

COVINGTON'S DOMAIN NAME
PRACTICE



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OVERVIEW

Covington has unparalleled expertise in all aspects of Internet brand protection involving domain names. Our global team of attorneys, who have extensive knowledge and experience in all aspects of online brand protection (including anti-counterfeiting and anti-piracy), complements both our skilled in-house internet investigators and our individualized technology tools to provide far-reaching and comprehensive global domain name-related brand protection services.

Our attorneys -

- play a leading role in domain name system policy issues ranging from domain tasting to the introduction of new generic Top Level Domains (gTLDs);
- develop offensive and defensive domain name registration strategies;
- participate in pre-launch rights protection mechanisms, utilize sophisticated technology to identify and monitor existing and new third party domain name registrations;
- take enforcement actions through the Uniform Domain Name Dispute Policy (UDRP) and the AntiCybersquatting Consumer Protection Act (ACPA); and
- acquire domain names.

Our unmatched expertise in these areas has allowed us to develop a sophisticated catalogue of legal arguments and an expansive network of relationships with domain name registries and registrars, ISPs, local counsel in virtually every country, outside investigators, policy makers, and government contacts that aid us in more efficiently and cost-effectively meeting our clients' goals.

Covington's successful holistic domain name strategy and management approach is a key component of our efforts to support clients in protecting their brands online, and also seeks to reduce long-term domain name abuse, including that associated with the expected introduction of new gTLDs.

DOMAIN NAME POLICY EXPERTISE

Our expertise in domain name system policy issues is unequalled. Since December 2006, one of our lawyers has been the Intellectual Property Constituency (IPC) (North America) representative to the ICANN GNSO Council, which develops and recommends to the ICANN Board of Directors policies relating to the DNS. (ICANN is the California non-profit corporation that manages assignment of domain names and IP addresses.) She has been deeply involved in ICANN policy development relating to Whois, domain tasting, proxy services, and the introduction of new gTLDs. Most recently, she led the efforts for the creation by the ICANN Board of Directors of a team of trademark experts to develop and propose solutions to the issue of trademark protection in the introduction of new gTLDs, and was selected as one of 16 members of the Implementation Recommendation Team (IRT). The IRT's May 2009 Final Report set forth a tapestry of seven recommended solutions that, if adopted and implemented, will decrease significantly trademark abuse in new gTLDs and provide trademark owners with new weapons for combatting such abuse.

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DOMAIN NAME REGISTRATION STRATEGIES

We work closely with clients to develop and implement offensive and defensive domain name registration strategies. Consideration of available and desirable domain names is a key component of our trademark clearance strategies. We identify the available domain names of interest and, with client confirmation, register the names on the client's behalf. To ensure that impending business plans are not discovered by those who track domain name registrations, we have accounts with several registrars so that we may register highly sensitive domain names in Covington's name and transfer the names to the client after the relevant plans are no longer confidential. If clearance efforts disclose that domain names of interest and relevance are registered to third-parties, we can utilize our significant acquisition expertise, which is discussed further below. From a "defensive" perspective, we identify those domain names for which third-party registration and use would be undesirable (e.g., disparaging domain names, obvious typographical errors), provide registration recommendations tailored to the client's business and online presence, and, where appropriate, handle the registrations. We recognize that some clients prefer to handle domain name registration internally and we tailor our services accordingly.

PRE-LAUNCH RIGHTS PROTECTION MECHANISMS

We have advised clients on and supported their participation in pre-launch Rights Protection Mechanisms (RPMs) to prevent and discourage abusive domain registrations at launch that were provided by the .asia, .biz, .info, .mobi, and .tel gTLDs, and the .eu, .me, and .us country code Top Level Domains. We have successfully initiated challenge processes to recover domain names acquired by ineligible entities through pre-launch RPMs in .biz and .mobi. For example, we filed – and won – the first Sunrise challenge for a .mobi name. Even when clients have submitted their own RPM applications, we have taken steps to ensure that the client is awarded the relevant domain name if a processing or submission error by a registrar or, occasionally, the client itself would have otherwise precluded the registration of the domain name. Our expertise with the .eu Sunrise policy and challenge process allowed us to identify a technical error committed by a client's registrar. Our letter to the registrar resulted in the registrar acquiring and transferring the domain name to the client. Similarly, we leveraged our relationship with a validation agent to secure prompt processing of a supplemental document required for the client's .tel domain name. We regularly monitor the ccTLD space to learn of new RPMs and advise our clients accordingly.

