

UNIVERSITY
of GUELPHCHANGING LIVES
IMPROVING LIFE

Office of Legal Counsel

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It's All in the Name ~ Domains and Trade-marks

We live in the age of "the name"....Madonna, Coke, Wikipedia, Google, Nike. The name can mean a product, an idea, a website, a corporation. It can also mean big dollars and as such, it helps to know what and how to protect it. In the name game, it's all about how you intend to use it and how you protect it.

Domain Names: "uoguelph.ca", "google.ca" - These are the addresses of Canadian virtual locations on the worldwide web. Using Domain names is like calling someone on the phone without needing to know the actual phone number. It allows the searcher to "call" using the domain name instead of the IP address and connect to a website. Registrants in Canada use the ".ca" suffix although others are equally common like ".com", ".org", etc., and each must be registered separately. Domain names are registered on a first come, first served basis. All that is needed is a fee, the name of an administrator and a password. In Canada, the organization responsible for managing the ".ca" domain (including dispute resolution), is the Canadian Internet Registration Authority ("CIRA").

Trade-marks : "Coca-Cola", "Pizza Hut" - Trade-marks are words, phrases, logos or a combination of these, which are used to identify specific products or services of the trade-mark holder. While registration of a trade-mark may not be mandatory, registration does provide enforcement options which may not be available to unregistered trade-marks. Trade-marks are registered for a period of fifteen years and must be renewed. Registration is also country specific so registration in Canada does not give trade-mark protection in the United States. Protection of trade-marks falls under the jurisdiction of the courts.

Official Marks: "University of Guelph", "Changing Lives, Improving Life" - This is a special form of trade-mark offered under s. 9 of the Trade-marks Act. Section 9 permits certain government authorities to protect a special form of mark called an 'Official Mark'. An official mark does not need to be renewed and permits protection without the need to specifically identify the mark with certain products or services. A simple way to distinguish between a trade-mark and an official mark is the former allows protection of part of a field whereas the latter provides for protection of the whole field.

It is important to note that the processes to register a domain name and a trade-mark are very different and so registration in one category provides no automatic protection in the other category. For example, registration of the domain name "skyblue.ca" for a website offering nature photography, may still run into problems if the trade-mark holder for "Skyblue" is a chain of hotels demanding the transfer of the domain name. If the parties are unable to come to an agreement and the dispute resolution process is undertaken, preference is often given to the trade-mark holder.

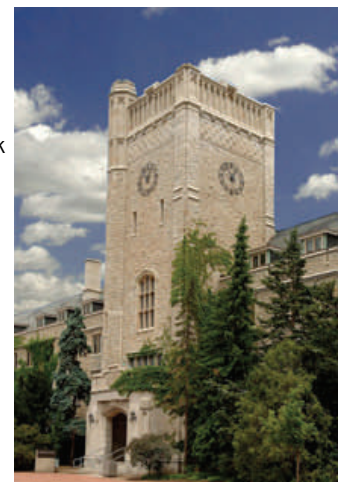
When considering registration of a domain name, it is therefore good practice to have a trade-mark check. If there is an existing trade-mark, it does not mean that the domain name can't be registered. It may however, affect whether it is worthwhile to invest time and resources into building a domain name that could later be the subject of a claim by the trade-mark holder.

In the University environment, the matter of who holds the domain name, trade-mark or official mark is also important. Domain names and trade-marks can be held by individuals but the costs associated with the registration and protection of the domain name and trade-mark also belong to the individual.

If the domain name is for university-related activity, approval should first be sought through CCS, (<http://www.uoguelph.ca/ccs/departmental-support/it-administrators/dns/dns-requests>).

To qualify for an official mark, the holder of the mark **MUST** be the University and such requests are processed through the Office of Legal Counsel.

If you are interested in further information, contact the Office of Legal Counsel at extensions 58633 or 53082.

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