

### Domain Names

The importance of trade marks is being increasingly highlighted by the rapid growth in use of the Internet. This sheet explains the process and some issues that you may encounter in choosing your own domain name, and the impact that other parties may have on your trade mark in their choice of domain names.

#### INTRODUCTION

Domain names are issued on a first-come, first-served basis by various Internet registration authorities.

Each domain name registered must be unique but may be very similar to another domain name. In most countries (including

the UK) there is at present no limit on how many domain names may be registered by an organisation, but there may be other requirements or limitations.

#### Should I be concerned about registering a domain name?

If you wish to use e-mail or have a website with an address which is identifiable with your business, then you will require a domain name. The act of registration stops someone else obtaining the same domain name thereby preventing you from having it, and so keeps your options open for the future.

You may also wish to register domain names similar to your main trade mark(s) in order to prevent others doing so.

This, however, is difficult to do comprehensively and is explained in more detail below.

#### Where can I register?

There are several levels of domains in which your domain name may be registered and many different organisations deal with registration:

1. Generic Top-Level Domains (gTLD's).  
There are currently five of these internationally agreed domains and they have the designations **.com**, **.gov**, **.edu**, **.org** and **.net**. Seven more gTLD's are proposed to be introduced.  
  
The **.com** domain is usually the one of interest to most businesses, and the registration requirements are administered by an organisation called the Internet Network Information Centre (InterNIC).
2. National Top-Level Domains (nTLD's).  
Most countries each have an nTLD and typically these

have designations such as **.uk**, **.de** and **.fr** (for the UK, Germany and France respectively). There are currently over 160 national domain name issuing authorities, known as Network Information Centres (NIC's), and each has its own requirements and fees.

Most nTLD's are usually divided into a number of subdomains; these subdomains typically relate to the type of organisation which may own domain names in them. In the UK, examples of these are **.ac.uk** (for academic institutions), **.co.uk** (for businesses) and **.ltd.uk** (for limited companies): there are also others available. In the UK, Nominet UK Limited administers the top-level domains and subdomains.

A domain name registered by you under one of these top level domains is called a second level domain.

#### Where should I register?

As mentioned above, under most TLD's there is usually no limit to the number or type of domain names which you may register. Which you will go for will therefore depend on your reasons for registering: is it simply to have a domain name to use yourself, or is it to stop others using a domain name similar to one of your trade marks?

If you only want a domain name to use yourself, then it is usually simplest and cheapest to register in your own country. However, if your aim is to have "pre-emptive" registrations of your main trade mark(s), then the options are virtually infinite and all that you can realistically do is to select the most desirable domains and register under those.

Which these are will depend on your circumstances but, for most businesses, the .com domain and the relevant nTLD's of your main trading jurisdictions are generally considered to be the most desirable.

### How similar may a domain name be to another domain name?

The domain name(s) you choose may be almost (but not exactly) identical to any other registered domain names. Similarly, of course, someone else may register a domain name which is almost (but not exactly) identical to yours. This is the reason why it is practically impossible to register as domain names all possible variations of even one trade mark.

For example, we have registered **mewburn.com** and **mewburn.co.uk**. However, someone else could still register **mewburn.org**, **meburn.com**, **mewburn.co.de** or **mewburnellis.com**.

Someone could even register **burn.com** and use it in the form **mew.burn.com** – the possibilities are endless and it is impossible to cover them all.

### How do I register?

To register a second level domain (e.g. **mewburn.com**) in a gTLD such as .com requires the submission of an application to InterNIC and payment of a fee to Network Solutions, Inc (NSI). However, in order for the chosen domain name to be registered, the IP address corresponding to the domain name must also be set up on a computer permanently connected to the Internet. For this reason, Mewburn Ellis does not handle the registration of domain names and we advise you to contact an Internet service provider (ISP).

If you are purchasing other services (e.g. an e-mail account or space for a web page) from the Internet service provider, they will often make only a small or even no charge themselves for setting up the domain name and posting a temporary web page. Typical charges may be in the region of £100-£200 + VAT per domain name, with annual renewal charges in some cases.

To register a domain name under one of the nTLD's or, as in the UK, in a sub-domain such as .co.uk, requires an application to the relevant NIC. In the UK, this is Nominet UK Limited. Some countries impose requirements for registration: for example, that an applicant has a business presence or trade mark registration in the chosen country. At present, the UK has no particular requirements or limitations and the official fees are around £40 + VAT per domain name.

Once you have registered your chosen domain name(s), you should be aware that some domains require the payment of renewal fees and/or that a domain name be kept in use in order for its registration to remain valid.

### Somebody is using "my" trade mark as a domain name

If you find that someone else is using one of your trade marks as part of a domain name, then it may be possible to have the

domain name cancelled by applying to the relevant domain name registration authority and/or the relevant national court(s). Success will depend on many factors, such as how close the domain name is to your trade mark, which goods/services are sold in relation to the domain name, whether your trade mark is registered and the position under national trade mark law.

However, caution must be exercised due to the international nature of the Internet. Even if someone else is using a domain name which is identical to a mark which you use (and/or have registered), it is still possible that their use of the name may be entirely legitimate.

It is accepted under trade mark law that someone else may legitimately own the same trade mark as you but in a different country and/or for different goods or services. In such a case, if the other party used "their" trade mark as a domain name, that might nevertheless be a legitimate use although their domain name is then accessible from most countries of the world. This is at present a grey area of the law.

The precise procedure for challenging an existing domain name registration will vary depending on the relevant Internet registration authority and the countries concerned. Also, national trade mark laws and practice relating to these matters are still developing. We can advise and assist you in taking the necessary action.

### Someone is using "my" trade mark in their website

This is nothing to do with the Internet registration authorities and currently is also nothing to do with the Internet service provider who "hosts" the website (although in cases of blatant infringement an Internet service provider can sometimes be persuaded to take limited action). Instead, whether or not you can stop this use of your trade mark will depend on national trade mark law.

Your case should be stronger if you have registered your trade mark.

However, a practical problem may again arise by virtue of the international nature of the Internet and world wide web (www).

In practice, the website in question could be physically located in almost any country of the world and can then be accessed from almost every other country.

As explained above, the same trade mark may be owned by different people in different countries and legitimate use of a trade mark in one country may infringe someone else's rights in another country, and vice-versa.

In most countries, the law is such that it is currently not certain how to determine where the trade mark infringement is taking place and therefore where you can bring legal action to stop it.

Again, we can advise and assist you on this.

### Monitoring the internet

If you are concerned about possible misuse of your trade mark(s) by others on the Internet, then you may wish to use some or all of the various monitoring services which are available.

A comprehensive audit service is available which provides details of current relevant uses of your trade mark(s) on the Internet (in web pages and domain names) and we can advise on the results. The approximate cost of this is at least £4500-£6000 + VAT.

A watching service is also available which provides details of uses of your trade mark(s) on the Internet (in web pages and domain names) over, for example, a 12-month period and, again, we can advise on the results.

The approximate cost of this is at least £1500-£2000 + VAT per year. A monthly domain name-only watching service is available for around £200-£300 + VAT per jurisdiction per year.

Given the currently undecided relationship between national trade mark rights and use of marks and names on the Internet, it is likely that it would be difficult to give you definitive advice based on the results produced by the above searches. Depending on the nature of the results, further investigations are likely to be necessary and this would, of course, add to the cost although we would keep you advised of this and discuss it with you. We can provide more details of these, and other, monitoring services on request.

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