

Frequently Asked Questions

8. **I own a trademark that I want to use as part of an Internet domain name. The domain name I want appears to have been registered by someone else. As the trademark owner, can I get the domain name transferred to me?**

Yes, this may be possible. The organizations that administer domain name registrations have established rules giving priority to trademark owners for domain names that incorporate or are likely to be confused with established trademarks. All registrants agree to these rules when they register their domain names.

Generally, the rules establish an arbitration process so that both parties' arguments can be considered and the domain name can be transferred (or a decision made that the registrant may keep it) without having to go to trial. This is important, since such conflicts often involve rights in different jurisdictions; litigation would be time-consuming and costly.

While the specific requirements differ, the rules are designed so that a legitimate trademark owner can have a domain name that is registered by a "cyber-squatter" who has no legitimate interest in the domain name transferred to the trademark owner. The results are less clear where there are legitimate conflicting trademark rights, e.g. in different countries or for different types of products. The specific rules (e.g. ICANN for .com, .org and other domain names and CIRA for .ca domain names) differ in the requirements that trademark owners are required to meet. For specialized legal advice the particular rules that will apply to the domain name(s) at issue, contact Carol Anne O'Brien at caob@caobrienlaw.com or (416) 640-7270.