

THE NEW gTLDs AND THE RESOLUTION OF TRADE MARK DISPUTES

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1 Introduction

Following the birth of the World Wide Web (or simply the “Web”),¹ trade mark issues relating to the registration of domain names were the first significant concern for trade mark owners, and the principal area of interest in the related area of information technology law.² What was particularly interesting concerning the disputes related to abusive domain name registrations was the alternate dispute resolution mechanism which was developed (and which will briefly be discussed below), in a relatively short period of time, to address the opportunistic or predatory practices which arose, and which mechanism has proven to be remarkably effective.

As was relatively recently reported in the press, the Internet Corporation for Assigned Names and Numbers (“ICANN”) announced four new top-level domains: the Arabic word for “web”; the Chinese word for “game”; and the Russian words for “online” and “web site”.³ Since then, the following additional new top-level domains have been approved for, amongst others, *.london*,⁴ *.clothing*, *.singles* and *.guru*.⁵ Closer to home, there have been registrations for *.africa*, *.capetown*, *.durban* and *.joburg*.⁶ This development is a consequence of ICANN’s decision in June 2011 to permit new top-level domains, including both new ASCII, and internationalised domain name

¹ Although the terms “Internet” and “Web” are often used interchangeably, it is worth noting that they are not the same thing. The Internet is the infrastructure on which everything runs, whereas the Web is the result of a higher level protocol (the Hypertext Transfer Protocol (“HTTP”)), which uses the Internet’s foundational TCP/IP protocol; it is, thus, a specific application of the network established by the Internet. Using the railway system as an analogy, the Internet is the tracks and signalling equipment, which allows a range of different traffic to be transported, such as the Web. A Murray *Information Technology Law: The Law and Society* (2010) 31-32; J Naughton *What You Really Need to Know About the Internet: From Gutenberg to Zuckerberg* (2012) 4 and 39-40.

² L Edwards & C Waelde *Law and the Internet* 3 ed (2009) 312; E Hurter “Not the Lesser Evil: Amending the Regulations for the Resolution of Domain Name Disputes in the ‘za’ Domain to Combat Reverse Domain Name Hijacking” (2012) 24 *SA Merc LJ* 416 416.

³ Anonymous “Internet Domain Name Expansion Now Underway” (23-10-2013) *ICANN* <<http://www.icann.org/en/news/press/releases/release-23oct13-en>> (accessed 23-10-2013).

⁴ Anonymous “UK Capital Gets london Domain” (15-11-2013) *News 24* <<http://www.news24.com/Technology/News/UK-capital-gets-london-domain-20131115#>> (accessed 23-11-2013).

⁵ Anonymous “Net Names bike and guru Available” (26-11-2013) *BBC* <<http://www.bbc.co.uk/news/technology-25105438>> (accessed 26-11-2013).

⁶ N Mawson “Onerous Liabilities Loom for africa” (17-14-2014) *IT Web* <http://www.itweb.co.za/index.php?option=com_content&view=article&id=120331:Onerous-liabilities-loom-for-africa&catid=14> 7 (accessed 21-05-2014).

(“IDN”),⁷ top-level domains (the “New gTLD Program”).⁸ However, the expansion of the top-level domains is not restricted to geographical names or generic terms; application can be made to register trade marks as top-level domains. The New gTLD Program is likely to lead to an explosion in the number of top-level domains (“TLD”s),⁹ and, at the time it was approved, it was anticipated that it would lead to a new raft of trade mark disputes which would have to be addressed. This has already proven to be the case. The application period for the first round of new TLDs opened on 12 January 2012, and closed on 30 May 2012,¹⁰ during which time ICANN received 1,930 applications for new TLDs.¹¹ There were 751 objections which were initially filed and which, therefore, potentially needed to be resolved.¹²

This article will indicate why it was considered necessary to introduce a new dispute resolution mechanism to deal with the envisaged disputes, explain the mechanism which was introduced, and highlight some of the legal issues which have emerged from the determinations relating to the first round of applications under the New gTLD Program, and provide further detail into how the mechanism works. The focus of this article will be on the resolution of conflicts based on trade mark rights, such as where two parties have the same (or similar) trade marks, and where one, or both, of such trade mark proprietors seeks registration of a new TLD incorporating the trade mark. This article will not consider other possible issues related to the New gTLD Program, such as the implications relating to freedom of expression, or the registration of personal names or geographical indicators as domain names. It will also not be concerned with the merits of ICANN’s decision to approve the New gTLD Program, which has been criticised as a cynical attempt to make money, resulting in the unnecessary waste of social and financial resources.¹³

An analysis of the new dispute resolution system should be of interest not only to trade mark specialists, but should also serve to illustrate how effective alternative dispute resolution mechanisms can be designed to resolve specific types of foreseeable conflicts. From a trade mark lawyer’s perspective it is a timely juncture, now that the determinations relating to

⁷ ASCII domain names are those which are based on the Latin script, and internationalised domain names (IDNs) are domain names which consist of non-Latin scripts (for example, Arabic Chinese, or Cyrillic) Therefore, ICANN will now allow domain names in languages other than those based on the Latin script See Anonymous “Internationalized Domain Names” (2013) *ICANN* <<http://newgtlds.icann.org/en/about/idns>> (accessed 03-10-2013)

⁸ Anonymous “About the Program” (2013) *ICANN* <<http://newgtlds.icann.org/en/about/program>> (accessed 03-10-2013)

⁹ The new top-level domains are more commonly referred to as “gTLDs” but “TLD” is factually more correct As will become clear, the new top-level domains are no longer necessarily generic – which is what the “g” in gTLD denotes – but may consist of a trade mark Also, technically the application is made for a “gTLD string”

¹⁰ S 111 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)* (2011) The period for submitting applications was extended from 29 March 2012 due to technical problems experienced with the online system (see Anonymous “TAS Interruption - Update” (21-05-2012) *ICANN* <<http://newgtlds.icann.org/en/announcements-and-media/announcement-21may12-en>> (accessed 04-10-2013))

¹¹ Anonymous “About the Program” *ICANN*

¹² Anonymous “Program Statistics” (2013) *ICANN* <<http://newgtlds.icann.org/en/program-status/statistics>> (accessed 04-10-2013)

¹³ See, for example, E Dyson “What’s in a Domain Name?” (25-08-2011) *Project Syndicate* <<http://www.project-syndicate.org/print/what-s-in-a-domain-name->> (accessed 04-10-2013)

the first round of applications have been completed,¹⁴ to see how the dispute resolution mechanism's substantive legal principles have been interpreted by the panels. This article will thus draw on the reported determinations, and highlight the key issues which have emerged concerning the mechanism. In any event, to date, there have been no South African academic articles which have considered any aspect of the New gTLD Program.

