

# THE RIGHT TO USE



## Guide to Intellectual Property for Domain Names

The domain name system enables users to navigate the Internet by providing a unique identification from which websites can be located and e-mail addresses can be constructed.

- DOES NOT GIVE LEGAL RIGHT TO USE NAME
- DOMAIN NAME MAY INFRINGE REGISTERED TRADE MARK
- CARRY OUT TRADE MARK SEARCH BEFORE USE

# WHAT MAY NOT BE REALISED IS THAT **DOMAIN NAME** REGISTRATION GIVES NO LEGAL RIGHT OR MONOPOLY TO THE USE OF THAT NAME

The domain name system enables users to navigate the Internet by providing a unique identification from which websites can be located and e-mail addresses can be constructed. It operates on hierarchical principles, based around either global top level domains (gTLD's) such as .org, .net, .com and more recently .biz and info, or country top-level domains (cTLD's) such as .uk.

Domain names must be registered and registration is generally administered by one of several registries within the gTLD system or a single registry covering an individual cTLD, usually on a first-come first-served basis. A number of domain name registries have few, if any, restrictions or special requirements for registration. Registration is also usually allotted without any examination as to whether the party concerned is entitled to the domain name in question or whether it infringes anybody else's rights.

#### **Domain Names & Trade Marks:**

A domain name that easily identifies a brand that customers want to find is of

major commercial importance. However, the first-come first-served system of domain name registration has enabled the registration of many domain names that are identical or confusingly similar to established trade marks by people who are not the brand owner. This may be deliberate or accidental but, with over 12 million global top-level domain names alone registered, it is not surprising that many conflicts have resulted.

What may not be realised is that domain name registration gives no legal right or monopoly to the use of that name, and use of the domain name could infringe the trade mark rights of another party who may be able to sue for infringement or take action

under the relevant dispute resolution procedure. Indeed, registering a domain name for sale or lease to the legitimate owner may itself be an offence.

In the US for example, special legislation has been enacted to tackle these problems, whilst in the UK a recent Court case has established that this practice can constitute both trade mark infringement and passing off.

If you are intending to register a domain name, we can assist by conducting appropriate searches and we can provide advice on the potential risks of trade mark infringement. The possibilities of obtaining protection by way of trade mark registration can also be discussed and we would be pleased to help.