



# The New gTLDs: To Apply or Not to Apply

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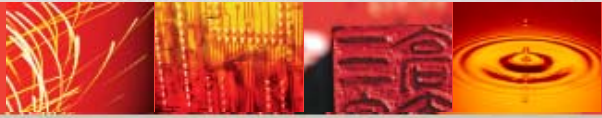
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- Best Law Firm - National - Intellectual Property Law, 2010  
***U.S. News & World Report***
- Intellectual Property Law Firm of the Year USA, 2010  
***Finance Monthly***
- Intellectual Property Firm of the Year - North America, 2010  
***InterContinental Finance***
- Patent Litigation Firm of the Year - Midwest, 2010  
Trademark Prosecution Firm of the Year - Midwest, 2010-2011  
Trademark Litigation Firm of the Year - Midwest, 2009-2011  
***Managing Intellectual Property magazine's North American IP Awards***
- #1 for Intellectual Property Law in Illinois, 2003-2010  
***Chambers USA: America's Leading Lawyers for Business***
- #1 Intellectual Property Firm in Illinois, 2005-2010  
***Practical Law Company, PLC Which Lawyer? Yearbook***
- #1 Intellectual Property Firm in Illinois and Chicago, 2009-2011  
***Best Lawyers in America***
- #1 Largest Intellectual Property Firm in Chicago, 2004-2005, 2007  
***Managing Intellectual Property magazine's "World IP Survey"***
- Top 5 Patent Litigation Firm - National, 2010  
Top 5 Trademark Litigation Firm - National, 2010  
Top 5 Patent Prosecution Firm - Regional, 2010  
***Managing Intellectual Property magazine's North American IP Awards***
- Decade Award for Outstanding Legal Writing, 2010  
***The Burton Awards for Legal Achievement***
- Thomas L. Sager Diversity Award - Midwest Region, 2009  
***Minority Corporate Counsel Association***





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# Biographies



## Mary M. Squyres

### Shareholder

Ms. Squyres is head of the International Trademark Practice Group.

#### Publications

- "Trademark Practice Throughout the World," three-volume treatise, West Group, May 2001-Present
- "The New gTLDs", *Intellectual Property Counselor*, Thomson West, April 2011
- "Geographical Indications in the Trademark Arena," Thomson West, 2007

#### Honors/Distinctions

- *World Trademark Review 1000 – The Definitive Guide to Trademark Legal Services*, 2011, Tier 1, 'Individuals - Non-Contentious'
- Leading Lawyers in Illinois, 2006-2011
- *The Best Lawyers in America*, 2009-2011
- *The International Who's Who of Trademark Lawyers*, 2011

#### Memberships & Affiliations

- International Trademark Association (INTA)
- MARQUES
- European Community Trade Mark Association (ECTA)

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#### **EDUCATION**

LL.M., Intellectual Property,  
The John Marshall Law  
School, 1994  
J.D., Valparaiso University  
School of Law, 1982  
M.A., American History, The  
University of Chicago, 1972  
B.A., Manhattanville College,  
1971

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## Tiffany W. Shimada

### Associate

Ms. Shimada is a member of the Trademark, International Trademark and Copyright Practice Groups.

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#### **EDUCATION**

J.D., DePaul University  
College of Law, 2009  
B.S., Finance, Indiana  
University, 2001

#### **STATE BAR ADMISSIONS**

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#### **ADMISSIONS**

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Illinois

#### Publications

- “.XXX Sponsored Top-Level Domain Registration Period Begins September 7, 2011,” *Brinks Hofer Gilson & Lione Client Alert*, August 5, 2011
- “New gTLDs Approved by ICANN,” *Brinks Hofer Gilson & Lione Client Alert*, July 12, 2011
- “Fashion Design under the Innovative Design Protection and Piracy Prevention Act,” *Intellectual Property Litigation*, Spring 2011

