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Trademark protection in the new domain frontier

My January 2011 column addressed the importance of trademark protection for names of PR firms. This topic is particularly important now, due to two new developments involving domain names. PR agencies that have not already filed a federally registered trademark in the name of their firm now have an added reason to do so.

The worldwide Internet domain name system is coordinated by a nonprofit entity called the Internet Corporation for Assigned Names and Numbers (ICANN). ICANN recently implemented two new domain name suffixes known as generic top-level domains (gTLDs). Perhaps the most familiar gTLDs are “.com,” “.org,” “.net,” and “.edu.” ICANN just introduced two new suffixes – .XXX gTLD and the unique or branded gTLD, in addition to the familiar and traditional suffixes previously mentioned.

PR firms commonly have one or more domain name registrations. In fact, most PR firms have registered their brand name as a “.com” along with one or two other suffixes, such as “.net” or “.org.” Many companies go even further and secure all similar sounding or looking domain names to avoid confusion in the marketplace.

For example, if the name of a PR firm were “Carey Communications,” that agency would typically register the domain names “carey.com,” “cary.com,” and “karry.com,” as well as the same permutations with “.net” and “.org.” Registering your company name with an additional spelling and suffix is important due to the three main purposes of domain registration:

■ **Drive current and potential clients to your brand.** A strong Internet presence will steer clients and potential clients to your website, increasing visibility and opportunity.

■ **Enhance your brand.** Your PR firm is in the business of enhancing brands. Lead your clients by example by proactively securing your place in the online world.

■ **Be defensive.** Don't let others get there first. By securing the appropriate domain names, you preclude other companies from registering your brand as a domain name or a confusingly similar domain name, whether other companies do this intentionally or unintentionally.

With the foregoing in mind, PR firms should consider securing rights in these two new domain frontiers: the “.XXX gTLD” and the “unique or branded gTLD.”

.XXX gTLD

The new .XXX gTLD domain name registration will afford trademark owners a greater opportunity to defensively secure their mark in the digital world.

PR firms and their clients are each owners of brands. Brand owners who own a registered trademark or service mark of national or international effect issued prior to September 1, 2011 can apply to permanently block another party from registering their mark as a .XXX domain. Registration of a .XXX domain is subject to a one-time fee of between \$200 to \$400, depending on the individual registrar, and an annual registration fee of approximately \$60. This is a relatively modest cost for companies to block intentional or unintentional infringements.

Domain names secured through this process will not lead to a live website, but instead will lead to a standard Web page that states that the domain is reserved for use. Effectively, the result of a successful application is that the domain name incorporating the trademark will be unavailable for registration by others.

Unique or branded gTLDs

Another new form of top-level domain is the unique gTLD. Think of these as the equivalent of a “vanity license plate” on the information superhighway. These unique gTLDs can be the name of a company itself, a trade name, description name, or almost anything else.

While the benefits of a unique gTLD are substantial, so are the costs. The initial application fee to ICANN is \$185,000. Accordingly, these domain names are likely to be used only by the world's leading brands such as Nike, Coca-Cola, Microsoft, and the like. Nonetheless, PR firms representing such brands should consider this development. ■

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