However, before considering the specified issues, a brief technical background concerning domain names will be useful. By understanding the basic technical background, the various legal issues should become clearer. Where necessary, any jargon in this field will also be explained.

2 Domain Name System

Data transmitted over the Internet are split into small portions, or packets, which may be sent *via* different routes to their final destination. Because transmission of data may be distributed, it is imperative that each computer on the network has a unique address (its Internet Protocol ("IP") address), to ensure the accurate delivery of data to the intended recipient computer.¹⁵ The Internet is arranged by giving each computer in the network a unique address.¹⁶ These addresses are, for example, used by an Internet user to access material, such as a website, which may be held (or hosted) on another computer.

The problem is that these IP addresses are strings of numbers, which are not easy for humans to remember, probably because the system was never designed with the intention that humans would need to remember such addresses. Accordingly, following the emergence of the Web, a system was devised by which each IP address could be matched with more human-friendly addresses, which are usually descriptive of the content which may be found at that website, or descriptive of the operator of the website, and, therefore, more memorable. These more-memorable addresses are the domain names or Uniform Resource Locators ("URL"s). So, for example, the IP address for the Google URL (www.google.com) is 173.194.113.41, and surf forecasts can be found at www.surf-forecast.com. The system which ensures that there is a unique matching of IP addresses and domain names is the Domain Name System ("DNS"), a database, which is administered by ICANN.

Domain names are hierarchical, and generally have two or three levels, with the highest (or top) level appearing on the rightmost side of a domain name. Until the New gTLD Program, the top-level domain was either a generic top-level domain ("gTLD"), or a country code top-level domain ("ccTLD"). In the case of ccTLDs, there are also typically specified second-level (or sub)

¹⁴ WIPO Arbitration and Mediation Center *WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013* (2013) <<http://www.wipo.int/export/sites/www/amc/en/docs/lrreport.pdf>> (accessed 22-12-2013)

¹⁵ Murray *Information Technology Law: The Law and Society* 24; Naughton *What You Really Need to Know About the Internet: From Gutenberg to Zuckerberg* 305

¹⁶ Murray *Information Technology Law: The Law and Society* 24

domains, such as *.co* or *.ac*. As there were only 22 gTLDs,¹⁷ applicants for domain names were restricted to applying for domain names at the second level (or the third level in the case of ccTLDs). An applicant's desired domain name – which may have been a trade mark or name in which the trade mark formed a dominant part – had to be unique at the lowest domain level (the leftmost portion of the domain name): in the case of a two-level gTLD, this would be the second level, and in the case of a three-level ccTLD, this would be the third level (under one of the second-level domains).

3 New gTLD Program

Pursuant to the New gTLD Program, an applicant for a domain name is no longer restricted to register a domain name *within* the few generic gTLDs, an applicant may seek to register an entirely new TLD.¹⁸ For example, an applicant could apply for a general category, or a geographic location, such as *.music* or *.capetown* as a TLD, with the purpose of running a domain registry business offering others the ability to register second-level domain names (and presumably, third-level domain names) within such TLD;¹⁹ or, a trade mark, such as *.dunlop*, with the intention that only related businesses may register second-level domain names in that TLD. The latter type of TLD, where a trade mark owner seeks to register a trade mark as a TLD and restricts registration of second-level domain names to related or approved businesses, is also referred to as a “dotbrand” TLD, and is an example of a closed TLD registry. For example, the Apple Corporation could seek to have sub-domains for its various products or services under the *.apple* TLD, such as *ipad.apple* and *itunes.apple*, which may serve to strengthen its brand. In contrast, where third parties may apply for domain names within the applied-for TLD, the new TLD will be an open registry.²⁰

Given the fact that the New gTLD Program allowed for the registration of trade marks as TLDs, “it [was] inherent to the nature of the gTLD regime that the prospect of coincidence of brand names will exist”.²¹ The discussion of the trade mark issues concerning TLDs pursuant to the New gTLD Program will focus on situations in which the TLD is a trade mark, or incorporates a trade mark as a dominant part of the domain name.

¹⁷ The initial set of gTLDs, predating ICANN, were: *.com*, *.edu*, *.gov*, *.net*, *.arpa*, *.int*, *.org*, and *.mil*. In 2000 ICANN added the following gTLDs: *.aero*, *.biz*, *.coop*, *.info*, *.museum*, *.name*, and *.pro*. The 2004 expansion added the following gTLDs: *.asia*, *.cat*, *.jobs*, *.mobi*, *.tel*, *.travel*, *.post* and *.xxx*. See Anonymous “About the Program” ICANN.

¹⁸ Anonymous “About the Program” ICANN. Although these new domains which may be applied for are commonly referred to as “gTLDs”, they are not restricted to generic concepts or strings. Accordingly, it is preferable to drop the “g” prefix.

¹⁹ Anonymous “Benefits and Risks of Operating a New gTLD” (2013) ICANN <<http://newgtlds.icann.org/en/about/benefits-risks>> (accessed 05-10-2013).

²⁰ J Lipton & M Wong “Trademarks and Freedom of Expression in ICANN’s New gTLD Process” (2012) 38 *Monash University L Rev* 188 224-226.

²¹ *hibu (UK) Limited v Telstra Corporation Limited* 2013 LRO2013-0013, 25 July 2013 11.

4 Domain names and trade mark disputes

Given the fact that trade marks can now be registered as TLDs, trade mark conflicts were, unsurprisingly, anticipated, and, accordingly, a mechanism had to be devised in order to allow trade mark owners the ability to prevent the unauthorised use of their marks as TLDs, or to resolve competing claims for TLDs based on the same, or similar, marks. ICANN, therefore, introduced objection procedures to give an aggrieved party the opportunity to prevent the registration of a new TLD.²² As already mentioned, ICANN had previously introduced an alternative dispute resolution system to deal with abusive domain registrations in the existing gTLDs. It is worthwhile to briefly consider ICANN's earlier alternative dispute resolution system – the Uniform Dispute Resolution Policy²³ (“UDRP”) – for a couple of reasons: first, some of the difficulties which had to be addressed, and were addressed, by the UDRP also arise in connection with the New gTLD Program; and, second, to illustrate why it could not simply be extended to deal with the issues relating to the New gTLD Program.

