

# Domain names: marketing dream, business nightmare

Preparing brand owners for the risks of personalised online registry names is your responsibility, says **Robert MacGinn**



Robert MacGinn is a trade mark attorney and director of brands at Silverman Sherliker [www.silvermansherliker.co.uk](http://www.silvermansherliker.co.uk)

**Whether profile conflicts concern design registrations on Trunki children's suitcases or high-profile trade mark cases such as *Apple Corps v Apple Computer*, both established businesses and start-ups are at last waking up to the value of securing their brands against competitors.**

Nevertheless, lawyers advising businesses need to be alert to other changes coming into play. Just as clients thought they had their brand securely protected with the requisite trade mark registrations and familiar '.com' and '.co.uk', a new shadow appears on the horizon: the generic top-level domain.

GTLD is a new official registry governing online namespace that is set to change the way businesses will be able to protect and police their brands. If not addressed properly it will put at risk those safeguards already in place.

More than 600 gTLDs are soon to be released, including identifiers such as '.solutions' or '.cool'. Applications have already been filed for '.london', '.nyc', '.fashion', '.sports' and '.film'.

## Cynical ploy

Whether this represents a great chance to secure valuable new online marketing opportunities, or a cynical ploy by the Internet Corporation for Assigned Names and Numbers (ICANN), to charge vast registry fees from established brands and industries, lawyers need to flag the issues to their clients who cannot risk ignoring what is happening.

The new regime offers



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tempting opportunities for businesses to run their own registry, e.g. mybrand.financial, or secure their own corner of one, e.g. mybrand.london, linking their products or location to the mind of the target market.

Equally, it also poses a threat

in the form of a new wave of cybersquatters, and online 'haters' and the onus is on the practitioner to alert the client to the potential risks.

Brand names are being increasingly used – by fans and critics – as identifiers on social media. Now put your competitors and 'haters' together with new gTLDs such as '.sucks', '.fail' and '.wtf' and you have a recipe for brand tarnishment on a global scale.

## Wise up

Now is the time to wise up on the terminology around gTLDs, principally:

- The Trademark Clearinghouse (TMCH): the repository where brand owners can and should file their official trade mark ownership information. A prerequisite is to have a registered trade mark or a right upheld in the courts.
- Sunrise registrations: valid trade mark rights should be filed at the TMCH to be eligible for a sunrise period before the relevant domains are released to the general public. Owners of rights lodged at the TMCH will then be notified if someone applies for a Sunrise Registration. If this develops into a conflict, it can be dealt with under SDRP (below).
- Sunrise Dispute Resolution Policy (SDRP): the complaints procedure run by the registry operator that applies during this period.
- Trademark Claims: clients

should be made aware that where an application for a new domain is filed, even if it is identical to a trade mark already lodged in the TMCH, the Trademark Claims service will not object but will only put the applicant on notice. So it is crucial to ensure service addresses are kept up to date.

- Uniform Rapid Suspension (URS) System: this is planned to be a quick and inexpensive method of dealing with trade mark infringements, but only a temporary measure, and may be subject to appeal.
- Post-Delegation Dispute Resolution Procedure (PDDRP) and Registry Restriction Dispute Resolution Procedure (RRDRP): both are procedures for handling bad faith and harmful registries and registrations.

This new landscape is as yet uncharted, far less has it been tested in the courts.

But advising businesses that they will need to prepare for it sooner rather than later is set to become good practice.

At such times, perhaps the late John Harvey-Jones put it best: "Planning is an unnatural process; it is much more fun to do something.

"And the nicest thing about not planning is that failure comes as a complete surprise rather than being preceded by a period of worry and depression."

Make sure your clients are prepared. **SJ**