

# **The Relationship Between Domain Names And Trademarks**

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## **Abstract**

This paper analyzes the problems arising from the collision between domain names and trademarks. While both of them are similar in nature, they differ one from the other in a number of ways. On the one side stands the traditionally recognized trademark, identifying goods or services of a particular merchant, on the other side, there is the domain name; a new phenomenon serving as an address that identifies a specific location on the internet. The clash between domain names and trademarks is associated with a number of questions concerning the applicable substantive law, procedural rules and issues connected with the enforcement of the judgments. The goal of this study is to distinguish lawful use of an internet domain name from cases of its abusive or dishonest exploitation. The examination focuses on available means of legal protection on regional levels in the US and the EU, and describes an alternative to court action in the form of administrative proceeding under the Uniform Domain Name Dispute Resolution Policy.

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## Introduction

The technological developments taking place in the last number of decades gave rise to the beginning of a new era. The internet enabled a world-wide flow of information accessible from any place at any given time; a flow of information independent from material mediums or national borders, creating a global network. Like every invention, the internet provides not only a number of advantages, but also new possible ways of violating person's rights protected by the legal system. One of the most vulnerable fields likely to be infringed through the expanding use of the internet is intellectual property (IP). The object of intellectual property is to protect the product resulting from human creative activity. It is undisputed that such creations deserve legal safeguards for their originality, individuality and uniqueness.

This thesis discusses the collision between trademarks, as a type of intellectual property, on the one hand, and domain names, on the other. Trademarks act as an identification of a merchant with the purpose to assign goods or services to this individual merchant and simultaneously to distinguish them from those of the competitors, while domain names serve as an address of a particular internet location. Thus, both the trademarks and domain names function as an identifier that can be used (in respect with trademarks, must be used) in the course of commerce. Therefore, the question arises: what happens when there is one entity using a domain name identical or substantially similar to a trademark of someone else. The goal of this thesis is to explain the concept of abusive domain name registration and its consequences, to draw a line between a lawful and illegitimate use of a domain name when it comes to such collision. Subsequently we will examine possible legal defenses available to the harmed party, procedural questions accompanying these cases and the different legal remedies to be claimed.

The first chapter describes the nature and main characteristics of trademarks, the process of their registration, the scope of legal protection and the different ways of their infringement. The purpose of the chapter is to provide a basic background for the further understanding of reasons and grounds from which the collision with domain name may arise, the consequences and problematic issues accompanying such clash.

The second chapter defines the term ‘domain name’, explaining its functions, the process of acquirement and the relevant rules regulating the use of domain names and the internet in general.

The third and final chapter deals with the actual cases of conflicting domain names and trademarks belonging to different entities. We will take a look at applicable substantive rules governing these cases of collision. Particularly we will focus on the EU law and compare it with the US approach. Beside the substantive provisions, the procedural issues will be considered as well. Lastly, we will describe an alternative solution provided for on the international level and point out the advantages and disadvantages and main differences in comparison to national, eventually regional regulation.

In the cases of a clash between domain names and trademarks, there are a number of questions stemming from the different features of these two concepts that are to be resolved. This thesis attempts to answer what are the legal defenses available to a trademark owner whose rights have been infringed by the use of a domain name; which party is likely to prevail on the merits of such cases; on which grounds and legal provisions to base the complaint; what are the applicable rules and provisions; what can the injured party demand; where a complaint can be filed, etc.. By this analysis, attention will be paid to the current legislation in

a comparative way with regard to the European and United States' system, to the significant comments and opinions of the scholars on the issues and to the relevant case law. The outcome of the study should provide the main guidelines for distinguishing the legitimate exploitation of a domain name from that of an abusive and dishonest nature, and offer a basic overview of the possible substantive and procedural rules governing those situations.

## Chapter 1 - Trademarks

The use of trademarks is almost as old as trade itself.<sup>1</sup> The goods of a particular guild in the medieval period were marked by the guild sign for the purpose of identification of their products.<sup>2</sup> These marks pursued several functions: they served as an advertisement; they provide evidence that they were sold by a particular merchant what helped to resolve the ownership disputes; and they guaranteed quality associated to the individual merchant.<sup>3</sup> First statutes governing trademarks in Europe enacted already in thirteenth century demonstrate the recognition and social and economic importance of such labeling.<sup>4</sup>

Today, the purpose of marking goods or products of a particular manufacturer has not changed much. We can conclude that the main functions of trademarks are twofold;<sup>5</sup> from the merchant's point of view, they are valuable instrument in business competition; from the consumers' perspective trademarks serve as guarantee of origin and quality of goods. We can also find other functions exceeding mere protection of public from deception or confusion and prevention of unfair business practice. One of such additional functions can be the role of trademark as a "lifestyle indicator"<sup>6</sup> reflecting the social dimension of trademark.

### ***1.1 International and Regional Trademark Regulation***

Beside the national laws concerning trademarks, and intellectual property in general, this subject matter is also, and even more importantly, regulated on international level. The system of international institutions and treaties pursues the aim to facilitate the acquisition and

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<sup>1</sup> ROBERT P. MERGES ET. AL: INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 617 (2006)

<sup>2</sup> ARTHUR R. MILLER & MICHAEL H. DAVIS: INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT IN A NUTSHELL 146 (1990)

<sup>3</sup> ROBERT P. MERGES ET. AL: INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE 617 (2006)

<sup>4</sup> ARTHUR R. MILLER & MICHAEL H. DAVIS: INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT IN A NUTSHELL 147 (1990)

<sup>5</sup> See MARGARET J. RADIN ET. AL: INTELLECTUAL PROPERTY AND THE INTERNET 3 (2004)

<sup>6</sup> GRAHAM DUTFIELD & UMA SUTHERSANEN: GLOBAL INTELLECTUAL PROPERTY LAW 139 (2008)



recognition of particular rights falling within the scope of intellectual property, and simultaneously creates the concept of minimum standards applicable to intellectual property to be followed by member (or contracting) states.<sup>7</sup>

Among the most important international organizations count the World Trade Organization and World Intellectual Property Organization; regional organizations with the greatest importance are the European Union and the United States of America.

