



The Institute of
Trade Mark
Attorneys

5th Floor, Outer Temple
222-225 Strand
London WC2R 1BA
Tel: 020 7101 6090
Fax: 020 7101 6099

Trade Marks and Domain Names

Set out below are a number of frequently asked questions about the interaction of trade marks and domain names. The issues involved can be, and often are, complex and all cases turn on their specific facts. Moreover, the law in this area is constantly evolving. The FAQs can therefore only be considered to provide the most general of pointers and you should seek professional advice from an ITMA member on any given case.

I have registered my domain name and so I have already protected my name. Why bother registering a trade mark?

The mere registration of a domain name does not provide you with any enforceable intellectual property rights and so will not allow you to prevent third party use. The easiest and most secure way to get enforceable rights in your mark is to register it.

If I have a domain name registration, is that a defence to infringement?

No. Whether you can use (or indeed in certain circumstances register a domain name) depends on the intellectual property rights of third parties, in particular trade mark rights. If you are using the same mark for the same goods and services or what you are doing is likely to give rise to a likelihood of conflict, then your domain name registration is not a defence to infringement, even if you registered the domain name in good faith or were unaware of those earlier rights.

I have a trade mark registration but the corresponding domain name has been registered to a different company who is not using it actively. Can I sue the domain name owner or take any other action to try to obtain the domain name?

It depends on the particular facts of the case but the answer is generally no. If a mark is particularly famous and consumers would consider that the domain name could, realistically, only be used in good faith by the owner of the corresponding trade mark (for example, coca-cola.co.uk, microsoft.com) then it may be possible to force the transfer by way of legal action for "passing off" or trade mark infringement. Similarly, if bad faith on the part of the domain owner can be shown (for example it has registered your mark and those of several other competitors as "blocking" domain names), then it may be possible to force the transfer of the domain name through the dispute resolution procedures offered by WIPO and other national registries for top level domains e.g. Nominet for UK domains. However, if the domain name simply replicates your mark but is capable of genuine good faith use by an unrelated party, it is generally not possible to force the transfer of the mark. These sorts of cases require careful consideration of the material facts and you are advised to seek appropriate professional advice from an ITMA member.

I have a registered trade mark but another company has registered and is using a domain name incorporating or replicating that trade mark. Can I stop them?

The first thing to consider is whether the other company is using the domain in the jurisdiction in which you have enforceable rights. If you have a UK Registration but the owner of the domain name is a company based in a different jurisdiction with no market presence in the UK, it is generally not possible to take action.

The second thing to consider is the way in which the other party is using the domain name. If it is being used for different goods and services (for example the other party is a firm of architects and your registration is for clothing), then there is no likelihood of confusion in practice and, absent special circumstances, you are unlikely to be able to take any action to prevent the use and registration of the domain name.

If, on the other hand, the third party is using the domain name to provide the same goods and services under the same mark and in country where you have rights, this is likely to constitute infringement. Again, you are advised to seek professional advice in this type of case.

If both parties have the same trade mark but for different goods and services, which has the better rights to the domain name?

In principle, neither party has the better rights, even if one of the parties is better known than the other. The party who registers first (domain names are allocated on a "first-come-first-served" basis) gets to register the domain name. This happens very often in practice. The domain name polo.com is registered by Ralph Lauren whereas Volkswagen is the owner of polo.de.

For more information [click here](#) for a fuller explanation of domain names and the domain name system.