



ICANN Outlines Proposed Trademark Protection Measures in Preparation for the Introduction of New gTLDs in Early 2010

October 9, 2009

By [Mark V.B. Partridge, Trademark Attorney](#)

The Internet Corporation for Assigned Names and Numbers (ICANN) is introducing new generic top-level domains (gTLDs) in early 2010. This past weekend ICANN issued its third Draft Applicant Guidebook, which addresses some of the trademark issues that have been raised.

Implementation Recommendations

While specific trademark protection mechanisms are still to be decided, ICANN has drafted a set of implementation recommendations to protect intellectual property in the new gTLD space based upon recommendations from the Implementation Recommendation Team and others. ICANN also considered the comments of the broader Internet community.

Additional Rights Protection Mechanisms

The Guidebook provides the following additional rights protection mechanisms:

- a requirement to maintain a "thick" Whois database; and
- specification of a dispute procedure that trademark holders can use to lodge complaints against registries.

GNSO Policy Consideration

In addition, the Generic Names Supporting Organization (GNSO), the organization that developed the new gTLD policy, has the opportunity to provide its input on whether the rights protection mechanisms stated below and recommended by ICANN staff are consistent with the GNSO's



PATTISHALL
McAULIFFE
NEWBURY
HILLIARD &
GERALDSON LLP • 311 South Wacker Drive, Suite 5000 • Chicago IL 60606 • T (312) 554-8000 • F (312) 554-8015 • www.pattishall.com

These materials have been prepared by Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP for general informational purposes only. They are not legal advice. They are not intended to create, and their receipt by you does not create, an attorney-client relationship.

proposed policy on the introduction of new gTLDs, and are an appropriate and effective option for achieving the GNSO's stated principles and objectives:

- The creation of an IP Clearinghouse, which is a database of validated trademarks to be utilized by new gTLD registry operators in implementing either an IP claims service or Sunrise process during gTLD launch; and
- The creation of a Uniform Rapid Suspension process for use in clear-cut, blatant cases of trademark infringement.

Public Comment

Through November 22, 2009, the public may comment on the proposed trademark protection mechanisms outlined above, as well as any other new gTLD issues, in the comment sections found on ICANN's gTLD web page, available at <http://www.icann.org/en/topics/new-gTlds/gnso-consultations-reports-en.htm>.

In addition, prior to implementation, ICANN is seeking community input regarding remaining issues such as competition, consumer protection, security, stability and resiliency, malicious abuse issues, sovereignty concerns, and rights protection.

These new developments may affect the interests of various industries and companies, but how and to what extent remains to be seen. For more information, see <http://www.icann.org/en/announcements/announcement-04oct09-en.htm>.

* * *

Mark V.B. Partridge is an attorney with [Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP](#), a [leading intellectual property law firm](#) based in Chicago, Illinois. Pattishall, McAuliffe represents both plaintiffs and defendants in [trademark](#), [copyright](#) and [unfair competition trials and appeals](#), and advises its clients on a broad range of domestic and international intellectual property matters, including brand protection, Internet and e-commerce issues. Mr. Partridge's practice focuses on litigation, transactions and counseling in domestic and international [trademark](#), [trade dress](#), [Internet](#) and [copyright law](#).