IDENTIFYING, MONITORING AND ANALYZING THIRD-PARTY DOMAIN NAME REGISTRATIONS

Our unique, sophisticated in-house technology allows us to identify existing domain names and to monitor newly registered domain names for client marks or other keywords. Depending on each client's individually tailored strategy, we identify, monitor and analyze the domain name for a variety of uses (e.g., direct infringement, fraud, phishing, pay-per-click monetization, disparaging content, adult content), then take action as appropriate according to a threat matrix tailored for each client. Such actions may include continued monitoring, acquisition, enforcement action against the registrant, or simply providing our client's in-house staff with our findings so that they may take the enforcement reins.

As a result of our years of experience and in-house technical capabilities, we have moved beyond the high-cost, "one off" enforcement model and are now uniquely situated to create

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strategies that provide the most efficient and cost-effective solution for each client. For example, our experience and familiarity with core domain resellers and cybersquatters has allowed us to quickly identify and recover large volumes of domain names through a single demand letter. Our reputation as a “we-mean-business” firm results in increased responsiveness to our enforcement actions. We have helped to turn the tide in favor of trademark owners that seek to recover domains registered through domain name proxy services, prevailing in a proceeding on behalf of The American Automobile Association, Inc. (AAA) against a proxy service provider that yielded the successful transfer of 55 infringing domain names – as opposed to having to file more than 30 separate UDRP complaints against the proxy service provider’s customers, on whose behalf the names were registered.

ENFORCEMENT ACTIONS

We use a threat matrix developed and tailored for each client to assess the type and priority of enforcement action to best suit that client’s needs.

In the majority of cases, our carefully drafted demand letters, which are customized for each domain name and registrant, are the only enforcement action necessary to cause the registrant to stop using the name and, where requested, transfer it to our client. Where appropriate, we call upon our relationships with and knowledge about domain name registries and registrars to facilitate the voluntary transfers of infringing domain names to our clients. We have also had success with ICANN compliance complaints about registrars, which in one recent case led to that registrar facilitating the transfer to our client of more than 10 names. We can undertake many of these more routine measures with limited client oversight depending upon our clients’ preferences and needs.

When it is necessary to initiate a proceeding under the UDRP or a lawsuit under ACPA, our team has been extraordinarily successful. We have recovered hundreds of domain names in UDRP proceedings and ACPA actions. As previously noted, we obtained a key decision in a 2009 UDRP proceeding on behalf of AAA, which has given trademark owners a new weapon in their efforts to cost-effectively recover multiple infringing domain names registered through domain name proxy service providers. In addition to AAA, we have handled UDRP proceedings on behalf of numerous other clients, including Borgata Hotel Casino & Spa, LIN Television, National Geographic Society, New Skies Satellites, Ourisman Dodge, and Verizon. Our ACPA expertise includes victories for AAA, Armani, Cartier, and PBS.

As a result of our extensive experience, we have developed a catalogue of legal arguments that we easily adapt for use in connection with a wide variety of enforcement actions at significant cost savings to our clients.

ACQUISITIONS

We have acquired dozens of domain names for clients in circumstances ranging from impending business announcements about new brands to eliminating potential third-party obstacles, to use and registration of a new brand to avoiding the need for an enforcement action. Our acquisition services are provided directly or indirectly through an intermediary, depending on the client’s preference and needs. We call upon our global network of local counsel for assistance in acquisitions of domain names registered to persons and entities located in countries in which we do not have offices, and, for example, recently acquired .in (India) and .sg (Singapore) domain names with Italian counsel’s assistance in negotiating with

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the Italian registrant. Clients for which we have handled domain name acquisitions include AAA, Borgata Hotel Casino & Spa, Echelon Resorts Corporation, National Geographic Society, and Pfizer.

THE TEAM

Our global domain name team includes:

- nearly 15 attorneys experienced with the laws and the practical enforcement considerations applicable to dealing with domain name matters;
- an in-house team of Internet investigators who have many years of experience in conducting complex online monitoring and evidence gathering services for our clients using advanced proprietary online forensic tools; and
- trademark specialist paralegals with extensive experience in assisting with routine monitoring and enforcement matters, and locating, compiling, and analyzing complex factual information necessary to support our domain name services.

This combination enables us to offer a more efficient, comprehensive and effective response to the domain-name related challenges that our clients face.

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