4.1 Domain Name System *versus* trade marks

Although a trade mark may be registered as (or, more correctly, may be incorporated in) a domain name, and a domain name may be registered as a trade mark, there are differences – both functionally and legally – between trade marks and domain names, which introduces a level of complexity. First, although the registration of a trade mark has to be periodically renewed, a trade mark gives the registrant a proprietary right in the registered mark, whereas it is generally accepted that a registrant of a domain name only has a contractual right to the domain name. Second, as far as trade marks are concerned, subject to limited exceptions, the principle of territoriality is strictly followed.²⁴ Registration of the relevant trade mark is required in each jurisdiction in which protection is sought, otherwise no protection will be afforded to the relevant trade mark in that jurisdiction. In contrast, a domain name gives its registrant the rights on a global basis. Thus, the global nature of the Internet challenges the territorial nature of national laws, and the greater variation permitted by trade mark law.

While it is true that an identical domain name may be registered in various gTLDs, or as a third-level domain under different ccTLDs, the trade mark

²² Although this article will only be concerned with the dispute resolution procedure following objections by third parties (and, more particularly, those based on legal rights), there is also an objection procedure which may be followed pursuant to advice of the Governmental Advisory Committee on a new gTLD concerning a specific application (ICANN *gTLD Applicant Guidebook (Version 2011-09-19)* 3-1)

²³ ICANN *Uniform Domain Name Dispute Resolution Policy* (26-08-1999)

²⁴ The exceptions being well-known (or famous) marks under article 6bis of the International Convention for the Protection of Industrial Property (1883) (“Paris Convention”) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”), which is Annexure 1C of General Agreement on Tariffs and Trades (15-04-1994) (“GATT”) For example, the trade mark “reef” may be registered as second, or third-level, domain names, such as *reef.co.za*; or *reef.com*

system potentially allows for more possible registrations.²⁵ In addition to the fact that trade mark registration has to be sought in a particular jurisdiction, a trade mark must also be registered in respect of specified goods or services falling within a particular class, which means that an identical trade mark may be registered by different persons in the same jurisdiction (and, of course, in different jurisdictions). Third, another reason why trade marks potentially allow for more possible registrations is that trade marks are not confined to being words, letters or numerals, which is the case with domain names. A trade mark can comprise any sign capable of being represented graphically, including a device, signature, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned.²⁶ Thus, domain names cannot use the techniques that businesses can use to distinguish their trade marks, such as stylised representations of their marks.²⁷ Fourth, as is clear from the brief description above of the technical aspects of the Internet, the primary function of a domain is to serve as an address for unambiguous communication, whereas a trade mark's primary function is as a band of origin.²⁸ Fifth, the registration process for a trade mark is subject to greater scrutiny as it allows for opposition to the registration of a proposed trade mark. In contrast, given the automated, first-come, first-served basis by which domain names are registered, third parties are only able to object after the registration of the domain name. As the grounds for objecting to a domain name registration are limited, and given the more limited opportunity for multiple registration of identical marks, there is a greater potential for conflicts – even in the absence of cybersquatting.

4.2 UDRP and cybersquatting

Cybersquatting involves the bad faith registration of domain names which conflict with third parties' rights, such as the trade mark rights.²⁹ The registrant's (commonly referred to as a "cybersquatter") motivation with such a registration is to profit from the sale of the relevant domain name to the relevant rights holder through extortion, or to derive income from the substantial number of visitors (or "traffic") which the domain name is likely to have. For example, the cybersquatter could threaten to sell the domain name to a competitor of the rights holder, use the domain name to divert potential

²⁵ A trade mark proprietor will need to make an assessment of whether it seeks to register domain names incorporating its trade mark in more than one generic top-level domain (gTLD) or country-code top-level domains (ccTLD). This decision will become even more difficult if ICANN's decision to expand the number of generic top level domains (gTLDs), approved on 20 June 2011, is implemented. The expanded gTLDs may include characters used in other languages, such as Arabic or Cyrillic.

²⁶ Ss 2(1) and 9 of the Trade Marks Act 194 of 1993.

²⁷ T Pistorius "Cyberbusters versus Cybersquatters: Round II in the ZADNA Ring" (2009) 21 *SA Merc LJ* 661 662.

²⁸ *Beecham Group plc v Triomed (Pty) Ltd* 2003 3 SA 639 (SCA) 646; *Die Bergkelder Bpk v Vredendal Koöp Wynmakery* 2006 4 SA 275 (SCA) 281.

²⁹ Although the bad faith registration of domain names may include the registration of business names or the names of famous individuals, the treatment in this article will be confined to the abusive registration of trade marks.

customers to competitors or host offensive content (or content which is critical of the rights holder) on the website served by the domain name.³⁰

Given the fact that the registrant of a domain name could be anywhere in the world, and although it may be possible to identify the registrant of the disputed domain name, an aggrieved party may be faced with the prospect of having to institute legal proceedings in the registrant's jurisdiction, which may be totally unfamiliar to it, not to mention the associated costs of having to do so, and the possible vagaries of the relevant legal system. The situation is compounded by the fact that the growth of e-commerce meant that thousands of domain disputes were possible at any one time. If that were not bad enough, there are no significant barriers to prevent cybersquatting, given the first-come, first-served registration system for domain names, and the nominal costs of registering domain names. The net effect of these factors meant that, in the absence of an effective mechanism protecting trade mark proprietors against such opportunistic conduct, the domain-name registration system would place the burden of policing abuse of the system, and the associated financial burden, on trade mark proprietors.

On 24 August 1999 ICANN introduced the UDRP, a novel alternative dispute resolution process for settling disputes relating to bad faith domain name registrations in the existing gTLDs. The UDRP is an online dispute resolution procedure, and submission to the UDRP is incorporated as part of the contract between the relevant domain-name registrar (through which the application for the domain name was made) and the registrant of the domain name. As the domain-name registrars are appointed by ICANN, they are contractually bound to include the adherence to the UDRP as part of their contracts with domain-name registrants. In this manner, the registrant of a domain name is bound to submit to the UDRP procedure if a complainant has lodged a dispute with one of the ICANN-approved dispute resolution providers, such as the World Intellectual Property Organization ("WIPO").