#### Honors/Distinctions

- Certificate in Intellectual Property Law, DePaul University College of Law
- Selected for the Black Women Lawyers' Association (BWLA) of Greater Chicago Mercedes Anita Laing Scholarship, 2009

#### Memberships & Affiliations

- Black Women Lawyers' Association of Greater Chicago
- American Bar Association, Section of Litigation
- Chicago Bar Association

## Preview

- Application Process and Fees
- Objections to new gTLDs (.brinkshofer)
- Offensive strategies
- Defensive strategies
- Resources





## Application Process & Fees

## Application Process



- User registration from January 12, 2012 (00:01 UTC) – March 29, 2012 (23:59 UTC)
- Application submission closes April 12, 2012 (23:59 UTC)
- Vendor of ICANN (Internet Corporation for Assigned Names and Numbers)
- If required, 500 registrations in first batch; 400 registrations in subsequent batches
- 2<sup>nd</sup> registration period will occur

# Application Process - Possibilities

- Products: .software, .lamps, .swimmingpools

- Brands: .GM, .Nestle



- Geographic locations: .Chicago



- gTLDs that use Chinese, Japanese, Cyrillic, Arabic, Hangeul characters



## Application Process

- No individuals as applicants, only corporations, organizations, and institutions
- No “bad faith” applicants (cybersquatters)
- Submission of 3-year financial plan
- Submission of proof of technical ability to run a gTLD
- Thorough background checks (including intellectual property violations)
- Potential ICANN collaboration with INTERPOL

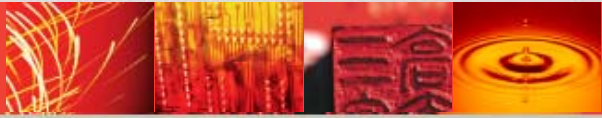


## Application Form – 50 Questions

- Applicant Guidebook – Module 2, attachment, pp. A-5 through A-45
- TAS, The Application System, \$5,000 to get log-in to fill out form
- \$180,000 with completed form

## Questions 1 – 12

- Criminal and corporate status check
- 15% shareholders – thorough check, including violent, computer and trust crimes
- Query: Do we form a separate corporation as registrant?



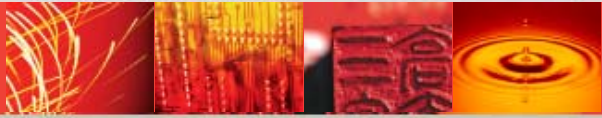
## Questions 13 – 17

- Selection of string
- IDN strategy
- 63 characters, no numbers or symbols
- Worldwide searching



