

When “Domain Name Disputes” Are Just Bogus Solicitations

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If you are a brand owner and you have never received an alarming, if somewhat confusing, notification of a domain name dispute from a Chinese company you have never heard of, just wait. Chances are, it will happen eventually. For the uninitiated, the subject line of such an email might read: “Domain name dispute: YOURMARK,” and the email itself might look something like this:

We have an important issue to confirm with you. On April 8, 2011, we formally received an application, from a company called “ABC INVESTMENT INC,” to register “YOURMARK” as an Internet brand and Chinese domain names with suffixes such as:

YOURMARK.cn / .com.cn / .net.cn / .hk / .com.hk / .tw / .com.tw / .asia / .in

During our preliminary investigation, we found the brand name and these domain names being applied for are the same as your company’s, so we need to confirm with your company. If the aforesaid company is your business partner or your subsidiary company, please DO NOT reply to us, we will approve the application automatically. If you have no relationship with this company, please contact us within 10 working days. If we do not hear from you by the deadline, we will approve the application submitted by “ABC INVESTMENT INC” unconditionally.

Most conscientious brand owners who receive this type of email for the first time do not know what to make of it. They may have spent substantial time and resources registering and protecting their brand, perhaps even worldwide, only to be told their rights are being threatened in certain Asian countries.

Luckily, it turns out that these emails are nothing more than solicitations, and misleading ones at that, intended to frighten your company into registering several Asian country code top-level domains (“ccTLDs”) with the registrar sending the email. These emails are misleading at best, because registrars do not conduct trademark clearance searches of proposed domain names, and it is doubtful that a third party is trying to register these domains in conflict with your company’s marks. In fact, in some cases, the domain names may already be registered. In effect, these emails purport to notify the trademark owner of a dispute when no such dispute exists.

Typically, you should not respond to these types of emails. If there is any doubt, however, we recommend you seek the advice of trademark counsel. In no case should payments be made to the sender of such an email without conducting proper diligence to confirm the legitimacy of such a request.

At most, such an email may serve as a reminder to pay attention to your company’s domain name portfolio overseas and to evaluate your company’s strategy with respect to ccTLDs. If your company does wish to register domain names with these extensions, then it should do so using a reputable registrar.

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You should probably not, however, look to a registrar who sent a bogus email solicitation for assistance. You may even be able to register such an extension through the same registrar used for generic top-level domains (“gTLDs”), such as .com and .net. Many domestic gTLD registrars are also accredited registrars for .cn (the ccTLD for China) domains. A list of accredited registrars can be found at the websites of the official agencies responsible for administering the domain name registration systems—in China, that agency is China Internet Network Information Center (CNNIC), www.cnnic.net.cn, and in Hong Kong, it is Hong Kong Internet Registration Corporation Limited (HKIRC), www.hkirc.hk.

Even if you are not actively conducting business in a particular country, it may be a good idea to register domain names in various ccTLDs as a preemptive measure for your primary brands—along with combinations of your brand coupled with generic words for your goods and services. Indeed, major brand owners often own several thousand domain names incorporating their brand for this reason.

Even so, a company is unlikely to be able to register every conceivable combination of brand name, descriptive wording, and domain name extension. Therefore, it is important to obtain trademark registrations in countries of interest. Trademark registrations provide much broader protection than domain name registrations, and they are effective tools in forcing the transfer of domain names registered by cybersquatters and other suspect entities claiming to be assisting you.