



Domain Name Management & Dispute Resolution



Introduction

It is now very rare to come across a business without any online presence. As a result, domain names have become a crucial aspect of intellectual property and one which requires careful management. Unauthorised third party registrations are now much more prevalent with fraudulent activity such as phishing and cyber squatting.

As one of the UK's premium in-house domain name management services we understand the importance of an effective and bespoke domain name strategy, tailored to suit each individual portfolio. By merging this with our market-leading trade mark portfolio management, brand protection and trade mark dispute resolution services we seamlessly cover the full spectrum of domain name and online branding issues. This is our truly unique offering: domain name management as part of best-of-class brand protection legal services.

Our expertise

Domain Name Portfolio Management

- Registrations
- Transfers into Management
- Local presence services
- Automatic renewals
- Privacy protection of domain names
- Processing Trade Mark Clearing house (TMCH) Applications
- Alerts for new gTLD releases & domain name launches
- Domain name portfolio audits, advice on registration timing and strategy, help with portfolio expansion and downsizing
- DNS Management
- SSL Certificates
- DNS Assurance and Domain Name Security Services

Domain Name Portfolio Management

- Domain Name Search Reports (comprehensive historic trace of previous third party registrations)
- Weekly Domain Name Watching Service (identifying all new third party registrations)
- Research and analysis of results (even in instances of privacy protected domain names) and advice on appropriate action
- Domain Name Monitoring services (tracking low risk domains for expiry and changes to Whois status)
- Snapback/ Backorder Services
- Website takedowns
- Coordinating police action in respect of fraudulent UK websites
- URS, UDRP and Nominet/DRS complaints
- Litigation and negotiation

Our team of experts



Simon Chapman

Partner

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Simon acts for clients in many different sectors including the media, retail, manufacturing, financial and technology sectors. He advises on the protection and exploitation of all forms of intellectual property and in recent years has been one of the busiest IP litigators in the country being the lead partner on numerous high profile IP trials and various trade mark cases including Jack Wills v House of Fraser, Lush v Amazon and Enterprise v Europcar. He is identified in the Super Lawyers directory as a leading practitioner in the field of IP and he has also been appointed by Nominet as an Expert to decide domain name complaints within its Dispute Resolution Service.



Steven Jennings

Trade Mark Counsel

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Steven specialises in trade mark and design law and has extensive private practice and in-house IP experience in working with brand owners on a global basis. Steven was formerly an examiner at the UKIPO before managing the Gillette brands in 160 countries. He subsequently held positions at Clifford Chance and Cadbury before joining Lewis Silkin. Steven regularly acts for leading brand owners, marketing services agencies and their networks, overseas law firms, trade bodies and associations and governmental departments. Steven has lectured at QMW on trade mark searching including searching more challenging marks like shape marks, colour marks and multi-jurisdictional searches.

Domain name management services

Registrations and transfers into management

All our domains are securely managed using a web-based domain portfolio management system. As a result, we are able to process all new orders with great efficiency and offer a quick turnaround time for all our services.

Automatic renewal of domains

Our service has the added benefit of an automated renewal system to domain names. This provides substantial security, preventing valuable domains from lapsing and being exposed to misuse by “cybersquatters”.

Local presence services

Certain country specific extensions (ccTLDs) require the registrant or administrative contact of a domain name to have local presence in that particular country, which can prevent brand owners from securing valuable domains, limiting the international outreach of their domain name portfolios. We offer local presence services for a very wide range of ccTLDs so that you can ensure full control over a brand's domains portfolio.

Monitoring of new gTLD releases and launch periods

New gTLDs can serve as a valuable asset for branding purposes, but registering domains in the early phases can also prevent cybersquatters from targeting the brand as soon as a popular and industry specific extension becomes available to the public. The Sunrise Phase prioritises all TmCH holders, whilst the General Availability Phase is open to all applicants and operates on a first come first served basis. We offer fortnightly updates on any new releases and advise on registrations which we believe would be best suited to compliment the brand's current portfolio.

Advice on portfolio strategy: portfolio expansion and downsizing

Which domains to register, which to retain and which to lapse can be a difficult choice for brand owners when considering portfolio expansion or reduction. A brand's online presence and activity is very much influenced by their choice of domain names and it is not unusual for brand owners to register names without an existing or well-planned strategy in place. Unlike many other providers, we have always avoided adopting a blanket, ‘one size fits all’ approach to domain name management and instead tailor our services to the needs of each individual brand, always considering the size and international outreach of their portfolio first in order to determine the specific range of services best suited to ensure the most effective management and protection of domains in each case.

DNS management and domain security services

Our service places a strong focus on protection and security in respect of a brand's online presence. This is of particular relevance to domain names which currently have, or where there are plans to have an active website in place and which generate traffic on a regular basis. Our providers operate on a “never-down” guarantee and our basic DNS service is offered free of charge to all our clients, ensuring ongoing domain name stability and security. We also generate SSL certificates on a regular basis, providing a safe environment for online interactions such as transactions.

