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US: TRADE MARKS

Trade mark enforcement for domain names

In order to protect their valuable brands from infringement and dilution, American companies often engage in a diligent monitoring of the marketplace for third party uses of marks that may be confusingly similar to their brands. These monitoring programmes typically include a review of every domain name registration which incorporates a formative of the company's particular trade mark. Aggressive trade mark owners will take enforcement measures against third party owners of domain names incorporating formatives of the mark at issue. These aggressive tactics can often lead the trade mark owner into conflict with a foreign entity using the identical mark and owning a domain name registration which incorporates such mark.

Despite a company's ownership of a trade mark registration in the United States, that company may not have standing to object to a foreign entity's use of the identical mark as part of a domain name address if the non-US entity has legitimate rights to use the mark outside of the United States and does not conduct business in the United States. Trade mark rights are territorial in nature and any rights that a trade mark owner may assert based on its ownership of a US federal trade mark registration do not give it rights outside of the United States. Certainly, a company has the legitimate right to be accessed online through a domain name which identifies it – especially if that name has been adopted and has been used in good faith.

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