Due to the fact that the procedure is essentially online, as parties must state their respective cases by way of written submissions (oral submissions only being permitted in exceptional cases), the UDRP has been effective in addressing the potentially thorny jurisdictional problems which may otherwise arise. The other advantages of the alternative procedure are that it is relatively inexpensive and expeditious, when compared to the alternative of civil litigation. The single most significant reason for the effectiveness of the alternative dispute resolution mechanism is the fact that the domain name registrar concerned has the ability to give effect to the decision of the adjudicator, such as transferring the registration of the disputed domain name to a successful complainant. Although there have been changes to the types of cybersquatting since the introduction of the UDRP, the UDRP has been versatile enough to also deal with these new forms of bad faith registrations in a satisfactory manner.³¹

³⁰ Edwards & Waelde *Law and the Internet* 320-321; Z Muscovitch "Cybersquatting Ain't What It Used To Be" (2012) *Intellectual Property Magazine* 36 36; Pistorius (2009) *SA Merc LJ* 663

³¹ Muscovitch (2012) *Intellectual Property Magazine* 36

Although the UDRP has been criticised – for example, because the system is said to be biased in favour of complainants³² – there is no doubt that it has been incredibly successful in resolving issues of cybersquatting. To date, for example, WIPO, as the most popular dispute resolution provider under the UDRP, has dealt with over 27,000 domain-name disputes.³³ This statistic is even more impressive given the fact that neither the registrant, nor the complainant, is precluded from rejecting the UDRP-specified dispute resolution mechanism, and submitting the dispute to a court of competent jurisdiction for independent resolution.³⁴ Thus, despite perceived complainant bias, registrants still seem prepared to submit to the UDRP.

The use of and reliance on the UDRP will probably increase as a consequence of the New gTLD Program. Just as trade mark owners have, arguably, managed to get a handle on preventing infringements of their trade marks in the existing gTLDs and ccTLDs, they will be faced with having to police their trade marks to prevent trade mark infringements, such as cybersquatting, in an ever-expanding number of TLDs. It is, therefore, worth noting that while this article will be focusing on the dispute resolution mechanism to deal with the envisaged disputes concerning the approval of new TLDs, the relevance and importance of the UDRP to trade mark owners in the expanded constellation of TLDs being brought about by the New gTLD Program should not be forgotten.

5 New gTLD Dispute Resolution Procedure

5.1 Overview

The New gTLD Dispute Resolution Procedure (the “Procedure”) is contained in Module 3 (“Objection Procedures”) to ICANN’s *gTLD Applicant Guidebook*, dated 19 September 2011 (the “Guidebook”).³⁵ Pursuant to section 3.2.1 of the Guidebook, a formal objection to an application for a TLD may be filed on any one of the following four grounds: String Confusion Objection; a Legal Rights Objection; Limited Public Interest Objection; and, Community Objection.³⁶

There are different dispute resolution mechanisms, and dispute resolution service providers (“DRSP”s), for each of the four enumerated grounds of opposition, but as this article focuses on the protection of trade marks in the New gTLD Program, only the Legal Rights Objection (“LRO”) will be considered as it is the most important ground for objection for trade mark

³² Lipton & Wong (2012) *Monash University L Rev* 203; A Roy “Reflections on the Uniform Domain Name Dispute Resolution Policy as it Enters its Second Decade” (2012) 1 *Int. J. Technology Policy and Law* 15 21

³³ WIPO “Total Number of Cases per Year” *WIPO* <<http://www.wipo.int/amc/en/domains/statistics/cases.jsp>> (accessed 28-10-2013)

³⁴ Para 4(k) of the *UDRP*

³⁵ ICANN *gTLD Applicant Guidebook (Version 2011-09-19)* Module 3, Objection Procedure

³⁶ The String Confusion Objection concerns situations in which the applied-for TLD is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications. The Limited Public Interest Objection may be relied upon when the applied-for TLD string offends generally accepted legal norms of morality and public order that are recognised under principles of international law. The Community Objection may be used if there is substantial opposition to the applied-for TLD from a significant portion of the community to which the TLD may be explicitly or implicitly targeted.

owners.³⁷ ICANN appointed the WIPO's Arbitration and Mediation Center as the DRSP for LROs,³⁸ and WIPO's rules and procedures for the resolution of LROs, the WIPO Rules for New gTLD Dispute Resolution³⁹ ("WIPO Rules"), have to be complied with.⁴⁰ During this first round of application for new TLDs, 69 disputes were determined *via* the LRO Procedure.⁴¹

The LRO may be sought to be relied upon if the applied-for TLD infringes the existing legal rights, which would include trade mark rights, of the objector. However, it is important to bear in mind that the substantive basis for a LRO is potentially of broader application than simply protecting trade mark rights relating to the New gTLD Program: it allows for an objection that the applied-for TLD "infringes the existing legal rights of others that are recognised and enforceable under generally accepted and internationally recognised principles of law".⁴² It is not confined to the protection of trade marks, and may, for example, permit objections on the basis that the proposed TLD may be offensive to a particular group.⁴³

A registered trade mark owner will obviously be a rights holder, and has standing to file an objection.⁴⁴ In the case concerning the *.mls* TLD, the panel held that the objector to the applied-for TLD bears the burden of proving that it has the standing to lodge a LRO.⁴⁵ The source of, and documentation relating to, the existing legal rights the objector claims are infringed by the applied-for TLD – such as the trade mark registration certificates – must be included in the filing.⁴⁶ Surprisingly, most of the applicants for TLDs in the LRO proceedings did not seek to rely on registered rights *per se*, as the majority of objections concerned applications for generic or descriptive TLDs.⁴⁷ The filing of an objection commences the Procedure.⁴⁸

Upon receipt of an objection, the DRSP must promptly send a notice to the applicant for the new gTLD,⁴⁹ who must file its response to the objection.⁵⁰ As the Procedure was "designed with an eye toward timely and efficient dispute resolution",⁵¹ and at reasonable cost,⁵² it seeks to limit the substantive portions of both the objection, and the response, to 5,000 words or 20 pages, whichever

³⁷ Although the Governmental Advisory Committee ("GAC") Early Warning notice is not a formal objection procedure, and does not directly lead to a process that can result in rejection of the application (see s 1 1 2 4 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*), a trade mark holder may seek to rely on it. It provides the applicant with an indication that the application is seen as potentially sensitive or problematic by one or more governments.

