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Arbitration  
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Center



# Legal Rights Objections and New Rights Protection Mechanisms under ICANN's New gTLD Program

# Pre-Delegation Objection Procedures

## ■ New gTLD Dispute Resolution Procedure (Att. to AGB § 3)

- String Confusion Objection confusingly similar to existing/applied for TLD
- Limited Public Interest Objection contrary to generally accepted legal norms of morality and public order recognized under principles of international law
- Community Objection substantial opposition from a significant portion of the intended target community
  - Public Interest/Community: Independent (public interest) Objector
- Legal Rights Objection (LRO) infringes existing trademark or IGO rights

- ICANN's Governmental Advisory Committee (GAC) may provide an Early Warning or "GAC Advice on New gTLDs" concerning applications identified by governments as problematic

# 60-day public comment period

- <https://gtldcomment.icann.org/comments-feedback/applicationcomment/viewcomments>
- Search by: Applicant, String, Application Status, Panel/Objection Ground, Name
- **Public comments** already received by ICANN in its “LRO forum”
  - .NAVY (“Breach of Australian Law”)
  - .OLDNAVY (“Breach of Australian Law”)
  - .VIDEO (“Video is a public common word”)

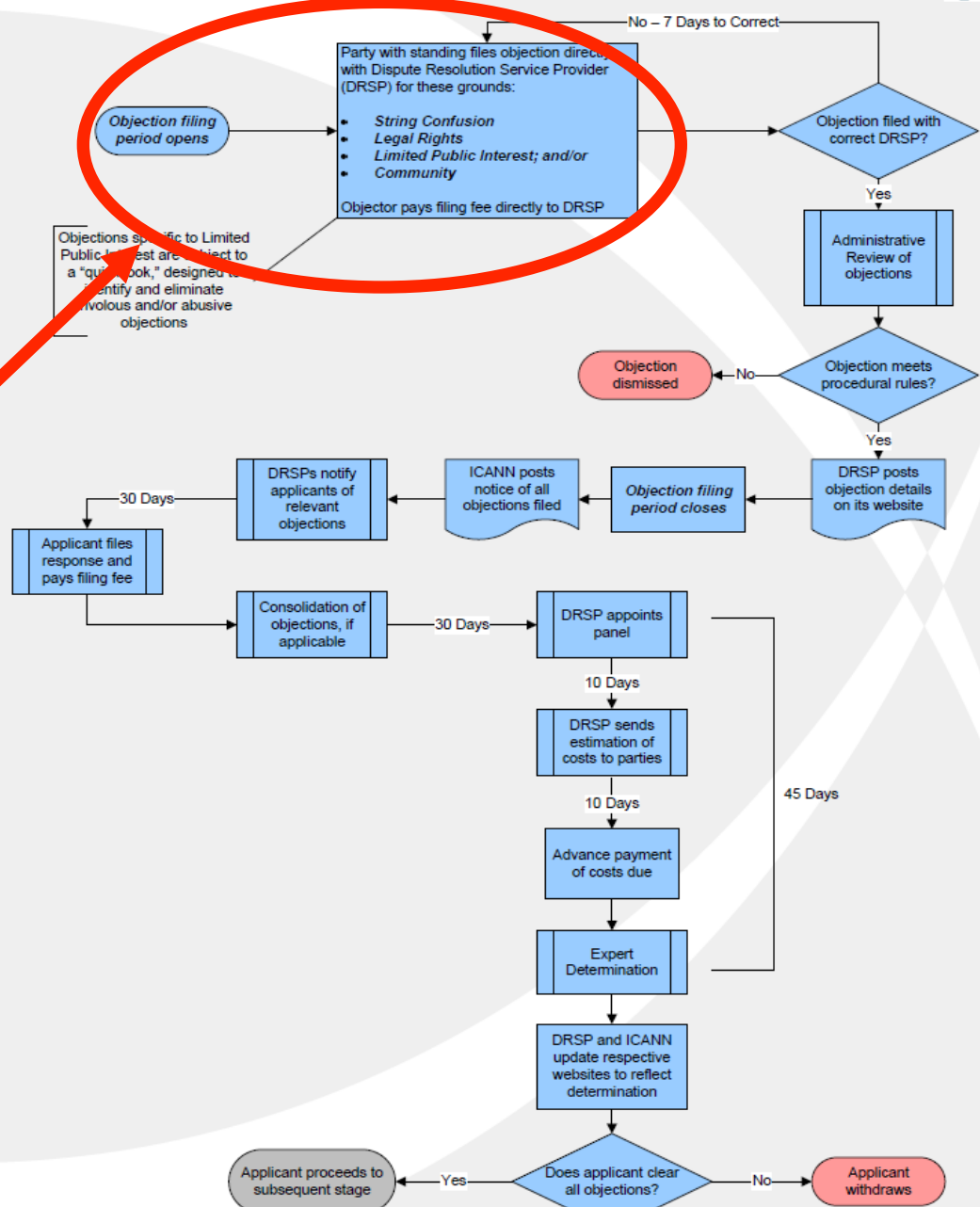
# What is a Legal Rights Objection?

