

Duff on Hospitality Law

## **Brand Protection in the Era of Exploding Domains**

on 11.10.14 | Posted in Brands and Trademarks, Entertainment, Trademark, Web Domains, Web/Media

*Since 2013 the number and type of web domains has exploded and is having a major impact on brands. [Ruth Walters](#) has been watching this new era of growth and can share her insights on brand protection. Ruth focuses on hospitality operations and general intellectual property and technology transactions. Thank you for today's post, Ruth! - Greg*

Back in the olden days of last year, there was no particular reason for hospitality industry members to be particularly interested in the administration of the Internet unless you were curious. Now, it benefits every brand owner to understand and pay attention to the basics of how new domain names come into being, who selects them and how they become public. Beginning in late 2013 and early 2014, the number and type of domains has exploded, providing brand owners both the opportunity to expand and strengthen their on-line presence and to expand the number of potential infringing domains there are to worry about. Much of the domain name process operates outside the awareness of many brand holders, and many have been caught unaware.

The Internet is administered by a non-profit corporation called the [Internet Corporation for Net Names and Numbers](#) (ICANN). It is this entity that decides, among other things, what letter strings go after the dot. Beginning in 2012, ICANN began its [New Generic Top-Level Domains Program](#) to “increase competition and choice in the domain name space.” ICANN accepts applications for new letter strings and then evaluates them and delegates them to the applicant registry (not *registrar*, which is the entity in this process most familiar to brand owners and the public—like Register.com, GoDaddy, or Network Solutions). Eventually, the registry works with ICANN-approved registrars and the new strings are available to the public for registration.

Some terminology: the letter strings after the dot are called top-level domains (**TLDs**) and are divided into two main categories—generic top-level domains (**gTLDs**) and country-code top level domains (**ccTLDs**). gTLDs are further divided into two sub-categories “unsponsored” gTLDs (**uTLDs**) which anyone can register (like .com, .net, .biz and .info) and sponsored gTLDs (**sTLDs**) which can only be registered by members of a “sponsored community” (like .gov, .

edu, .aero)

The huge push in adding TLDs in the last year or so has focused on gTLDs and the addition of a third category of domains, the Internationalized Domain Name (**IDNs**) which allow TLDs in characters that are not US-ASCII, such as Chinese, Arabic or Cyrillic. These may be representations of existing TLDs, like .com, in the applicable characters or new TLDs or both.

Any brand owner can see the potential problems here. The number of TLDs to worry about has gone from a handful to, over the next few years, possibly more than 1300. That makes more than 1300 opportunities for a cybersquatter to register [your brand] in connection with a new domain and possibly several opportunities missed to register useful new TLDs, such as **.review**, **.hotel**, **.restaurant** or, depending on how you feel about things, **.wtf**. There is also the possibility that the new TLD itself may infringe a trademark, and ICANN has accounted for that possibility in its review and the provision of a [post-delegation dispute resolution process](#).

### Trademark Clearinghouse

The more likely scenario is that the second-level domain (the bit right before the dot) will be the infringing piece. ICANN has responded to the significant concerns of brand owners in this regard by introducing a new rights policing mechanism called the [Trademark Clearinghouse](#), participation in which is mandatory for all new gTLD registries. Rather than requiring brand owners to rely on the [Uniform Domain Name Dispute Resolution Policy process](#), requiring brand owners to proceed only after a potential infringing name is registered, the Clearinghouse allows for some pre-registration enforcement. Successful registration of valid trademarks with the Clearinghouse permits those trademark owners—for a fee, of course—to:

- Apply before the general public for the domain names in which the second-level domains; and
- Receive notice of any third-party registrations for domain names containing an exact match to the registered mark(s) for as long as the records are maintained at the Clearinghouse. The potential registrant of an infringing domain name also receives a warning when attempting to register a domain name during the 90 days after the close of the sunrise period, which is called the “Trademark Claim” period.

Registering with the Clearinghouse, if possible, has obvious benefits.

### Blocking Mechanisms

The Clearinghouse in turn works with a variety of registrars who provide what are called “blocking mechanisms” for the new gTLDs. In very brief, the owner of a trademark registered at the Clearinghouse can purchase blocking services to block third-party registrations of domain names containing that trademark (and, possibly, similar marks) without having to go to the

trouble of defensively registering [your brand],[gTLD] 70 or 80 times.

### Uniform Rapid Suspension System

If blocking, defensive registration and notification still don't work (which is entirely possible, given the nature of the Internet) ICANN has also instituted the URS which creates a more streamlined process for shutting down infringing domain names than even the UDRP provides.

As we have written before in many circumstances, the Internet is a tough place for brand owners and, in some ways, it has gotten tougher. Fortunately, there are mechanisms that exist to help brand owners keep control of their good names on the Internet and also to explore new opportunities for expanding their on-line presences.

**Tags:** blocking mechanisms, brand, brand owners, Brand protection, ccTLDs, domain name registration, gTLDs, ICANN, Internet Corporation for Net Names and Numbers, Internet marketing, New Generic Top-Level Domains Program, TLDs, Trademark Clearinghouse, Trademark registration