Creating, Managing and Protecting your Domain Name Portfolio
Your speakers today

Lianne Bulger
Senior Associate
Intellectual Property and Technology
Squire Sanders (London office)

Natalie Leroy
Strategic Account Manager
Corporation Service Company
Agenda

- Best registration practices
- Portfolio optimisation
- Protection against infringements
- Back to basics: what are the risks?
- Monitoring to fill the gaps
The importance of having a policy

WHO CAN REGISTER?

WHAT TO REGISTER?

WHERE TO REGISTER?
Avoid unnecessary costs by keeping your WHOIS data accurate and uniform:
Consolidation

- Leverage better pricing
- Global strategy
- Central management
Optimisation:
1. Point domains

Ensure all URLs resolve to relevant, current and secure content

CSC researched 500,000 domain names that contain brands from the Interbrand 100™. 70% did not resolve to relevant content
Optimisation:

2. Monitor traffic

URL Forwarding Traffic Tracking Report

Report generated on Thu Aug 9 11:48:48 2012 for data logged during the last 30 days (2012-07-10 >= date < 2012-08-09)

<table>
<thead>
<tr>
<th>DOMAIN</th>
<th>Is CSC URL Forwarding</th>
<th>START</th>
<th>FINISH</th>
<th>NUM</th>
<th>TQT</th>
<th>1D-AVE</th>
</tr>
</thead>
<tbody>
<tr>
<td>tdank.com</td>
<td>Y</td>
<td>2012/07/12</td>
<td>2012/08/08</td>
<td>28</td>
<td>17645</td>
<td>630.18</td>
</tr>
</tbody>
</table>

Error 404

Page Not Found

Mon Jul 14 2008 4:43:30 am EDT
168.192.104.2 tried to load www.revacsystems.com/images/
User Agent = Mozilla/4.0 (compatible; MSIE 6.0; Windows NT 5.1; SV1; .NET CLR 1.1.4322; InfoPath 1)
You are in a Wrong page!
Visit

Home Page
Optimisation: 3. Lapse

Lapse domain names that are not delivering value

- Stop renewing domains that have no traffic and pose limited to no infringement risk
- Re-allocate $ saved to areas of greatest risk/opportunity
Optimisation:
4. Sell or lease

Identify unused, valuable domain names that could be sold or monetised

Domain: Widget.com
(purchased for marketing campaign 10 years ago, but has not been used since)

Currently valued at $350,000 in Secondary Market
Identify & register available domain names that have high likelihood of infringement

- gTLDs, new gTLDs, sTLDs, rTLDs
- IDNs
- Typos
- Repositioned / Novelty TLDs
- Common, Industry, and Negative Terms
- Top ccTLDs
Popular forms of infringement

- Doppelganger Domains
- Cybersquatting In Search
- Socialsquatting
- Typosquatting
Popular forms of infringement

- Doppelganger Domains
  - Example
    - Real domain: @uk.brand.com
    - Doppelganger domain: @ukbrand.com

- Socialsquatting
- Typosquatting
Popular forms of infringement

Example
Cybersquatting domain: brandoutlet.com

Cybersquatting In Search

Socialsquatting

Typosquatting
Popular forms of infringement

- Doppelganger Domains
- Cybersquatting In Search

Example
Real domain: brand.com
Typosquatting domain: brandd.com

Typosquatting
Popular forms of infringement

- Doppelganger Domains
- Cybersquatting In Search

Socialsquatting

Example:
- Socialsquatting: brand.tumblr.com
- Or facebook.com/brand
What’s at Risk?

Doppelganger domains

Typosquatting

Cybersquatting

Socialsquatting

- Diverted traffic
- Increased paid search costs
- Increased risk of fraud/phishing attacks
- Lost revenue
- Brand degradation and increased related legal costs
Strategy Focus Areas

- Key Domain Name Typos
- Key Branded Domain Names
- Key ccTLDs
Strategy
Focus Areas

Key Domain Name Typos

Key Branded Domain Names

Key ccTLDs

Divert .5 – 1% of main website's traffic

Direct navigation: 4.23% conversion rate

Vs.

Search engine searches: 2.3% conversion
Impacts search engine rankings
Creates infringing domains using terms like “Outlet” or “Online”
Searches on Google, Bing, Yahoo, Yandex or Baidu yield results which included infringing domains
ccTLDs affect Google rankings

Relevant country code extensions allow search engines to find you

Strategy Focus Areas

Key Domain Name Typos

Key Branded Domain Names

Key ccTLDs
Optimisation: 5. Monitor

Continually monitor the name space to identify new opportunities/threats

- Domain Names
- New gTLDs
- Social Media
- Internet Content
Optimisation:
6. Recover

Identify & recover potential high traffic / disparaging 3rd party owned domains

Prioritize URLs based on traffic (visibility in search engines, social web or via direct navigation), registrant details and content

Prioritization will help recover infringing URLs with a potential ROI associated with them
Recent article in The Times

• Legal fight for online names at record high - WIPO adjudications increased by 6% on last year