### *1.1.1 World Trade Organization (WTO)*

WTO is a global international organization that deals with the rules of trade between nations in order to help producers of goods and services, exporters, and importers conduct their business.<sup>8</sup> The most important WTO treaty in the field of intellectual property is the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement), which introduced, for the first time, rules of intellectual property into the international trading system.

### *1.1.2 World Intellectual Property Organization (WIPO)*

As one of the specialized UN agencies, WIPO was established in 1967. Its objective is defined as follows:

The mission of WIPO is to promote through international cooperation the creation, dissemination, use and protection of works of the human mind for the economic, cultural and social progress of all mankind. Its effect is to contribute to a balance between the stimulation of creativity worldwide, by sufficiently protecting the moral and material interests of creators, on the one

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<sup>7</sup> DANIEL C. K. CHOW & EDWARD LEE: INTERNATIONAL INTELLECTUAL PROPERTY PROBLEMS, CASES, AND MATERIALS 3 (2006)

<sup>8</sup> WTO: What is the WTO, at [http://www.wto.org/english/thewto\\_e/whatis\\_e/whatis\\_e.htm](http://www.wto.org/english/thewto_e/whatis_e/whatis_e.htm)

hand, and the provision of access to the socio-economic and cultural benefits of such creativity worldwide, on the other hand.<sup>9</sup>

Among the number of treaties administered by WIPO, the most relevant to trademark protection are Madrid Agreement Concerning the International Registration of Marks (Madrid Agreement), Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol), Paris Convention for the Protection of Industrial Property (Paris Convention), and the Trademark Law Treaty (TLT).

### *1.1.3 European Union (EU)*

One of the main goals of the EU is the establishment of internal market with no boundaries, where the free movement of goods, persons, services and capital is ensured.<sup>10</sup> For the achievement of the said objective, the harmonization of national laws of member states is necessary. On this basis EU secondary legislation related to intellectual property was enacted. For the purposes of this thesis, those of the greatest importance are Directive 2008/95/EC of the European Parliament and of the Council to approximate the laws of the Member States relating to trade marks (EC Trademark Directive), and Council Regulation (EC) No 40/94 (EC Trademark Regulation).

### *1.1.4 United States (US)*

Trademark law in the US, formerly governed by common law, became subject to the federal regulation upon the enactment of Lanham Act in 1946, that is now incorporated in 15 U.S.C. Chapter 22. In addition to the previous forms of trademark protection, Lanham Act established federal protection of trademark based on registration.

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<sup>9</sup> WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE 5 (2001)

<sup>10</sup> TREATY ON THE FUNCTIONING OF THE EUROPEAN UNION, Article 26

## 1.2 Definitions and characteristics

The international and regional rules concerning trademarks provide for several definitions of trademark which vary in the wording, however, all of them reflect the essential character and nature of trademark.

TRIPS Agreement, Article 15 (1) reads as follows:

Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks.<sup>11</sup>

For comparison, Article 4 (1) of the EC Trademark Regulation in defining protectable subject matter states:

A Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.<sup>12</sup>

Lastly, the US Lanham Act says in 15 U.S.C. § 1127:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof - (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.<sup>13</sup>

These definitions together with the conditions of protectability and requisites for protection laid down in national legislation and regional and international treaties reflect the

<sup>11</sup> TRIPS AGREEMENT, Article 15 (1)

<sup>12</sup> COUNCIL REGULATION (EC) NO 40/94, Article 4 (1)

<sup>13</sup> 15 U.S.C. § 1127

specific nature and character of trademarks. To understand the reasons of and problems arising from the conflict between domain names and trademarks discussed in this thesis, it is necessary first to understand the main features of trademarks.

### *1.2.1 Subject Matter*

What can be protected as a trademark is laid down in relevant legal provisions usually in a broad manner. Article 15 (1) of the TRIPS agreement allows the registration of “any sign or any combination of signs ... in particular words including personal names, letters, numerals, figurative elements and combinations of colors, as well as any combination of such signs ....”<sup>14</sup> EC Regulation No 40/94 states in Article 4 that a “Community trade mark may consist of any signs capable of being represented graphically, particularly words, including personal names, designs, letters, numerals, the shape of goods or of their packaging ....”<sup>15</sup> U.S. law permits to use as trademark “any word, name, symbol, or device, or any combination thereof ....”<sup>16</sup>

More specifically, trademark can consist of words (especially trade names, personal names, geographical indications, fanciful names, etc.); letters and numerals (and combination thereof); devices (drawings, signs); colored marks (any of the previous types in color plus color combinations as such); three-dimensional signs (shape of the goods and packaging); sound marks; smell marks; other (invisible) signs.<sup>17</sup>

This doesn't mean, however, that any designation is suitable to constitute a trademark. In addition to the very extensive description of what can amount to trademark, the extent of protectable subject matter is subject to exceptions resulting from the lack of distinctive

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<sup>14</sup> TRIPS AGREEMENT, Article 15 (1)

<sup>15</sup> COUNCIL REGULATION (EC) NO 40/94, Article 4

<sup>16</sup> 15 U.S.C. § 1127

<sup>17</sup> WIPO INTELLECTUAL PROPERTY HANDBOOK 80 (2004)

character, immoral character and other features. These exceptions are examined in the following subchapter.

