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Internet Name is Trademark Infringement

by Robert Kain

(c. 1996)

The name you pick to use on the Internet may violate someone else's federally registered trademark. In a case of first impression, the U.S. District Court for the Northern District of California found that the Internet domain name "juris.com" is likely to infringe the federally registered trademark JURIS owned by Juris, Inc. The federal court issued a preliminary injunction commanding the Comp Examiner Agency, Inc. to stop using the Internet domain name "juris.com."

Comp Examiner is the owner by assignment of the Internet domain name "juris.com" which was registered with Network Solutions, Inc. (NSI) in 1993. Comp Examiner maintains a web site which provides computer services for legal, insurance, forensic and related professions and advertises those web sites to other law-related sources throughout the Internet or world wide computer web. Internet domain names are commonly used to identify and locate particular web sites on the Internet.

Juris, Inc. sells law office management software such as time and billing software. Juris federally registered its trademark JURIS in 1988 for computer programs, educational services and enhanced computer programs. The dispute arose in June, 1995 when Juris sought to register its JURIS trademark as a domain name on the Internet. That application for an Internet domain name was rejected by NSI based upon Comp Examiner's earlier domain name registration for juris.com. NSI, a domain name registration service, has a first come, first serve policy regarding domain names and a dispute resolution procedure. Juris twice requested Comp Examiner to discontinue its use of the domain name juris.com, but Comp Examiner refused.

Under trademark law, the first one to use a mark in conjunction with the delivery of goods or the providing of services owns the right to the trademark in the geographic area of use. If that person applies for and obtains a federal registration, he or she may enforce his or her rights to that name throughout the United States provided

that he or she is engaged in commerce with the mark. Since Juris had been using the trademark JURIS long before Comp Examiner began using the domain name juris.com, under established federal trademark law principles, Juris was entitled to an injunction.

At the preliminary injunction hearing, Juris argued, and convinced the court, that the mark juris.com was nearly identical to its federally registered mark JURIS, that the marks were used on competing or related goods, and the marks were also used in the same marketing channels. Further, Juris established that it sold the same or similar products to the same or similar customers, and that there would be a likelihood of consumer confusion between the two marks juris.com and JURIS.

Judge Byrne, of the U.S. District Court, ruled that the use of the term "juris" was an infringement of the federally registered mark JURIS and that Juris, Inc. was likely to succeed at the trial. Accordingly, Comp Examiner is required to remove the domain name juris.com and to cease operating the juris.com Internet web site after May 3, 1996. Currently, the case is scheduled to go to trial in July, 1996.

1. *Comp Examiner Agency v. Juris, Inc.*, Case No. 96-CV-213, U.S. District Court, Northern District of California, April 26, 1996.

2. Federal Trademark Law (The Lanham Act), 15 U.S.C. §1051, et seq.

3. Comp Examiner's referral notice at <http://www.juris.com>. Referral notice will be posted until July 30, 1996.

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