

An issue that has arisen in the past is whether and, if so, the extent to which, holders of trademarks have felt it necessary to register those trademarks as domain names in new TLDs in order to prevent others from doing so. There have been a number of studies of the extent to which holders of major trademarks have engaged in such “defensive” registrations and we present the results of our own analysis of this issue below. However, in evaluating the results of these studies, it is important to note that not all instances of duplicate registrations are necessarily “defensive” in nature. For example, a trademark holder might register the same mark in multiple domains in order to increase the probability that it will be found through user searches, a consideration that has become increasingly important as the number of domains has grown.¹ Nonetheless, it appears that “defensive” registration is a significant phenomenon because many trademark holders apparently feel that the costs of challenging registrations of their marks by others are considerably greater than the costs of registering their marks in multiple domains.

Previous Studies

Krueger and Van Couvering surveyed 1,043 brand names of Fortune 500 companies and found the following registration percentages: (1) 100 % in .com; (2) 76% in .org; (3) 84 % in .net; (4) 69% in .info; (5) 65% in .biz; and (6) 57% in .mobi.² Zittrain and Edelman found that, 6 months after open registration in .biz began, 91 percent of a sample of .biz domain names were also registered in .com, 63 percent were also registered in .net, and 49 percent were also

¹ Consider users that search for web sites by guessing internet addresses. As the number of TLDs increases, finding the “correct” website by guessing becomes more difficult and, on average, the number of required guesses is substantially increased. Faced with this fact, one would expect that some “guessers” would use search engines more frequently than in the past. In addition, some registrants may choose to register in a larger number of TLDs in order to reduce the number of guesses that a user must make in order to find them.

² F. Krueger and A. Van Couvering, “An Analysis of Trademark Registration Data in New gTLDs,” Minds + Machines Working Paper 2010-02.

registered in .org.³ Strategies International analyzed the extent of duplicate name registrations and the presence of the same registered name holder between four of the then-new and three legacy TLDs and found that: “The statistics for .info indicate that only 11% of registrants hold the same name in .com, which suggests that .info has created significant new opportunities. With .biz, 42% of duplicate registrations appear to be registered to the same party, thereby suggesting that they are protective in nature.”⁴ Katz, Rosston, and Sullivan analyzed the overlap in domain registrations for 200 of the top 500 global brands as ranked by Brand Finance and found (at 61) “that a very high percentage of them were registered in the different TLDs” that they examined.⁵ However, they also found “a big range in the share of registered domains with content” and that the percentage of active sites “was quite low” except for .com. Finally, Halvorson et al, who employ a variety of measures to identify matches of registrants between .com and .biz, found “at least some degree of a match for around 40% of the [biz-com] pairs [they] could assess.”⁶ Using what they describe as “stronger indicators” they classified 11.6% of biz domains as “defensive.”⁷

³ J. Zittrain and B. Edelman, “Survey of Usage of the .biz TLD”, <https://cyber.law.harvard.edu/tlds/001/>.

⁴ Strategies International, *Evaluation of the New gTLDs: Policy and Legal Issues*, July 10, 2004, Table 12 – Same Registered Name Holder in .com/.net/.org, at 102 It is important to note, however, that the authors point out that “The data...is based on an extremely small sample of only 100 names for .biz and .info.” This study was prepared for ICANN.

⁵ M.L. Katz, G.L. Rosston, and T. Sullivan, “Economic Considerations in the Expansion of Generic Top-Level Domain Names, Phase II Report: Case Studies, December 2011. These domains were .com, .net, .org, .biz, .info, .mobi, and .us. This study was prepared for ICANN.

⁶ T. Halvorson, J. Szurdi, G. Maier, M. Felegyhazi, C. Kreibich, N. Weaver, K. Levchenko, and V. Paxon, “The BIZ Top-Level Domain: Ten Years Later,” in N. Taft and F. Ricciato (Eds.): PAM 2012, LNCS 7192, pp. 221-230, 2012, p. 228.

⁷ Ibid.

The CCT-RT Analysis

We, together with the Analysis Group, used data from the most recent “round” of gTLD entry to analyze the same issue. Specifically, we began by identifying a number of trademarks for which one might expect some degree of “defensive” registrations together with the identity of the registrant.⁸ We then determined: (1) whether or not the each of these trademarks was registered by the trademark holder in least one legacy gTLD; (2) whether the same string was registered by the trademark holder in at least one new gTLD; and (3) for those strings that were registered by the trademark holder in at least one new gTLD, the number of new gTLDs in which the trademark holder had registered the string. We found that 54% of the strings that were registered in a legacy gTLD were also registered in at least one a new gTLD. We also found that, of these strings, 8 was the mean and 3 was the median number of registrations in new gTLDs.

JORDYN HAS PROPOSED A SEPARATE PROJECT INVOLVING MATCHING STRINGS IRRESPECTIVE OF THE IDENTITIES OF THE REGISTRANTS. I ASSUME THAT HE WILL BE WRITING THAT UP.

⁸ The trademark strings that we analyzed were limited to verified or corrected Latin text strings in the Trademark Clearinghouse. Matches were identified as those involving an exact match in accordance with ICANN’s matching criteria where the registrant was identified as the trademark holder associated with the registered string based on an approximate text comparison between registrant and trademark holder names. DESCRIPTION TO BE CONFIRMED BY ANALYSIS GROUP.