

gTLD Domain Name Update

By Tiffany Ferris¹ and Jeffrey Becker²

On January 23rd, coinciding with the ability of trademark owners to register their brands in many of the new gTLD domain names, Haynes and Boone's Dallas Office hosted the Dallas/Ft. Worth Metroplex INTA Roundtable on the timely topic "gTLDs: Protecting Your Brand." The nearly 50 attendees were an excellent mix of new gTLD stakeholders: outside counsel and trademark administrators from a dozen firms; brand representatives from companies including AT&T, Alcon Laboratories, Lennox International, and YUM! Brands; service providers Corsearch and Mark Monitor; and of special note, Jon Nevett, Co-Founder and Executive Vice President of Donuts, Inc., the largest applicant for new gTLDs, with dozens already in Sunrise.

After participants had some time to mix, mingle, and enjoy blue corn tortillas and fajitas from Blue Mesa Grill, moderator Jeff Becker, a partner in our Dallas Office, began the Roundtable with a discussion of the history that led to the launch of the new gTLDs, and how those assembled could take a more active role by joining ICANN's Intellectual Property Constituency, as Haynes and Boone has done. He highlighted the obstacles brand owners are encountering as they try to register marks with the Trademark Clearinghouse and then, based on those registrations, attempt to register domain names incorporating their marks. Having gone through the process recently both for Haynes and Boone itself and for several clients, Jeff was able to speak first-hand to the delays brand owners face in their interactions with the Trademark Clearinghouse and the difficulties in working with domain name registrars to consummate Sunrise domain name purchases.



Nearly fifty trademark professionals discuss procedural issues faced by brand owners at Haynes and Boone.

Much of the discussion at the Roundtable was centered on the mechanics of brand protection during the initial period of gTLD launches. The advantages of registration in the Trademark Clearinghouse received heavy emphasis, especially to Sunrise registrations, claim services, and third-party protection mechanisms like the Domains Protected Marks List ("DPML") program offered by Donuts. Corsearch and Mark Monitor were highlighted as service providers with whom participants had worked to successfully register marks in the Trademark Clearinghouse, and MelbourneIT was praised for its Sunrise website interface and personal service in facilitating Sunrise purchases. Participants were given an extensive collection of resource materials—including Trademark Clearinghouse policy documents, ICANN publications, lists of delegated gTLDs, helpful Internet websites and links, and more—to take with them for further perusal.

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Roundtable participants went home with a bevy of helpful materials.

The highlight of this Roundtable, however, was the discussion surrounding some of the broader themes in the gTLD landscape. INTA Board Member Purvi Patel, also a partner with Haynes and Boone, voiced perspectives on the advantages provided by allowing closed generic gTLDs. Jon Nevett was able to give attendees his explanation of how he sees the new gTLDs becoming relevant to companies and consumers, and how Donuts, in response to suggestions made by the trademark bar, has adopted systems to assist mark owners in protecting their brands, such as the aforementioned DPML and Donut's decision to avoid first-come, first-served registration periods. Mr. Nevett was also kind enough to answer questions from participants and share his perspectives on why Trademark Clearinghouse registration is a valuable tool for brand owners.



Mr. Becker and Mr. Nevett field questions and discuss the trademark bar's concerns about brand protection in the new gTLD era.

Haynes and Boone extends its highest thanks to those in attendance for the engaging and insightful discussions that took place on this topic, and special appreciation to Mr. Nevett for being kind enough to travel to Dallas just to attend this roundtable event and share his unique and firsthand insights with the INTA Roundtable Group.