

DOMAIN NAME LAW AND PRACTICE

AN INTERNATIONAL HANDBOOK

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OXFORD
UNIVERSITY PRESS

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FOREWORD

Registers often breed markets in their contents which allow the value of particular entries to be realized. Given half a chance, this happens with telephone numbers and car registrations; likewise with names such as those of corporations or products or celebrities. Sometimes the interest is rather general – lots of people might pay dearly for a car number-plate that spells “H 00 RAY”. Sometimes it is more specific, as when it is “THEWH 0”. There are situations where enterprises build up reputations in trade around marks, get-up, logos, slogans and the like which become their badges of recognition. In most of the world there are systems for registering these signs as trademarks, and there is likely to be further legal protection against their use by others. Smart operators will of course be around to jump in ahead where they can. One recurrent case has been the trademark that has become popular in one country but is not yet known in another. An interloper may seek to register it in the second country mainly in order to sell it on later to the actual trader. Over time, trademark systems have developed answers to this sort of fast practice.

The Internet has provided an unexampled opportunity to do the same sort of thing. If the name of a worldwide success story – “Mercedes”, “FCUK”, “Dior”, “KLM”, “Celine Dion” – is made the principal element in a domain name registration, this can give access to sites containing, or linking to, all kinds of content (or maybe, only promising to do so). The mark owner may not be quick enough to get to registration ahead of a “cybersquatter”; if so, the price for retrieving its position may be considerable. Respectable businesses have objected loudly to the practice; but where to take their protests?

This book details the responses that have been made by national courts and by international arbitral bodies associated with the various organs empowered to register domains for the Internet. Defining what exactly is objectionable in this sort of conduct is itself difficult: cybersquatters cannot be accused simply of unfair competition, since they are not in any ordinary sense competing. They may be labelled “fraudsters”, but it may be hard to say why. All sorts of justifications may be offered for the choice of particular domain names. How does one distinguish between the justifiable and the sham?

To a large extent, solutions have lain with the bodies which deal with domain

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name disputes – bodies, that is, that can examine objections to registrations and, if appropriate, order the registering body to transfer or cancel the particular registration. In the lead has been the service provided by the Arbitration Center of the World Intellectual Property Organization in Geneva for domains registered with the ICANN. The same or similar arrangements have now been put in place for the operators of country-based domains (“.uk”, “.de”, etc).

All of them depend on the standard terms for the registration in the first place, which insist that the dispute settlement procedures are part of the grant. These terms also define in some detail what will constitute an unsustainable registration. An adhesion contract is thus the basis of the whole arrangement and the process makes maximum use of the Internet itself for rapid resolution of disputes. Out of the international ether, a body of rules and practices for these bodies has evolved. These nevertheless vary in detail, as they do again from the approaches of courts in different countries, when they are faced with litigation under their national law attacking the practice.

This compendious book deals with the whole phenomenon of control over cybersquatting from the days when a rapid response was first being mooted to the elaborate answers that are now available around the world. In itself, the book is a splendid achievement and one which a great many lawyers, business people and government officials will need to have right at hand. Because there has been so much dispute settlement, the subject is enlivened at all sorts of turns by instances of ever-increasing ingenuity and complication.

Inevitably there has been some criticism of what has been achieved, and a small proportion of the objections have merit – not least where panelist-judges have shown too bluff a readiness to side with their home industries. But more measured assessments put the balance of achievement clearly on the positive side. The big question is not whether this unique method of reducing a particular form of predatory practice should be abandoned, but how far it provides a precedent for dealing quickly and cheaply with other unacceptable business practices in the global marketplace.

Professor William Cornish
University of Cambridge

PREFACE

The Internet launched a new era in the internationalisation of trade. With a minimum of financial and logistical resources, any business can advertise its goods and services around the globe, and, provided that the goods or services can be converted into digital form, transmit them directly to purchasers using the global computer networks.

