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Technology: 8 strategies to protect trademarks against new domain names

ICANN has several procedures in place to prevent infringement by new gTLDs

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Now that the Internet Corporation for Assigned Names and Numbers (ICANN) is proceeding on schedule to accept applications for new generic Top Level Domains (gTLDs)—the extensions to the right of the final dot in an Internet address such as .com and .org—trademark owners need to know how to protect their rights. Following is a description of the procedures ICANN makes available for this purpose.

1. **Public comments.** ICANN will post the public portions of every gTLD application on its website approximately two weeks after the application period ends on April 12. Based on the information, anyone may submit written comments on a pending application and those comments will be considered by an evaluation panel if submitted within 60 days. Pointing out how an applied-for gTLD infringes on, or might be confused with, a registered trademark is an easy way to inform ICANN and the offending applicant that the gTLD should not be awarded.
2. **Legal rights objection.** Formally disputing a gTLD application on this ground must show “the potential use of the applied-for-gTLD by the applicant takes unfair advantage of the distinctive character or the reputation of the objector’s registered or unregistered trademark or service mark.”
3. **Trademark Clearinghouse.** Certain protections are afforded trademark holders even after a new gTLD has been added to the Internet. Among them is the Trademark Clearinghouse, “a central repository for information to be authenticated, stored, and disseminated, pertaining to

the rights of trademark holders.” It will be operated by a service provider through a contract with ICANN.

4. **Trademark claims service.** Operating in conjunction with the Trademark Clearinghouse, this service allows a mark holder to notify a domain name registrant that the applied-for domain name is an identical match to a trademark listed in the Trademark Clearinghouse. The service “is intended to provide clear notice to the prospective registrant of the scope of the mark holder’s rights in order minimize the chilling effect on registrants.”
5. **Sunrise service.** This service allows trademarks to be added to a list of names unavailable for use by other registrants in a particular gTLD. An applicant must demonstrate “ownership of a mark” that is “nationally or regionally registered and for which proof of use ... was submitted to, and validated by, the Trademark Clearinghouse” or has been “court-validated” or is “specifically protected by a statute or treaty currently in effect and that was in effect on or before 26 June 2008.”
6. **Uniform Rapid Suspension System.** A remedy for “clear cases of trademark abuse,” the Uniform Rapid Suspension System(URS) permits a domain name to be locked and suspended if found to have been used in bad faith. A complaint must show by clear and convincing evidence that “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 “validated through court proceedings” or “specifically protected by a statute or treaty in effect at the time the URS complaint is filed.”
7. **Trademark post-delegation dispute resolution procedure.** This procedure allows an alternative form of relief for less obvious cases of trademark infringement. The complainant must prove “by clear and convincing evidence that a registry operator’s “affirmative conduct in its operation or use of its gTLD string” either “causes or materially contributes” to the new gTLD string “taking unfair advantage of the distinctive character or the reputation of the complainant’s mark” or “impairing the distinctive character or the reputation of the complainant’s mark” or “creating a likelihood of confusion with the complainant’s mark.”
8. **Registry restrictions dispute resolution procedure.** This remedy is available when a new gTLD owner’s violation of the community-based

registration restrictions in the registry agreement harms an established institution associated with a defined community.

Strict timing rules govern when these procedures are available and, except for submitting public comments, ICANN's rules also require proof of standing and the payment of costs to make use of them. Deciding which of these procedures may be appropriate will require a careful evaluation of an organization's particular circumstances in light of ICANN's requirements.

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