

The new gTLDs

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rights protection mechanisms

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Session Outline

- Pre-Delegation Objection Mechanisms
- Trade Mark Clearing House (“TMCH”)
- Uniform Rapid Suspension (“URS”)
- Uniform Domain Name Dispute Resolution Policy (“UDRP”)
- Post-Delegation Dispute Resolution Procedure (“PDDRP”)

Background

- 26 June, 2008 - process commenced
- 12 January, 2012 - application window opened
- 30 May, 2012 - application window closed
- 13 March, 2013 - objection filing period closed
- 23 October, 2013 - first new domains delegated

Applicant Guidebook

- Background screening and initial evaluation (module 2)
- Government Advisory Committee (“GAC”) (module 3.1)
- Public Objections (module 3.2)
- Independent Objector (module 3.2.5)
- Dispute Resolution Principles (module 3.5)

Public Objections (263)

- String Similarity Objections (ICDR) - 67
- Legal Rights Objections (WIPO) - 69
- Limited Public Interest Objections (ICC) - 23
- Community Objections (ICC) - 104

String Confusion Objections

- String is confusingly similar to an existing gTLD or another applied-for gTLD
- Probability that “confusion will arise in the mind of the average, reasonable Internet User”
- Objector must be an existing gTLD operator or an applicant in the same round

Issues arising from the decisions

- Panel selection
- Who is the “average, reasonable Internet user/consumer” Where does he/she reside? What is his/her first language?
- Issues giving rise to diverging views: possibility v. probability of confusion; relevance of potential damage; open or closed domain; finding of string similarity panel; context of planned use/target market; second level use; trade mark law; UDRP decisions; doctrine of foreign equivalents; co-existence of parties’ trade marks; the relative significance of visual and aural similarities and similarity in meaning

Existing Legal Rights Objections

- takes unfair advantage of the distinctive character/reputation of the objector's trade mark
- unjustifiably impairs the distinctive character/reputation of the objector's trade mark
- otherwise creates an impermissible likelihood of confusion

Existing Legal Rights Objections

- 49 selected panelists responsible for 6,000 of the 20,000 WIPO UDRP decisions
- very high level of consistency in reasoning
- only 4 objections succeeded

Limited Public Interest Objections

- String is contrary to generally accepted legal norms of morality and public order that are recognised under principles of international law
- Objector can be anybody and may be the Independent Objector
- Quick-look review to exclude those manifestly unfounded and those constituting an abuse of the right to object

Limited Public Interest Objections

- 23 objections of which only 7 appear to have gone through to a decision (at least 11 still pending)
- 10 filed by the Independent Objector - mainly health related (e.g. '.health', '.med', '.hospital')
- the only LPI objection to have succeeded thus far is '.hospital' (by a majority)

Community Objections

- Objector must be an established institution associated with a clearly delineated Community
- Substantial Opposition within the Community
- Targeting (strong association between Community and String)
- Likelihood of Material Detriment to the Community

Post-Delegation Rights Protection Mechanisms

- Trade Mark Clearing House (“TMCH”)
- Uniform Rapid Suspension (“URS”)
- Uniform Domain Name Dispute Resolution Policy (“UDRP”)
- Post-Delegation Dispute Resolution Procedure (“PDDRP”)

Trade Mark Clearing House

- Centralised database of verified trade mark data (Deloitte and IBM)
- nationally or regionally registered word marks; judicially validated word marks; word marks protected by statute/treaty; “other marks that constitute IP”

Trade Mark Clearing House

- Sunrise Services
- Trade Mark Claims Services
- Registrations need to be renewed annually
- trade marks featuring dots will be excluded

Uniform Rapid Suspension

- abbreviated form of UDRP
- for clear-cut cases of abuse
- intended to be low-cost and efficient
- and complementary to the UDRP
- only relief is suspension
- scope for appeal

Uniform Domain Name Dispute Resolution Policy

the UDRP is applicable to all the new
gTLDs

Post-Delegation Dispute Resolution Procedure

- the PDDRP is the route to go if a gTLD registry is mis-behaving
- only covers 'affirmative' misconduct
- does not cover 3rd party abuse at the second level
- implementation of remedies at ICANN's discretion

thank you