³⁸ S 3 2 1 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*.

³⁹ WIPO *WIPO Rules for New gTLD Dispute Resolution* (20-06-2011).

⁴⁰ S 3 2 1.

⁴¹ WIPO Arbitration and Mediation Center *WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013 2*.

⁴² *hibu (UK) Limited v Telstra Corporation Limited* 2013 LRO2013-0013, 25 July 2013 3.

⁴³ Lipton & Wong (2012) *Monash University L Rev* 191.

⁴⁴ S 3 2 2 2 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*.

⁴⁵ *The Canadian Real Estate Association v Afilius Limited* 2013 LRO2013-0008, 16 July 2013 7.

⁴⁶ S 3 2 2 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*.

⁴⁷ WIPO Arbitration and Mediation Center *WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013 12*.

⁴⁸ S 3 2 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*.

⁴⁹ Art 11(a) of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)* Module 3, Objection Procedure.

⁵⁰ Art 11(b).

⁵¹ Preamble.

⁵² Art 18.

is less.⁵³ The Procedure does not generally allow for further submissions and evidence in reply.⁵⁴ However, the panel has a discretion to allow an objector to file submissions in reply to the applicant's response, and for the applicant to file a further reply.⁵⁵ Such additional submissions will only be allowed in exceptional circumstances, depending on whether sufficient evidence had been adduced in the objection and in the response to enable the panel to reach a fair decision, without the need for additional submissions or evidence.⁵⁶ The onus is on the panel (not on the parties) to determine whether to request further written submissions.⁵⁷ While this may suggest that additional submissions would be an exceptional occurrence, the data indicates that in more than half of the 63 expert determinations, additional submissions were filed.⁵⁸

If an objection has been properly filed and complies with the requirements of the Procedure and the WIPO Rules,⁵⁹ the dispute will be determined in accordance with the dispute resolution procedure, unless the parties have reached a settlement (in which case the proceedings will be terminated),⁶⁰ or the applicant failed to file a response to the objection within 30 days (in which case the objection will be deemed to have been successful).⁶¹ The parties are encouraged – but not obliged – to participate in negotiations or mediation, at any time throughout the dispute resolution process, with the aim of settling their dispute amicably.⁶²

The dispute must be determined by one expert in intellectual property rights disputes, unless all the parties have agreed that it be determined by three experts.⁶³ All the experts must be impartial and independent of the parties, and each expert must confirm and maintain his, or her, impartiality and independence.⁶⁴ According to the WIPO Rules, the cost of having the objection determined by a one-expert panel is US\$8,000, and US\$20,000 for a three-expert panel.⁶⁵ In addition, each part must pay WIPO a filing fee of US\$2,000 for a one-expert panel determination, and US\$3,000 for three-expert panel determination.⁶⁶ While both parties must pay these costs, the successful party will have its payments refunded at the termination of the

⁵³ Arts 8(b) and 11(e)

⁵⁴ *Del Monte Corporation v Del Monte International GmbH* 2013 LRO2013-0001, 29 July 2013 6

⁵⁵ Art 17 of the ICANN gTLD Applicant Guidebook (Version 2011-09-19) Module 3, Objection Procedure

⁵⁶ Art 18 *Del Monte Corporation v Del Monte International GmbH* 2013 LRO2013-0001, 29 July 2013 6

⁵⁷ *Del Monte Corporation v Del Monte International GmbH* 2013 LRO2013-0001, 29 July 2013 5

⁵⁸ WIPO Arbitration and Mediation Center *WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure* 2013 11

⁵⁹ Each objection is reviewed to ensure that it complies with the procedural rules (Art 9 of the ICANN gTLD Applicant Guidebook (Version 2011-09-19) Module 3, Objection Procedure)

⁶⁰ Art 16(e)

⁶¹ Art 11(g)

⁶² S 3.4.3 of the ICANN gTLD Applicant Guidebook (Version 2011-09-19); and Art 16(a) of the ICANN gTLD Applicant Guidebook (Version 2011-09-19) Module 3, Objection Procedure

⁶³ Art 13(b)(ii) of the ICANN gTLD Applicant Guidebook (Version 2011-09-19) Module 3, Objection Procedure

⁶⁴ Art 13(c)

⁶⁵ WIPO "Schedule of Fees and Costs: New gTLD Pre-Delegation Legal Rights Objection Procedure" WIPO <<http://www.wipo.int/amc/en/domains/lro/fees/>> (accessed 13-12-2013)

⁶⁶ Arts 8(c) and 11(f) of the ICANN gTLD Applicant Guidebook (Version 2011-09-19) Module 3, Objection Procedure

dispute.⁶⁷ Interestingly, in determinations related to the first round of TLD registrations, 54 objections were determined by one expert, and only nine by a three-expert panel.⁶⁸

Importantly, similar to the UDRP, the dispute resolution mechanism does not constitute an arbitration. Although the Guidebook describes the parties' submission to the stipulated procedure in contractual terms,⁶⁹ parties are not prevented from initiating legal proceedings, even while the matter is pending with the DRSP.⁷⁰ The only obligation of a party who has initiated such other proceedings is to notify the panel thereof. If legal proceedings have been initiated in another forum, the panel has the discretion to decide whether to suspend or terminate the process.⁷¹ Legally, a panel's determination of a LRO pursuant to the Procedure – should one be made – amounts to an expert determination, rather than an arbitration.⁷² It is likely because of this that the WIPO Rules expressly make provision for an exclusion of liability in favour of the panel.⁷³ Importantly, however, ICANN is entitled to accept such determination for determining its actions,⁷⁴ which is probably the key to the effectiveness of the Procedure, as has been the case with the UDRP.

