

NEWS & INSIGHTS

Protecting your domain address

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Many businesses put in a lot of effort and resources to create and protect their brand identity and online presence. However, there are cases where individuals can register a domain name that is very similar to the brand, which can pose a potential threat to the business (also known as cybersquatting). In such instances, what options does the business have?

ICANN is the global organization responsible for managing the Domain Name System (DNS), which is the backbone of the internet's addressing system. The Uniform Domain-Name Dispute-Resolution Policy (UDRP) was introduced to provide an efficient and standardized mechanism for resolving conflicts arising from the registration and use of domain names.

When a dispute arises, the harmed party can file a UDRP complaint with the World Intellectual Property Organization along with a fee.

After filing the complaint, both parties receive each other's contact information to seek a resolution. If no resolution is reached, a panel of independent arbitrators decides whether the domain should be transferred to the complainant.

How to file a complaint

The complainant must demonstrate three key elements to succeed in a UDRP case:

1. The domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.
2. The current domain name holder has no rights or legitimate interests in the domain name.
3. The domain name has been registered and is being used in bad faith.

The first element is satisfied by a showing of trademark rights by the complainant. The easiest way of showing trademark rights is trademark registration.

The second element is satisfied if the respondent doesn't have a reason to own the domain other than to harm the complainant.

The third element looks to why the respondent registered the domain.

The respondent is given an opportunity to respond and present any evidence or arguments that oppose the complaint. Once the complaint and response (if any) have been submitted, there is no further opportunity to provide additional information. Therefore, it is important for a party to include as much supporting information as possible in their initial submission.

Regardless of whether a response is filed, the matter is then decided by an administrative panel based on the submissions. This allows the UDRP to resolve genuine disputes between parties and prevent misuse by complainants. To put it simply, if the respondent has a legitimate reason for owning the domain and does not use it to harm another business, the complainant may not succeed. The parties also have the option to privately agree on a resolution before the administrative panel is convened. In such cases, a portion of the initially paid fees may be refunded.

The UDRP offers several advantages compared to traditional trademark infringement cases. Firstly, it is designed to be a swift and cost-effective process. As ICANN oversees the network of domain name servers, the UDRP has a global reach and operates efficiently. From start to finish, a complete UDRP action can be completed in as little as two months, at a fraction of the cost of even the simplest trademark infringement case.

Be proactive

To proactively address potential problems, there are certain steps businesses can take:

- Obtain trademark registrations for their name, as well as any important product brand names, slogans, and logos.
- Register relevant domains
- Monitor their brand and promptly consult their lawyer if any concerns about infringement arise.

If you'd like to learn more about how to protect your brand [contact me](#) at sodonnell@saxtonstump.com or call 717-556-1032.

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