

¹ ICANN, *29 March is Last Day to Register as New gTLD Applicant*, <http://newgtlds.icann.org/en/announcements-and-media/announcement-29feb12-en> (noting the March 29th and April 12th deadlines) (last visited Apr. 13, 2012).

² *Id.*

³ ICANN, *Statement on TLD Application System* (Apr. 12, 2012), <http://newgtlds.icann.org/en/announcements-and-media/announcement-2-12apr12-en> (noting the system was temporarily taken offline).

⁴ ICANN, *TAS Interruption – Update* (20 April 2012), <http://newgtlds.icann.org/en/announcements-and-media/announcement-20apr12-en>.

⁵ ICANN, *New gTLD Program Statistics* (Apr. 17, 2012), <http://newgtlds.icann.org/en/program-status/statistics>.

⁶ *New gTLD Batching – The Art of Digital Archery*, NEVDOMAINS.ORG (Apr. 17, 2012), <http://www.nevdomains.org/de/New%20gTLD%20Batching%20-%20The%20Art%20of%20Digital%20Archery>.

⁷ Geri L. Haight, *United States: Second Application Window for New gTLDs “Reaffirmed” by ICANN*, MONDAQ (Feb. 20, 2012), www.mondaq.com/unitedstates/x/165182/Trademark/Second+Application+Window+For+New+gTLDs+Reaffirmed+By+ICANN (speculating that although ICANN “reaffirmed” it would open a second application window “as expeditiously as possible,” there is a “growing concern that the potential applicants may miss out . . . if they did not participate in this first application round”); Joshua S. Jarvis, *Welcome to the New Regime: the New gTLD Application Window Launches*, TRADEMARK & COPYRIGHT L. BLOG (Jan. 12, 2012), www.trademarkandcopyrightlawblog.com/2012/01/articles/domain-names/welcome-to-the-new-regime-the-new-gtld-application-window-launches/ (noting the current window is the “only time” when parties may apply “at least for the foreseeable future”).

⁸ ICANN, *GTLD APPLICANT GUIDEBOOK* ¶ 1.1.2.5 (Jan. 11, 2012), available at <http://newgtlds.icann.org/en/applicants/agb>.

⁹ ICANN, *New gTLDs: What to Expect in 2012*, <http://newgtlds.icann.org/en/announcements-and-media/announcement-23jan12-en> (last visited Mar. 5, 2012).

¹⁰ ICANN, *TAS Interruption – Frequently Asked Questions*, <http://newgtlds.icann.org/en/applicants/tas/interruption-faqs> (last visited Apr. 25, 2012).

¹¹ *Id.*

¹² ICANN, *GTLD APPLICANT GUIDEBOOK*, *supra* note 8, at ¶ 1.1.2.2.

¹³ *Id.* at ¶ 1.1.2.3.

¹⁴ *Id.*

DOT DEADLINES: WHAT TO EXPECT WITH gTLDs IN 2012 AND HOW TO PROTECT YOUR RIGHTS AND BRANDS



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The new generic top-level domain application process launched in late 2011, and 2012 is bringing a flurry of gTLD-related activities and deadlines. Here’s a look at some of the key milestones, along with a few strategies for protecting your rights and brands.

THE CLOSE (BEGINNING MARCH 29, 2012):

The registration period for the online tool used to file gTLDs closed to new users on March 29, 2012.¹ The gTLD application window, originally set to close completely on April 12, 2012,² has been delayed due to a glitch in the online application system.³ Once the system reopens, it will remain open for “at least 5 business days.”⁴

ICANN, the Internet governing body overseeing the new gTLD process, previously announced that more than 800 users registered for the online tool as of March 25, 2012.⁵ Some observers estimate that between 1000 to 1500 gTLDs will be applied for by the end of the application window.⁶ Although there is currently no restriction against having another application window, some observers believe that ICANN will have its hands full with the first application window and that another window may not open for a long time, if ever.⁷ For now, if more than 500 applications are received in the current round, which at this point seems inevitable, ICANN will evaluate the applications in “batches,” with an initial batch of 500 and subsequent batches of 400 applications.⁸

THE REVEAL (MAY 2012):