- Prior to ICANN approving a New gTLD application, trademark owners and IGOs may file a formal objection on the basis of a “Legal Rights Objection” (LRO)
  - Standing: “rightsholders” (3.2.2) registered or unregistered trademark or service mark or IGO name or acronym (3.5.2)
- **An independent panel would determine whether the applicant’s potential use of the applied-for gTLD would be likely to infringe the objector’s trademark, or IGO name or acronym**
- *The availability of an LRO proceeding does not preclude court options*

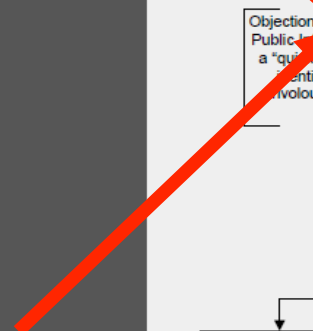
# Approximate LRO Procedure Timeline

- Jan 2012: new ICANN Applicant Guidebook; application window opened
- May 30 2012: application window closed
- **June 13 2012: “ICANN Reveal Date”**
  - ICANN admin review / 60-day public comment period
  - **7-month objection filing period open**
- Mid-Jan 2013: close of LRO filing window
- Mid-Feb 2013: ICANN Dispute Announcement; Applicants notified of objections (Response due: 30 days)
- Mid-April 2013: Panel appointed (Determination due: 45 days)

# DRAFT - New gTLD Program – Objection and Dispute Resolution



Objections specific to Limited Public Interest are subject to a "quick look," designed to identify and eliminate frivolous and/or abusive objections



# Overview of LRO Stages

- Under the ICANN Procedure, in principle proceedings would typically be based on a single round of **electronically filed pleadings using model forms**, without hearing (by teleconference if possible)
  - Fees due at filing; 5-day cure period for administrative compliance deficiencies
- Seven-month **objection filing window**
  - 30 days from close of filing window ICANN publishes "Dispute Announcement"
- From WIPO Center **notification**: 30 day (mandatory) response due date
- 30 days from **response**: WIPO Center to appoint panel (stay for any mediation)
- 45 days for **panel determination**

# What Criteria Will LRO Panels Apply?

## ■ ICANN AGB § 3.5.2

- LRO criteria founded on WIPO *Joint Recommendation Concerning Provisions on the Protection of Marks, and Other Industrial Property Rights in Signs, on the Internet*
- Whether – with respect to the objector’s trademark or IGO name or acronym – the potential use of the applied-for gTLD by the applicant:
  - (i) **Takes unfair advantage of** the distinctive character or reputation, or
  - (ii) **Unjustifiably impairs** the distinctive character or reputation, or
  - (iii) Otherwise **creates an impermissible likelihood of confusion**
- Panels may refer to non-exclusive consideration factors



# LRO Consideration Factors

ICANN AGB § 3.5.2 (con't.)...

