

Solutions For Trademark Holders

Tuesday, Jun 19, 2007 --- Trademark holders with domain names registered at Registerfly.com breathed a collective sigh of relief last week when GoDaddy.com announced that it would assume command of more than 850,000 domain names held by Registerfly.com

Registerfly.com is in the midst of accreditation problems with the Internet Corporation for Assigned Names and Numbers, the organization in charge of Internet address policies, due to significant operational problems.

Complaints include unsuccessful renewal of domain names despite payment by the domain name holder, failure to update contact information, and refusal to allow the transfer of domain names to other registrars.

While GoDaddy.com's assumption of the Registerfly.com domain names should prevent further renewal and maintenance issues, several domain names improperly expired due to Registerfly.com's operational deficiencies.

Companies with domain names that have expired or are about to expire may have legal recourse to regain possession of the name. The recourse will depend on a combination of the company's trademark rights in the domain name and the current status of the domain name.

For domain name owners with names that have not yet expired, owners should verify that the domain name was properly transferred to GoDaddy.com.

To confirm proper transfer, domain name owners should go to GoDaddy.com and click on the link on the home page that states "Welcome, Registerfly Customers." GoDaddy.com's Web site then leads the domain name owner through a process to set up an account and confirm transfer of the domain names.

Once transfer is complete, the domain names may be renewed and registration and server information may be updated. For questions concerning the transfer to GoDaddy.com, contact GoDaddy by telephone at (480) 505-8877.

Domain name holders whose name has already expired may still have rights to their domain names. ICANN has extended the renewal grace period for domain names that expired while customers were waiting for their Registerfly.com issues to be resolved. Owners will have until June 29, 2007, to renew their domain name through GoDaddy.com using the process mentioned above.

Domain name holders that have lost their domain and are unable to take advantage of ICANN's extension may still have remedies to reacquire their names.

Companies that paid the renewal fees at Registerfly.com, but lost the domain name due to RegisterFly.com's failure to file a renewal, may be able to pursue a legal claim against RegisterFly.com. Potential causes of action include, among others, breach of contract and false advertising.

Another remedy available to trademark holders is to initiate a lawsuit or arbitration proceeding against the third party that registered the domain name after it inadvertently expired.

Trademark holders may initiate an action in federal court for cybersquatting under the Lanham Act. Trademark holders must show they have trademark rights in the domain name in question and that the domain name was registered in bad faith.

Trademark holders who do not want to initiate a lawsuit may regain rights to their domain names by filing an arbitration proceeding under ICANN's Uniform Domain Name Dispute Resolution Policy.

Trademark holders will regain rights to the domain names if they can show the domain name is identical or confusingly similar to the holder's trademark; that the current registrant has no rights or legitimate interests in the disputed domain name; and that the domain name was registered in bad faith.

Trademark holders whose domain names were registered with Registerfly.com should take action quickly to confirm the status of their domain names. If legal action is required, trademark holders should act immediately to regain rights to their domain names.

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