### 1.2.2 *Distinctiveness*

The purpose of trademark is to distinguish goods of various producers. To protect costumers from confusion as to the origin of goods they are purchasing, the trademark must be recognizable, identifiable, and different from other marks.<sup>18</sup> Laws concerned with trademarks thus make the requirement of distinctiveness a *conditio sine qua non*. TRIPS Agreement, Article 15 (1) states that a trademark must be capable of “distinguishing the goods or services of one undertaking from those of other undertakings.”<sup>19</sup> The term ‘distinctiveness’ as such is not defined, but rather it is regulated by a negative list of marks that do not satisfy the prerequisite of distinctiveness.<sup>20</sup> Dutfield and Suthersanen divided grounds for exclusion from legal protection of marks, based on the lack of distinctive character, into five categories:

- trade marks which are devoid of any distinctive character;
- marks which are descriptive;
- marks, which are generic;
- marks which comprise certain types of shapes;
- marks which are refused on general grounds of morality and public policy.<sup>21</sup>

*Marks devoid of distinctive character.* The ground of trademark application refusal based on the absolute lack of distinctiveness is provided for in Article 7 (1) (b) of the EC

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<sup>18</sup> ARTHUR R. MILLER & MICHAEL H. DAVIS: INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT IN A NUTSHELL 156 (1990)

<sup>19</sup> TRIPS AGREEMENT, Article 15 (1)

<sup>20</sup> See e.g. 15 U.S.C. § 1052; COUNCIL REGULATION (EC) No 40/94, Article 7

<sup>21</sup> GRAHAM DUTFIELD, UMA SUTHERSANEN: GLOBAL INTELLECTUAL PROPERTY LAW 142 (2008)

Trademark Regulation. It is questionable when a mark can be seen as devoid of any distinctive character. The European Court of Justice resolved this question by stating that “[f]or a mark to possess distinctive character within the meaning of [Article 3 (1) (b) of EC Trademark Directive] it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from products of other undertakings.”<sup>22</sup> In particular, letter, numbers, and colors per se without additional unusual or fanciful features are deemed to be devoid of any distinctive character, and are considered to be in public domain and are available to all traders.<sup>23</sup>

*Descriptive marks.* The EC Trademark Regulation prohibits the registration of “trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service.”<sup>24</sup> These terms serve the purpose to describe, rather than identify goods of a particular producer. Words like ‘fresh’, ‘new’, ‘kilo’, ‘dozen’, ‘extra’, and the like, are perceived by the public as product descriptions, rather than marks.<sup>25</sup> The rationale justifying the prohibition of descriptive marks is best explained by ECJ stating:

...Article 3(1)(c) of the [EC Trademark] Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.<sup>26</sup>

<sup>22</sup> EUROPEAN COURT OF JUSTICE (ECJ), Joined Cases C-53/01 to C-55/01, April 8<sup>th</sup>, 2008

<sup>23</sup> GRAHAM DUTFIELD, UMA SUTHERSANEN: GLOBAL INTELLECTUAL PROPERTY LAW 142 (2008)

<sup>24</sup> COUNCIL REGULATION (EC) No 40/94, Article 7 (1) (c)

<sup>25</sup> ROCHELLE C. DREYFUSS & ROBERTA R. KWALL: CASES AND MATERIAL, INTELLECTUAL PROPERTY: TRADEMARK, COPYRIGHT AND PATENT LAW 63 (2004)

<sup>26</sup> EUROPEAN COURT OF JUSTICE (ECJ) C-108/97 May 4<sup>th</sup>, 1999

The Court, however, goes on to make clear that:

...Article 3(1)(c) of the [EC Trademark] Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location — or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.<sup>27</sup>

*Generic marks.* Like descriptive marks, EU legislation precludes the registration of “trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.”<sup>28</sup> A word is generic, if it is used by public to describe the category of goods to which it belongs to.<sup>29</sup> As a general rule, a mark (word, sign, etc.) can be protected as trademark as long as it has secondary meaning, i.e. the capability to distinguish goods of a particular merchant. As Dryfuss and Kwall point out, “[a] term acquires secondary meaning when its *primary* meaning in consumers’ minds is the trademark meaning.”<sup>30</sup> Consequently, trademark is protected as long, as it is in public’s view associated with the goods of a particular producer. Therefore, on one hand even a descriptive term can by its use obtain distinctive character, and thus acquire protection granted to trademarks; on the other hand, however, there are also trademarks that have become generic terms and lost their distinctive function (e.g. aspirin, escalator, thermos, etc.). Moreover, even language versions of generic terms can be denied eligibility for registration.<sup>31</sup>

*Marks consisting of shapes.* EC Trademark Regulation does not permit the registration of marks consisting exclusively of shapes:

<sup>27</sup> *Id.*

<sup>28</sup> COUNCIL REGULATION (EC) No 40/94, Article 7 (1) (d)

<sup>29</sup> ROCHELLE C. DREYFUSS & ROBERTA R. KWALL: CASES AND MATERIAL, INTELLECTUAL PROPERTY: TRADEMARK, COPYRIGHT AND PATENT LAW 64 (2004)

<sup>30</sup> *Id.* at 79

<sup>31</sup> See e.g. Otokoyama v. Wine of Japan Import 7 Fed. Appx. 112; 2001 U.S. App. LEXIS 6048

- which results from the nature of the goods themselves; or
- which is necessary to obtain a technical result; or
- which gives substantial value to the goods.<sup>32</sup>

*Marks contrary to morality and public policy.* Whether or not a particular word or sign is contrary to public policy or is being seen as immoral, is to be ascertained in every particular case considering the ordinary meaning of the expression in question; its meaning in association with the goods or services protection of which is sought; public's view and perception and other relevant circumstances. Prohibited on the this ground are for example marks offending public decency,<sup>33</sup> deceiving marks, trade marks which include badges, emblems or escutcheons which are of particular public interest,<sup>34</sup> and others.