5.2 Grounds of opposition

The substantive basis for a LRO to an applied-for TLD must be one or more of the following: that it takes *unfair* advantage of the distinctive character or the reputation of the objector's registered or unregistered trade mark; that it *unjustifiably* impairs the distinctive character or the reputation of the objector's trade mark; or, that it creates an *impermissible* likelihood of confusion between it and the objector's trade mark.⁷⁵ Furthermore, the Procedure requires that where, in the case of a LRO, the objection is based on trade mark rights, the panel hearing the dispute must consider the listed eight non-exclusive factors.⁷⁶ However, it has been stated that the eight criteria should not be applied formulaically.⁷⁷ As the list is non-exclusive, the panel may also consider other relevant factors in determining whether the objector's rights will be infringed by the approving the applied-for TLD.⁷⁸

Given the fact that the panel must consider the eight non-exclusive factors, and that panels thus far appear to consider them *seriatim*, it is worthwhile listing the factors that each panel is mandated to consider. First, whether the applied-for TLD is identical or similar, including in appearance, phonetic

⁶⁷ Art 14(e)

⁶⁸ WIPO Arbitration and Mediation Center *WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013* 10

⁶⁹ S 3.2 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*

⁷⁰ Para 13(a) of the WIPO Rules

⁷¹ Para 13(b)

⁷² S 3.4.6 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*

⁷³ Para 16 of the WIPO Rules

⁷⁴ S 3.4.6 ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*

⁷⁵ S 3.5.2

⁷⁶ S 3.2.2. See also *DotTunes Limited v Amazon EU S.à.r.l.* 2013 LRO2013-0065, 14 July 2013 4 and *The Canadian Real Estate Association v Afiliat Limited* 2013 LRO2013-0008, 16 July 2013 12

⁷⁷ *The Canadian Real Estate Association v Afiliat Limited* 2013 LRO2013-0008, 16 July 2013 14

⁷⁸ 12

sound, or meaning, to the objector's mark. Second, whether the objector's acquisition and use of rights in the mark has been *bona fide*. Third, whether, and to what extent, there is recognition in the relevant sector of the public of the mark corresponding to the TLD, as the mark of the objector, of the applicant, or of a third party. Fourth, the applicant's intent in applying for the TLD, including whether the applicant, at the time of application for the TLD, had knowledge of the objector's mark, or could not have reasonably been unaware of that mark, and including whether the applicant has engaged in a pattern of conduct whereby it applied for or operates TLDs or registrations in TLDs which are identical or confusingly similar to the marks of others. Fifth, whether and to what extent the applicant has used, or has made demonstrable preparations to use, the mark corresponding to the TLD in connection with a *bona fide* offering of goods or services or a *bona fide* provision of information in a way that does not interfere with the legitimate exercise by the objector of its trade mark rights. Sixth, whether the applicant has intellectual property rights in the mark corresponding to the TLD, and, if so, whether any acquisition of such a right in the mark, and use of the mark, has been *bona fide*, and whether the purported or likely use of the TLD by the applicant is consistent with such acquisition or use. Seventh, whether and to what extent the applicant has been commonly known by the mark corresponding to the TLD, and if so, whether any purported or likely use of the TLD by the applicant is consistent therewith and *bona fide*. Eighth, whether the applicant's intended use of the TLD would create a likelihood of confusion with the objector's mark as to the source, sponsorship, affiliation, or endorsement of the TLD.

While the list of non-exhaustive factors will be familiar to us, with our trade mark law based on Anglo-American principles, they are enumerated for consideration by the panel because there is no internationally accepted standard by which the concepts which form the substantive basis for a LRO are determined. For example, there is no internationally accepted standard for "unfair" in the context of trade mark infringement.⁷⁹ The listed factors may be viewed collectively as analytical proxies for the more general concepts discussed above. There is no particular hierarchy of the importance of the factors listed. Depending on the facts of the particular case, some factors may be more significant than others.⁸⁰ The Guidebook does not provide any guidance about how a panel is to draw its conclusion from the assessment of the eight factors. It is clear that a panel does not need to find in favour of the objector in respect of all eight factors to support an objection.⁸¹ They are simply factors that may assist in the context of a particular case and the weight and regard that is to be given to each factor will depend on the specific facts.⁸²

Various panels have reiterated that in a case of a LRO based on trade mark rights, the use of the terms "unfair", "unjustifiably", and "impermissible" as modifiers, respectively, of "advantage", "impairs", and "likelihood of

⁷⁹ *Right At Home v Johnson Shareholdings Inc* 2013 LRO2013-0030, 3 July 2013 3

⁸⁰ 3

⁸¹ *Sina Corporation v Tencent Holdings Limited* 2013 LRO2013-0041, 28 August 2013 5

⁸² 10

confusion” suggests that there must be something more than mere advantage gained, or mere impairment, or mere likelihood of confusion for an objection to succeed under the Procedure; there must be something untoward – even if not to the level of bad faith – in the conduct or motives of the applicant, or something intolerable in the state of affairs which would obtain if the applicant were permitted to use the applied-for TLD.⁸³

If the applicant for a new TLD is *bona fide*, it is unlikely that one of the three substantive bases for an LRO will be met. It might be that advantage is being taken of the distinctive character or the reputation of the objector’s trade mark, but will likely not be unfair. So too, it might be that the distinctive character or reputation of the objector’s trade mark is being impaired by the proposed TLD, but it will likely be justified. Again, it might be that a likelihood of confusion between the applied-for TLD and the objector’s trade mark is created, but it may not necessarily be impermissible.⁸⁴ This is reasonable because it is inevitable that the prospect of confusion or impairment of marks may occur, given the fact that, as with the previous gTLDs, there can only be one TLD registrant of a particular TLD, despite there being multiple trade mark owners of the same mark in different jurisdictions. As previously indicated, trade mark law allows for a greater number of *bona fide* users of the same trade mark – whether in different jurisdictions, or in relation to different goods or services within the same jurisdiction – than allowed by the DNS. Given the fact that there can only be one TLD which could serve as a domain name for such a trade mark, it makes sense to require that an objection to an applied-for TLD must be based on more than an allegation of advantage being taken of, impairment to, or the likelihood of confusion with, the objector’s trade mark, as may be the case in trade mark infringement cases pursuant to domestic law.⁸⁵ In other words, because there could quite conceivably be *bona fide*, independent, and parallel rights to trade marks in different jurisdictions, there is a real likelihood that there may be some “infringement” of another’s claim to a TLD based on a trade mark, which must be tolerated in such a congested environment. Accordingly, subject to the comment above relating to untoward conduct or an intolerable situation, the first *bona fide* party who seeks registration of its trade mark as a TLD should be entitled to register such TLD, if there are no other applicants therefor. If there are equally valid, competing claims for an applied-for TLD, the matter should be regarded as a String Confusion Objection, and resolved in accordance with Module 4 (“String Contention”) of the Guidebook. The latter disputes are ultimately resolved through an auction process.