While this global advertising and sales activity that the new communication technologies have brought within reach constitutes a considerable potential for business expansion, it also involves considerable legal risks. So far, the most frequent cause of disputes on the Internet has been the infringement of another's trade mark rights through registration and use as domain names.

The intellectual property law issues created by the global medium of the Internet represent a major challenge. Up to the end of the 1990s, the law tended to lag behind the new business practices in the online environment. In the absence of court decisions, there was in most countries considerable uncertainty as to how to approach the new tort of cybersquatting and other Internet-related intellectual property issues. Particularly in cases where domain names had been hijacked by foreign cybersquatters, the difficulties in obtaining recognition and enforcement of judicial decisions meant that the rightholder's claims very often existed only on paper, with the result that trade mark holders were obliged to yield to the laws of a "digital Klondike", the principle of "first come first served", as domain name piracy continued to increase.

Today the situation has changed. In almost all jurisdictions, the major intellectual property and competition law issues of domain name law have now been addressed by national courts, and an astonishing amount of case law has established a solid basis to deal with the legal issues that arise in connection with the registration and use of domain names. In some countries national legislatures have adopted specific domain name statutes directed generally against infringement of rights through registration and use (e.g. Spain, Japan) or specifically against the abusive registration of domain names (e.g. USA).

The systems for the registration and administration of domain names have also been reformed in a good number of countries, and in part put on a statutory basis. In view of the complex questions of jurisdiction, applicable law and

enforcement that arise when resorting to national judicial systems and the resulting delays and costs, alternative dispute resolution procedures have been established in many countries, allowing intellectual property owners to rectify abuses of rights in domain name registrations more efficiently.

At international and supranational level, too, the organisations responsible have started to deal with greater intensity and creativity with the legal problems resulting from the registration and use of domain names. The Uniform Domain Name Dispute Resolution Policy has been in force since 24.10.1999, and provides trade mark owners with an alternative dispute settlement procedure that can serve as effective and inexpensive protection against domain name piracy. A similar alternative procedure has been introduced by European Commission Regulation (EC) 874/2004 of April 2004 for disputes arising in connection with the registration and use of domain names under the European top-level domain “.eu”, which is expected to be available to Internet users from mid-2005.

On October 3, 2001, the General Assembly of the World Intellectual Property Organisation (WIPO) and the Paris Union presented a Joint Recommendation concerning Provisions on the Protection of Marks and other Industrial Property Rights in Signs on the Internet. This provides a clear legal framework for trade mark owners who wish to use their marks on the Internet, with rules to determine whether, under the applicable laws, use of a sign on the Internet has contributed to the acquisition, maintenance or infringement of a mark or other industrial property right in the sign, or whether such use constitutes an act of unfair competition.

Finally, the evolution and reform process in connection with the administration of the Internet number and name zones that had been ongoing since the Internet Corporation for Assigned Names and Numbers (ICANN) was founded in 1999 came to a provisional conclusion with the amendment of the ICANN Bylaws in October 2003. This means that the main features of the governance structures of the Internet have now been fixed.

It can be said that at both national and international level a reliable interim status has been reached and that there is likely to be no further radical restructuring in the field of registration and administration, nor any fundamental change in the approach to the legal issues arising.

The aim of this present volume is to provide a comprehensive picture of the different registration procedures for domain names, together with an analysis of the law that has developed in respect of domain name at both national and international level.

As a precondition for the discussion of the legal issues, Part I A presents an overview of the technical and organisational basis of the domain name system

and the Internet governance structure. This is followed in Part I B by a review of the registration principles and the various dispute resolution systems in connection with the registration of domain names under the generic and country code Top-Level Domains. Part I C contains a number of statistical details on the development of domain name registration in the gTLDs and ccTLDs, demonstrating the increasing importance of domain names in the business sector.

Part II comprises presentations of the registration requirements and the domain name law in 27 countries. All are written by acknowledged experts in the field of domain name law who, as attorneys and panellists in the various national and international alternative dispute settlement procedures and as jurists, have been involved directly in the development of domain name law.

