

First indications of brand owner engagement with gTLDs

The first seven of Donuts' new generic top-level domains (gTLDs) opened for public registration in January, marking the first opportunity to gauge the appetite – and how brand owners are strategising – for the online expansion. The world's leading brands seem to be evenly split between those which opted for inclusion on Donuts' domain protected marks list (DPML) and those initially choosing to wait and watch.

On January 29 2014 '.bike', '.clothing', '.guru', '.holdings', '.plumbing', '.singles' and '.ventures' opened for general availability. In addition to over 50 of its gTLDs currently live on the Internet, Donuts expects five new gTLDs to go live each week. The company has taken in excess of \$5 million in "total orders and commitments (to date) for its services".

One of these service

offerings is the DPML, which enables trademark owners to block their trademarks across multiple strings for a single fee. The cost is around \$3,000 for an initial five-year term. Mark owners will also have to carry out defensive registrations via the sunrise for each Donuts gTLD. To participate in both the sunrise and the DPML, marks must be registered in the Trademark Clearinghouse (TMCH). Those wishing to use

the DPML should note that the earlier a block is purchased, the more TLDs it will provide protection for.

In the last week of January, *World Trademark Review* looked at the situation in terms of sunrise or DPML engagement among the top 25 brands on last year's BrandFinance Global 500, using the Donuts WHOIS tool. Almost half of the top 25 (12) had opted for DPML protection, while the others appeared not to have engaged (at least for their master brand). The exception was Amazon, which opted for registrations in the seven gTLDs mentioned above.

Counsel comment:

"Brand owners should be wide awake and actively pursuing opportunities – the starting gun has just sounded for this domain name explosion. Marks should already be registered in the TMCH and it's time to start registering during the new sunrise and landrush periods that open weekly. Even with vigilance

and new rights protection mechanisms, trademark owners are still not in the clear. Registry operators may still not fully disclose the terms of, or exceptions to, 'blocks' and blanket protections, or identify names they will set aside for premium pricing. This lack of transparency casts a shadow of uncertainty

over what trademark owners are paying for when they purchase a registry-wide block. The lesson is: don't assume that a trademark protection mechanism offered by the registry operator is sufficient to protect your brands. Be alert. Ask questions. Follow up."
Tiki Dare, legal director, Oracle Corporation