## Questions 18 – 22

- Mission statement
- Community designation



## Questions 23 – 44

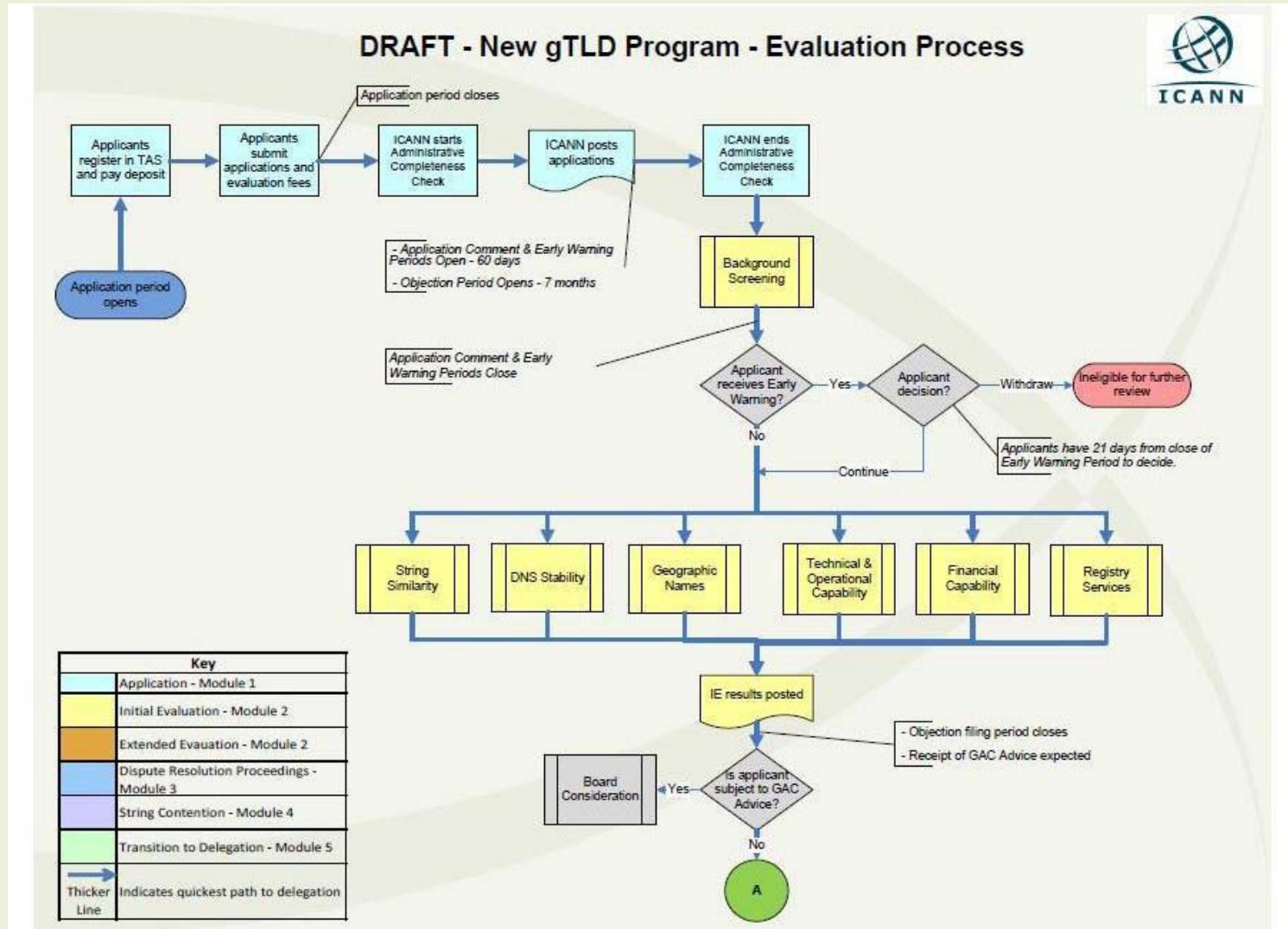
- Registry services (technical, business, financial and risk components)
- In-house or outside provider (similar to choice for legal services)



