICs</th>
<th>Apply Filters</th>
</tr>
</thead>
</table>

**Prioritization Number** | **String [1]** | **Applicant** | **Location [2]**
--- | --- | --- | ---
1 | 天主教 | Pontificium Consilium de Comunicationibus Socialibus (PCCS) (Pontifical Council for Social Communication) | VA |
2 | ストア | Amazon EU S.à r.l. | LU |
3 | شبكة | International Domain Registry Pty. Ltd. | AU |
4 | 香格里拉 | Shangri-La International Hotel Management Limited | HK |
5 | 中信 | CITIC Group Corporation | CN |
6 | онлайн | CORE Association | CH |

[https://gtldresult.icann.org/application-result/applicationstatus](https://gtldresult.icann.org/application-result/applicationstatus)
INITIAL EVALUATION RESULTS (1)

There are three possible outcomes of Initial Evaluation: Pass, Eligible for Extended Evaluation, or Ineligible for Further Review.

- **Pass** - The evaluation panels determined that the application is consistent with the requirements in the Applicant Guidebook and can advance to the next phase of the Program.

- **Eligible for Extended Evaluation** - The Financial, Technical/Operational, Registry Services, or Geographic Names evaluation panels determined that the application did not provide sufficient information to award a passing score. The application is eligible for extended evaluation.

- **Ineligible for Further Review** - The DNS Stability, String Similarity, Background Screening, and/or Geographic Names evaluation panels determined that the application did not meet the relevant criteria in the Applicant Guidebook, and the application is ineligible for further review.

“OPEN” OR “CLOSED” TOP LEVEL DOMAINS

(1)

- **Closed Brand Top Level Domains**: Top Level Domains corresponding to trademarks, applied for by trademark owners in order to protect and also enhance their IP rights by creating a secure online location that could be recognized by their consumers as a reliable source of information and safe environment to purchase goods and services (e.g. .GUCCI, .FERRERO).

- **Open generic Top Level Domains**: Top Level Domains constituted of generic terms open to third party registration (.SHOP, .ONLINE, .STORE, .APP, .LAW, .MAIL, .FASHION, .LUXURY).
“OPEN” OR “CLOSED” TOP LEVEL DOMAINS (2)

- **Closed generic Top Level Domains**: Top Level Domains constituted of generic terms but not open to any third party registration (.JEWELRY, .WATCHES, .MAKEUP, .SKIN)

  - Google: 101;
  - Amazon: 76;
  - Richemont 14;
  - Microsoft: 11;
  - L’Oreal: 11

THE JURY IS STILL OUT
OPPORTUNITIES FOR COMPANIES THAT APPLIED FOR CLOSED BRAND TLDs (1)

• Protection of Intellectual Property rights

• Communication and Marketing advantages:
  • i) shorter URLs, with no confusion of extensions;
  • ii) brand identity is enhanced through creation of a global brand platform and of an authentic location for branded goods and services;
OPPORTUNITIES FOR COMPANIES THAT APPLIED FOR CLOSED BRAND TLDs (2)

• iii) control over the allocation of domain names at the second level, including registration of domain names for advertising campaigns and possible assignment of specific domains to partners, licensees and distributors

• iv) use new TLD in keyword advertising and improve the position of the main web site on search engine ranking results
OPPORTUNITIES FOR COMPANIES THAT APPLIED FOR CLOSED BRAND TLDs (3)

- **Security advantages:**
  - i) DNSSEC & IPv6 more secure for transmission of confidential information;
  - ii) domain name registrants must be authorized by the Registry/trademark owner;
  - iii) possible creation of secure e-commerce portals to interact with customers
HOW THE NEW gTLDs WILL AFFECT TRADEMARK HOLDERS …RIGHTS PROTECTION MECHANISMS

• START-UP RIGHTS PROTECTION MEASURES
  • A) Sunrise period
  • B) Trademark Claims Service
  • Both the services will be supported by the TMCH

• POST-LAUNCH RIGHTS PROTECTION MEASURES
  • A) Uniform Rapid Suspension Procedure (URS)
  • B) Trademark Post-Delegation Dispute Resolution Procedure (PDDRP)

• every new Registry of a new gTLD will be required to grant a minimum standard of protection.
The Trademark Clearinghouse: Protect your trademark online

The Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for managing the domain name system and ICANN developed the new gTLD program in order to increase competition and choice in the domain name space. The Trademark Clearinghouse (TMCH) is the most important rights protection mechanism built into ICANN’s new gTLD program. It allows brand owners to submit their trademark data into one centralized database, prior to and during the launch of new gTLDs. Simply put: The TMCH is a one-stop-solution for protecting your brand in the new gTLD era.
ICANN