The first major milestone after the close of the application window will be the reveal of application data, including applied-for gTLD character strings and their corresponding applicants.⁹ The target date for this reveal was originally April 30, 2012, but the glitch in the application system caused ICANN to postpone this date.¹⁰ ICANN will announce the date for the reveal following its announcement of the reopening of the application system.¹¹ Assuming the application system is quickly fixed by early May, the reveal will likely occur sometime in May 2012, as ICANN initially stated it would reveal the data “within two weeks of the close of the application submission period.”¹²

PUBLIC COMMENTS (MAY – JULY 2012):

Beginning with the reveal of applied-for gTLDs, ICANN will invite the public to submit written comments on the published gTLD applications at no fee.¹³ Anybody, including non-trademark owners and non-interested persons, may submit comments. Comments submitted during a 60-day period after the reveal will be considered by evaluation panels if the comments provide information about the applicant’s prima facie case for getting a gTLD.¹⁴

FORMAL OBJECTION PERIOD (MAY – DECEMBER 2012):

The reveal of application data will also trigger the start of an approximately seven-month formal objection period. During this time, parties may lodge formal objections on one of four grounds:

- **String Confusion Objection:** Existing TLD operators or gTLD applicants from the same round of applications¹⁵ may lodge a string confusion objection when the “applied-for gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string.”¹⁶
- **Legal Rights Objection:** The holder of a trademark or other legal right¹⁷ may file a legal rights objection when the “applied-for gTLD string infringes the existing legal rights of the objector,” including registered or unregistered trademark rights.¹⁸
- **Limited Public Interest Objection:** Any party¹⁹ may file an objection when the “applied-for gTLD string is contrary to generally accepted legal norms of morality and public order.”²⁰ However, given that there is no limitation on who can bring these objections, ICANN will perform a “quick look” review to weed out “frivolous and/or abusive objections.”²¹
- **Community Objection:** “Established institution[s] associated with a clearly delineated community”²² may lodge objections when “[t]here is substantial opposition to the gTLD application from a significant portion of the community to which the gTLD string may be explicitly or implicitly targeted.”²³

Formal objections must be filed electronically with an appropriate Dispute Resolution Service Provider (DRSP) listed on the ICANN website.²⁴ Additionally, each objection must be filed in English, and if an objector wishes to file more than one objection, each objection must be filed separately.²⁵ Substantively, objections must include the objector’s name and contact information, the objector’s basis for standing, a description of the grounds of the objection, and copies of any documents pertinent to the objector’s basis for the objection.²⁶ Moreover, objections can be no more than the lesser of 5000 words or 20 pages, excluding any attachments.²⁷ Finally, the

objector will be required to pay a filing fee.²⁸

Once objections are filed, the gTLD applicant will have an opportunity to file a response to the objection.²⁹ The dispute resolution process will then continue with an administrative review, possible mediation, and finally the issue of an expert determination by the dispute resolution panel.³⁰ Alternatively, the applicant and objector may reach a settlement, or the applicant may decide to withdraw its initial gTLD application in response to a formal objection.³¹

INITIAL EVALUATIONS BEGIN (APPROXIMATELY JULY – DECEMBER 2012):

Beginning approximately 8 weeks after the close of the application period,³² initial evaluation panels will conduct string and applicant reviews.³³ During string reviews, the panels will evaluate whether the applied-for strings are “confusingly similar” to existing TLDs or other applied-for gTLD strings.³⁴ The panels will also evaluate whether the applied-for gTLD string violates an already reserved string, contributes to instability on the Internet, or is a prohibited geographic name.³⁵ During applicant reviews, the panels will evaluate the applicant organization, focusing on technical, operational, and financial capabilities, as well as Internet stability issues.³⁶

ICANN will publish the results of the initial evaluation period mid-November 2012, including whether the applications have passed or failed the evaluations.³⁷ If the application passed the initial evaluation, the gTLD will be on its way to final clearance and will eventually transition to be live on the Internet by as early as 2013.

If the application fails the initial evaluations, applicants can request additional, or extended, evaluation.³⁸ The extended evaluation period will allow the applicant to clarify information in the application through one **MORE>**

¹⁵ *Id.* at ¶ 3.2.2.

¹⁶ *Id.* at ¶ 3.2.1.

¹⁷ *Id.* at ¶ 3.2.2.

¹⁸ *Id.* at ¶ 3.2.1.

¹⁹ *Id.* at ¶ 3.2.2.

²⁰ *Id.* at ¶ 3.2.1.

