

Is it necessary to register your domain name as a trademark?

Domain name is an obvious and important aspect of the use of trademarks, but it has not yet been conferred the same protection: trademark protection is necessary for domain names.

A trademark is a distinctive sign which identifies certain goods or services as those produced or provided by a specific entity.

A trademark grants protection to the registered owner of the mark by ensuring an exclusive right to use that trademark to identify goods or services, or to authorize a third party to use it in return for payment.

A domain name is an Internet IP address identifying a computer site connected to the Internet. Because a domain name may suggest identity, quality and content and creates an expectation about who and what is located at that address, it may be closely related to or function as a trademark.

However, domain names have not been given legal qualification as an intellectual property right, because of the discrepancies over geographical boundaries. Even if some jurisdictions tend to consider that domain names are comparable to distinctive signs due to its ability to identify a person or a company behind them, **domain name registration does not confer the same protection as trademark registration.**

Trademark registration provides the owner of the trademark with a number of effective measures to protect its trademark which could be profitable to domain name holders.

1) Action against counterfeiting

Trademark registration allows the owner to take specific legal action against trademark infringement - an action against *counterfeiting*.

To bring a successful trademark counterfeiting claim, the plaintiff needs to demonstrate a likelihood of confusion and its right in the trademark.

2) Criminal charges

Trademark's registration allows Trading Standards Officers or Police to bring criminal charges against counterfeiters if they use the trade mark without being authorised to do so.

The registration of a domain name creates significant protection but is not tantamount to trademark protection.

3) Possibility to bring a UDRP action

In 1999, ICANN promulgated Uniform Domain Name Dispute Resolution Policy (UDRP). Most domain name registrars now operate a Dispute Resolution Procedure under the UDRP, a procedure that provides an efficient remedy against bad faith and abusive registration of domain names that violate trademark rights.

Under the UDRP, the complainant must show, among other claims, that he has **rights in a relevant mark**¹.

As a result, it is strongly advisable to register a domain name as a trademark. The owner of a domain name can register it as a trademark and give it the same protection as conferred to a registered trademark, provided that the domain name satisfies the same requirements as the one applicable to trademarks and service marks and be used as a source identifier.

For instance, the sign must be distinctive, to enable consumers to distinguish the sign as identifying that particular product or service. The problem with domain names is that they can be descriptive and cannot be registered as trademark.

From a practical point of view, it is preferable to add a logo to the domain name when applying for a trademark registration in order to avoid a lack of distinctiveness.

In addition, a domain name, to be registered as a trademark, must not mislead nor deceive customers or violate public order or morality.

If the requisite requirements are satisfied, a domain name can be registered as a trademark at the Trademark Office. Upon registration, a registered domain name confers the same protection to its registered owner as a registered trademark.

Trademark registration of a domain name gives the domain name holder the exclusive right to use this name in the entire territory covered by the trademark registration, and provide a complete registered trademark protection for this territory.

Therefore, in case of infringement of the domain name, the holder of a trademarked domain name can take, not only the UDRP proceeding and the action against unfair competition, but also the action against counterfeiting in order to claim damages, to obtain remedies such as monetary relief, equitable relief (injunctions), seizures, cost and Attorney's fees.

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¹ Paragraph 4(a) of the UDRP rules provides for "*You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) you have no rights or legitimate interests in respect of the domain name; and (iii) your domain name has been registered and is being used in bad faith. In the administrative proceeding, the complainant must prove that each of these three elements are present.*"