## ■ Trademarks:

1. Identity or similarity (appearance, phonetics, meaning)
2. Objector's bona fide acquisition/use of the mark
3. Relevant recognition by the public
4. Knowledge of the objector's mark, any pattern of applicant infringement
5. Applicant's use (including preparations) of the mark in connection with a bona fide offering
6. Applicant's rights in the mark, including whether such acquisition/use has been bona fide, and whether the intended TLD use is consistent therewith
7. Whether applicant is commonly known by the mark
8. Whether the applicant's intended use would create a likelihood of confusion

## ■ IGOs: five similar consideration factors

# LRO Filing Fees

- One objection to one application (i.e., for one gTLD) decided by one expert:
- USD 10,000 for each party, **due on filing** of objection / response, respectively
  - Non-refundable USD 2,000 case administration fee per party
  - Expert fee (USD 8,000) refunded to the prevailing party
- Different fee arrangements apply to three-member panels and consolidation scenarios
- ***Any reduced Panel fees (i.e. on the basis of a consolidation scenario), would be refunded to the appropriate party from the initial filing fee, after the close of proceedings***
  - *Non-payment of fees by an objector will result in rejection of the objection, without panel appointment. Non payment of response fees by an applicant will result in the objection being deemed successful.*

# LRO Language Requirements

- In all cases, the language is English
  - "Parties may submit supporting evidence in its original language, provided [...] that such evidence is accompanied by a certified or otherwise official English translation of all relevant text"

## LRO Word / Page Limits

- Substantive portion limited to 5,000 words or 20 pages (whichever is less), excluding attachments
  - Objector/applicant must also list, describe and provide copies of any attached supporting evidence

# LRO Expert Appointment

- Experts required to affirm neutrality by signing the Center's Statement of Acceptance and Declaration of Impartiality and Independence
- The Center will appoint a single-member panel in its sole discretion
- Where **all parties agree** on a three-member panel:
  - Each party submits a list of three candidates from the Center's list of experts (one of whom would be the respective co-panelist)
  - The Center will then provide the parties with a list of five candidates from the Center's list of experts for the parties' respective ranking, with a view to the Center's appointment of the third (presiding) panelist

# WIPO LRO Experts

- Over 100 Experts drawn from the Center's list of UDRP panelists:
  - collective panel experience spanning over 11,000 WIPO UDRP cases (slightly lower than UDRP average transfer rate)
  - significant experience in trademark, e-commerce, and Internet law
  - over 30 countries, with corresponding linguistic/regional diversity represented
- ***The Center's LRO list of experts may be subject to additional development in light of case needs***

# LRO Remedies

- Remedies limited to the success or dismissal of the objection
- No monetary damages
  - But, prevailing party entitled to a partial refund (i.e., the panel fee)
- According to the ICANN Applicant Guidebook, a panel determination is “considered an expert determination and advice that ICANN will accept within the dispute resolution process”
  - Such determination is independent of any determination under either of the other types of ICANN objection options available

# Multiple LRO Objections / Consolidation

- Where multiple objections are filed against the same application (to streamline costs and for procedural efficiency), the Center will seek to consolidate those objections for determination by a single panel
  - A separate determination would be rendered for each objection
- Within seven days of the Center's notification of the commencement of the response filing period to the applicant, the parties themselves may also propose (for the Center's determination) that objections be consolidated
- The Center may take into account factors such as:
  - Whether the same or similar application is at issue
  - Any request/opposition of the parties
  - The trademarks/evidence relied-upon
  - Expert availability

# Are LRO Cases Made Public?

- Upon registering an objection for processing, the Center will post on its website the following information:
  - the **proposed string** to which the objection is directed
  - the **names** of the (parties) objector and applicant
  - the **grounds** for objection (i.e., "Legal Rights Objection")
  - the **date** of the WIPO Center's receipt of the objection
  
- Unless in exceptional circumstances the panel deems it appropriate to redact portions of its determination, as required under the ICANN Procedure, the Center will post each determination in full on its website



