

Gray Reed Retrieves Another Domain Name for Client through UDRP Win

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Someone other than the Berkeley Eye Center had been using the domain name www.berkeleycenter.com since 2003. When the local media reported prominent physician, Dr. Ralph Berkeley, was going to set up shop with that name, a cybersquatter claimed the domain name prior to the registration of Berkeley Eye Center's trademark. Concerned that it would never be able to obtain its first domain name of choice, Berkeley Eye Center settled on www.berkeleye.com as its domain. Gray Reed attorneys [Travis Crabtree](#) and [Carol Wilhelm](#) won a Uniform Domain Name Dispute Resolution ("UDRP") arbitration with the World Intellectual Property Organization to win back the name for the Houston-based medical practice despite the fact the original owner had owned the domain name since 2003 and it was claimed prior to Berkeley Eye Center's trademark registration.

The UDRP is an online process that is decided on the papers without discovery or live testimony. As the holder of a domain, you are required to submit to a "mandatory administrative proceeding" to determine rights to the domain. Regardless of whether you participate, your domain registrar must enforce the decision of UDRP panel. If either side elects to go to court instead, the UDRP proceedings are usually put on hold. To prevail in a UDRP claim, you must prove: (1) you have a trademark right that is identical or confusingly similar to the domain of the infringer; (2) that the infringer has no legitimate interest in the domain name; and (3) and that the person is using the name in bad faith. You can read more about UDRP proceedings at Travis Crabtree's www.emedialaw.com blog.

Travis Crabtree brings a unique perspective to his internet marketing, online media and commercial litigation practice. Travis graduated from the University of Missouri School of Journalism and spent several years in television news before taking on a law career. Travis explores the emerging legal issues and trends for internet marketing and online media on his blog, eMediaLaw.com. In addition, Travis represents plaintiffs and defendants in complex business matters including cases involving defamation, open records issues, antitrust, RICO, the False Claims Act, shareholder derivatives, minority shareholder oppression, corporate officer/director fiduciary cases, partnership disputes, trade secrets, the DTPA, the UCC, employment and class actions in both state and federal court. He provides advice and counsel to clients at all stages of conflict from avoiding disputes, to alternative dispute resolution, trials and appeals.

Carol Wilhelm is an intellectual property law attorney who joined Gray Reed & McGraw in September 2008 after 16 years of practice at the national law firms of Pennie & Edmonds, Jones Day and Jenner & Block. Carol has extensive experience in all areas of trademark, copyright and unfair competition, including litigation, prosecution, transactions, due diligence and client counseling. Carol's practice also encompasses general corporate matters and transactions.

About Gray Reed & McGraw

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