

Technology, Entertainment
and Intellectual Property

lavery
LAW ▶ BUSINESS

CREATION OF NEW INTERNET DOMAIN NAMES IN 2012

SIMON LEMAY

ON JUNE 20, 2011, IN SINGAPORE, ICANN (INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS), THE GLOBAL CO-ORDINATION BODY FOR INTERNET ADDRESSES, APPROVED THE NEW PROGRAM FOR THE THEMATIC EXTENSION OF GTLDS. THIS PROGRAM WILL CERTAINLY LEAD TO SIGNIFICANT GROWTH IN THE NUMBER OF DOMAIN NAMES (GTLDS) ON THE INTERNET. THIS CHANGE WILL AFFECT ALL OWNERS OF TRADEMARKS WHO WILL HAVE TO WEIGH THE PROS AND CONS AND OPPORTUNITIES AND RISKS THEY WILL FACE UNDER THE NEW PROGRAM, WHICH WILL BE OFFICIALLY LAUNCHED ON JANUARY 12, 2012.

Once launched, the registration of domain names will become public, and everybody will be able to register a gTLD. To open it up to the public, ICANN will allow new thematic extensions, which will no longer be restricted to the existing 22 generic extensions. They may now consist of geographic domains such as *.switzerland*, *.canada*, *.vancouver* or even trademarks. Practically any word, name, trademark or other designation may be identified with a new specific domain name.

For trademark owners, the issue will then be what procedure and what rules are to be followed for registering a domain name during the period before the launch, as well as after the launch, at which time domain names will become a mechanism that is available to the general public for registration.

This wave of new gTLDs is an unprecedented situation for trademark owners. The purpose of the initiative is to increase competition and the diversity of domain names. The new gTLDs will increase the number of valid choices for registering personalized Internet addresses and create new opportunities for branding and marketing strategies.

The decision to register will be an expensive one for businesses, since the costs to file a new suffix application will be at least \$185,000. Also, applicants will have to show they have a legitimate right to the name and have the technical capability to operate the new suffix.

PROCESS

At the appropriate time, i.e. between January 12 and April 12, 2012, any organizations and businesses who wish to set up and operate registry services for such new generic extensions (gTLDs) must file an application with ICANN. ICANN will then decide which of such organizations have submitted proof that they have the necessary technical and organizational capability to operate such a service. ICANN has made an «Applicant Guidebook» available on its Internet site. This information package describes the criteria to be met and procedures to be followed for filing an application under the new program. The site also provides information on the taxes that will be charged for the administration of the applications and disputes.

This therefore means that, once the application period is completed and the applications have been approved, the Internet will likely contain hundreds, if not thousands, of new suffixes representing large brand names, names of cities or regions and even family names.

On a related issue, legitimate trademark owners have the option of excluding their trademarks from the new ".xxx" registry, and now is the time to do so. We are currently in the period prior to the launch which was created to allow businesses that are not members of the adult entertainment industry to exclude their trademarks from this registry. Registering a trademark in this way will block it from appearing in any ".xxx" registry. The fee for such a filing is quite low and the deadline for doing so is October 28, 2011.

Please do not hesitate to contact us if you have any questions, need help or would like strategic advice on these new developments.

SIMON LEMAY

418 266-3064 slemay@lavery.ca

YOU CAN CONTACT THE FOLLOWING MEMBERS OF THE TECHNOLOGY, ENTERTAINMENT AND INTELLECTUAL PROPERTY GROUP WITH ANY QUESTIONS CONCERNING THIS NEWSLETTER.

JAMIL CHAMMAS 514 878-5539 jchammas@lavery.ca

MARIE-EVE CLAVET 418 266-3067 meclavet@lavery.ca

CATHERINE CONIDES 514 878-5651 cconides@lavery.ca

JEAN-SIMON DESCHÊNES 418 266-3075 jsdeschenes@lavery.ca

DAVID ERAMIAN 514 877-2992 deramian@lavery.ca

OLGA FARMAN 418 266-3052 ofarman@lavery.ca

JOCELYNE GAGNÉ 514 878-5542 jgagne@lavery.ca

MARIE-HÉLÈNE GIROUX 514 877-2929 mhgiroux@lavery.ca

ÉDITH JACQUES 514 878-5622 ejacques@lavery.ca

SIMON LEMAY 418 266-3064 slemay@lavery.ca

JOHN N. MCFARLANE 613 233-2674 jmcfarlane@lavery.ca

LOUIS ROCHETTE 418 266-3077 lrochette@lavery.ca

LUC THIBAUDEAU 514 877-3044 lthibaudeau@lavery.ca

ANDRÉ VAUTOUR 514 878-5595 avautour@lavery.ca

SÉBASTIEN VÉZINA 514 877-2964 svezina@lavery.ca

EMIL VIDRASCU 514 877-3007 evidrascu@lavery.ca

SUBSCRIPTION: YOU MAY SUBSCRIBE, CANCEL YOUR SUBSCRIPTION OR MODIFY YOUR PROFILE BY VISITING PUBLICATIONS ON OUR WEBSITE AT lavery.ca OR BY CONTACTING CAROLE GENEST AT 514 877-3071.

► lavery.ca

© Copyright 2011 ► LAVERY, DE BILLY, L.L.P. ► BARRISTERS AND SOLICITORS

The content of this text provides our clients with general comments on recent legal developments.

The text is not a legal opinion. Readers should not act solely on the basis of the information contained herein.

MONTREAL QUEBEC CITY OTTAWA