⁸³ *Right At Home v Johnson Shareholdings Inc* 2013 LRO2013-0030, 3 July 2013 3; *Limited Stores LLC v Big Fest LLC* 2013 LRO2013-0049, 15 July 2013 3; *hibu (UK) Limited v Telstra Corporation Limited* 2013 LRO2013-0013, 25 July 2013 14

⁸⁴ *Limited Stores LLC v Big Fest LLC* 2013 LRO2013-0049, 15 July 2013 8; *Merck KGaA v Merck Registry Holdings Inc* 2013 LRO2013-0009, 6 September 2013 6

⁸⁵ The stated grounds for objection in s 3 5 2 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)* largely correspond with the grounds for determining trade mark infringement in s 34(1) of the Trade Marks Act. Although s 34(1) also refers to “unfair” advantage as a possible ground for infringement, it does not have additional modifiers in relation to “detriment” (which is the equivalent of “impairs” in s 3 5 2) or “likelihood of deception or confusion”

The Procedure does not mandate particular tests for the three grounds of objection. For example, there is no test for determining whether there is a likelihood of confusion which would be caused by the applied-for TLD and the objector's trade mark.⁸⁶ The panel determinations, thus far, indicate that there should not be a significant difference between the criteria for a LRO and those which have been applied under UDRP.⁸⁷ How the applicant intends to use the applied-for TLD may be critical to its chances of success in cases where there is another *bona fide* user of the trade mark.

The assessment of whether the applied-for TLD takes unfair advantage of the distinctive character or the reputation of the objector's registered or unregistered trade mark, unjustifiably impairs the distinctive character or the reputation of the objector's trade mark, or, creates an impermissible likelihood of confusion between the applied-for TLD and the objector's trade mark, must be based on the postulated notional use of the TLD. In this regard, the applicant's statements in its application concerning the manner in which the applied-for TLD will be used are important. Once an application for a new TLD is approved and delegated by ICANN, the commitments made by the applicant in its application about how the TLD will be used will be incorporated into its agreement with ICANN, the New gTLD Base Agreement. The panel will, therefore, conduct its assessment as to whether the objector's rights are infringed on the assumption that the TLD will be used by the applicant in the manner described in its application.⁸⁸

Importantly, the mere fact that an objection to an applied-for TLD is dismissed by a panel, does not prevent an objector subsequently seeking to rely on its trade mark rights in relation to how that TLD is used. It may still be the case that if the TLD incorporates, or is identical to, the objector's trade mark, and is used in relation to identical or similar services in territories where the objector has rights, that the use (or the manner of use) of such TLD by the applicant may infringe the objector's rights; the objector may take the necessary legal action to prevent the infringing use.⁸⁹

The objector bears the burden of proving that its objection should be sustained.⁹⁰ This onus was an issue which the dissenting decision found not to have been discharged by the objector in *Del Monte Corporation v Del Monte International GmbH* ("*Del Monte*").⁹¹ Coincidentally, the *Del Monte* matter had a South African connection as the applicant sought to rely, amongst other things, on its South African trade mark registration for the *DEL MONTE* mark. The case is also notable for being one of only two cases in which the objection succeeded.⁹² The dissenting panellist was of the opinion that, as an

⁸⁶ *Limited Stores LLC v Big Fest LLC* 2013 LRO2013-0049, 15 July 2013 7

⁸⁷ *Merck KGaA v Merck Registry Holdings Inc* 2013 LRO2013-0009, 6 September 2013 6

⁸⁸ *Sina Corporation v Tencent Holdings Limited* 2013 LRO2013-0041, 28 August 2013 5

⁸⁹ *Merck KGaA v Merck Registry Holdings Inc* 2013 LRO2013-0009, 6 September 2013 6

⁹⁰ Art 20(c) of the ICANN gTLD Applicant Guidebook (Version 2011-09-19) Module 3, Objection Procedure

⁹¹ *Del Monte Corporation v Del Monte International GmbH* 2013 LRO2013-0001, 29 July 2013

⁹² The other case in which the LRO was sustained also had a South African connection (*Sina Corporation v Tencent Holdings Limited* 2013 LRO2013-0041, 28 August 2013) In that matter, the applicant, Tencent Holdings Limited of China (of which Naspers is a significant shareholder), applied for the TLD *.weibo*, which was opposed by Sina Corporation of China

objector bears the burden of proof, in close cases the balance should be tipped in favour of the applicant. There was nothing to suggest that the applicant's rights in the *DEL MONTE* mark in South Africa, and its use of that mark, were not *bona fide*. In the circumstances, an adverse inference should have been drawn from the objector's failure to mention the South African marks. Given the streamlined nature of the Procedure, where discovery does not occur and cross-examination is absent, it is incumbent on parties to be forthcoming and candid.⁹³

The *Del Monte* matter does leave one with the distinct impression that trade mark rights in the larger markets, such as the United States, are given more weight than those which may exist in other jurisdictions. As stated, given the possibility of *bona fide*, independent, and parallel rights to trade marks in different jurisdictions, priority should be given to the applicant, unless there is something untoward concerning the applicant for the TLD, or the registration of the TLD would bring about an intolerable situation, or the applied for TLD must be resolved on the basis of it being a String Confusion Objection. Panellists should guard against the propensity to favour trade mark interests in particular jurisdictions above those of others. We have already seen significant disputes arising as a consequence of a trade mark being owned by different proprietors in various jurisdictions, for example, in relation to the *.merck* and *.delmonte* TLDs.

6 Comparing the Procedure to the UDRP

It is worthwhile to briefly note the differences between the Procedure and the UDRP, and to appreciate why it would not have been appropriate to simply employ the UDRP to disputes relating to the New gTLD Program.

