

New Generic Top Level Domain Names Top Three Steps to Take Today

On June 13, 2012, the Internet Corporation for Assigned Names and Numbers (ICANN), published the much-anticipated list of 1,930 newly-applied for generic Top-Level Domains (gTLDs – the group of letters after the “dot” in a domain name) for which it had received applications from parties seeking to operate new registries. A full list of the applied-for gTLD strings is available on [ICANN's website](#).

A cacophony of hoopla and handwringing surrounded ICANN's announcement last year that it would soon be accepting applications for new gTLDs, and the commentary has returned in full-force following ICANN's publication of the list. In planning how to address this new Internet landscape, we recommend ignoring the hype and focusing instead on the following three action items.

1. Review the List for Infringements

First, we strongly recommend that brand owners review the list for proposed gTLDs that might be confusingly similar to your brand. June 13 marked the opening of a 60-day period for submitting public comments to ICANN for consideration by ICANN's evaluating committee. These comments must address a specific application and applicant, and will be considered by an evaluation panel. The reveal date also marked the opening of the seven month period for filing formal objections to the applications. An application can be objected to on the grounds that (1) it violates the legal rights of a trademark owner, (2) it is confusingly similar to another application or an existing TLD, (3) it is not in the interest of the public and violates the legal norms of morality and public order, and (4) where there is a substantial opposition within the community targeted by the proposed gTLD.

2. Review the List for Business Opportunities

Second, consider whether the list contains any new generic gTLDs that might be helpful for your business. The list contains many possible gTLDs directed to specific industries, such as .bank, .app, .baby, .boots, .family, .fashion, .fish, .games, .food, .health, .hotel, .love, .news, .store, and .wine. Identify any gTLDs that are within your relevant field, or might be helpful from a marketing perspective.

Given the numerous new options, it may not make sense to register every possible iteration of your trademarks and corporate name under each possibly relevant platform. However, because no one is certain how this slew of new gTLDs will impact search engine optimization (SEO), you may want to consider at least registering your primary brands and business name with relevant industry-directed new gTLD programs (e.g., YOURBRAND.baby or YOURBRAND.bank).

The new gTLDs may provide unique opportunities for new marketing opportunities, or they may simply help you maintain your web presence once the Internet is no longer dominated by .com. Either way, the cost of registering a few additional domain names is likely worth the investment.

Each new gTLD program will open a mandatory “sunrise” period upon launch, during which time trademark owners will be allowed to pre-register for their trademarks under that particular new gTLD. Keep track of the review process of gTLDs of interest to your business, to ensure that you are able to register your core marks when desired domains become available.

3. Register Your Trademarks with the Trademark Clearinghouse

Finally, register your trademarks with the new global Trademark Clearinghouse established by ICANN to protect trademark owners from future domain name infringements involving the new gTLDs. The Clearinghouse is intended to function as single database of authenticated registered trademarks, and will eliminate the need for trademark holders to register their marks in many different verification databases as new gTLDs are launched. ICANN will require every new gTLD operator to utilize the Clearinghouse. The fee for initial authentication and validation services is expected to be less than \$150 per mark, and can be renewed annually. ICANN expects to implement the Clearinghouse in the Fall of 2012.

Please contact Monica Riva Talley at mtalley@skgf.com or 202.772.8688 if you would like to discuss how to navigate the new gTLD landscape.

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