### 1.2.3 Territoriality

Trademarks are characterized by their territoriality. The recognition and protection of intellectual property (including trademarks) is considered in each and every country individually. As Professor Dinwoodie states, "a trademark has a separate existence in each independent legal system that accords and recognizes trademark rights; indeed, the same mark may be owned by different persons in different countries."<sup>35</sup> The independence of marks is set down in Article 6 (2) (3) of the Paris Convention saying:

...an application for the registration of a mark filed by a national of a country of the Union in any country of the Union may not be refused, nor may a registration be invalidated, on the ground that filing, registration, or renewal, has not been effected in the country of origin. A mark duly registered in a

<sup>32</sup> COUNCIL REGULATION (EC) No 40/94, Article 7 (1) (e)

<sup>33</sup> WILLIAM CORNISH & DAVID LLEWELYN: INTELLECTUAL PROPERTY: PATENTS, COPYRIGHT, TRADE MARKS AND ALLIED RIGHTS 675 (2003)

<sup>34</sup> COUNCIL REGULATION (EC) No 40/94, Article 7 (1) (i)

<sup>35</sup> GRAEME B. DINWOODIE ET. AL: INTERNATIONAL INTELLECTUAL PROPERTY LAW AND POLICY 89 (2001)



country of the Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin.<sup>36</sup>

In the U.S., the principle of territoriality is to be found in case law. In *Person's Co v. Christman*, the court pointed out that “[t]he concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme.”<sup>37</sup>

#### *1.2.4 Attachment to Goods or Services*

The very nature of trademarks as designations of particular goods or services makes their existence possible only when a trademark is assigned to goods or services. As Miller and Davis state, unlike copyright or patent, “[a] trademark cannot be appropriated *in gross* because its nature is incapable of such existence. A trademark is something that only exists with respect to some other commercial activity...”<sup>38</sup> According to Article 26 (1) (b) of EC Trademark Regulation the application for a Community trade mark must, among others, include a list of goods or services in respect of which the registration is requested.<sup>39</sup> On the other hand, the nature of goods and services shall not be an obstacle to registration of the trademark.<sup>40</sup>

#### *1.2.5 Acquirement of Legal Protection*

As a general rule, a trademark acquires legal protection upon registration at the designated office (Patent and Trademark Office; PTO). The conditions for filing and

<sup>36</sup> PARIS CONVENTION, Article 6 (2) (3)

<sup>37</sup> *Person's Co., LTD. v. Catherine Christman* 900 F.2d 1565; 1990 U.S. App. LEXIS 5591; 14 U.S.P.Q.2D (BNA) 1477

<sup>38</sup> ARTHUR R. MILLER & MICHAEL H. DAVIS: INTELLECTUAL PROPERTY: PATENTS, TRADEMARKS AND COPYRIGHT IN A NUTSHELL 149 (1990)

<sup>39</sup> COUNCIL REGULATION (EC) No 40/94, Article 26 (1) (b)

<sup>40</sup> TRIPS AGREEMENT, Article 15 (4)

registration are governed by the national law;<sup>41</sup> the exception is the registration of a community trademark, by which the conditions for registration are laid down in the EC Trademark Regulation. In the US, the Lanham Act established trademark registration on the federal level. Although some specific provisions concerned with the conditions for registration, and the registration process itself may differ from country to country, the main points reflecting the unique nature of trademarks remain the same. The rules governing registration process require the mark to comply with the statutory definition, i.e. to fall within the scope of protectable subject matter, to fulfill the condition of distinctiveness and to be assigned to particular goods or services. Some legal systems make registration dependent on actual use of the mark. In the US, the applicant for registration has to show that his mark is used in commerce,<sup>42</sup> or that he has a bona fide intention to use a trademark in commerce.<sup>43</sup> According to Article 15 of the TRIPS Agreement, member states may make registrability of a trademark dependent on distinctiveness acquired through use.<sup>44</sup>

Even after the fulfillment of all statutory requirements, there is no guarantee that the registration will be successful, for, beside absolute grounds for refusal of a trademark registration considered by the PTO *ex officio*, the application still can be objected by private interested parties on the basis of so called relative grounds for refusal.<sup>45</sup>

Once the process has reached its end and the mark is registered, the protection is granted in within the territory where protection was sought (as was already discussed in Section 1.2.3 above) and only in respect with certain goods or services. Therefore, an infringement of a registered trademark can be established only when the infringing act takes place in the same territory where the protection was granted and only in connection with the

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<sup>41</sup> See PARIS CONVENTION, Article 6 (1)

<sup>42</sup> 15 U.S.C. § 1051 (a) (3) (C)

<sup>43</sup> 15 U.S.C. § 1051 (b) (1)

<sup>44</sup> TRIPS AGREEMENT, Article 15 (1); However, actual use of a trademark shall not be a condition for filing an application for registration (TRIPS AGREEMENT, Article 15 (3)).

<sup>45</sup> See e.g. COUNCIL REGULATION (EC) NO 40/94, Article 8; 15 U.S.C. § 1063

same or similar goods or services. Moreover, for an act to be seen as a violation of trademark owner's rights, the both conditions have to be present simultaneously. Thus, any supposed infringement taking place outside the territory where the protection is granted, or even within the same territory but in respect with different goods or services, is being seen as a lawful act not interfering with the registered mark.