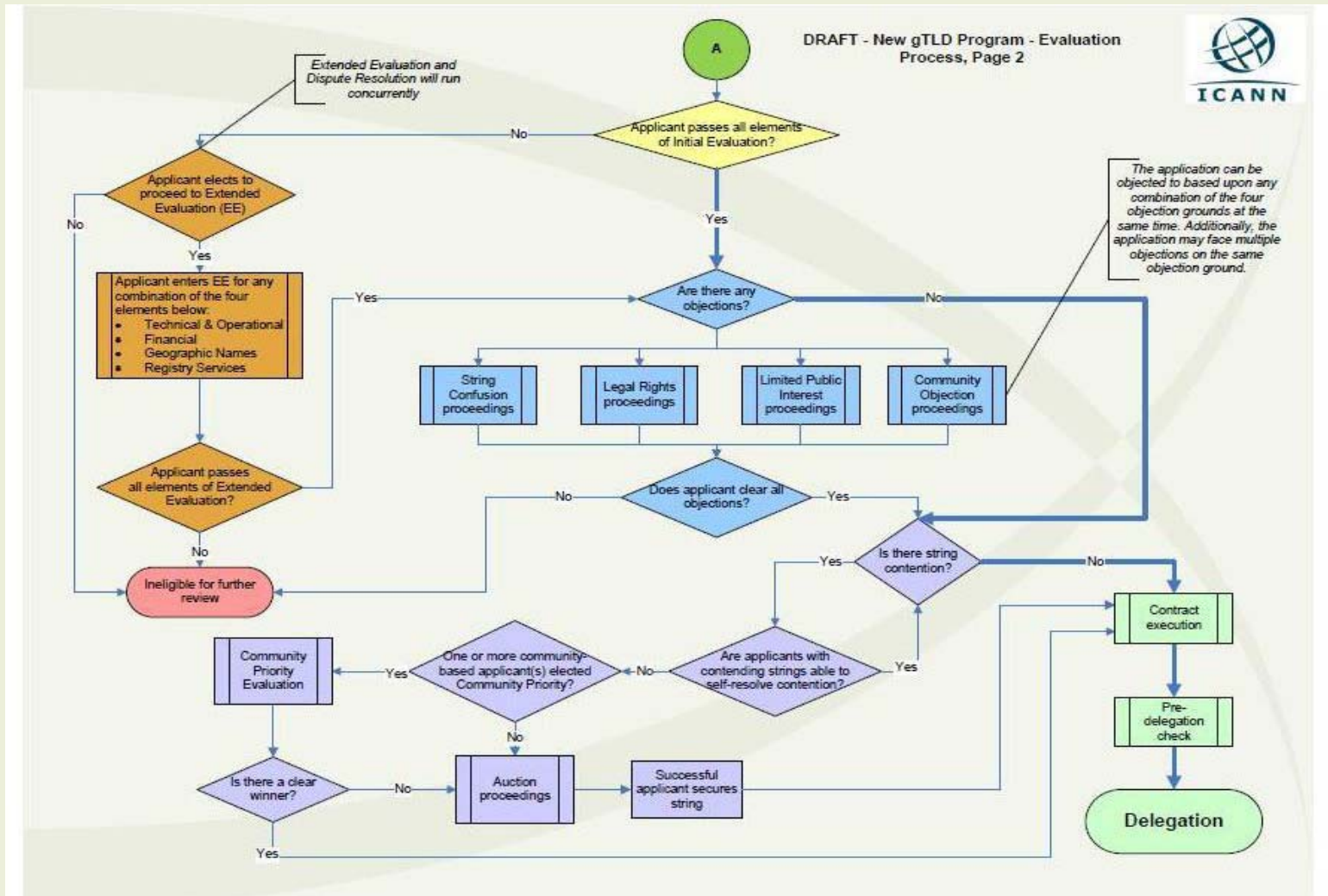
## Questions 45 – 50

- Financial plans and data, including disclosures to investors
- 3 year plan and funding

# Initial Evaluation



# Extended Evaluation



## ICANN Contracting Panels

- ICANN will contract with various panels throughout the application process:
  - String Similarity Panel (Initial Evaluation)
  - Geographic Names Panel (Initial Evaluation)
  - DNS Stability Panel (Initial Evaluation)
  - Technical Evaluation Panel (Initial and/or Extended Evaluation)
  - Financial Evaluation Panel (Initial and/or Extended Evaluation)
  - Registry Services Technical Evaluation Panel (Extended Evaluation)