# More WIPO LRO Information/Resources

- LRO FAQs

- [www.wipo.int/amc/en/domains/lro/](http://www.wipo.int/amc/en/domains/lro/)

- LRO Filing Guidelines

- WIPO LRO Rules

- WIPO LRO Fee Schedule

- LRO Model Pleadings

- [lro@wipo.int](mailto:lro@wipo.int)

- ICANN-WIPO LRO MOU:

- [www.icann.org/about/agreements/partnership-mous/wipo-mou-07jun12-en.pdf](http://www.icann.org/about/agreements/partnership-mous/wipo-mou-07jun12-en.pdf)


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## Legal Rights Objections under ICANN's New gTLD Program

### Filing a Legal Rights Objection at WIPO: What You Need To Know

The WIPO Arbitration and Mediation Center has been appointed by ICANN as the exclusive provider of dispute resolution services for trademark based "pre-delegation" Legal Rights Objections under ICANN's New gTLD Program. This mechanism forms part of the available [Trademark Rights Protection Mechanisms for New gTLDs](#).

Below are responses to some frequently asked questions about Legal Rights Objections; these responses summarize information found in the authoritative [ICANN Applicant Guidebook](#). ICANN also separately provides an [Objection and Dispute Resolution Fact Sheet](#) and [webpage](#).

- [What is a Legal Rights Objection?](#)
- [Does ICANN offer other types of objection options?](#)
- [What criteria will a panel use to determine the outcome of a Legal Rights Objection?](#)
- [When can a Legal Rights Objection be filed?](#)
- [How does a rights owner submit a Legal Rights Objection?](#)
- [Is it necessary for an applicant to file a response to a Legal Rights Objection?](#)
- [What are the main stages of a Legal Rights Objection?](#)
- [How many rounds of pleadings are involved?](#)
- [Are there hearings?](#)
- [Can the parties mediate/settle their dispute?](#)
- [How much does it cost to file/defend a Legal Rights Objection?](#)
- [Are there language requirements?](#)
- [Are there word/page limits?](#)
- [Who are the experts available for appointment?](#)
- [How is the expert panel appointed?](#)
- [What are the remedies available?](#)
- [What happens if there is more than one objection to an applied-for New gTLD?](#)
- [Is the panel's determination made publicly available?](#)
- [Do parties retain their court options?](#)
- [What is the WIPO Center's role in Legal Rights Objections?](#)
- [Background on WIPO's involvement in Legal Rights Objections](#)
- [What trademark protection mechanisms are available after new gTLDs are approved?](#)
- [Additional information on WIPO's involvement in the Domain Name System](#)
- [Questions?](#)

### What is a Legal Rights Objection?

Prior to ICANN's approval of a New gTLD, third parties may file a formal objection to an application on several grounds, including, for trademark owners and Intergovernmental Organizations (IGOs), on the basis of a "Legal Rights Objection."

When such an objection is filed, an independent panel (comprised of one or three experts) will determine whether the applicant's potential use of the applied-for gTLD would be likely to infringe (described below) the objector's existing trademark, or IGO name or acronym.

### Does ICANN offer other types of objection options?

To address potential disputes over new gTLD applications, ICANN offers three other types of pre-delegation objection-based dispute resolution

**LEGAL RIGHTS  
 OBJECTIONS TOOLKIT**

- ▶ [ICANN Applicant Guidebook, Module 3, Objection Procedures](#)
- ▶ [ICANN New gTLD Dispute Resolution Procedure](#)
- ▶ [WIPO Rules for New gTLD Dispute Resolution](#)
- ▶ [WIPO Schedule of Fees for New gTLD Dispute Resolution](#)
- ▶ [Legal Rights Objection FAQs](#)
- ▶ [Legal Rights Objection Filing Guidelines](#)
- ▶ [LRO Model Objection](#)
- ▶ [LRO Model Response](#)
- ▶ [List of WIPO LRO Experts](#)