Apart from registered marks, in the US, legal protection may be awarded to marks established by custom and practice in connection with specific goods or services (common law mark).<sup>46</sup> Another exception in the recognition and protection of marks is the concept of well-known marks, established by the Paris Convention. This provision prohibits the registration and use of a mark that is already well known in the country where the registration is applied for as a mark used in connection with identical or similar goods.<sup>47</sup> The TRIPS Agreement has extended the application of the said provision also to service marks, and made clear that "[i]n determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark."<sup>48</sup> Thus, this category of marks enjoys legal recognition even without registration. Such treatment is consistent with the rules precluding unfair business practices (unfair competition law). Individual form of protection similar to that of well-known marks in the Paris Union<sup>49</sup> can be found also in the US system under the doctrine of famous marks. According to the Federal Trademark Dilution Act (15 U.S.C. § 1125 (c)) a mark is famous "if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner."<sup>50</sup>

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<sup>46</sup> PRACTICAL INTELLECTUAL PROPERTY: SUPPLEMENT SUMMARY, SUPPLEMENT 11 at 2/7 (1998)

<sup>47</sup> PARIS CONVENTION, Article 6<sup>bis</sup> (1)

<sup>48</sup> TRIPS AGREEMENT, Article 16 (2)

<sup>49</sup> The States to which Paris Convention applies (Paris Convention, Article 1 (1)).

<sup>50</sup> 15 U.S.C. § 1125 (c) (2) (A)

For a mark to acquire legal protection, as we could see, there is a number of conditions to be complied with. Registration is a formal process in which the conformity of a particular mark with a number of statutory requirements is examined. Even after the registration, the protection is limited as to the territory and to the subject of protection. Accordingly it is not easy to establish that a particular act amounts to a trademark infringement.

### *1.2.6 Rights Conferred*

Trademark constitutes property that is in many aspects similar to real or chattel property. Trademark can be transferred, used as a security, may be levied in execution, etc. The use of trademark is the essential right of the trademark owner which includes the right to affix the mark on goods, containers, packaging, labels, etc.<sup>51</sup> Trademark is of economic value, which is often significant. The following chart lists ten most valuable marks of the year 2012.

**Chart 1** Top ten world's most valuable Trademarks<sup>52</sup>

Trademark		Value (in billion USD)
1.	Apple	183.0
2.	IBM	116.0
3.	Google	107.9
4.	McDonald's	95.2
5.	Microsoft	76.7
6.	Coca-Cola	74.3
7.	Marlboro	73.6
8.	AT&T	68.9
9.	Verizon	49.2
10.	China Mobile	47.0

Source: The 28 Most Valuable Brands In The World at [www.businessinsider.com](http://www.businessinsider.com)

<sup>51</sup> WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE 83 (2001)

<sup>52</sup> The 28 Most Valuable Brands In The World, at <http://www.businessinsider.com/the-most-valuable-brands-in-the-world-2012-5?op=1>

Without the need of any further examination, it can be said that the value of a trademark (and in some cases also other types of intangible property) is often remarkably higher than the value of chattels or lands and other tangible property.

In addition to the mentioned positive rights, and more importantly, the right to use encompasses also the right to exclude third persons from exploiting the protected mark without the trademark owner's consent. The right to exclude reflects the specific character of trademarks and intellectual property in general. Instead of a bunch of rights to be exercised by a trademark owner, the scope of protection is rather determined by listing possible ways of conduct that amounts to trademark infringement. Thus, the rights are of negative nature.

Article 16 (1) of TRIPS Agreement reads as follows:

The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.<sup>53</sup>

Since the trademark proprietor's rights are to be inferred from the cases of infringement we will discuss this issue in more detail in the following chapter.

### **1.3 Trademark Infringement**

The marking of goods and services is, and has been for a long time, a valuable and important business instrument. Trademarks enable the identification of a particular merchant; by their use, a producer can build his reputation, attract costumers, and occupy specific market position. Trademark is tool used in business competition, but also a device to protect the public from being deceived. It is therefore in the common interest of both the merchant

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<sup>53</sup> TRIPS AGREEMENT, Article 16 (1)

(competitor) and the society as a whole to prevent others from the unlawful exploitation of other's trademark.

The trademark infringement arises from any conduct which may cause the likelihood of confusion. From all the already described features of trademarks and the scope of protection, we can conclude, that the likelihood of confusion can be present only in respect with the protected mark, the goods and services designated by such mark and only within the territory, where the protection is granted. It is of no relevance, whether the protection is granted on the basis of registration, or stems from the status of a well-known (or famous) mark, the prohibited acts are in both cases the same.

The EC Trademark Regulation prevents third parties not having the trademark owner's consent from using in the course of trade:

- any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;
- any sign where, because of its identity with or similarity to the Community trade mark and the identity or similarity of the goods or services covered by the Community trade mark and the sign, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association between the sign and the trade mark;
- any sign which is identical with or similar to the Community trade mark in relation to goods or services which are not similar to those for which the Community trade mark is registered, where the latter has a reputation in the Community and where use of that

sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the Community trade mark.<sup>54</sup>

The Regulation further lists in a non-exhaustive way few examples of prohibited acts of third parties. Those acts include affixing the sign to the goods or to the packaging thereof; offering the goods, putting them on the market or stocking them for these purposes under that sign, or offering or supplying services thereunder; importing or exporting the goods under that sign; using the sign on business papers and in advertising.<sup>55</sup>

The civil law concept of likelihood of confusion is in the US known as the doctrine of passing-off, i.e. the use of a trademark on a product in a manner that is likely to cause confusion of the consumer as to the source of origin of a product.<sup>56</sup> Such conduct is actionable under 15 U.S.C. § 1114 on the basis of the use in commerce of any reproduction, counterfeit, copy or imitation of a registered trademark in connection with goods or services in a manner that is likely to cause confusion or mistake, or to deceive consumers.<sup>57</sup> Similarly, 15 U.S.C. § 1125 (a) imposes civil liability on anyone, “who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which - is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or in commercial advertising or

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<sup>54</sup> COUNCIL REGULATION (EC) No 40/94, Article 9 (1)

<sup>55</sup> COUNCIL REGULATION (EC) No 40/94, Article 9 (2)

