

ICANN's list of "Early warnings" to requested new top domains now listed

ICANN (Internet Corporation for Assigned Names and Numbers) is now evaluating the almost 2,000 applications for new generic Top Level Domains which have been filed. Countries/State authorities have the possibility of objecting to applications if they are in conflict with current national laws or if they are sensitive or problematic for other reasons. For instance, they may object to applications if they consider the applications to potentially harm consumers.

ICANN's Governmental Advisory Committee has now published a list of 'Early Warnings' to about 250 of the applications submitted for new generic Top Level Domains. The list includes information about which country has issued an "Early Warning" in relation to a specific application and details of the grounds for doing so. The "Early Warning" may lead to a formal objection at a later stage.

The list clearly shows that very few countries have decided to involve themselves in the process. One exception is, however, Australia. Australia has typically decided to issue "Early Warnings" to applicants who have applied for a generic term, but who seek to restrict the availability to third party registrants and thus to obtain exclusive access to a common generic Top Level Domain that relates to a broad market sector.

The "Early Warning"-list includes for example strings like ".app", ".book" and ".tire". For other strings such as ".attorney", ".doctor" and ".lawyer" the ground for the early warning is that the strings are linked to a regulated market sector and do not appear to have proposed sufficient protection mechanisms to address the potential for misuse. Another string is ".gmbh" (Gesellschaft mit beschränkter Haftung) which is the German equivalent to a Limited Liability Company or Aktiebolag, and the reason for objecting has been that the abbreviation is linked to a specific corporate form for companies and that the registry should issue domain names under .gmbh only to entities which are in fact GmbH entities.

[Here](#) you can view the whole list, including information about applications, applicants, and country/state which has issued the Early Warning.

What happens now? Options.

The applicants who have received "Early Warnings" can:

1. Meet with the concerned state/states to discuss their concerns
2. Withdraw the application within 21 days (which implies that the applicant will get a refund of 80% of the application fee)
3. Continue with the application with the risk that the application will be rejected later.

Zacco's view on the new generic Top Level Domains:

The new Top Level Domains will involve significant costs and much more work for trademark holders in order to keep track of and/or register domain names. We question the need for establishing so many new generic Top Level Domains in such a short time.

Not only will the sheer number of new top level domains confuse the market, it will also put an enormous strain on trademark holders to police the domain name arena at a much higher expense, either through domain name registrations, domain name dispute cases, or by battling increased Internet fraud attempts.

There are also issues relating to future Internet Stability. How, for example, will ICANN handle gTLDs which, over time and for various reasons – be it commercial or other, will not be sustained by the current registry or any other party? ICANN does not have an answer to this. Will we ultimately have to accept a certain amount of gTLDs which will come and go making the robust Internet addressing system we know today more unstable?

There is also a risk that .brand TLDs are applied for purely due to fear of being left behind, outdated or unable to explain to decision makers why an application for their particular .brand was not processed, or fear of being denied a .brand at a later stage.

Recommendations

Zacco recommends its customers, as a first step, to take the following actions:

- Go through the list of applications and identify potential Top Level Domains that can create problems for your own company and brand, and review its options in regards to protecting your interests.
- Establish a strategy and a policy for how to relate to the various new Top Level Domains that are established both from an IP perspective and from a marketing perspective.
- Consider registering your (registered) trademarks with the so-called "Trademark Clearing House" which will be created to make it easier for trademark holders to obtain information about domain name registrations that are identical to the mark in the new Top Level Domains and to be able to register domain names beforehand based on the trademark when needed.

Background

Currently there are about 250 Top Level Domains. They are either country code top level domains such as .se., .dk, .no, .nl, and .de or generic international top level domains such as .com, .net, and .info.

During a period of three months, January 12 and April 12 this year, ICANN (Internet Corporation for Assigned Names and Numbers) accepted applications to operate new generic Top Level Domains (New gTLD program). Anyone was invited to apply for a new Top Level Domain and trademark owners and others could apply for a ".brand" (e.g. ".apple" or ".volvo") or any other words or geographic places like ".game", ".tourist", ".berlin" or ".paris".

On June 13, ICANN published a list of almost 2.000 applications. The complete list is found [here](#).

ICANN is now evaluating the applications and ICANN's Government Advisory Committee has published a list of 'Early Warnings'.

The plan is to start releasing the new Top Level Domains during Q3, 2013, and approximately 20 gTLDs are intended to be released every week.

As the new generic Top Level Domains are approved, there will be different "sunrise periods" during which trademark owners can apply for second level domain names within the new gTLD before the general public can. Zacco will provide further information about these sunrise periods as soon as it becomes available.

Questions?

Zacco can provide further assistance concerning the new gTLDs or domain name matters in general. For further information about the new gTLDs, see www.icann.org.

For questions on domain names you may consult:

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About Zacco

Zacco is a leading European consultancy within Intellectual Property with approx. 500 employees, many of whom are European Patent, Trademark and/or Design Attorneys. Zacco covers all technical and legal areas within intellectual property and assists clients with technical, legal and strategic advice, including handling of conflicts and litigation. In addition to assistance in protecting intellectual property rights, Zacco also offers its clients strategic advice aimed at increasing their competitive edge through a professional exploitation of these rights. Zacco has fourteen offices in five European countries (Denmark, Sweden, Norway, Germany and the Netherlands). Visit www.zacco.com for further information.