



Trademark and Domain Name Co-Dependence

Trademark registration is critical in protecting your domain name. Trademarks are words, phrases, or graphics that serve as "source identifiers" for specific goods or services. More commonly, trademarks are "brand names" or logos identifying a brand. Domain names are internet website addresses.

The Internet Corporation for Assigned Names and Numbers, (ICANN), the entity responsible for managing top-level domain names, has announced it is about to release 2,000 additional "Generic Top Level Domains," (gTLD's). Most are familiar with ".com" and ".net" and ".org", and perhaps even ".gov" and ".us" and ".tv". However, what ICANN is planning now is going to open countless new possibilities.

For example, Bank of America could obtain the domain name www.BankOfAmerica.bank instead of [.com](http://www.com). Amazon is attempting to obtain www.Amazon.book. Google is said to be attempting to obtain www.Google.search. What could it all mean to you and your brand name and identity on the internet?

The internet and the readily available comprehensive search engines such as Google, Bing, and Yahoo, cultivate and facilitate a great deal of angst amongst brand owners. Many brand owners conduct frequent internet searches and find unauthorized, third-party uses of prized names and trademarks. Frequent inquiries come to this office seeking redress of these unauthorized uses.

The only reasonable answer lies within the Trademark Act, known as the Lanham Act. The "Lanham Act" was named and enacted in 1946 in honor of Representative Fritz G. Lanham of Texas. Then to keep up with technology, in 1999 Congress passed the Anticybersquatting Consumer Protection portion of the Lanham Act.

The Anticybersquatting Act provides that a "trademark owner" may bring a cause of action against a domain name registrant who has a bad faith intent to profit from the mark and registers, traffics in, or uses a domain name that is identical or confusingly similar to a distinctive mark. The importance of being a "trademark owner" become apparent. Owning a trademark registration typically streamlines the work of removing an objectionable domain name. There are, however, considerations to keep in mind.

First, the law provides that the domain name must be "confusingly similar" to a distinctive mark. Given that domain names are comprised of letters and numbers only, then having a design logo registered as a trademark is not going to be as helpful as having a standard character word mark registered.

The Lanham Act allows a trademark owner to register both a design mark (a logo), or a standard character word mark. A design mark may be any combination of words, letters, numbers, plus any graphic design. It can also be just a design, as is the

case with the famous Nike "swoosh" mark, often referred to as a "check mark" design. A "standard character word mark" is words and numbers only, with no claim to any specific font, color, size, capitalization, or other type-set variants. A standard character mark is thought to be applicable to any way the subject mark is displayed, wherein a design mark must be displayed exactly as it is shown in the registration.

Domain name owners should be concerned now since ICANN is about to open up 2,000 new Top Level Domains. This means there will soon be at least the ability for scrupulous people to attempt to grab up popular names as domain addresses using the new extensions.

ICANN did provide for a trademark clearinghouse which initially sounded exciting, having the prospect of built-in prevention against domain name piracy. However, as it turns out the clearinghouse is only a notice list, and does not become involved with any real prevention and certainly not enforcement. It is perhaps better than nothing, but a cyber pirate is still able to purchase an infringing domain name and a trademark owner must still use self-enforcement policing methods much as is already required.

And, because the Anticybersquatting Act uses the "identical or confusingly similar" standard in comparing objectionable domain names with trademarks, then the closer your trademark reflects the domain name, the better. If the only registered trademark you have incorporates a design element, then that design element could serve to differentiate your trademark from the objectionable domain name, which can only be letters and numbers. Inversely, if one has a standard character word mark registered and then the same cyber pirate registers even an intentionally misspelled domain name, (one or two letters off), and using one of the new Top Level Domain extensions, the "confusingly similar" standard would likely prevent that.

ICANN has enacted a "sunrise" period that is intended on allowing trademark owners an uninhibited opportunity to purchase up new domain names using new Top Level Domain extensions, without having to compete with the "general population." If you are a trademark owner, you may wish to take advantage of this opportunity and buy up some new domain names reflecting your trademark.

If you do not have your brand names registered as trademarks, or if you have only design marks registered, now is the time to re-evaluate your trademark portfolio protection. Certainly, at a minimum, it would make sense to file new applications to re-register your previous design + word marks into strictly standard character word marks, (minus the design).

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