

What's In a Name?

Interplay Between Trade Marks, Business Names, Company Names and Domain Names



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Voila! You have coined a great NAME for your business and you have big plans to brand your products and services using the name as well as sell your products and services on the internet using that name.

Importance of names in trade

Do you know what you need to do to ensure you have the right to operate under that chosen name? This factsheet briefly examines the interplay between business / company names, domain names and trade marks and how entrepreneurs can avoid being prevented from using a name which they have invested money and time developing.

Business / company name

A business or company name is the name chosen when that business or company is formally registered. It is a legal requirement to register a business or company name if you are carrying on business under this name. Having obtained a business or company name registration does not mean that you are automatically entitled to use, or stop others from using, that name as a domain name or trade mark. Neither does it mean that the name would be acceptable by IPOS as a registered trade mark. This is because a trade mark has to meet certain criteria before it can be registered (please refer to "Trade mark" on page 2).

Domain name

A domain name locates a company or other entity on the Internet. Most often, a company would want to have a domain name that is similar to their company name. So if you plan to do business over the Internet, or have a web presence for promotional purposes, you must conduct a domain name search to make sure that the name you would like to use is available for you to use. Even where there is no immediate need for the domain name, registration is sometimes sought for defensive purposes in order to protect against cybersquatting. The fact, however, that a domain name is available and

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registrable does not necessarily mean that it is legally safe for you to use it. For example, if the name is identical or similar to another person's registered trade mark, you may be infringing that trade mark.

Trade mark

A trade mark is a sign used by a person in the course of business or trade to distinguish his goods or services from those of other traders. For a mark to be registrable, it must be distinctive of the goods and services you provide. In other words, it should be recognized as a sign that differentiates your goods or services from others. Further, a name would not be acceptable as a trade mark if it is:

- descriptive of your goods or services or any characteristics of them;
- a geographical name;
- customary in your line of trade;
- offensive;
- against the law¹
- deceptive;
- similar or identical to any earlier mark in relation to similar or identical goods or services; and
- in certain circumstances, similar or identical to a well-known mark even if in relation to dissimilar goods or services

Interplay

Registering a trade mark in a country gives the owner statutory rights to use the trade mark in that country in respect of the goods or services for which the trade mark is registered, to the exclusion of others. This means a trade mark registered in Singapore has no statutory rights in other countries unless trade mark protection is sought in those other countries. For this reason, when you venture overseas, you run the risk that another company may prevent you from using your business / company name or domain name if :

- they have trade mark rights over the name in that country;
- their trade mark rights extend to those goods or services or similar goods or services which you are trading in; and
- the use of your business / company name or domain name is likely to cause confusion to the public in that country.

Similarly, owning a registered trade mark does not automatically entitle you to use that trade mark as a business / company name or domain name. This is because the same trade mark can be registered

¹ Where the trade mark contains or consists of a sign which some other national legislation stipulates cannot be used, for example, the word "Red Cross".

for different goods or services and by different proprietors. Also, someone may have already, and quite legitimately, registered the business / company name or domain name, perhaps using it without securing trade mark registration for it.

Below is an overview of similarities and differences of trade mark, business name, company name and domain name.

	Trade Mark	Domain Name	Business and Company Name
Where to register	Trade mark office of country. IPOS in the case of Singapore. Generally first to file.	ICANN accredited registrars for gTLD. SGNIC accredited registrars for .sg domain names (ccTLD). First come first serve.	Company registry of country. ACRA in the case of Singapore. First come first serve.
Requirements for registration	Distinctive in relation to goods and services. Not similar or identical to any earlier mark in relation to similar/identical goods/services.	No requirement to be distinctive or specific to goods or services. Not identical to any earlier domain names.	No requirement to be distinctive or specific to goods or services. Not identical to any earlier business or company names, undesirable or of a kind the Minister has directed the Registrar not to accept for example "Temasek".
Registration	Registration and protection is country specific and specific to particular goods and services. Once registered, you are the trade mark owner in the country of registration for your goods or services. Another party in the same country may be able to register a similar/identical mark for different goods or services. Several other parties in another country can register the same trade mark without infringing your trade mark.	Registration is unique. Once registered, your domain name is unique in the internet. Another party is not able to register the same domain name.	Registration and use is country specific. Once registered, you can operate under the business or company name in the country of registration. Another party in the same country may not register the business or company name. Another party can register the same business or company name in another country.

