

STAKING YOUR CLAIM ON THE WEB

TRADE MARKS AND DOMAIN NAMES

Trade marks can be infringed in cyberspace, just as they can be infringed in the real world. It is up to the domain name applicant to make sure they are not violating anyone else's trade mark.

A domain name can function as a trade mark in terms of identifying and distinguishing the source of particular goods and services from those of other traders. However, be aware that registering a domain name does not automatically give you the right to register that name as a trade mark.

Similarly, no one has an automatic right to a domain name. Just because you have a company or business name, or a registered trademark, does not automatically give you a better right than anyone else in the corresponding domain name. The domain name system is entirely separate from the trade mark registration system.

Domain name applicants are responsible for ensuring that they are eligible to use a particular name. The act of lodging a request for domain name registration asserts such a claim. However, if you intend to trade mark your business/domain name, you should search both the trade marks register and domain name listings to ensure our proposed name:

- is available for registration as both a trade mark and domain name; and
- will not be subject to opposition based on a domain name or trade mark proprietor's evidence of prior use.

The following databases should both be searched before settling on a domain name. You can access them via the Internet by going to:

- IPAustralia's trade mark database at www.ipaustralia.gov.au/trademarks;
- the www.ausregistry.com.au for .com.au, org.au, asn.au, and id.au and gov.au names; and
- the www.aunic.net site for edu.au names.

By using a domain name that is identical to, or deceptively similar to a registered trade mark, there is a risk of trade mark infringement, particularly if the name relates to the same or similar goods or services covered by the trade mark registration.

If the domain name is merely registered but is not used in the course of trade then an infringement of the trade mark is unlikely to be sustained. Conversely, evidence of a domain name being actively used would be relevant in demonstrating prior use of the mark within Australia, and could be a case against trade mark registration.

You may not be able to stop another party from using your preferred domain name even if it is identical to your trade mark if:

- they are selling a product/service in a different class/classes to your product and service; and
- they are not attempting to 'pass off' trading on your name.

For more information regarding resolution of a .au domain name dispute, read the .au Dispute Resolution Policy (auDRP) at www.auda.org.au/policy/audrp.

For more information regarding resolution of a global domain name dispute, read the Uniform Dispute Resolution Policy (UDRP) at www.icann.org/udrp.

For more information on trade marks go to www.ipaustralia.gov.au