



Importance of Website Domain Ownership for Managing your Brand

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Overview

This white paper describes the importance of website domain name ownership for a business or organization and the legal process involved with owning a domain name. The paper also describes the process for preventing the potential loss of ownership of a domain name.

Introduction

Many organizations often select and register a website domain name in order to best promote their products and services online. In most cases, especially with small businesses, setting up proper ownership of a domain name is an afterthought. Not establishing clear ownership of the domain name can lead to domain ownership disputes between the organization and the party who owns the domain. For example, if an organization contracts a web developer to build a website and the web developer sets up the domain but lists themselves as the registrant and not the organization as the registrant, the web developer would be the owner of the domain.

Not establishing clear ownership of a domain name can lead to problems down the road for an organization. An example would be an organization who contracts a new web developer to redesign their website and also move their website hosting to the new web developer but the old web developer is the registrant of the domain name. In this case the old web developer has rights to the domain name because the organization is not the registrant of the domain. Issues such as the example above would be resolved through a domain name dispute.

According to the Harvard School of Law (Domain Name Case Law , n.d.), in order to constitute the legality of a domain trademark dispute, an organization must prove either of the following:

Domain Name Infringement

- The organization must prove that the trademark was established through use of the trademark.
- The organization must commercially use the trademark.
- The organization must prove the likelihood that the domain name in dispute would create confusion between the organization and their customers.

Domain Name Dilution

- The trademark must be well known
- The organization must commercially use the trademark.
- Trademark protects against blurring or tarnishment
 - Blurring – occurs when the domain in question causes the public to no longer think of the company when seeing the famous trademark.
 - Tarnishment – occurs when an association of a trademark with offensive products tarnishes the trademark.

Problem

Many organizations are ignorant of domain name ownership laws and other forms of online intellectual property law. When disputing domain name ownership there are many different cases that can constitute a legal dispute. Harvard Law outlines the following five instances:

Cybersquatting

Cybersquatting is the most common form of domain ownership dispute. Cybersquatting is when someone who lacks legitimate claim registers a domain with intent to sell the name or prevent the trademark holder from using the name.

Competing Use -

Competing use occurs when a competitor registers their adversary's trademark as a domain name.

Concurrent Rights -

Concurrent rights is when two companies both have legally registered trademarks and have rights to the domain. The first company to register the domain would hold the rights to the domain name. An example of this was when Prince Sports attempted to have the domain prince.com transferred to them from Prince Computers. Prince computers kept the domain because they were the first to register the domain. (Domain name disputes, 2008)

Reverse Domain Hijacking -

Reverse domain hijacking (also known as reverse cybersquatting) is when a trademark owner attempts to secure a domain name by making false cybersquatting claims against the domain name's rightful owner. (Reverse domain hijacking, 2015)

Gripe Sites -

A Gripe site is where a domain is registered in order to generate content that negatively reflects the trademarked brand. An example of this would be starsuckcoffee.com versus starbucks.com

Proving trademark infringement is no easy task, especially so in the case of concurrent rights or a gripe sites because the sites are used in good faith and are not registered to be used as a cybersquatting site.

Solution

The best way to approach a domain name dispute is to weigh the cost of disputing. Disputing a domain name in court can be costly and time consuming. The first and best option is prevent a domain dispute. Options for preventing a domain dispute are outlined below.

Establish your organization as registrant

When registering a domain name be sure to verify that your company is the registrant of your domain name. The registrant of the domain name has legal rights of the domain if the domain is being used in good faith. The best way to verify the owner of a domain is through a WHOIS

lookup. A WHOIS lookup is a free search engine for looking up domain ownership and other information regarding a domain. Some popular WHOIS lookup engines are: whois.com, whois.net, whois.icann.org, domaintools.com. See the image below for an example WHOIS lookup.

Whois Record

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Domain Name: KERIGANMARKETING.COM
Registrar URL: http://www.godaddy.com
Registrant Name: Jack Kerigan
Registrant Organization: Kerigan Marketing Associates
Name Server: LARS.NS.CLOUDFLARE.COM
Name Server: MARJORY.NS.CLOUDFLARE.COM
DNSSEC: unsigned
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Consider trademarking the brand

The first step in preventing a domain dispute is to trademark the brand. When a trademark is registered the Lanham Act (Legal Information Institute, 2015) can be applied to resolve the dispute. The Lanham Act prohibits trademark infringement, trademark dilution and false advertising. The act provides three causes of action in which a trademark owner can sue a domain name registrant for violation of his or her trademark. These are: trademark infringement, trademark dilution and cybersquatting or cybersquatting. You can learn more about registering a trademark at: <http://www.uspto.gov/>

Register domain extension variations

It is not always possible to register every domain extension variation. However, owning the variations an organization thinks customers would use to find the organization online. Focus efforts on top-level domains or TLDs that are: ccTLDs (Country-code top-level domains), or gTLDs (Generic top-level domains). Examples of ccTLDs and gTLDs are: .us, .com, and .org.

Register common misspellings

Register common misspellings of a brand. For example Starbucks would want to register starbucks.com, starbuck.com, starsuck.com, starbuckscoffee.com and so on.

Regularly monitor domain expirations

New top-level domains are being released all the time so it is best practice to monitor if any new domains are being registered that match your trademark. You may also want to register any new TLDs for your brand. In the case of Starbucks, they would want to register starbucks.coffee a recently released TLD.

Another option for disputing domain ownership is through the ICANN Uniform Domain Name Dispute Resolution Policy (UDRP) (WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP), 2015). The Uniform Domain Name Dispute Resolution Policy is a policy created by the Internet Corporation for Assigned Names and Numbers (ICANN) to set out a legal framework for the resolution of disputes between a domain name registrant and a third party.

However, the Uniform Domain Name Dispute Resolution Policy is only applied to cases where:

1. The domain name registered by the registrant is identical to the trademark being disputed.
2. The domain name registrant has no rights or legitimate interest in respect of the domain name in question.
3. The domain name has been registered and is being used in bad faith.

Conclusion

This white paper has shown the importance of verifying ownership of your domain and ways to prevent domain ownership disputes from arising. This paper was published to help businesses and organizations understand the importance of knowing who owns their domain and to educate them on how to secure the ownership of their domain.

Works Cited

Domain Name Case Law. (n.d.). Retrieved from Harvard School of Law:

<http://cyber.law.harvard.edu/property00/domain/CaseLaw.html>

Domain name disputes. (2008, March). Retrieved from out-law.com: <http://www.out-law.com/page-5700>

Legal Information Institute. (2015, February 18). Retrieved from Cornell Law:

http://www.law.cornell.edu/wex/lanham_act

Reverse domain hijacking. (2015, February 18). Retrieved from Wikipedia:

http://en.wikipedia.org/wiki/Reverse_domain_hijacking

WIPO Guide to the Uniform Domain Name Dispute Resolution Policy (UDRP). (2015, February 18).

Retrieved from World Intellectual Property Organization:

<http://www.wipo.int/amc/en/domains/guide/>