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Contributed by Adam Cohen, Esq.  
of Kane Kessler, P.C.

### **Protect Your Trademarks From Cybersquatters**

Protecting trademarks, trade names and other trade identifications has always been essential to the overall value of a business. With the advent and widespread use of the Internet, protection of trademarks has encountered a new and vexing hurdle. The problem? Recovering control of your valuable trademarks and trade names that have been coopted by so-called “cybersquatters” who register domain names incorporating your valuable trademarks and then attempt to hold such domain names hostage.

In the last year or so, several hotels have been surprised to learn that someone else claimed to own their Internet domain names or domain names of a hotel’s restaurant or bar. There are many obvious problems that may arise if someone else owns your domain name, not the least of which are that you cannot locate your web site at that address and visitors to the web site will become frustrated when they find no site there or even worse when they find a site that does not belong to you. Luckily, now there is a new streamlined procedure for recapturing domain names containing your marks.

The Internet Corporation for Assigned Names and Numbers (“ICANN”) recently enacted the Uniform Domain Name Dispute Resolution Policy (“UDRP”) which allows you to reclaim your domain name relatively quickly and inexpensively in an arbitration proceeding. Here’s what you need to know.

In order to recapture your domain name under the UDRP, a trade or service mark owner has to prove three elements: (1) that the domain name registered by the third-party is identical or confusingly similar to a trademark in which the Complainant has rights; (2) that the domain name holder has no rights or legitimate interest in the domain name at issue; and (3) that the domain name has been registered in “bad faith”.

The first element is usually the easiest to prove. If the hotel’s name is used in the domain name with the simple addition of .com, .net or .org, this element is satisfied. Even if the brand name is misspelled, a brand holder may successfully seek relief. Submitting a copy of a trademark registration is sufficient evidence of an owner’s rights to a trademark. However, even if a hotel’s mark is not registered with the United States Patent and Trademark Office, the hotel may still have “common law” rights sufficient to warrant recapture of the domain name. (Note that if your mark is not registered with the Patent and Trademark Office we urge you immediately to instruct your attorney to file a service mark application in order to gain the benefits of a trademark registration, which will vastly improve your rights against a subsequent trademark infringer. This simple step is relatively inexpensive but invaluable in protecting your rights)

The second element to prove is that the Respondent has no legitimate rights in the domain name. This is usually the case in most cybersquatter situations; however, if the Respondent is an individual with the same proper name or nickname as the domain name, he or she may be deemed to have a legitimate

interest in the domain name. Most UDRP arbitrators will require substantial evidence demonstrating a legitimate right in a certain name.

The third element - - "bad faith" - - is often the most difficult to prove. If you can demonstrate that the Respondent has any type of history of registering famous names as domain names and/or warehousing domain names, or Respondent has demanded substantial sums of money for the transfer of a domain name, or if the offending web site contains pornographic or other objectionable material, bad faith should exist.

Some of the benefits of the UDRP are that most decisions are rendered within 60-90 days of the filing of the Complaint, the filing fees are relatively minor and an attorney with experience in this area can conduct the whole process relatively inexpensively. The disadvantages of the UDRP are that you are limited to the transfer of ownership of the domain name at issue; there are no monetary damages available.

We strongly advise every hotel to check whether any of its brand names have been registered as domain names. You may do so by checking the whois database located at [www.networksolutions.com](http://www.networksolutions.com). If your domain name is claimed, or if you want to register your trademarks or service marks, legal counsel will be able to advise you accordingly.

Mr. Cohen heads the firms Intellectual Property Department at Kane Kessler, P.C., 1350 Avenue of the Americas, New York, N.Y. 10019 (212) 541-6222.  
Kane Kessler's web address is [www.kanekessler.com](http://www.kanekessler.com).