Each individual national contribution begins with a short summary of the national system for the protection of trade marks and other intellectual property rights in signs. This is followed by a presentation of the registration requirements for the country code Top Level Domains (ccTLDs) and the alternative dispute settlement procedures in operation in the country, an aspect of considerable relevance for the legal practitioner and a major supplement to the protection available through the ordinary courts.

The author of each contribution then analyses and comments on the – in some countries already extensive – case law on the protection of trade marks, commercial designations, names and work titles against registration and use as domain names. The questions of the independent protection of domain names as proprietary rights, the admissibility of descriptive domain names and the liability of the registrar are treated as separate law problems. Each country report ends with a section dealing with the forms of relief available to the owner of intellectual property rights and with a variety of procedural factors affecting their enforcement against the registration and use of domain names, plus a section on rules relating to issues of international jurisdiction, applicable law (private international law) and enforcement in international conflicts.

Part III A examines in detail the alternative dispute resolution procedure set out in the Uniform Domain Name Dispute Resolution Policy, and critically analyses a large number of key decisions from the over 8,000 panel decisions now rendered. This is followed in Part III B by a critical exposition of the alternative dispute resolution procedure for “.eu” adopted in European Commission Regulation (EC) 874/2004 of April 28, 2004. While taking the UDRP as its model, the Regulation nevertheless deviates in some significant aspects from it, particularly with respect to the substantive criteria for decisions, and also raises a wide range of questions of construction.

Part IV sets out the WIPO/Paris Convention Joint Recommendation concerning the Provision on the Protection of Marks and other Industrial Property Rights

in Signs on the Internet, and summarises the case law on international conflicts relating to trade marks and other protected signs in the various legal systems.

Part V contains an alphabetical quick-reference summary of the registration conditions in the 45 most important domain name jurisdictions.

The work is rounded off with a compilation of statutory provisions and guidelines, aimed at providing the legal practitioner with convenient access to the most important legal materials in the field of domain name law.

Disclaimer

All information provided in this handbook is provided to the reader as a source of general information on domain name law and related intellectual property issues. It is hoped that the information on these pages will provide useful guidance on domain name dispute registration and dispute resolution, but it cannot take the place of professional advice based upon full knowledge of the specific circumstances of each case. Readers should therefore consult with an attorney licensed to practice in the relevant state or country.

While most concerted efforts have been made to ensure the accuracy of the information in this volume, the editor and the authors cannot guarantee the completeness or timeliness of any of the information presented on these pages. The Internet is a transient medium. Thus, references to web locations, data, pricing and registration policies are subject to change without notice. Readers are encouraged to check the companion website, freely accessible to all purchasers of the book (see inside front cover for details), as well as other relevant online locations for more current or specific information.

Acknowledgements

The editor would like to express his thanks to all the authors, who, despite their many other duties, devoted their time and creativity to the success of this volume. A very major part of this success is due in particular to the two authors Tony Willoughby and Sally M. Abel, without whose assistance in the editorial revision of the English manuscripts this work would not have been possible. My special thanks are also due to Oxford University Press, in particular its Editor-in-Chief for Commercial Law Chris Rycroft, Katarina Wihlborg and Amanda Greenley, for their excellent support for the book and for the successful collaboration.

To my honoured teacher, Professor W. R. Cornish, whose legendary textbook on intellectual property law accompanied me throughout my studies at the London School of Economics and my research work with the Max Planck Institute for Intellectual Property, Competition and Tax Law, I extend my warmest thanks for the Foreword.

Preface

Last but not least, particular thanks are due to Carl Heymanns Verlag, Cologne, which generously granted the licence for the English edition of the work and which itself accepted a number of delays to the publication of the German edition in order to enable the two editions to be released almost simultaneously.

The editor would be very grateful to receive any suggestions and criticisms from the readership at the postal or email address below.

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Munich, January 2005

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