²¹ *Id.* at ¶ 3.2.2.

²² *Id.*

²³ *Id.* at ¶ 3.2.1.

²⁴ ICANN, *Objection and Dispute Resolution Fact Sheet*, available at <http://www.icann.org/en/topics/new-gtlds/objection-dispute-resolution-fact-sheet-14dec11-en.pdf> (last visited Mar. 5, 2012).

²⁵ ICANN, GTLD APPLICANT GUIDEBOOK, *supra* note 8, at ¶ 3.3.1.

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.* at ¶ 3.3.2.

²⁹ ICANN, *Objection and Dispute Resolution Fact Sheet*, *supra* note 24.

³⁰ *Id.*

³¹ *Id.*

³² ICANN, GTLD APPLICANT GUIDEBOOK, *supra* note 8, at ¶ 1.1.2.5 (noting initial evaluations begin “immediately after the administrative completeness check concludes); *id.* at ¶ 1.1.2.2 (noting the administrative completeness check “is expected to be completed . . . in a period of approximately 8 weeks” after close of the application period).

³³ *Id.* at 2-2.

³⁴ ICANN, *New gTLDs: What to Expect in 2012*, *supra* note 9.

³⁵ *Id.*

³⁶ ICANN, GTLD APPLICANT GUIDEBOOK, *supra* note 8, at 2-2.

³⁷ ICANN, *New gTLDs: What to Expect in 2012*, *supra* note 9.

³⁸ ICANN, GTLD APPLICANT GUIDEBOOK, *supra* note 8, at ¶ 2.3.

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additional exchange of information between the applicant and the evaluation panel.³⁹ The applicant will have 15 days to request the extended evaluation and must do so expressly.⁴⁰ Additionally, some evaluations and objections may result in “string contentions” if the applied-for gTLD will create user confusion

extended evaluation if the application fails the initial evaluation. While the foregoing overview provided a general summary, a full guidebook on the application and approval process is available through ICANN’s website.⁴³

Non-applicant clients who own protectable trademarks should monitor ICANN’s

Additionally, if the trademark owner believes an applied-for string is confusingly similar to its trademark, the owner should consider lodging a legal rights objection during the formal objections period.

due to similarity to other applied-for gTLDs, existing TLDs, or protected trademarks.⁴¹ These applications will result in contention resolution for evaluation of priority or auction.⁴²

publication periods, including the initial reveal of gTLD strings and applicants. Additionally, if the trademark owner believes an applied-for string is confusingly similar to its trademark, the owner should consider lodging a legal rights objection during the formal objections period. Alternatively, non-applicant clients may also participate in the public comment period early in the process, but must tie the comment to an applicant’s prima facie application to be considered during evaluations.

Additional information and updates on the gTLD process can be found through ICANN’s website: <http://newgtlds.icann.org/en>. ■

GENERAL ACTION ITEMS:

Clients who are gTLD applicants will have a busy year. Applicants will need to monitor the initial reveal to determine if other applied-for strings are confusingly similar. They can submit objections and public comments, and applicants will need to respond to objections lodged against them. Additionally, applicants will need to correspond with the evaluation panels during initial evaluations, and may need to apply for

BANNER & WITCOFF RAISES THE BAR

To meet the urgent need for increased funding for legal services, the D.C. Access to Justice Commission formally launched the “Raising the Bar in D.C.” campaign, with the endorsement of the D.C. Bar Foundation and the D.C. Bar. The campaign’s goal is to substantially increase financial support to the District’s legal services community by establishing benchmarks for law firm giving and annually recognizing and celebrating those firms that have donated at benchmark levels.

Banner & Witcoff and 22 other law firms were recognized for donating \$3 million to local legal service providers as part of the inaugural fundraiser of “Raising the Bar in D.C.” Banner & Witcoff was recognized as a silver level donor.



³⁹ ICANN, *New gTLDs: What to Expect in 2012*, *supra* note 9.

⁴⁰ ICANN, *GTLD APPLICANT GUIDEBOOK*, *supra* note 8, at ¶ 2.3.

⁴¹ *Id.* at ¶ 4.1.

⁴² *Id.*

⁴³ ICANN, *gTLD Applicant Guidebook* (Jan. 11, 2012), available at <http://newgtlds.icann.org/en/applicants/agb>.