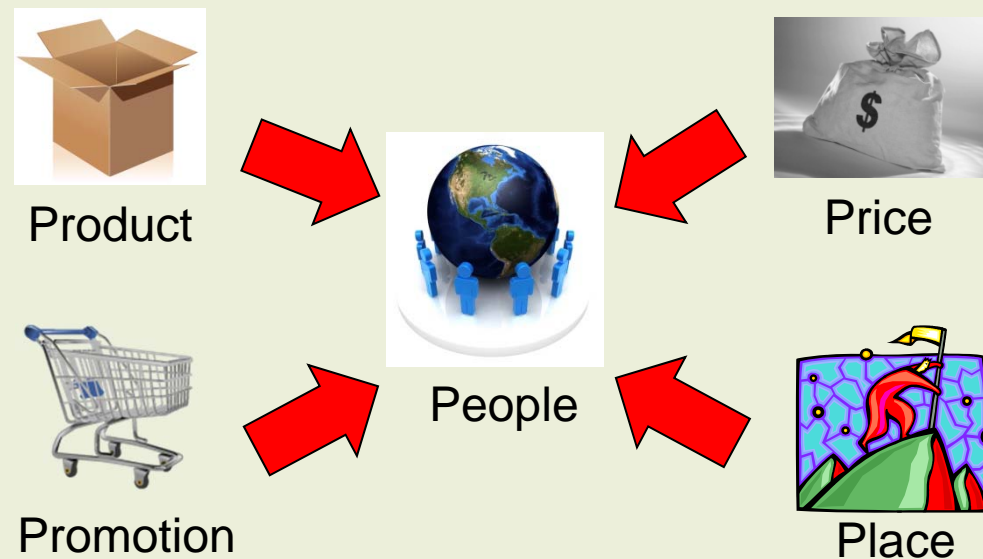
## Fees

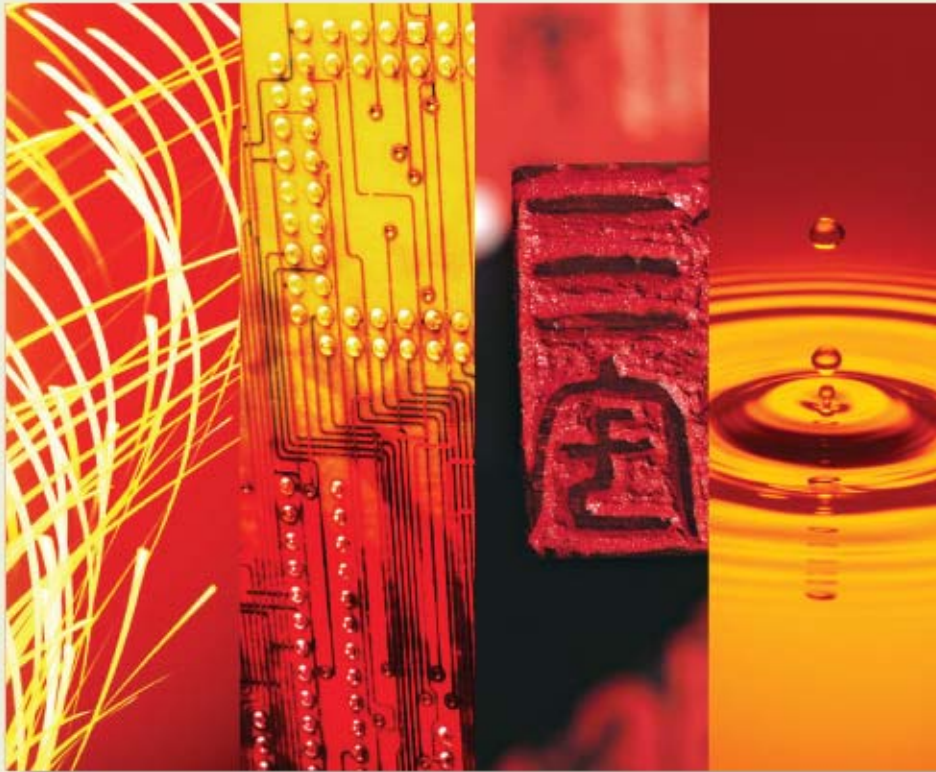
- \$185,000 for the initial application
- \$50,000 for an extended evaluation
- \$2,000 – \$150,000 to respond to objections
- \$25,000 or more for annual registry fee
- Fees for ICANN expert
- Fees for law firm



