

MARKS & CLERK

Intellectual Property

Domain Names

a short guide





Domain Names - a short guide

What is a Domain Name?

A domain name is simply an address that will enable a third party to access a particular site on the World Wide Web. As domain names do not have to be simply numeric, it is possible to adopt a domain name that consists of, or includes, a trade mark. However, a domain name should not be confused with a trade mark, especially when it comes to the question of registration.

Should I register my Trade Mark as a Domain Name?

If you do not intend to use your trade mark as your domain name then there is no real purpose in registering the trade mark as a domain name. If you do intend to use your trade mark as your domain name then the answer is, yes. However, it is more important to have your trade mark registered in the countries where you are trading.

Should I register my Domain Name as a Trade Mark?

Quite simply, yes. However, we would only advise including the designation ".com" or ".co.uk", for example, if you are genuinely using the entire domain name as a trade mark. If the domain name is used solely as the address of the web site, we would recommend only registering the distinctive element of the domain name i.e. "marks-clerk" and not "marks-clerk.com".

How do I go about registering my Domain Name?

The first step is to undertake a search to establish whether the domain name is available for registration. A normal search will simply indicate whether or not the identical name has already been registered in that jurisdiction. It is possible to undertake a more comprehensive search to establish whether similar names have been registered in the same or other jurisdictions.

If the search is clear, you should reserve the new name with the appropriate registry. It is necessary to provide details of the person or

company in whose name the domain name is to be registered, including contact details. Upon payment of the necessary fee, the domain name is registered and a certificate issued.

How long will my domain name registration last?

In most countries the name is, initially, registered for two years. It must be renewed at the end of that period and annually thereafter.

What if I forget to pay the renewal fee?

If the renewal fee is not paid, the domain name becomes available for others to register on a "first come, first served" basis. Marks & Clerk will undertake, without obligation, to notify you when the domain name becomes due for renewal and to effect payment of the renewal fees on your behalf.

Can I transfer my domain name to someone else?

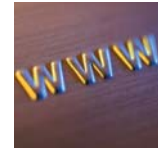
Yes, a domain name may be transferred or assigned. The transfer is effected once you provide the domain name registry with the details of the new owner, they will then issue a fresh registration certificate. However, in some jurisdictions a transfer can only be effected by simultaneously cancelling the existing registration and filing a fresh application for registration. If the two actions are not co-ordinated there is a theoretical possibility that a third party might reserve the name in the intervening period.

If there is a dispute regarding ownership of my domain name do I have to go to court?

Not necessarily. Most domain name registries now operate a Dispute Resolution Procedure that is relatively quick and is cost-effective.

Will my domain name protect me in other countries?

No, domain names are granted by "national" registries and are effective only in that country. Registration at one registry does not provide any



priority for registration in other jurisdictions.

Can I register my domain name in other countries?

Generally, yes. However, in some countries it is necessary to have a local company or a real and effective place of business in that country before a domain name will be granted. It can add considerably to the cost of obtaining and maintaining a domain name, if it should be necessary to set up a local company to "own" the domain name in any particular country.

How do I register my domain name in other countries?

Assuming it is not necessary to incorporate a local company, the registration procedure is similar in most countries. The name is reserved and, once the fee is paid, the registration is granted.

What if someone else registers my trade mark as a domain name?

The activities of so called "Cybersquatters" are being gradually restricted. Generally, such activities can be curtailed if appropriate trade mark registrations are in place. It is more problematic when a legitimate business wishes to adopt a domain name that is the same or similar to your trade mark. The outcome may depend on whether the other company is involved in a similar business or whether they trade in the same jurisdiction. The trade mark rights of both companies may also be a determining factor.

Is there anything else I should consider?

With the increasing importance of the Internet in all aspects of business and the expected growth in e-commerce, it is important to ensure that your business is in a position to meet these challenges. We recommend the adoption of a domain name registration strategy as part of an overall trade mark registration strategy. You should consider undertaking an audit of your trade marks and domain names.

How can Marks & Clerk help?

With over fifty partners and 300 staff, we serve a client base ranging from the private individual to the largest multi-national corporations. Voted the UK's No. 1 firm of both trade mark and patent attorneys* for 6 years in succession, we have the experience and expertise to assist you in obtaining, maintaining and exploiting your domain names.

