

Synergism: Domain Name Registrations and Trademark Registrations

In the legal world, lawyers often take action in order to obtain a known benefit. Sometimes, one action is beneficial to another action. Fewer times, there is a mutual benefit between two actions such that synergism results. As further described below, when a mark is registered with the U.S. Patent and Trademark Office and the mark is also the subject of a domain name registration, the resulting benefit is greater than the sum of its parts.



Companies that offer services or sell goods have marks. The question is whether the marks are registered or not. Accordingly, a company can decide to protect those trademarks proactively or to wait until they are exploited unfairly by another, then take action to clean up the mess. With regard to the use of marks on the Internet, protecting and enforcing rights must be handled proactively. It is just too easy for another to exploit a company's marks and then to attempt to disappear without consequence. It is important to obtain U.S. trademark registrations for at least the primary marks. As further noted below, the registrations also have value relative to domain name registration and use.

As 2011 approaches, it is fair to say that a company's portfolio of domain name registrations is as important as its portfolio of trademark registrations. In this wireless and Internet-driven society it is mandatory for a company to have a portfolio of domain name registrations consisting of its brands, in addition to misspellings, and other domain name registrations that "add to" the base domain name registrations, such as the addition of descriptive wording related to the goods or services offered. The logic is simple: If the company owns the domain name, a competitor does not. That is the best way to stop others from exploiting domain names unfairly. A company can obtain top-level domain name registrations for a nominal fee for each registration.

The steps that need to be taken to obtain a domain name registration may be performed by anyone with an Internet connection; sophisticated knowl-

edge of computer details is no longer needed. It is important, however, to have a detailed plan for using and maintaining such registrations. Elements of trademark law come into play when selecting a domain name for registration. Accordingly, it is preferable to know how the Web page (the content to be provided at the domain) will be used. A real opportunity is available to be creative and develop branding that is unique and not just merely descriptive of a company's goods or services. Doing so at the outset will allow the registration of a unique ".com" domain name in addition to the other available extensions (.us, .tv, and so forth). In most cases, the domain name will be the mark followed by an extension (.com, .us, .tv, and the like).

From a strategic perspective, domain name registrations and trademark registrations strengthen each other. The best thing a company can do is to identify its basic marks and obtain a U.S. trademark registration and a domain name registration for each. First, the U.S. trademark registration is evidence of ownership of the mark. That is a key issue in disputes involving domain names. For example, in such a dispute, showing ownership of a trademark may be as simple as offering an affidavit by an officer of the company in order to introduce the U.S. trademark registration into evidence. If the disputed domain name is identical or confusingly similar to the previously existing trademark registration, then the first of three prongs of proof is complete. The remaining two prongs to be proven in a dispute over domain names include whether the current owner of domain name has a legitimate interest in the domain name and whether the domain name was registered in bad faith and is being used that way. The remaining prongs are complex and fact-dependent. That said, it is important not to overlook the first prong. The number of companies that do not have trademark registrations when they are needed for a dispute over a domain name is surprising.

So, what happens when a domain name is disputed? A complaint is filed under the Uniform Domain Name Dispute Resolution Policy (UDRP). Then, the respondent may respond to the complaint, voluntarily transfer the domain name registration, or take no action. By taking no action, a decision will be reached based on the information provided in the complaint. In advance of filing a UDRP complaint, sending a notice letter referencing a U.S. trademark registration



may often result in the voluntary transfer of a domain name registration. Either way, it is far more expensive not to be proactive and subsequently to have to forcefully remove a portfolio of domain name registrations from a variety of registrant owners by use of various measures.

The ownership and use of domain name registrations is beneficial to U.S. trademark registrations. Each domain name (such as www.wyattfirm.com) displays content that provides a platform for displaying trademarks and descriptions of the goods or services offered by a company. When maintaining existing U.S. trademark registrations, it is common to submit a printout of a Web page to the U.S. Patent and Trademark Office as a specimen of proper trademark use for a service mark. Furthermore, as a company's marketing slightly changes or is modified, it is easy to

update or alter such a Web page.

Without question, it is difficult to anticipate all domain names that are confusingly similar to a company's mark. Knowing that, a company must still attempt to be proactive in the protection of its marks. One way to do so is to make use of the synergism resulting from the combined ownership of domain name registrations and U.S. trademark registrations.

TFL

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MESSAGE *continued from page 3*

Our Chapters, Sections, and Divisions are the backbone of this Association, and our Members are its heart. Together we can ensure that the FBA's vision is realized and that the FBA is recognized as the premier bar association serving federal practitioners and the judiciary. I am honored to become your National President and to be part of the champion-

ship team that will work to increase the visibility, relevance, and value of our membership. **TFL**



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dispute.

Model contract language to incorporate the civil litigation prenuip into contracts is available for download at no cost for lawyers and companies at www.cpradr.org, the Web site of the International Institute for Conflict Prevention & Resolution, a nonprofit organization. The use of litigation prenups in business contracts will help bridge the practices of corporate lawyers, who draft business agreements, and trial lawyers, who litigate the disputes arising from those

agreements. The potential savings of costs, time, and human resources have encouraged several major companies to take a hard look at the economical litigation agreement as the newest tool available to American businesses. It is a tool whose time has come. **TFL**

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job relatedness, validity, and business necessity and the petitioners' rebuttal that less discriminatory alternatives were available but not adopted").

¹⁵*Lewis v. City of Chicago*, 528 F.3d 488, 491–492 (7th Cir. 2008).

¹⁶*Id.* at 491.

¹⁷*Lewis*, *supra* note 1, at 2197 (citing Title VII, 42 U.S.C. § 2000e–2(k)(1)(A)(i)).

¹⁸*Id.* at 2198.

¹⁹*Id.*

²⁰*Id.* at 2198 (citing *United Air Lines Inc. v. Evans*, 431 U.S. 553 (1977)).

²¹The city relied on *Ledbetter v. Goodyear Tire &*

Rubber Co., 550 U.S. 618 (2007), *Lorance v. AT&T Technologies Inc.*, 490 U.S. 900 (1989), and *Delaware State College v. Ricks*, 449 U.S. 250 (1980).

²²*Lewis*, *supra* note 1, at 2199.

²³*Id.* at 2198–2199.

²⁴*Id.* at 2199.

²⁵*Id.*

²⁶*Id.* at 2199–2000.

²⁷*Id.* at 2200.

²⁸*Id.*

²⁹*Id.*

³⁰*Id.*