

Changing Internet Presents New Opportunities (and Challenges) for Brand Owners

by Kyle T. Peterson, Patterson Thuentel IP



The internet is growing at an astonishing rate. The number of websites online, now over 500 million, more than doubled in 2011. As a result, it is becoming increasingly difficult for entrepreneurs coming online to find an appropriate name for their business at a reasonable price. Accordingly, ICANN, or the Internet Corporation for Assigned Names and Numbers, is “opening up” the domain name space by allowing organizations globally to apply for the right to operate a new generic top level domain (gTLD) registry of their choosing and introduce it for use on the internet.

A gTLD is essentially what comes after the last dot in a web address. For example, ‘.com’ is a gTLD as are ‘.net’, ‘.org’, ‘.gov’ and ‘.edu.’ It is important to recognize, however, that a gTLD is not a domain name. Rather, it is like digital real estate—a critical piece of internet infrastructure—and owning one is not meant for the casual user. A gTLD registry is expected to be a functioning technical business, operating in a manner that supports the security and stability of the world wide web.

Once a new gTLD extension is delegated, the registry can, if they choose, make second level domain names beneath it available for registrars to then sell to end users (registrants) for use as their address on the world wide web. Internet users can expect to see domain names such as www.minivans.cars, www.merlot.wine, www.iphone.apple, and many more. ICANN expects new gTLD applications could

exceed 1,000. Every internet user will be impacted, especially businesses who maintain and promote brands.

The prospect of owning your own gTLD is expensive. Applicants for new gTLDs will pay a \$185,000 application fee and undergo extensive evaluation for technical, financial, and administrative qualifications to ensure the applicant can operate a gTLD registry in a manner that supports the stability and security of the internet. The window for this first round of gTLD recently opened, and will close on April 12, 2012.

In early May, 2012, public application information will be posted to ICANN’s website for brand owners to monitor for possible infringement. Any dispute resolution proceedings must be based on one of the following four criteria:

1. String Confusion Objections – the objector must be a current TLD operator or gTLD applicant in the same round
2. Legal Rights Objections – the objector must be a trademark owner whose rights are being infringed
3. Limited Public Interest – objections may be filed by any member of the public
4. Community Objections – the objector must be an established institution clearly defined with a community

In October, 2012, ICANN expects to release the details and procedures for trademark

owners to file their registered marks within a “Trademark Clearinghouse.” Third party applications for new gTLDs will not be

permitted for marks that are listed in the Trademark Clearinghouse.

Patterson Thunte IP’s trademark team is highly knowledgeable in the areas of domain registration and protection and is pleased to assist companies looking to register a gTLD or those concerned about protecting their brands through the new gTLD program launch. For more information, please contact Kyle Peterson (peterson@ptslaw.com) or Tye Biasco (Biasco@ptslaw.com) or call (612) 349-5740.