We can:

- Advise on whether a domain name can be registered and used
- Carry out searches to establish availability of domain names and possible infringements
- Handle the registration of domain names in the UK and abroad
- Advise on issues such as amendment, validity and infringement
- Undertake an audit of your intellectual property rights
- Help you to formulate a domain name and trade mark registration strategy
- Handle alternative dispute resolution procedures with the appropriate authorities (ICANN)

* *Managing Intellectual Property* magazine surveys over 3000 intellectual property professionals worldwide.

MARKS & CLERK

Intellectual Property

For a free no obligation discussion about how we can help, please contact us at one of our offices: -

UK OFFICES

LONDON

57-60 Lincoln's Inn Fields
London
WC2A 3LS
Tel: +44 (0)20 7400 3000
Fax: +44 (0)20 7404 4910
Email: admin@marks-clerk.com

BIRMINGHAM

Alpha Tower
Suffolk Street
Queensway
Birmingham
B1 1TT
Tel: +44 (0)121 643 5881
Fax: +44 (0)121 606 4766
Email: birmingham@marks-clerk.com

BRISTOL

Aztec Centre
Aztec West
Almondsbury
Bristol
BS32 4TD
Tel: +44 (0)1454 203402
Fax: +44 (0)1242 579383
Email: bristol@marks-clerk.com

CAMBRIDGE

Wellington House
East Road
Cambridge
CB1 1BH
Tel: +44 (0)1223 451038
Fax: +44 (0)1223 451120
Email: cambridge@marks-clerk.com

CHELTENHAM

27 Imperial Square
Cheltenham
GL50 1RQ
Tel: +44 (0)1242 524520
Fax: +44 (0)1242 579383
Email: cheltenham@marks-clerk.com

COVENTRY

5 The Quadrant
Coventry
CV1 2EL
Tel: +44 (0)24 7622 2756 or 7145
Fax: +44 (0)24 7625 6197
Email: coventry@marks-clerk.com

LEEDS

43 Park Place
Leeds
LS1 2RY
Tel: +44 (0)113 389 5600
Fax: +44 (0)113 389 5601
Email: leeds@marks-clerk.com

LEICESTER

144 New Walk
Leicester
LE1 7JA
Tel: +44 (0)116 233 8181
Fax: +44 (0)116 233 0192
Email: leicester@marks-clerk.com

MANCHESTER

Sussex House
83-85 Mosley Street
Manchester
M2 3LG
Tel: +44 (0)161 236 2275
Fax: +44 (0)161 236 5846
Email: manchester@marks-clerk.com

NOTTINGHAM

Sutton Place
49 Stoney Street
Nottingham
NG1 1LX
Tel: +44 (0)115 924 2969
Fax: +44 (0)115 924 2968
Email: nottingham@marks-clerk.com

OXFORD

4220 Nash Court
Oxford Business Park South
Oxford
OX4 2RU
Tel: +44 (0)1865 397900
Fax: +44 (0)1865 397919
Email: oxford@marks-clerk.com

INTERNATIONAL OFFICES

ALICANTE

Edificio Carbonell
Explanada de España 1
Alicante 03002
España
Tel: +34 96 514 2727
Fax: +34 96 521 3048
Email: alicante@marks-clerk.com

HONG KONG

20/F Chinachem Hollywood Centre
1-13 Hollywood Road
Central
Hong Kong
Tel: +852 2526 6345
Fax: +852 2810 0791
Email: general@marksclerk.com

LUXEMBOURG

6 Rue Glesener
SP 1775
Luxembourg
L1017
Tel: +352 40 02 70
Fax: +352 40 04 96
Email: luxembourg@marks-clerk.com

MUNICH

8000 München 2,
Alzheimer Eck 2,
Deutschland

OTTAWA

280 Slater Street
Suite 1800
Ottawa
Ontario
Canada K1P 1C2
Tel: +613 236 9561
Fax: +613 230 8821
Email: ottawa@marks-clerk.com

TORONTO

350 Burnhamthorpe Road West
Suite 402
Mississauga
Ontario
Canada L5B 3J1
Tel: +1 905 272 2252
Fax: +1 905 272 2557
Email: toronto@marks-clerk.com

www.marks-clerk.com