<sup>56</sup> ROCHELLE C. DREYFUSS & ROBERTA R. KWALL: CASES AND MATERIAL, INTELLECTUAL PROPERTY: TRADEMARK, COPYRIGHT AND PATENT LAW 82 (2004)

<sup>57</sup> 15 U.S.C. § 1114 (1)

promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities....<sup>58</sup>

It is clear from the cited provisions, that the underlying concept giving rise to liability for trademark infringement is the 'likelihood of confusion'. This doctrine protects the public, namely consumers, on one hand, and the merchants and business competition, on the other. To ascertain whether or not particular business practice can cause the likelihood of confusion, the U.S. case law created guidelines taking into consideration:

- strength of the mark,
- evidence of confusion,
- similarity between two marks,
- proximity of the products,
- good faith.<sup>59</sup>

Similarly, when considering the possibility of infringement, according to WIPO Intellectual Property Handbook the following should be examined:

- similarity of goods,
- similarity of trademarks,
- influence of use and non-use.<sup>60</sup>

The most common unlawful practices likely to cause confusion and therefore giving rise to trademark infringement are:

*trademark piracy* – meaning the registration or use of a well-know trademark in a country where the mark is not registered;

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<sup>58</sup> 15 U.S.C. § 1125 (a)

<sup>59</sup> See McDonald's Corporation v. Druck and Gerner, DDS., 814 F. Supp. 1127; 1993 U.S. Dist. LEXIS 6505; 26 U.S.P.Q.2D (BNA) 1493

<sup>60</sup> WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE 84-87 (2001)



*counterfeiting* – the unlawful imitation of product with the aim to pretend the counterfeited good being the genuine one;

*imitations of labels and packaging* – practice of taking an unfair advantage by imitation of labeling and packaging of a competitor's product.<sup>61</sup>

Beside the legal protection based on the likelihood of confusion, famous marks in the US are also given protection against dilution. Dilution of a famous mark means the impairment of the distinctiveness (dilution by blurring)<sup>62</sup> or detriment to a famous mark's reputation (dilution by tarnishment)<sup>63</sup> arising from the similarity between mark and a famous mark. While in the case of passing-off (or likelihood of confusion) the primary object of protection is the public, the concept of dilution prevents a famous mark from lessening its distinctive character (therefore the protection is aimed more at the mark owner or the preservation of the mark itself).

#### **1.4 The Impact of the Internet**

What has been discussed up to this part was the nature and characteristics of trademarks, their main functions and ways of their infringement. Such overview is essential in order to acknowledge the value and importance of trademarks and the need for their protection. What has changed with the introduction and growth of the internet is that it established a new, world-wide market place that can be accessed very easily by anyone at any time from any place at relatively low costs. The most significant features of the internet defined in the WIPO Domain Name Process final report can be summed up in the following points:

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<sup>61</sup> WIPO INTELLECTUAL PROPERTY HANDBOOK: POLICY, LAW AND USE 88-90 (2001)

<sup>62</sup> 15 U.S.C. § 1125 (c) (2) (B)

<sup>63</sup> 15 U.S.C. § 1125 (c) (2) (C)

- the Internet is something that increasingly large numbers of people throughout the world find an interest in being connected to;
- it is increasingly an affordable and relatively low-cost matter to become connected to the Internet and thus to be able to participate in the advantages that it offers;
- the multifunctionality of the internet;
- the lack of central point of authority and control;
- multijurisdiction aspect of the internet;
- the unspecific regulation of the internet.<sup>64</sup>

Intellectual property law protects the creations resulting from “intellectual activity in the industrial, scientific, literary and artistic fields.”<sup>65</sup> Although the target of protection is not the material (physical) object encompassing such creation, but the creation itself, traditionally the infringement of intellectual property rights could nevertheless take place only in material world (for example, in respect with trademarks by counterfeiting competitor’s goods or imitating his packaging or labeling). This is, however, no longer true in the modern technological era. The virtual environment made the content independent on the material medium. Likewise, the principle of territoriality characterizing IP rights started to face the world-wide reach of the internet. While the offer for sale of counterfeited products or imitations in real world causes infringement only at the place where such counterfeits are located, the display of such products on the internet gives rise to the infringement in the whole world at the same time. Thus, the infringement became incomparably more extensive and much cheaper than previously, when it occurred in the physical world. What’s more, beside the quantitative growth in infringement that the internet provides, it enabled the development of qualitatively entirely new forms of trademark rights violation; forms, that were formerly

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<sup>64</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 1-2 (1999)

<sup>65</sup> WIPO INTELLECTUAL PROPERTY HANDBOOK 3 (2004)

unknown and unforeseen by laws and rules governing trademark and intellectual property in general. One of such new ways of unlawful conduct is the use of domain name corresponding with a competitor's trademark. As Cornish and Llewelyn state, internet provides "virtual space in which unfair trading with marks, brands, business names and the like can take place."<sup>66</sup>

To the most common new forms of IP rights infringement arising from the nature of cyber-space created by the internet count the cybersquatting, typosquatting and the use of trademark in one's metatags.

*Cybersquatting.* Cybersquatting was defined by U.S. courts as a "deliberate, bad faith, and abusive registration of Internet domain names in violation of rights of trademark owners."<sup>67</sup>

*The use of trademark in metatags.* Metatag is a "hypertext markup language ("HTML") code, invisible to the internet user, that permits web designers to describe their webpage."<sup>68</sup> Although metatags are invisible for internet users, they are used by search engines (such as google) to generate a list of results for a particular word entered by an internet user into the search bar. One can infringe someone else's trademark by using it in own metatags, so as to attract internet users searching for the trademark to one's own webpage.<sup>69</sup>

*Typosquatting.* The principle of typosquatting is the same as in cybersquatting with the difference that the infringer registers as a domain name the most common misspellings of protected trademark, so that an incautious consumer may accidentally visit web site he hasn't intended to.

