



Handling the Oncoming Tide of Generic Top-Level Domain Name Disputes



Christopher K. Larus,
Partner, Robins,
Kaplan, Miller & Ciresi

As early as late summer 2013, the Internet Corporation for Assigned Names and Numbers (ICANN), the nonprofit entity that oversees domain names, will launch as many as 500 new Generic Top-Level Domain

names (gTLDs). A top-level domain name is the last part of an Internet address, after the final “dot.” The most common current top-level domain names are .com, .net and .org. Under the gTLD program, however, ICANN invited applications from individuals, companies and organizations to create many new top-level domains. Some of the proposed gTLDs include .book, .music, .app and .buy.

During the dot-com boom of the early 2000s, many brand owners spent a significant amount of time and money fighting off trademark infringement caused by cybersquatting or even just unintended brand confusion.

With the new gTLDs, those expensive battles could be coming back.

“Many anticipate a ‘land rush’ toward registering a wide variety of new top-level domains, many of which may constitute or incorporate trademarks,” said Christopher K. Larus, a partner in the IP Litigation Group at Robins, Kaplan, Miller & Ciresi L.L.P. in Minnesota. “This has generated substantial concern among trademark owners since ICANN first announced the expansion of designations that can serve as top-level domains. Given the large numbers of disputes arising from the registration of domain names incorporating trademarks and various country-specific top-level domains, this concern seems justified.”



Maria Crimi Speth,
IP Litigator, Jaburg
& Wilk

The new gTLDs could also create a new kind of domain name trademark dispute, particularly those that are generic industry terms.

“If the gTLD is a generic industry term, the registration of a brand in connection with that industry could be a problem,” said Maria Crimi Speth, an IP litigator with Jaburg & Wilk, P.C., in Arizona, who also sits on the gTLD subcommittee of the International Trademark Association. “For example, Subway is a registered trademark for restaurant services and for amplifiers. Consider the implications if the owner of the Subway trademark in connection with amplifiers decided to register the domain name ‘subways.restaurants.’ We expect to see these types of disputes.”

What should trademark owners do? There is some recourse available through ICANN, which has established Rights Protection Mechanisms (RPMs) designed to resolve disputes related to gTLDs.

“The Trademark Clearinghouse is a mechanism that allows brand owners to list their brands in a central repository,” said William D. Schultz of the IP firm Merchant & Gould in Minneapolis. “Once listed, the brand owners may obtain domain names on an expedited basis. Additionally, third parties designing to register domain names that relate to the brands in the clearinghouse are notified of the brand and may stop the registration with that knowledge. If the registration proceeds, the brand owner is notified of the registration and may act accordingly.”

Schultz noted that in the case of clear-cut trademark infringement, ICANN



William D. Schultz,
Merchant & Gould

also offers the Uniform Rapid Suspension (URS) system, which provides brand owners with an expedited process to take down infringing websites. Another process is the Post-Delegation Dispute Resolution Procedure

(PDDRP), an administrative proceeding to handle allegations of trademark abuse.

There is also recourse available outside of ICANN’s processes.

“Litigation, either for trademark infringement or violation of the Anti-Cybersquatting Protection Act, remains an available option,” said Marc C. Levy, a partner with Faegre Baker Daniels in Denver.

Given the cost of litigation, however, and the delays created by an overburdened U.S. court system, brand owners might also consider arbitration for certain gTLD disputes.

“Trademark owners might wish to use arbitration to resolve close or difficult questions of domain name ownership,” said R. Shawn Gunnarson, a shareholder with Kirton McConkie PC in Salt Lake City who advises clients on Internet strategy and ICANN matters.

Schultz noted arbitration can be effective in disputes involving non-U.S. entities, as notice can be served by email.

“Additionally, under the registration rules, the decisions from the panel are binding on the registrars, regardless of whether the domain name is registered

See “Handling the Oncoming Tide” on Page 12



Handling the Oncoming Tide continued from Page 8

with a registrar in the United States or Japan,” Schultz said. “Registrars generally comply with the transfer orders because not doing so can result in sanctions.”

Arbitration may also better serve the unique needs of parties in domain name disputes.

“Since damages are not usually the goal, arbitration may make sense as being less expensive,” said Crimi Speth.

Regardless of how brands will deal with disputes, it is important to have a strategy in advance of the launch of the new gTLDs.

“Brand owners should put a plan in place to determine at what point to take action against a domain name registrant,” said Schultz. “Brand owners should assess their policing policies to determine the best course of action for their particular brands.” ●

Worth Reading continued from Page 10

topics. There is advice on mediation advocacy, advice on how to find a mediator, advice for mediators on how to work through some difficult situations and advice to clients on how to understand the mediation process. There’s something in there for everybody.

Anatomy of a Mediation is an easy read, and Freund is a practiced and skilled storyteller. If I had one quibble, it would be that Freund glosses over the ethical issues associated with the mediator arriving at a solution and then

bringing the parties there—sometimes without their full awareness of what’s going on. Freund is comfortable that he’s not doing anything deceptive or unethical, but in my view, he might have discussed this further.

Overall, the book is great, and I would recommend it to anyone interested in learning more about mediation. Freund’s style of mediation is not for everyone, but there’s still something in this book for every reader to learn. ●

JAMS Ireland continued from Page 11

According to Tweed, Ireland’s Arbitration Act 2010 “has generated much discussion and debate, but the impact has, in my experience, been less significant than would have been anticipated, although this situation is gradually changing, particularly with Ireland’s profile being raised with its favorable tax treatment of corporations and the capital value of IP.”

Tweed said, “It’s still too early to assess how the new Court Rules on ADR and changes to the mediation law have impacted or will impact the immediate development of ADR in this jurisdiction, but the changes have certainly created a whole new niche in mediations and arbitrations.” ●

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