

Strategies for Brand Owners in Cyberspace

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Whether you like it or not, if you have a brand worth protecting, it is worth hijacking and nowhere is it easier to misappropriate than in cyberspace.

The fact is that the entire world has gone digital. Even if you have not established a strong internet presence in branding for whatever reason, it is very likely that the first thing potential consumers do upon learning of your brand is to jump on a search engine to conduct research on your brand. Your brand reputation will precede you in cyberspace. Peer review publications, industry publication, blogs, news and popular media channels. All of these media outlets are hungry for content and more likely than not, they will discover you on the internet whether you have established an active online presence or not.

With a brand reputation existing in cyberspace, enter the cybersquatter or competitor eager to misappropriate your brand wholesale or devise brands close to yours via “me – too” brands in a bid to usurp the vault of goodwill and reputation inherent in your brand.

With the proliferation of generic Top Level domains (“gLTDs”) such as .money, .party, .wtf, .fund, .legal, .poker, .dad, .cash etc. , the threat of your brand being misappropriated and appearing as a domain name of another is apparent.

Strategies

We have set out a proposed two pronged strategy to combat such possible misappropriation namely:-

- Registering trade marks at the Trademark Clearinghouse
- Maintain a watching service

TMCH Registration

Brand owners are advised to attempt to reduce the misappropriation of their trademarks in new domains as they are released by taking advantage of the Trademark Clearinghouse (TMCH).

The TMCH is a centralized database devised by the Internet Corporation for Assigned Names and Numbers (ICANN) as part of a regime to protect brands and intellectual property rights. Basically, it comprises a central repository, which is managed by Deloitte wherein brand owners may submit their trademarks for validation. As of 22 January 2015, the TMCH has received trademarks from over 104 countries and covering 118 jurisdictions.

The trademarks that are eligible for registration include:-

- Nationally or regionally registered trademarks
- Court validated trademarks
- Statute or treaty protected trademarks

Thus, unregistered trademarks, which might be protected under the common law can only be filed at the TMCH if there is a court decision validating such trademark rights.

Trademark registrations with the TMCH will be valid for one, three or five years and may be re-validated once per year or registered for multiple years in advance.

The principal advantages of this service for brand owners are twofold:

Sunrise Period

Each new gTLD will have a Sunrise period usually about 30 days before the actual launch i.e. a pre-launch phase during which a holder of a mark registered at the TMCH will have priority to register domain names corresponding exactly to their marks in the new gTLDs. The domain name sought to be registered must match identically to the trademark registered at the TMCH. Thus, the owner of the trademark APPLE has priority to register apple.solutions before others. Once a trademark is registered with the TMCH, trademark holders should monitor the various Sunrise periods of the different gTLDs entering into operation and use their active registrations for all new gTLD Sunrise periods to register their trademarks as domain names.

Brand owners who have not registered their trademarks at the TMCH will not be able to register domain names during this Sunrise period and will need to wait until the opening of the general registration period and compete with the masses on a first come first serve basis.

Claims Notification

Trademark holders who have registered their trademarks with the TMCH will be provided a trademark claim notification service where the TMCH will notify a registered right holder about any new domain registration that is identical to their registered trademark(s) in the TMCH. The TMCH will also notify a potential registrant when its proposed domain name conflicts with a registered right.

Such warning notices will only be issued during the first 90 days following the launch of the gTLD to the general public.

It must be noted that the warning notices are only triggered by an identical match between the proposed domain name registration and the trademark registered at the TMCH. This means that applications by others for variants or merely similar domain names will not be notified to the brand owner.

Watching

Thus, these TMCH services will allow brand owners preliminary monitoring advantages. However, the TMCH will not detect if someone applies for a domain name that is confusingly similar but not identical to a deposited trademark.

Consequently, such a strategy needs to be complemented by a watching service for variants or merely similar domain names applied for by third parties. By engaging such a watching service, you would then be notified by the watch service provider of domain names, which may be considered to be confusingly similar to your trademarks. Such watching services are highly expert services drawing upon the skills of trademark specialists proficient in the nuances of trademark comparison rules and methodologies.

Brand owners are advised to employ this two pronged strategy in combating potential misappropriation in the high seas of cyberspace as cyberspace continues to be ever increasingly populated with gTLDs. The registration of your trademarks with the TMCH will provide brand owners with benefits. Coupling this strategy with a robust watching service will bode well for brand owners as they brave cyberspace.