The first thing to note about the Procedure is that, unlike the UDRP, it provides a trade mark proprietor with an *ex ante* remedy, that is, it seeks to prevent an objectionable registration. Until the opposition has been disposed of, the registration of the applied-for TLD will not be approved. In contrast, the UDRP seeks to set aside a domain name registration which was obtained in bad faith, and is, therefore, an *ex post facto* remedy. Given that a successful applicant will be awarded a significant slice of our cyber real estate, it is clearly desirable that such grant should only be made after giving others an opportunity to present a case for why it should not be allowed. However, as noted above, the mere fact that an objection may have been rejected does not deprive the unsuccessful objector from seeking to rely on its trade mark rights in relation to how a TLD is used. The manner in which the TLD is used may still amount to infringing conduct.

While the UDRP was implemented to primarily address the problem of cybersquatting, given the low barriers to domain name registrations, it is unlikely that cybersquatting would be a significant issue in relation to the New gTLD Program. The costs and other requirements to register a TLD would make such predatory conduct economically unviable. For example, the

⁹³ *Del Monte Corporation v Del Monte International GmbH* 2013 LRO2013-0001, 29 July 2013 12

registration fee payable for a TLD is an amount of US\$185,000, which would not include the costs of the Procedure if any objection has been filed. Although an applicant for a TLD is entitled to a refund of 20% of such fee if it withdraws its application following a successful objection, the sum forfeited should have a sufficiently deleterious effect to prevent speculative bad faith registrations.⁹⁴

Furthermore, in addition to the application fee, an applicant has to expend considerable resources – particularly where it will be operating an open registry in relation to the applied-for TLD – in demonstrating its technical, operational and financial capability to operate the TLD, including demonstrating compliance with policies and practices intended to protect the legal rights of others.⁹⁵ The data from first round of applications under the New gTLD Program support the contention that bad faith registrations is not the principal concern.

Given the fact that the New gTLD Program has adopted a largely permissive approach to the registration of TLD, there has been a scramble to register descriptive terms (regardless of whether they are trademarks), which may be sought-after as TLDs, particularly by those seeking to operate open registries under the TLD so that others can apply to register second-level domain names. So, for example, there have been applications for descriptive terms such as *.academy*, *.coach*, *.food*, *.home*, and *.mail*. The overwhelming majority of LROs in the first round of registrations were filed against applications for TLDs with descriptive or dictionary meanings, rather than on the basis of trade mark registrations.⁹⁶ However, trade mark owners would be well advised to be vigilant, and, depending on their financial resources, to avail themselves of ICANN's services, such as the Trademark Clearinghouse, which notifies trade mark proprietors of a potential conflict between a TLD being sought and its trade mark.⁹⁷ Registration with ICANN's Trademark Clearinghouse will also be important to trade mark owners in the ever-expanding constellation of TLDs, as the service will warn them of applications for domain names which are the same as their trade marks within a new TLD, and give them priority to purchase domain names corresponding to their trade marks within the TLD before the general public during the so-called "sunrise registration periods". For example, Woolworths may want to be notified should some other person register *woolworths.clothing* in the new *.clothing* TLD. Of course, the service provided by the Trademark Clearinghouse comes at a fee, which has presented ICANN with another opportunity to make money out of the New gTLD Program.

⁹⁴ S 1 5 1 of the ICANN *gTLD Applicant Guidebook (Version 2011-09-19)*

⁹⁵ S 1 1 2 5

⁹⁶ WIPO Arbitration and Mediation Center *WIPO Arbitration and Mediation Center End Report on Legal Rights Objection Procedure 2013 12*

⁹⁷ Anonymous "Rights Protection Mechanisms for New Top-Level Domains" (2013) *ICANN* <<http://www.wipo.int/amc/en/domains/rpm/#d>> (accessed 22-12-2013)

7 Conclusion

The New gTLD Program has introduced another arena for trade mark disputes, requiring trade mark owners to monitor applications for new TLDs to ensure that their rights are not infringed. Due to the fact that a significant slice of our cyber real estate could be awarded to an applicant pursuant to the New gTLD Program – much more so than the registration of a domain name within any of the existing gTLDs – it would not have been appropriate to simply use the UDRP, which was devised to deal with the potentially vast-scale issue of cybersquatting, given the, comparatively, nominal costs of registering domain names within the existing gTLDs. This fact is borne out by the considerable application fee payable for a new TLD (and that there appears to be no shortage of applicants which have been willing to pay it), not to mention the costs associated with ensuring that the applicant can satisfy ICANN of the other stipulated requirements for applicants. Having said that, in the absence of *bona fide* competing claims, an applicant should be awarded the applied-for TLD in the absence of something untoward concerning the applicant for the TLD, or where there is nothing to indicate that the registration of the TLD would bring about an intolerable situation. At the present moment, the *Del Monte* matter suggests that, legally, not all trade marks are given equal recognition.

Although bad faith registrations may not be a significant risk under the New gTLD Program, it would nonetheless be prudent for trademark owners to be vigilant about the applications which are sought for TLDs. Irrespective of the merits of the decision to expand the number of TLDs, it would be much cheaper for a trademark owner to pursue a LRO rather than having to later institute trade mark infringement proceedings in multiple jurisdiction as a consequence of the manner in which the TLD is being used. Trade mark owners will also have to monitor the TLDs which are approved to ensure that second-level domain names registered within such TLDs do not infringe their rights.

SUMMARY

Following ICANN's decision to permit new top-level domains pursuant to its New gTLD Program, and the likely explosion in the number of top-level domains ("TLDs"), it was anticipated that there would be competing claims to register new TLDs, particular by trade mark owners. Given the success of ICANN's earlier alternative dispute resolution system – the Uniform Dispute Resolution Policy ("UDRP") – ICANN decided to again make use of an alternative dispute resolution mechanism. To this end, the New gTLD Dispute Resolution Procedure (the "Procedure") was introduced to resolve disputes relating to applications for new TLDs. There are different dispute resolution mechanisms within the Procedure for each of the four enumerated grounds of opposition, and the Legal Rights Objection ("LRO") is the dispute resolution mechanism for trade mark disputes. A number of trade mark disputes have now been determined under the LRO, which has provided some insights into how disputes are likely to be determined under it. From a trade mark perspective, there does appear to be a concern that not all trade marks are being given equal recognition. There appears to be a tendency to give greater weight to trade marks from certain jurisdictions. Hopefully, this concern is more apparent than real, because, if that is not the case, the credibility of the LRO as a dispute resolution mechanism may be undermined.