## Fees

- Marketing fees
- Promotion fees
- \$1,000,000 to run a gTLD for a year





## Objections to New gTLDs

## Objections to new gTLDs

- Simultaneous with Extended Evaluation
- Warnings from Governmental Advisory Committee (GAC) that a gTLD is unacceptable to one or more governments
  - GAC will develop a standard vocabulary and set of rules for use in providing advice on new gTLDs

Objections

## Objections - Types

- A gTLD string is confusingly similar to an existing or concurrent string (handled by the International Centre for Dispute Resolution, a division of the American Arbitration Association) - string confusion objection



- A legal rights objection based on existing rights (handled by the WIPO Arbitration Center) – rights holder objection

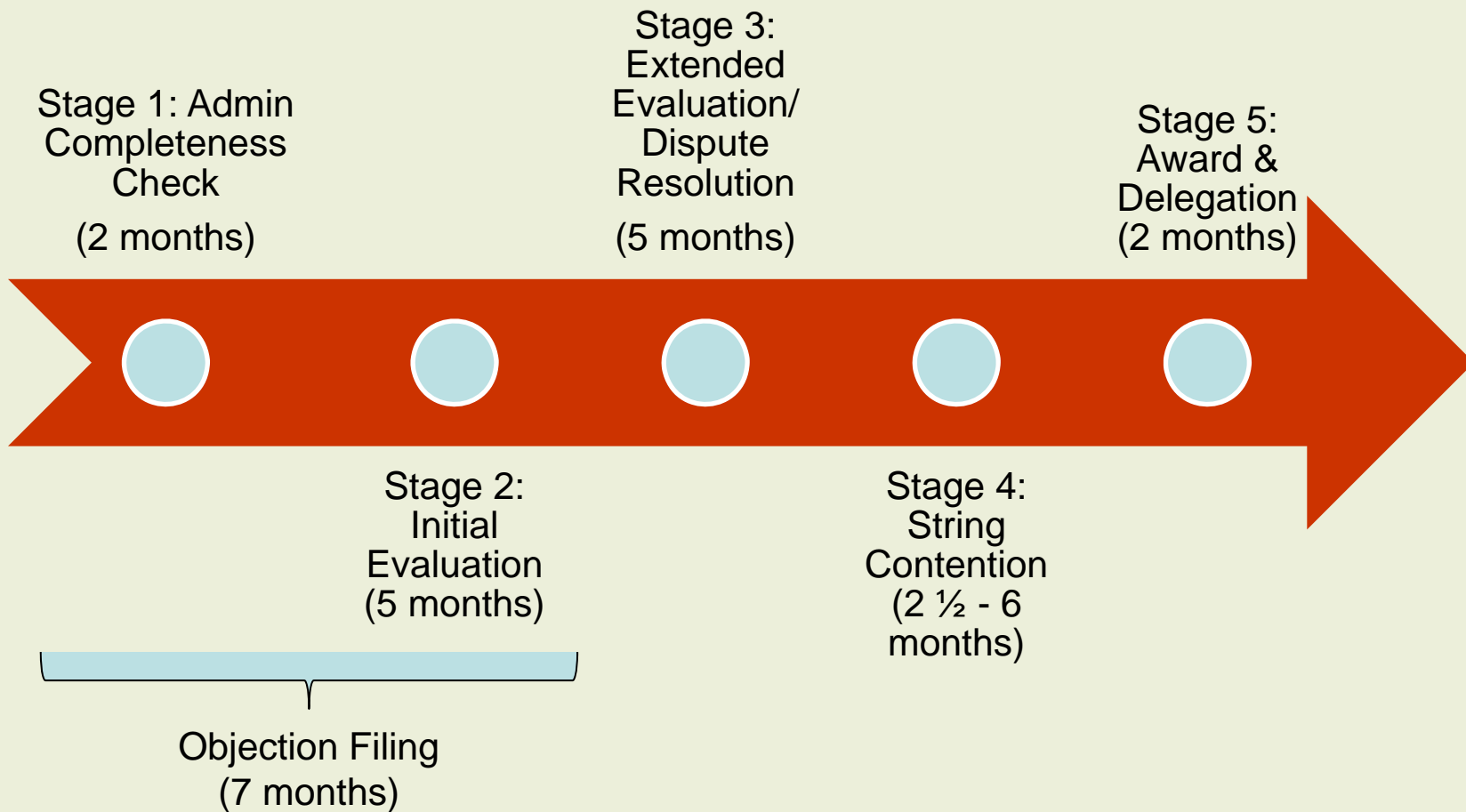