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<sup>66</sup> WILLIAM CORNISH & DAVID LLEWELYN: INTELLECTUAL PROPERTY: PATENTS, COPYRIGHT, TRADE MARKS AND ALLIED RIGHTS 815 (2003)

<sup>67</sup> *In re Wright*, 355 B.R. 192 (Bankr. C.D. Cal. 2006)

<sup>68</sup> *Bensusan Restaurant Corp. v. King*, 126 F.3d 25, 27 (2d Cir. 1997); *Bihari v. Gross*, 2000 WL 1409757 (S.D.N.Y. 2000).

<sup>69</sup> See e.g. *Brookfield Communications v. West Coast*, 174 F.3d 1036, 50 U.S.P.Q.2d 1545

## Chapter 2 - Domain Names

The impact of the internet gave rise to an entirely new form of intangible asset, the internet domain name.<sup>70</sup> The internet can be seen as a “super-network”<sup>71</sup> providing access to unlimited number of various types of data and information.<sup>72</sup> The flow of information over the internet is organized through the use of IP (Internet Protocol) address. IP address is a sequence of numbers which constitutes an “actual physical network address by which routing on the Internet takes place and which ensures that IP packages sent via the data networks reach the host computer.”<sup>73</sup> Every resource placed on the internet,<sup>74</sup> such as e-mail address, web page, particular file, etc., has its own Uniform Resource Locator (URL). One part of this ‘cyber-address’ is a domain name. Just like every school, hospital, or house in material world has a unique street address, every website is built on a unique domain name in cyberspace.<sup>75</sup> The factual address remains still the IP address, however, the Internet's domain-name system (DNS) enabled users to enter particular web site or other resources simply by using easier-to-remember domain names instead of the all-numeric IP addresses.<sup>76</sup> However, this is exactly what gives domain names their value. According to WIPO Internet Domain Name Process final report:

Precisely because they are easy to remember and to identify, however, domain names have come to acquire a supplementary existence as business or personal identifiers. As commercial activities have increased on the Internet, domain names have become part of the standard communication apparatus used by businesses to identify themselves, their products and their activities. Advertisements appearing in the media now routinely include a domain name address, along with other means of identification and communication, such as the corporate name, trademark and telephone and facsimile numbers. But, whereas the telephone and facsimile numbers consist of an anonymous string

<sup>70</sup> MARGARET J. RADIN ET AL.: INTELLECTUAL PROPERTY AND THE INTERNET: CASES AND MATERIALS 2 (2004)

<sup>71</sup> Playboy Enterprises, Inc. v. Universal Tel-A-Talk, Inc., 1998 WL 767440 (E.D.Pa.1998)

<sup>72</sup> *Id.*

<sup>73</sup> TORSTEN BETTINGER: DOMAIN NAME LAW AND PRACTICE 4 (2005)

<sup>74</sup> LILIAN EDWARDS & CHARLOTTE WAEDELDE: LAW AND THE INTERNET: REGULATING CYBERSPACE 45 (1997)

<sup>75</sup> MARGARET J. RADIN ET AL.: INTELLECTUAL PROPERTY AND THE INTERNET: CASES AND MATERIALS 85 (2004)

<sup>76</sup> ICANN: Top-Level Domains (gTLDs), at <http://archive.icann.org/en/tlds/>

of numbers without any other significance, the domain name, because of its purpose of being easy to remember and to identify, often carries an additional significance which is connected with the name or mark of a business or its product or services.<sup>77</sup>

Each domain name consists of several levels separated from each other by a dot.<sup>78</sup>

Level on the last position of a domain name is called top-level-domain (TLD). TLDs are of different types, most common are generic TLDs (gTLDs)<sup>79</sup> including “.com”, “.net”, “.biz”, and the like, and country code TLDs (ccTLDs) such as “.fr”, “.de”, “.it” etc.<sup>80</sup> The part of a domain name preceding TLD is called second-level-domain and serves as a subdivision or specification within particular TLD (for example “justice.gov.sk”, or “ebay.co.uk”), or they are open for registration by the public. Third-, eventually fourth-level-domains are usually registered by the owners of second-level-domain.

## **2.1 Acquisition**

The only way how to obtain a domain name is registration, which is based on first-come, first-served principle. The preservation of the operational stability of the internet is exercised by Internet Corporation for Assigned Names and Numbers (ICANN).<sup>81</sup> More specifically, ICANN “coordinates the Domain Name System (DNS), Internet Protocol (IP) addresses, space allocation, protocol identifier assignment, generic (gTLD) and country code (ccTLD) Top-Level Domain name system management, and root server system management functions.”<sup>82</sup>

<sup>77</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 3 (1999)

<sup>78</sup> TORSTEN BETTINGER: DOMAIN NAME LAW AND PRACTICE 5 (2005)

<sup>79</sup> Generic TLDs can be subdivided into sponsored and unsponsored TLDs.

<sup>80</sup> Beside gTLDs and ccTLDs there is one more type containing only one TLD, and that is “.arpa” serving to infrastructure purposes (<http://archive.icann.org/en/tlds/>).

<sup>81</sup> ICANN Factsheet at <http://archive.icann.org/en/factsheets/fact-sheet.html>

<sup>82</sup> ICANN: Welcome to ICANN!, at <http://www.icann.org/en/about/welcome>

Domain name can be registered by any natural or legal person. The competences by the registration process are divided between the registry and the registrar(s),<sup>83</sup> both under the supervision and administration of ICANN. Registry administers and maintains the LTD. Registrars are, usually private, entities providing the domain name registration services to the end users. To be allowed to offer the domain name registration services, an entity needs to obtain an accreditation from ICANN; the relationship between ICANN and the registrar is governed by the Registrar Accreditation Agreement.<sup>84</sup> Except for special TLDs reserved to only limited purposes,<sup>85</sup> there are no requirements for registration; no examination takes place prior to the assignment of a particular domain name to the registrant and no conditions are to be fulfilled. The applicant for domain name registration does not need to prove any legal interest in the chosen name.

