

Trademark Law as it relates to Domain Name Registration

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Many people mistakenly believe that registering a domain name is as simple as finding one that is available and paying the registration fee. While a person may be able to register a domain name because it's available, it's up to the person registering the name to perform due diligence in making sure he/she is not infringing upon a trademark.

What is a trademark? The United States Patent and Trademark Office (USPTO) defines a trademark or service mark as "...a word, phrase, symbol, or design, or a combination of words, phrases, symbols or designs, that identifies and distinguishes the source of the goods of one party from those of others."

The Internet Corporation for Assigned Names and Numbers (ICANN) was formed in 1998. One of the things ICANN deals with is the issue of domain name ownership resolution. In cooperation with the World Intellectual Property Organization (WIPO), a policy called the Uniform Dispute Resolution Policy (UDRP) was established. The UDRP states "...2. Your Representations. By applying to register a domain name, or by asking us to maintain or renew a domain name registration, you hereby represent and warrant to us that (a) the statements that you made in your Registration Agreement are complete and accurate; (b) to your knowledge, the registration of the domain name will not infringe upon or otherwise violate the rights of any third party; (c) you are not registering the domain name for an unlawful purpose; and (d) you will not knowingly use the domain name in violation of any applicable laws or regulations. It is your responsibility to determine whether your domain name registration infringes or violates someone else's rights."

This means the responsibility for ensuring the domain name being registering does not infringe or violate someone else's rights is placed solely upon the registrant. GoDaddy.com will gladly take your money, even if you are purchasing something you have no legal right to use! Let the buyer beware.

Getting back to trademark law, the first and continuous user of a trademark is considered the owner of it under common law. So, even though a trademark may not actually be registered, it is still protected under law. While laws vary slightly from state to state, the first and continuous user is generally considered the owner of a given trademark. A trademark is not necessarily a symbol, although that is what we commonly think of. Words can also be considered a trademark, e.g. Cape Cod Potato Chips. This is why domain name registration needs to be approached with caution and due diligence.

Section 12 of Massachusetts General Laws, Chapter 110H states:

"Subject to section 16, a person who shall:-

(i) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of a mark registered under this chapter in connection with the sale, distribution, offering for sale, or advertising of any goods or services on or in connection with which the use is likely to cause confusion or mistake or to deceive as to the source of origin of such goods or services; or

(ii) reproduce, counterfeit, copy or colorably imitate the mark and apply the reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale or other distribution in the commonwealth of such goods or services; shall be liable in a civil action by the registrant for the remedies provided in section 14, except that under clause (ii) of this section the registrant shall not be entitled to recover profits or damages unless the acts have been committed with the intent to cause confusion or mistake or to deceive."

Further, continued use of a trademark by a competitor would tend to confuse the public and to divert customers away from the business of the trademark owner and is an unfair trade practice, as defined in

Massachusetts General Laws, Chapter 93A. This may subject the infringer to liability for damages and attorney fees, as well as injunctive relief as provided for under Massachusetts state law.

These laws are complex, so it's a good idea to retain an Intellectual Property Attorney before registering a domain name.

Reference List

1. United States Patent and Trademark Office http://www.uspto.gov/trademarks/basics/trade_defin.jsp (09/2011)
2. Internet Corporation for Assigned Names and Numbers <http://www.icann.org/en/dndr/udrp/policy.htm> (09/2011)
3. The 187th General Court of The Commonwealth of Massachusetts <http://www.malegislature.gov/Laws/GeneralLaws> (09/2011)