DELOITTE
TRADEMARK HOLDERS
TRADEMARK AGENTS

IBM
TLD REGISTRIES
TLD REGISTRARS

TRADEMARK CLEARINGHOUSE USER INTERFACE
TRADEMARK CLEARINGHOUSE DATABASE
FUNCTIONS OF THE TRADEMARK CLEARINGHOUSE

- It authenticates and validates the trademarks submitted to the Clearinghouse; and

- It will serve as a database to provide information to the new gTLD Registries to support the pre-launch rights protection measures:
  - A) Sunrise and
  - B) Trademark Claims Services.
A) SUNRISE PERIOD

• The Sunrise Period must be offered for a minimum of 30 days during the pre-launch phase

• All new TLD Registries will be required to provide brand owners the option to register their marks as domain names before a New gTLD goes live.

• A notice must be provided to all trademark holders in the Clearinghouse if someone seeks a sunrise registration for a second-level domain name identical to the brand.
WHICH TRADEMARKS ARE ACCEPTED? (1)

- Nationally or Regionally Registered Trademarks
  - US trademark, EU trademark etc.
  - Must be registered at the time of verification and in accordance with national laws
- Court Validated Trademarks
  - Unregistered trademarks, well-known protected marks
- Trademarks Protected by Statute or Treaty
  - Geographical indications, designation of origin
  - Statute or treaty must be in force before or on 26 June 2008
- Other Trademarks that constitute intellectual property
WHICH TRADEMARKS ARE ACCEPTED? (2)

• Trademark owners will be able to register also **up to 50 variations of their marks** in the Clearinghouse, if the variations were previously subject of a successful litigation or UDRP arbitration due to abuse by third parties (still to be implemented).
WHICH TRADEMARKS ARE NOT ACCEPTED? (1)

- Trademarks **starting with or containing a Dot (.)**
- Registered Trademarks subject to successful invalidation, cancellation, or opposition proceedings
- Intellectual property rights which cannot be represented within the technical limitations of the Domain Name System (e.g. patents, designs, etc.)
- Any mark that is not at least of national effect
- In case of marks that only contain letters, words, numerals and/or special characters, the name recorded in the Clearinghouse is...
WHICH TRADEMARKS ARE NOT ACCEPTED? (2)

... identical (provided that all characters included in the Trademark Record are in the Clearinghouse in same order as on the mark certificate)

- Marks not exclusively consisting of letters, words, numerals and special characters can be included in the Clearinghouse if the letters, words, numerals and special characters are:
  - Are predominant; AND
  - Clearly separable or distinguishable from the device element; AND
  - Included in the Trademark Record submitted to the Clearinghouse in the same order they appear in the mark
INFORMATION REQUESTED

• Name of the mark
• Registration number
• Registration date
• Application number (not mandatory)
• Application date (not mandatory)
• Jurisdiction
• Expiration date (not mandatory)
• Description of goods and services class
• Detailed description of goods and services
• Information about the holder (organization or full name, address and contact information)
• Status of the Trademark Holder (owner/licensee/assignee)
PROOF OF USE FOR SUNRISE SERVICES

- Evidence for the bona fide use of the Trademark by submitting:
  - A signed **Declaration** of use AND
  - A single **Sample** of proof of use.
- The following are **permissible** as proof of use: labels, tags, or containers from a product, advertising and marketing materials (including brochures, pamphlets, catalogues, product manuals, displays or signage, press releases, screen shots, or social media marketing materials)
- The following are **not permissible**: inclusion of a mark in a domain name, email messages, licenses to use a mark, business cards
SMD (SIGNED MARK DATA) FILE AND STATISTICS

- The SMD file is provided by the Trademark Clearinghouse to trademark owners when the sunrise eligibility requirements are fulfilled and will allow them to register a domain name identical to the trademark within a TLD, as long as it complies with the Registries policies.
- Currently there are about 4000 trademark records in the TMCH.
- A Sunrise Dispute Resolution Policy is available (SDRP)
B) TRADEMARK CLAIMS SERVICE

• The Trademark Claims service will be provided for a minimum of the first 90 days after the opening of general registration and it may also be offered after the start-up phases.

• Registries will provide:
  
  • i) notice to potential registrants of a second level domain name identical to a brand of the existing trademark rights and of the likely violation of IP rights;
  
  • ii) notice to rights holders of relevant names registered by third parties (notwithstanding the above notice).
WHICH TRADEMARKS FOR TRADEMARK CLAIMS SERVICE?

