

Imperatives of Private Arbitration in International IP Disputes

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The Generic Top Level Domain (gTLD) Space since 1998

- The original gTLDs:

.mil, .gov, .edu, .com, .org, .int, .arpa, .net

1998: ICANN formed

- 2000: seven new gTLDs introduced

.aero, .biz, .coop, .info, .museum, .name, .pro

- 2004: seven additional gTLDs approved

.asia, .cat, .jobs, .mobi, .tel, .post, .travel (.xxx approved in 2011)

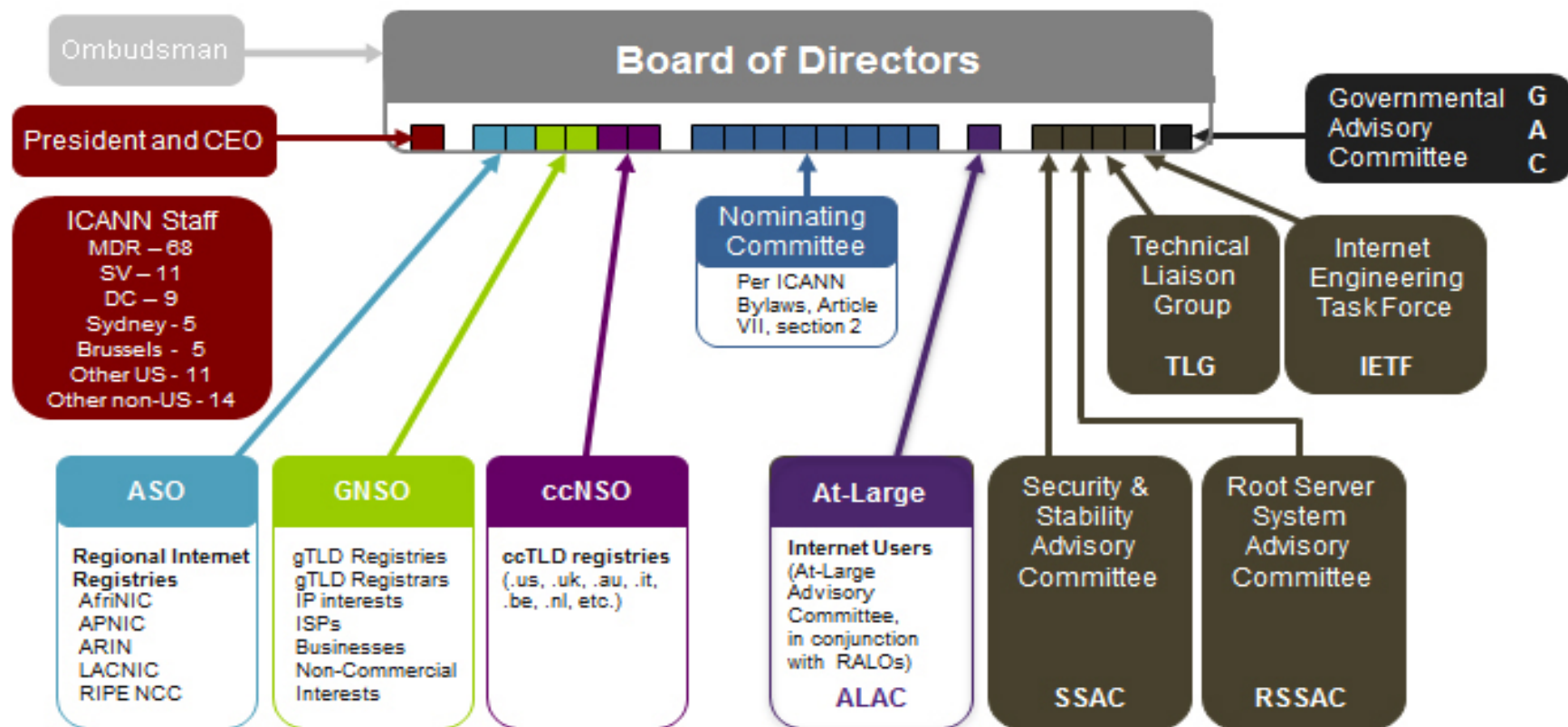
2008: ICANN Board approves new gTLD program

2011: .com registrations exceed 200 million

- 2012: Program launches - a potentially unlimited & unprecedented number of new gTLDs
 - ***.brand possible for the first time***

Policy Development at ICANN: a bottom-up, community-based, multi-stakeholder consensus process

ICANN Multi-Stakeholder Model



ICANN's organizational processes: “baroque in [their] complexity” ... ?