Brand protection and enforcement services

Domain name watching reports

This is at the very core of our service, providing brand owners with a comprehensive trace of all domain name registrations containing variations of the brand name and keeping them updated on any new registrations. We have access to some of the leading research programmes specifically designed to investigate instances of domain name cybersquatting. This in turn helps us determine whether a particular registration is low risk or high risk, allowing us to appropriately advise on the best course of action in that instance. We are able to easily link third party registrants to instances where they have targeted other well-known brands their domain name registrations and we have also been known to track down owners even in cases where the domain name has been privacy protected.

Trade mark Clearinghouse Applications (TMCH)

Trade mark Clearinghouse is a database of verified trade marks referred to by Registries during the launch of new extensions (new gTLDs). It allows for brand owners to be immediately alerted to the use of their trade mark in domain name registrations under a new gTLD extension. It also notifies the applicant for the domain as to the existence of the brandowners. This both puts them on notice and acts as a deterrent. The service is used to complement our weekly domain name watching service, which flags up all new registrations across the full range of extensions.

Domain name monitoring

Some domain names may include a brand or trade mark in their name, but will not be of particular interest to a brand owner for acquisition purposes and are therefore treated as low risk third party registrations. In instances such as this, the best course of action could be to periodically monitor these for changes to their details as listed in the Whois database. A change in name servers for example can be indicative of the owner preparing the domain for website use. In such instances, keeping a close eye on the domain name ensures that as soon as it becomes a high risk instance of domain cybersquatting, immediate action is taken.

Snapback/backorder services

Occasionally, a domain name may be currently owned by a third party and be of specific interest to a brand owner, but there may not be a strong enough case to substantiate a claim under existing domain dispute processes. We therefore offer a service which will pick the domain up as soon as it expires and becomes available for registration.

Domain name dispute procedures

We adopt various methods of dealing with instances of domain cybersquatting. The most effective are:

The URS (Uniform Rapid Suspension System)

We are one of the few firms to make frequent and effective use of the URS, which applies to domains registered under a new gTLD extension. The remedy provided under the URS has the effect of immediately suspending the domain name (as well as any subsequent renewal by the current owner) and any website which may be in place is taken down accordingly. If the brand owner is interested in acquiring the name upon its expiry, our snapback service will allow for the domain to be picked up once it becomes available for registration.

The UDRP (Uniform Domain Name Dispute Resolution Policy)

This is the recommended course of action for domain names that a brand owner may wish to make immediate use of and applies to most domain extensions. The recommended remedy under the UDRP is the transfer of the domain name to the brand owner. Upon transfer, we will take management of the name to ensure that it does not lapse upon its expiry date and that it is safely managed by our in-house domain name service.

[For any domain management related queries please contact our domain name team at first instance at lsnetminder@lewissilkin.com.](mailto:lsnetminder@lewissilkin.com)

If a domain name has been registered by a third party (illegitimate interest in the domain name and evidence of bad faith - so called instances of domain name "cyber-squatting"):

URS complaint

- This is used for 'new' domain name extensions, e.g. .london; .shop; .app
- URS complaints are usually for domain names which are not necessarily a priority to the brand owner and where they have no intention/need to use it right away, i.e. setting up a website
- A successful complaint has the effect of suspending the domain name from use and preventing its subsequent renewal by the current registrant

How will LSNetminder help?

Once the complaint has been made we can place a 'backorder' (an automatic tool) which allows us to try and secure the domain name when it expires and becomes available for registration.

UDRP complaint

- Used for generic domain name extensions (.com; .net; .org) as well as country code extensions
- Recommended for domain names which a brand owner may wish to make immediate use of, because if successful, a UDRP will acquire the domain name much sooner than a URS (10 weeks from filing the Complaint)
- The remedy here is an immediate transfer of the domain name to the brand owner

How will LSNetminder help?

Upon transfer we take over management of the domain name to ensure that it is renewed each year to prevent it from lapsing.

Other means of acquisition

- We have the option of putting a 'backorder' in place (a tool which automatically picks up a domain name upon its expiry).
- We could also monitor the domain name for any changes to its Whois status (a domain name database). For example, a change in name servers could indicate that the owner is preparing the domain name for transfer.
- We also have the option of reaching out to the current owner directly and negotiating as to the purchase price. We normally use a private investigator for this, who negotiates on our behalf. Pricing and process of this varies depending on the complexity of the case, i.e. if the domain name is privacy protected and difficulties involved in terms of tracking down the current registrant.

Price guide

Transfers into management

Transfer	Price
gTLD	£12
.co.uk	£12
ccTLD (Unrestricted)	£26
ccTLD (Restricted)	£69
CCTLD (Severely restricted)	£230 - £382

Registrations

Registration	Price
gTLD	£12
.co.uk	£12
ccTLD (Unrestricted)	£29
ccTLD (Restricted)	£79
CCTLD (Severely restricted)	£243 - £382

Domain monitoring

per domain name per month - £50

Internet monitoring

per annum per brand - £7,000

Domain watching

Domain name search report - £165 per brand

Weekly domain name watching full coverage (all extensions) - £1,040 per brand/year

Enforcement

Enforcement	Price
URS complaints	£700-£800 + disbursements
DRS/UDRP complaints	£3,000 + disbursements
Litigation	Usual hourly rates
Cease & Desist negotiation	£750



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