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IP ESSENTIALS

A Toolkit for Entrepreneurs,
Innovators, and Business Owners

DOMAIN NAMES



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A domain name, also known as a domain, is the internet address used by a web browser to access a corresponding website. Well-known examples include google.com and wikipedia.org.

Q *Is it possible to stop someone from registering/using a domain name with my trademark in it?*

A Yes. You may be able to obtain (or cancel) the domain name if you can prove that the domain was registered *and* is being used in bad faith, and that the registrant has no legitimate interest in the domain. In particular, you may be able to file a complaint under the Uniform Domain Name Resolution Policy (UDRP), or by filing a cybersquatting lawsuit. Even if the domain does not incorporate your exact trademark, it may still be actionable if the domain is confusingly similar to your mark.

Q *Do I need to own a trademark registration in order to bring a UDRP proceeding?*

A No. While a federal trademark registration is sufficient evidence to prove in a UDRP proceeding that you own a valid trademark, you can still prove your rights to the mark by providing evidence of your sales and marketing efforts while using the trademark. These “common law” rights are enforceable and arise automatically when you begin using a trademark in commerce.

Q What constitutes bad faith in a UDRP proceeding?

A A number of factors are considered in determining whether a domain was registered and is being used in bad faith, including:

1. Attempting to impersonate another brand;
2. Registering a domain incorporating a brand name in order to direct traffic to that brand's competitors;
3. Providing false information when registering the domain; and
4. Registering a brand-related domain with the intent to sell it to the brand owner or its competitor for a profit.

Q What can I do if someone has registered a domain incorporating my brand name to criticize my business?

A It may be possible to take action against the domain and/or its owner if the content is false or misleading, suggests a legitimate affiliation with you or your company (such as by incorporating your logo), or is being done for a commercial purpose (such as to steer visitors to a competitor's website). If the claims made on the website (or in the domain) are true (or cannot be proven false), or are simply a statement of opinion, the registrant may be protected on the grounds of free speech. A legitimate parody or other social commentary may also be protected.

Q What is a privacy service and what are the advantages and disadvantages to using one?

A Typically, registering a domain name requires you to provide identifying information which is made public such as your name, address, and email address. A privacy service may be used for a small fee to register your domain name using an intermediary in order to conceal your real identity. While the advantages of this privacy are obvious, it is worth noting that using a privacy service (or worse, providing false information) may be viewed as evidence of bad faith in a UDRP proceeding.

Q Does registering <mybrand>.com protect my brand name as a trademark?

A Not necessarily. Registering a domain name does not by itself create any trademark rights. However, using your trademark for commerce—which includes in the content of a website—may create common law rights that protect your trademark.

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Q *In what top-level domains (TLDs) should I consider buying a domain name?*

A While .com and .gov are among the more well-known, there are currently over a thousand top-level domains. Consider strategically buying domain names to use while operating or marketing your business. You may wish to buy country-specific domain names in countries where you operate (such as .co.uk in the United Kingdom, or .cn in China). Defensively buying domain names to prevent others from buying them may be beneficial in specific circumstances, but it is impossible and cost-prohibitive to buy every variation of your brand name.

Q *Is it beneficial to have multiple domains for my business?*

A Maybe. You may wish to have some secondary domains redirect to your main website to capture variations in how visitors find your site. (For example, secondary domains “newyorktimes.com” and “nyt.com” each redirect to the primary domain “nytimes.com.”) Or, you may want to register domains for particular country-TLDs where you operate and create country-or language-specific websites which would cater to your audience in that country or language.

Q *A domain registrar has written to say that someone is trying to register a domain name with my trademark but I can buy the domain first. Is this legitimate?*

A Usually not. Domain registrars generally do not research third-party trademark rights before registering a domain, so offers like this are typically solicitations intended to extract payment. Often, there is no third party trying to buy the domain. If such a domain is registered, it is best to monitor how it is used and consider bringing a UDRP action if necessary. And if the domain they are asking about is of interest to you, it can often be obtained through a reputable registrar.

Q *Can I register my full domain name as a trademark?*

A Possibly. If you use the full domain name in your marketing efforts, you may be able to register the full domain as a trademark. In a 2020 U.S. Supreme Court decision, the Court held that while the word “booking” was generic (and therefore not a trademark) for travel booking services, the domain name “booking.com” was *not* necessarily generic and could function as a trademark. Other trademarks registered since that decision include “sexyshoes.com” (for retail store services featuring “sexy footwear”) and “dunegear.com” (for off-roading vehicle accessories).

This IP Essentials Topic is one of a series:

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