  Reasons
  – Increase in internet shopping
  – New domain name extensions being released all the time
  – Cybersquatters becoming more sophisticated
  – Organisations failing to appreciate the scale of the issue and increase their budgets to deal with it
The domain name you want is taken

- Some domain names will slip through the net
  - Already owned when you decide you want it
    - New brand
    - New jurisdiction
  - Domain name not required under the company domain name policy but its registration by a third party is causing issues
  - New domain name extensions have entered the marketplace and have been purchased by third parties
You need it or don’t want them to have it

• Options
  ➢ Buy the same domain name with a different extension
  ➢ Try to buy the domain name from the owner
  ➢ Try and legally recover the domain name from the current owner
Try to buy

- Check whether you have rights to legally recover
- Consult regarding the value of the domain name
- Enquire anonymously
- If possible, do not offer an amount – wait for an offer to be made
- If transfer is agreed
  - Different registrars operate different rules of transfer (<.co.uk>, <.com>, <.ru>)
  - Consider requesting the current owner to enter into a domain name transfer agreement
  - Use an escrow agent
Try to legally recover

• Two methods
  - Court
  - Domain name dispute resolution

• For either method, you must have rights in or use the second level domain name, to challenge the registration

• Court
  - Appropriate if:
    – There are other IP issues involved
    – You have a big budget
    – You need immediate action or there is no urgency

• Domain name dispute resolution
  - Appropriate if:
    – Issue relates only to domain names
    – The registrant has registered/used the domain name in “bad faith”
    – You do not have a big budget
    – The registrant is not in your jurisdiction
Useful things to know about domain name dispute resolution

- Different extensions use different procedures
- The entire procedure is carried out on paper
- In straightforward cases, it takes approximately 2-3 months to obtain a decision from the date of filing
- If your complaint is successful the only remedies are transfer of the domain name in question or cancellation of that domain name
- It is significantly more cost-effective than trying to recover the domain name through court procedure
- In most cases, the complainant pays the official fees of filing the complaint
- Even if the complainant wins, it will not be able to recover its legal costs
- Even if you recover the domain name, the registrant might set up another domain name using a different extension
Remember, there may be other options

• In the UK
  - ASA – misleading advert
  - Police – Counterfeit goods
  - Host – Infringing/defamatory content
Domain slammers

• Recognise the signs
  ➢ Communication from China
  ➢ Indicate that they have been asked by a third party to register <yourbrand.extension>
  ➢ They are aware of your brand
  ➢ Ask you to confirm that you are content to allow the registration
  ➢ If not, they suggest that you can prevent the registration by registering it yourself
Domain slammers

- **Action**
  - Ensure people within your organisation are aware of the communication
  - **Response options**
    - Do not respond
    - Respond through a third party
    - Respond in a limited way
  - Never agree to register the domain name through the contact
  - If you are concerned about the domain name in question, ask your own domain name service provider if it can register the domain name on your behalf
New gTLDs – What is happening?

- January 2012 – Corporations/organisations could apply to ICANN for new gTLD extensions
- June 2012 – 1,409 new gTLD applications were published [http://newgtlds.icann.org/en/program-status/application-results/strings-1200utc-13jun12-en](http://newgtlds.icann.org/en/program-status/application-results/strings-1200utc-13jun12-en)
- Recommend that you study list
- Before 26 September 2012 – Anyone could comment on the applications
- Before 13 March 2013 – Those with standing can oppose an application
  - Four types of objection
  - Key objection for brand owners is legal rights objection
  - Filing and adjudication costs likely to be in excess of $10,000 - $23,000 plus legal fees
New gTLDs. What does this mean for you?

- From April 2013 there will be a significant increase in available domain names
  - Predicting that over 700 new gTLD extensions will be released
  - Inevitable that infringing activity will increase
  - Budgets for domain names will need to increase
  - A domain name strategy will be very important
New gTLDs – What you must do now

• Consider the list of applications for new gTLDs
• Consider whether making an opposition against a new extension is appropriate and, if it is, act quickly
• Consider your current portfolio in light of the new extensions
• Consider whether any of the new extensions are relevant to your business and whether you would want a second level domain name for that extension
New gTLDs – What you should know

• Consider whether you want to register your brands with the Trade Mark Clearing House
  ➢ Sunrise period – gives priority application period of currently 30 days
  ➢ Trade mark claims service – notification of identical applications/registrations (limited to first 60 days from launch of registry)
  ➢ Fee – expected to be $150 per trade mark

• Increase your organisation’s domain name budget for 2013
  ➢ Trade mark clearing house fees
  ➢ A more sophisticated monitoring solution
  ➢ Dealing with increased infringement activity
Any questions for us?
For more information ...

**Lianne Bulger**  
Senior Associate  
lianne.bulger@squiresanders.com  
T +44 20 7655 1335  
O +44 20 7655 1000  
F +44 20 7655 1001

**Natalie Leroy**  
Strategic Account Manager  
Corporation Service Company  
natalie.leroy@cscglobal.com  
T +44 207 854 6154  
M +44 759 048 6943