New GNSO Council Organization: October 2009



Legend: {} Voting; () Non-Voting

*Non-Voting Liaison – Counted as a Member

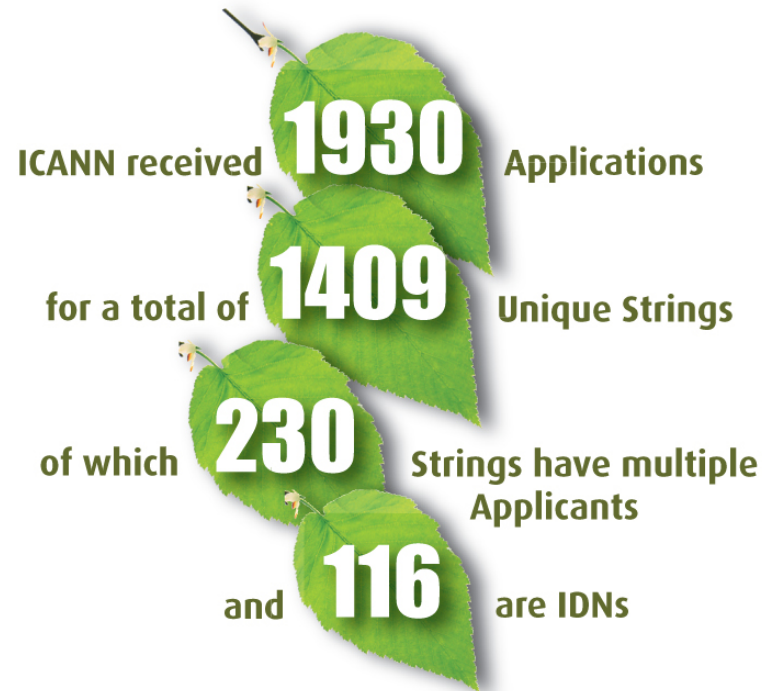
**Observer – Not Counted as a Member

Lobbying, insiders and industry interests: a recurring story of trademark protections at ICANN

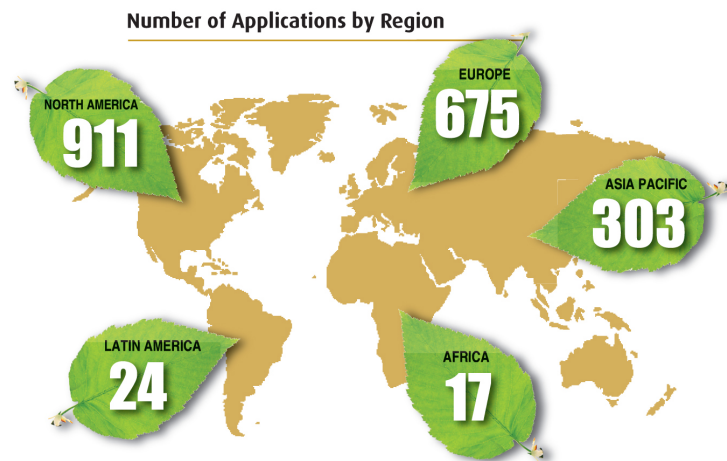
Three concurrent developments in the new gTLD program:

- *Constant demands by TM owners for additional second-level protections*
 - rampant cybersquatting highly unlikely at the top level
 - brand new rights protection mechanisms as well as existing UDRP
- *Special protections for the Int'l Olympic Committee & the Red Cross/Red Crescent Movement*
 - bypassing GNSO process through lobbying the GAC
 - based on unique legal status (protected by int'l treaty & numerous national laws)
- *Similar requests now being made by numerous Inter-Governmental Organizations*
 - partly based on Art 6ter, Paris Convention

What “Reveal Day” in the New gTLD Program Showed Us: Were the Pre-Launch Concerns Real? Who should Worry, and Why?



- 637 (33%) were for/by brands
- 36 of the Fortune 100 companies applied
 - Coca Cola (Interbrand #1) did not
 - Neither did Facebook, eBay or Twitter



- Google applied for 101
 - Amazon for 76
 - Richemont for 15
- Microsoft for 11, Apple for 1 (.apple)



Objections to New gTLDs: the Who, What, When & Why

- Rights-holders: **Legal Rights** objection
- Existing gTLD registry or another applicant: **String Confusion** objection
- Anyone or ICANN's independent objector: **Limited Public Interest** grounds (public international law)
- The GAC: GAC-specific “**Early Warning**” mechanism & through formal **GAC Advice** to ICANN Board
- Each ground has different dispute resolution service providers
 - WIPO for legal rights
 - ICDR for string confusion
 - ICC for limited public interest

Importing trademark law into private dispute resolution processes (I)

For a Legal Rights objection (top level):

- Applied-for gTLD infringes existing legal rights of objector, i.e. *takes unfair advantage of or unjustifiably impairs distinctive character or reputation of a mark, or otherwise causes impermissible likelihood of confusion*
- Non-exhaustive factors resemble infringement analysis, including *appearance, sound & meaning, and likelihood of confusion as to source, sponsorship, affiliation or endorsement*

For a String Confusion objection (top level):

- Applied-for gTLD *so nearly resembles existing or another applied-for string as to be likely to cause confusion* if granted

Importing trademark law into private dispute resolution processes (II)

For the new Rights Protection Mechanisms (second level):

- *Uniform Rapid Suspension* (URS) uses same substantive grounds as current Uniform Dispute Resolution Policy (UDRP)
- Differences lie in burden of proof and remedies
- URS intended to be cheaper & speedier than UDRP (an alternative & a supplement, not a replacement)
- Unclear who will be the dispute resolution service provider
- Likely that the biases & problems with the UDRP will be imported – magnified? – with the URS

And into this dilemma, add the GAC ... and other free speech concerns

Known sensitive applications include:

- *.patagonia, .bible, .catholic, .church, .islam, .halal, .shia, .adult .porn, .sex*

Potentially problematic: *.sucks, .gripe*

Looming problem: who should control generic words?

- *.hotel* vs *.hotels* vs *.hoteles*
- *.movie* vs *.film; .house* vs *.home*
- *.football* vs *.futbol* vs *.soccer*
- *.gift* vs *.gifts; .new* vs *.news*
- *.citi* vs *.citic; .nissan* vs *.nissay*
- *.jewelry* and *.watches* controlled by Richemont? *.book* by Amazon? *.search* by Google?

Where do we go from here?

- UDRP (1999) – an exception to trademark territoriality principles
- Intervening 12 years – norm-setting outside traditional judicial, legislative or other traditional “authoritative” institutions
- Current gTLD expansion – likely to speed up & expand scope of such norm-setting
- Question – ICANN as appropriate “authoritative” institution to oversee or facilitate such development?