## Objections - Types

- A limited public interest objection which claims a violation of morality or public order
- A community objection which objects to a string that affects it, e.g., .sharklawyers
- Both handled by the International Chamber of Commerce

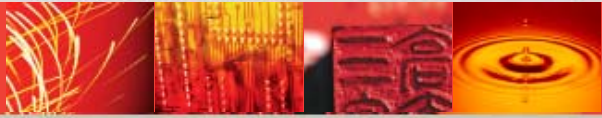


# Application Timeline



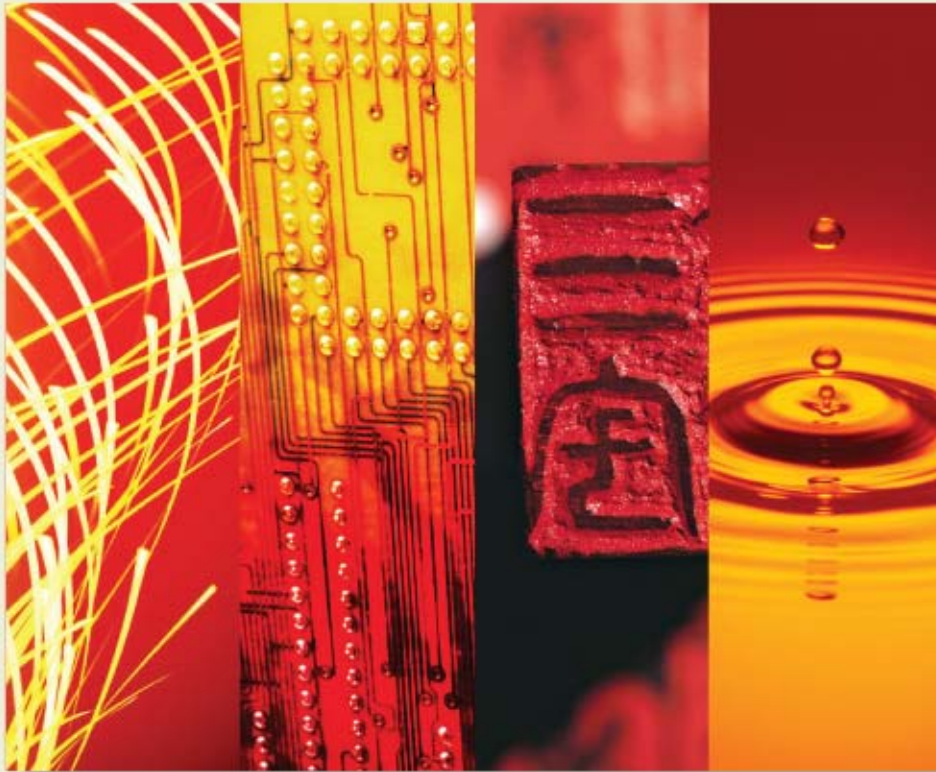


## Offensive Strategies



## Offensive Strategies

- Determine marketing platforms and use of the website
- Use of the Trademark Claims Service to notify registrants of possible problems
- Hiring of ICANN expert
- Determine capabilities to run a registry
- Determine return on investment
- Determine impact on marks from as a top level or second level domain
- Implement a post-launch rights protection mechanism



