

## Domain name registration as a trade mark

- 1. Make your domain name a trade mark.....1
- 2. Requirements for registering a domain name as a trademark.....1
- 3. Relevant class of goods and services.....1
- 4. Benefits of domain name registration as a trade mark.....2

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### **1. Make your domain name a trade mark**

Internet domain names play an increasingly important role in electronic commerce. They often have significant economic value for an undertaking that conducts its activity online, especially when they not only show the Internet users how to find the company on the Internet, but also identify and advertise goods and/or services offered via a particular website. A domain name that is distinctive and easy to remember might be an important asset for an undertaking, provided that it is sufficiently protected. However, because the mere registration of a domain name creates neither an exclusive right to it nor any *sui generis* protection of the domain name 'as such', it is advisable to seek protection of a domain name by other legal means, specifically through its registration as a trade mark. Traditionally, registration of a trademark is considered by an enterprise to be a very effective method of legal protection for a commercial sign.

### **2. Requirements for registering a domain name as a trademark**

As shown by the practices of European national patent offices, signs having the form www.xyz.com represented graphically might be registered as trademarks or service marks. However, only those domain names that are used as trade marks are eligible for trademark protection, that is to say only those identifying a web site as a source of origin of particular goods/services are eligible for trade mark protection. A domain name must therefore be perceived as an indication of source and not merely as an informational indication of the domain name address used to access a web site. Domain names that merely serve to identify the location on the Internet where the web site is located and do not separately identify products or services, as well as e-mail addresses that only refer to the e-mail box of a particular user on a server, cannot be registered as a trademarks.

Applications for the registration of marks consisting of domain names are subject to the same requirements as all other applications for trade mark registration. However, there are special issues that commonly arise in the examination of domain name mark applications.

In order to be registered, a domain name, like any other mark, must have a sufficiently distinctive character. The following types of domain names are considered to lack a sufficient distinctive character: 1) not capable of distinguishing, in trade, the goods for which the mark has been applied, 2) consisting exclusively or mainly of elements that describe the features of the identified product or service, 3) consisting of signs that have become customary in the current language. When a trademark is composed, in whole or in part, of a domain name, neither the beginning of the URL (http://www.) nor the Top Level Domain (TLD) have any distinctiveness. Instead, those designations are merely devices that every Internet site provider must use as part of its address. The average person familiar with the Internet recognizes the format for a domain name and understands that "http," "www," and a Top Level Domain extension are a part of every URL.

### **3. Relevant class of goods and services**

One of the practical problems with trade mark registration of domain names is the proper determination of the class (classes) of goods/services for which it should be applied. In that regard, a register of goods/services prepared for each class of Nice classification might be helpful, and

would also consist of goods/services pertaining to the Internet and on-line technologies. Moreover, the following guidelines should be taken into consideration when preparing an application for trademark registration:

- management of the web site that is merely used as a promotional and informational tool cannot be qualified as an independent service,
- providing services through the Internet is not necessarily a telecommunication service for which class 38 is relevant. This class includes only: e-mail services, providing access to the Internet (service providers), providing telecommunication access to a database, and/or transmitting information electronically. It does not include creating, maintaining or hosting websites which are in class 42,
- network content providers should apply for a trademark in the form of domain names in a class corresponding to services rendered in connection with such a domain name, e.g. for *home banking*, a mark should be applied for in class 36 etc.
- because of the specific character of the Internet, the publication of books and magazines on-line should be qualified not as 'offering paper materials' in the Nice class 9, but as 'offering publication *on-line*', for which class 41 is relevant.

#### **4. Benefits of domain name registration as a trade mark**

Due to a lack of protection of a domain name 'as such', registration of the domain name as a trademark should be considered the most effective way of ensuring legal exclusiveness over a domain name throughout the territory of the country where the trademark right was granted. The holder of a trade-marked domain name might prevent unauthorized third parties from using an identical or similar mark, including other domain names for products or services identical or similar to the ones under the registered mark, provided that there is a likelihood of confusion on the part of the public. Under the right to a registered trademark, the holder of a trademark may also protect a domain name against third party use of similar domain bringing unjustified advantage to the user or being detrimental to the distinctive character or the repute of the domain name.

As an IP asset of a company, a trademark right can be commercially exploited, for instance, by concluding licensing agreements allowing a third party to use a trade-marked domain name for a license fee. The right to a trademark might also be used as a non-cash contribution.

Finally, a domain name used as a trade mark might ensure visibility of a company on the on-line market and facilitate communication with the Internet users.