	Trade Mark	Domain Name	Business and Company Name
Issues to be mindful of	Common law tort of passing off based on goodwill in your trade mark.	Cybersquatting ² Typosquatting ³ Domain name disputes	Look out for approved similar business / company names.

How do I avoid potential problems

It is useful to conduct some searches before deciding on any particular name to use in case the name chosen has already been registered with the various Registries by someone else. Once you have a name in mind, you should:

- Search the business / company names registers to determine whether the name you have selected has already been registered by someone else (www.acra.gov.sg).
- Search the domain name register to determine whether the name you have selected is available as a domain name. You may have to search multiple registers if you wish to register a gTLD⁴ and ccTLD⁵.
- Search the trade mark registers in the key markets of your business to ensure that your business / company name and domain name are not identical or similar to another person's registered trade mark. If you find any identical or similar registered trade mark, you could be infringing someone's mark. You can search the Singapore trade mark database at the IPOS website [here](#).
- Conduct a "common law" search to determine if the trade mark you are intending to register is already in use by others who have not filed for registration. It may involve checking phone directories, yellow pages, industrial directories, etc.
- If you intend to use your business / company as a trade mark, you should consider registering it as a trade mark. Do note that not all chosen names are registrable as trade marks.
- You may also consider the need to register your domain name as a trade mark for additional level of security. If your business is primarily (or exclusively) an online enterprise, or this is an important medium for you to reach out to the public, this is particularly important.
- If you intend to bring your business overseas or sell your goods or services overseas, you may want to run through the same searches listed above in that country.
- If any of the above search results reveals an earlier registration or use by another party, you may wish to consider alternative names and go through all the searches again. If the chosen name is critical for your business, you may wish to consider other options such as acquiring ownership of

² Registering a domain name in bad faith with intention of selling it for profit.

³ A form of cybersquatting which relies on mistakes such as typographical errors made by Internet users when inputting a website address into a web browser.

⁴ Generic top level domain name for example ".com" and ".net"

⁵ Country code top level domain name for example ".com.sg"

the earlier registration, re-designing your chosen trade mark to differentiate from the earlier registration or taking action such as cancellation of a registered trade mark for non-use.

Conclusion

As you can see from the above, it is important to consider carefully when choosing your business / company name, domain names and trade marks, to look at them holistically and taking the necessary steps to obtain registrations in a timely manner where required. In a competitive landscape where it is a challenge to manage costs, risks and returns, seeking professional advice may be helpful in making the right decisions for the longer term in developing valuable brand assets for the business / company.

What next – Monitor & Defend Your Names

Once you have successfully registered your business / company name, trade marks and domain names, it does not mean the work has finished. As a defensive measure, it is useful to continue monitoring for look-a-likes, sound-a-likes or imitations by regularly scanning the environment, and monitoring trade mark filings, domain name registrations, business / corporate name reservations and common law uses (as many trade marks are not made the subject of a trade mark application) to identify potential infringement cases. A delay in commencing enforcement may adversely affect your rights and your brand. If you prefer to, there are surveillance or trade mark watching services which you may engage to do this for you.

Useful Resources

1. IPOS has an IP Management programme catered for SMEs. Please click [here](#) for more info or contact IPOS at Tel 6339 8616.
2. For a list of IP professionals, please refer to SNIPS [here](#).
3. For other topics featured on IP management, please refer to IP Knowledge Kaleidoscope [here](#).

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Feedback

We seek your views on how IP Knowledge Kaleidoscope can serve the business community better. Please email us your feedback to ipos_enquiry@ipos.gov.sg.

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