

Domain Name Registrations

Every domain name, or Uniform Resource Locator (URL), must be unique - no two different companies or individuals can use the same domain name. As a result, trademark rights holders often find themselves in disputes with individuals who wrongfully register their trademark as a domain name. Because trademark rights arise from using a word to indicate the source of goods or services, no state or federal trademark registration is necessary for one to have trademark rights. Conversely, parties with little or no trademark rights may wrongfully attempt to force the rightful owner of a domain name to convey that domain name despite the fact that there is little or no legal support for their threats.

Our attorneys are experienced in pursuing those who wrongfully register our clients' trademarks as domain names, and defending those who have been wrongfully pursued. Often, the process begins with a cease and desist letter advising the recipient that, to avoid litigation, the domain name must be transferred within a very short period of time. If the cease and desist letter is not successful in forcing transfer of the domain name, the trademark owner may pursue the issue further, either through arbitration, litigation, or both if necessary.

Whenever one registers a domain name, his or her contract with the domain name registration company requires the individual to comply with the Uniform Domain Name Dispute Resolution Policy (UDRP). The UDRP requires the registrant to submit to a mandatory administrative proceeding in the event that a third party (a complainant) alleges all three of the following:

- (1) The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights
- (2) The person registering the domain names has no rights or legitimate interests with respect to the domain name
- (3) The domain name has been registered and is being used in bad faith

When a complainant files a complaint before any approved arbitration forum, the party that registered the domain name must respond to the allegations in writing within a certain amount of time. Once each side has submitted its arguments in writing, the arbitration panel makes its decision, which is limited to either requiring the domain name to be transferred or refusing to transfer the domain name. Within a certain amount of time after the panel issues its decision, the losing party may file litigation to prove its rights to the domain name.

Because the only remedy provided by the UDRP is to transfer the domain name, many aggrieved parties proceed directly to litigation in court. The court, unlike the arbitration panel in a UDRP, can award money damages, including lost profits, costs, attorneys' fees and even punitive damages, under the applicable trademark law provisions. The court can also enter preliminary or permanent injunctions, which can include requiring transfer of the domain name and prohibiting the losing party from using a domain name or a trademark that is confusingly similar to the other party's trademark.

Our experienced Intellectual Property attorneys provide cost-effective assistance in prosecuting or defending domain name disputes, whether through informal negotiation initiated by a cease and desist letter, through arbitration, or through litigation.



Practice Team

Richard G. Salazar