- Registries must recognize and honor all word marks that **have been or are** (...broader than in Sunrise services):
  - (i) nationally or regionally registered;
  - (ii) court-validated; or
  - (iii) specifically protected by a statute or treaty in effect at the time the mark is submitted to the Clearinghouse for inclusion.
- It should be noted that **no demonstration of use is required**.
- In order to allow Registries to offer the service, the Clearinghouse Database will be structured to report them when registrants are attempting to register a domain name identical with the brand in the Clearinghouse.
POST-LAUNCH RIGHTS PROTECTION MEASURES

• The applicant guidebook sets forth various Trademark Right Dispute Resolution Procedures to allow trademark holders to challenge the infringement of their intellectual property rights after the Registries go live:
  
  • A) Uniform Rapid Suspension Procedure (URS)
  • B) Trademark Post-Delegation Dispute Resolution Procedure (PDDRP)

• Registry operators may introduce additional rights protection measures relevant to the particular gTLD.
A) UNIFORM RAPID SUSPENSION PROCEDURE (URS) (1)

• The URS will be an expedited complaint procedure, with requirements similar to the UDRP, but aimed only at the suspension of the disputed domain name.

• Fees: non-refundable fee (USD 375 - 500) to be borne by the Complainant. Respondent shall pay a Response Fee if the Complaint lists 15 or more disputed domain names against the same Registrant. In the case 15 or more disputed domain names, the Response Fee will be refundable to the prevailing party.
A) UNIFORM RAPID SUSPENSION PROCEDURE (URS) (2)

- It will be available a procedure to challenge the abuse of the URS. In the event of a decision against the trademark holder, there will be a penalty and a possible bar from utilizing the URS, temporarily (for one year in the event of two abusive Complaints or one “deliberate material falsehood”) or permanently (two findings of “deliberate material falsehood”).
GROUNDS OF THE URS COMPLAINT

• The registered domain name is identical or confusingly similar to a word mark for which the Complainant holds a valid national or regional registration and that is in current use; or (ii) that has been validated through court proceedings; or (iii) that is specifically protected by a statute or treaty in effect at the time the URS complaint is filed; and

• That the Registrant has no legitimate right or interest to the domain name; and

• that the domain was registered and is being used in bad faith (as in the UDRP there is a non exclusive list of four circumstances)
PROOF OF USE OF THE TRADEMARK

• Art. 1.2.6.1 of UNIFORM RAPID SUSPENSION SYSTEM ("URS")

Procedure:

• a. **Use can be shown by demonstrating** that evidence of use – which can be a declaration and one specimen of current use in commerce – **was submitted to, and validated by, the Trademark Clearinghouse**

• b. Proof of use may also be submitted directly with the URS Complaint.
RESPONSE

- Within 14 days (plus a 7 day potential extension), the Registrant can submit a Response electronically.
- Upon receipt, the Response will be forwarded to the Complainant by the URS Provider.
- The Response shall contain i.a.:
  - Confirmation of Registrant data;
  - Specific admission or denial of each of the grounds upon which the Complaint is based;
  - Any defense which contradicts the Complainant’s claims;
  - A statement that the contents are true and accurate.
- Administrative review of the Response by the URS Provider within 24 hours.
DEFAULT BY THE RESPONDENT

• The Complaint proceeds to Default if the Registrant fails to respond within 14 days.

• **Notice of Default** by the URS provider to the Complainant and to the Registrant.

• **No changes** by the Registrant to the web site and to the Whois information during the Default period will be permitted.

• **Review of determination in default cases**: if the Examiner rules in favor of Complainant, Registrant will be permitted to file a Response at any time up to **six months after the date of the Notice of Default**, requesting a **de novo review**. Prior to the expiration of the six month-deadline, and extension for an additional 6 months may be granted.
DETERMINATION (1)

• The determination shall be rendered by the Examiner on an expedited basis with the explicit goal that it be rendered within 3 business days from when Examination began. Absent extraordinary circumstances, however, Determinations must be issued no later than five (5) days after the Response is filed.

• The only remedy available in the URS will be the suspension of the domain name:

• Upon receipt of the determination, the Registry operator shall suspend the domain name, which shall remain suspended for the balance of the registration period (plus one optional additional year at commercial rates).
DETERMINATION (2)

- The Whois for the domain name shall continue to display all of the information of the original Registrant. The **web site will be redirected to an informational web page** about the URS.
APPEAL

• Either party has the right to seek an appeal of the Determination.

• The appeal must identify the specific grounds on which it is based, including why the appellant claims the Examiner’s Determination was incorrect;

• **Fee:** a standard fee for the appeal to be borne by the appellant, plus an additional fee if new evidence are introduced.