## Defensive Strategies

## Defensive Strategies

- Implement a wait and see approach
- Review submissions from applicants after published by ICANN
- Determine if objections are needed (i.e. string confusion or legal rights objections)
- Allocate needed budget amounts to object to gTLD applications in 2012
- Determine approach against second-level gTLD registrations in 2013



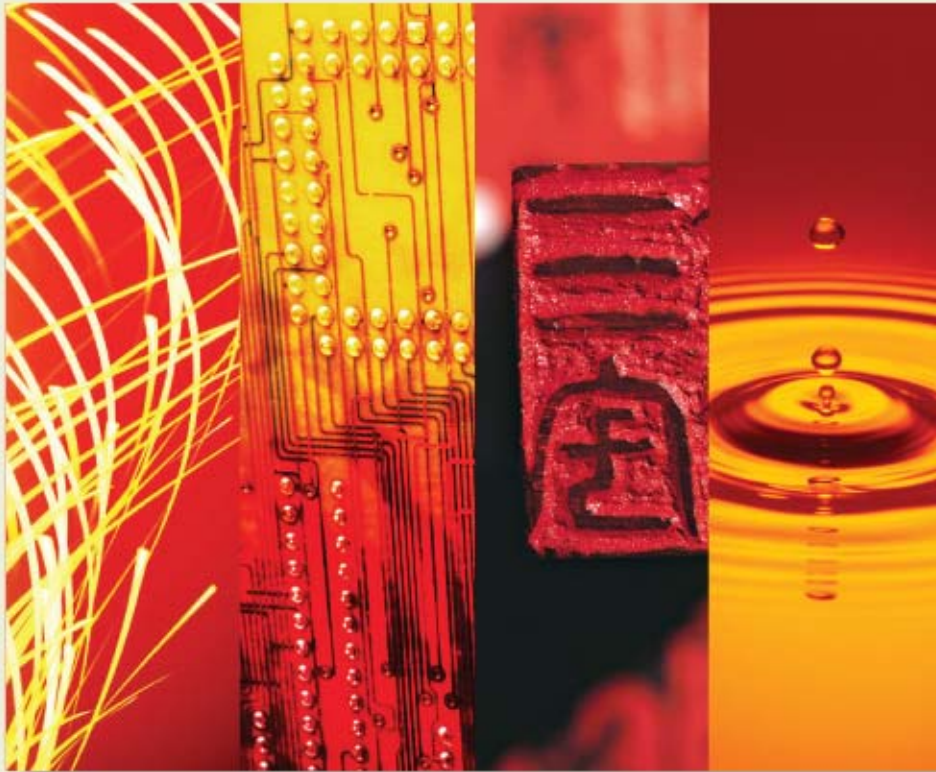
## Resources

## Resources

- Application Guidebook 19 – [www.icann.org/en/topics/new-gtlds/rfp-clean-19Sept11-en.pdf](http://www.icann.org/en/topics/new-gtlds/rfp-clean-19Sept11-en.pdf)
- ICANN new gTLD Information Center – <http://newgtlds.icann.org/>
- ICANN Basic Fact Sheet on New gTLDs – <http://www.icann.org/en/topics/new-gtlds/gtld-facts-31jul11-en.pdf>
- ICANN Fact Sheet for Rights Holders – <http://www.icann.org/en/topics/new-gtlds/rights-holders-with-insert-02sep11-en.pdf>

## Resources (cont'd)

- ICANN Trademark Fact Sheet Insert –  
<http://www.icann.org/en/topics/new-gtlds/trademark-factsheet-insert-02sep11-en.pdf>
- ICANN new gTLD Glossary –  
<http://www.icann.org/en/topics/new-gtlds/glossary-30aug11-en.pdf>
- WIPO Activities Related to New gTLDs –  
<http://www.wipo.int/amc/en/domains/newgtld>
- New gTLD Resource Website –  
<http://www.newgtldsite.com>



## Q & A



## Thank You

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