• **Deadline:** the appeal must be filed within 14 days after a Determination is issued and any Response must be filed 14 days after an appeal is filed. In case of a *de novo* review of a determination issued in default of Response, the appeal must be filed within 14 days from the second Determination and any Response must be filed 14 days after the appeal is filed.
B) TRADEMARK POST-DELEGAITION DISPUTE RESOLUTION PROCEDURE (PDDRP) (1)

• The Trademark PDDRP will allow brand owners to report the infringement of their trademarks by a Registry:
  
  – **Top level domain**: the Registry has registered a confusingly similar TLD and engages in abusive conduct;
  
  – **Second level domain**: the Registry consistently and on purpose permits third parties to register infringing second-level domain names.
B) TRADEMARK POST-DELEGATION DISPUTE RESOLUTION PROCEDURE (PDDRP) (2)

- **Fees**: non-refundable filing fee to be borne by the Complainant, additional administrative fees that will be paid in advance by the Complainant, but will be borne by the non-prevailing party.

- **Language**: English
INFRINGEMENT AT THE
TOP LEVEL DOMAIN (1)

• The complainant is required to prove, by clear and convincing evidence, that the registry operator’s affirmative conduct in its operation or use of its gTLD string that is identical or confusingly similar to the complainant’s mark, causes or materially contributes to the gTLD doing one of the following:

  – a) taking unfair advantage of the distinctive character or the reputation of the complainant's mark; or
  – b) impairing the distinctive character or the reputation of the complainant's mark; or
  – c) creating a likelihood of confusion with the complainant's mark.
INFRINGEMENT AT THE TOP LEVEL DOMAIN (2)

- **Example:** The Registry of a TLD string identical to a trademark holds itself out as the beneficiary of the trademark.
INFRINGEMENT AT THE SECOND LEVEL DOMAIN (1)

• The complainant is required to demonstrate, by clear and convincing evidence, that through the Registry operator’s affirmative conduct:

  • a) there is a **substantial pattern or practice of specific bad faith intent by the registry operator to profit from the sale of trademark infringing domain names**; and
INFRINGEMENT AT THE SECOND LEVEL DOMAIN (2)

• b) the registry operator’s **bad faith intent to profit from the systematic registration of domain names** within the gTLD that are identical or confusingly similar to the complainant’s mark, which:
  
  – i) takes unfair advantage of the distinctive character or the reputation of the complainant's mark; or

  – ii) impairs the distinctive character or the reputation of the complainant's mark, or

  – iii) creates a likelihood of confusion with the complainant's mark.
INFRINGEMENT AT THE SECOND LEVEL DOMAIN (3)

- **Example:** The Registry has a pattern or practice of acting as the registrant or beneficial user of infringing registrations in order to monetize and profit in bad faith.
REMEDIES AGAINST THE REGISTRY

• Variety of **graduated enforcement tools**:  
  Remedial measures for the registry to employ to ensure against allowing future infringing registrations;

• Suspension of accepting new domain name registrations in the gTLD for a period of time. Deletion, transfer or suspension of existing domain names are excluded since registrants are not party of the action.

• In extraordinary circumstances where the registry operator acted with malice, providing for the **termination of a Registry Agreement**.
REMEDIES AGAINST THE COMPLAINANT

- If the Complaint has been filed without merit, the Expert panel can award appropriate sanctions on a graduated scale, including:
  - Temporary bans from filing Complaints;
  - Imposition of costs of Registry operator, including reasonable attorney fees; and
  - Permanent bans from filing Complaints after being banned temporarily.
APPEAL IN THE POST-DELEGATION DISPUTE RESOLUTION PROCEDURE

• **Deadline:** the appeal must be filed **within 20 days** after the Expert Determination is issued and it will be possible to file a response in the following 20 days.
SUGGESTED STRATEGY FOR TRADEMARK HOLDERS (1)

• In light of the challenges posed by the 1000+ new generic Top Level Domains, it is advisable to protect IP rights on line:

• i) availing of the above new right protection mechanisms, including the submission of the main trademarks in the Trademark Clearinghouse, in order to participate to Sunrise and Trademark Claims periods;
SUGGESTED STRATEGY FOR TRADEMARK HOLDERS (2)

• ii) consider **possible selective defensive registrations** during Sunrise phases in some of the New gTLDs of interest;

• iii) monitoring **registrations of domain names** identical but also similar to their trademarks;

• iv) **Reclaiming** infringing domain names registered in the new TLDs **via the UDRP procedure**, which will still be applicable also to all the New TLDs, **or via Court actions**.
THANK YOU
FOR YOUR ATTENTION