## **2.2 Effects and Use**

The effects of registration of a domain name are much simpler than those of a trademark registration. First, it has to be noted that the only way how to obtain a domain name is by its registration. Situation is different in respect with marks, which can acquire legal protection even without being registered, as was discussed before. From the mere registration of a domain name flow no obligations to the registrant. While the trademark protection is dependent on the existence of goods (eventually services) and is granted only with respect to particular goods, domain name can exist as such. The domain name owner has the right (not a duty, however) to use his domain name in any desired manner.<sup>86</sup> The registrant is not obliged to restrict his intentional use of the domain name in any way, unlike in the case of trademarks.

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<sup>83</sup> TORSTEN BETTINGER: DOMAIN NAME LAW AND PRACTICE 22 (2005)

<sup>84</sup> Information for Registrars and Registrants at <http://www.icann.org/en/resources/registrars>

<sup>85</sup> For example ‘.mil’ is reserved for US military use; ‘.gov’ for US government; ‘.int’ for international organizations, etc.

<sup>86</sup> Of course there are limits resulting from the laws of a particular state, breach of which impose civil or criminal liability.

Thus, domain names can be used for commercial, educational, information, entertainment or any other purposes.

The very nature of a domain name suggests that rights conferred on its owner by the way of registration are of global reach. In the case of establishment of a web site on a registered domain, this web site can be accessed word-wide. Whereas intellectual property rights are limited territorially the registration of a domain name “gives rise to a global presence.”<sup>87</sup> It also logically follows from the above mentioned, that every single domain name in its entirety can exist and be registered only once. Therefore, the second- and third-level-domains can, if identical, only be registered on different TLDs. Consequently, the cases of domain name infringement are substantially limited in comparison with the possible ways of trademark infringement. It is technically impossible to exploit someone else’s domain name, as can be the case of counterfeiting or passing-off in relation with trademarks. The means of domain name infringement are thus restricted maybe to typosquatting, but much more relevant and of much greater importance are the situations where it comes to clash between domain names on one side and trademarks on the other.

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<sup>87</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 12 (1999)

## Chapter 3 - The Clash between Domain Names and Trademarks

The acquisition of a trademark is a long and difficult process. The application for registration has to meet several conditions. There has to be an actual business in existence, producing particular goods or rendering services to which a trademark is to be attached. The registration of a trademark is dependent on the business and cannot exist as such. After the registration of a trademark the possible problems do not end; just in the opposite. The trademark owner begins to build up his reputation, his good will, he preserves and controls the quality of marked goods or services and invest considerable time, effort and finance to advertise the trademark, to make it known to the public. Domain name, on the contrary, is very easy, cheap and fast to acquire. The following chart shows the number of registered domain names in individual years.

**Chart 2:** Number of registered domain names<sup>88</sup>

YEAR	NUMBER OF DOMAIN NAMES
1999	1
2000	3760
2001	2465
2002	2042
2003	1774
2004	2599
2005	3312
2006	2806
2007	3545
2008	3958
2009	4685
2010	4367
2011	4780
2012	5080
2013	1948

*Source:* Total Number of Domain Names by Year at [www.wipo.int](http://www.wipo.int)

<sup>88</sup> WIPO: Total Number of Domain Names by Year, at <http://www.wipo.int/amc/en/domains/statistics/domains.jsp>



From the information contained in the table it is clear that there is an increasing tendency in the domain name registrations. Therefore the need of the regulation of possible conflicts with trademarks in an efficient way is becoming more and more important.

In addition to the above mentioned, there are no limitations, no restrictions and no obligations accompanying the registration or use of a domain name. It follows that it can come very easily to a clash between a domain name and a particular trademark. The collision can be accidental when the domain name registrant is not aware of the existence of a trademark identical or similar to his domain name, or intentional, when such domain name is registered in bad faith for a commercial gain. When a conflict between domain name and a trademark occurs, there are number of problems and controversies arising in this situation.

Since trademarks are limited in territorial scope of protection, the same mark can be registered by various merchants in different states or regions. Domain name, on the other hand, has global reach and can be registered and exist only once. The question is which of the merchants has the right to use the domain name corresponding to his trademark. What happens if the domain name is already registered by an entity that does not own such trademark at all? And from the other point of view, does a domain name registrant infringe a trademark rights by using a domain name identical to protected trademark? The answer can be positive in states where such trademark enjoys protection and negative in the others. It is therefore unclear what the legal consequences in such case are. It would be inadequately burdensome for a domain name registrant to comply with the intellectual property law of every single state across the world. It would also be unfair to deprive such registrant of the right to use selected domain name if it conflicts with a trademark that is protected in only one or only few states; especially when the domain name owner had no actual knowledge about the existence of such trademark. Domain names can, and often do, serve as a platform for business activities; something like a place of business, or shop in physical world. The domain

name owner can establish a well known domain address with good reputation and a significant number of the web page visitors. Can he be forced to abandon this internet address for the reason that it is actually identical to someone else's trademark? And, on the other hand, does a proprietor of a wide-known prestigious trademark possess the right to use the mark as his domain name (and exclude others from such use)? And if such name is already registered, are there any means of its acquisition? Once a trademark becomes well-known and famous, it is very important and valuable instrument for the merchant to exploit a domain name corresponding to the mark. Since the domain name can exist only once and is assigned on first-come, first-served basis, the domain name owner has in such situation literally absolute bargain power. There should be, therefore, some means for the trademark owner to obtain the domain name from its registrant. The question therefore remains, where is the border and what are the limits of lawfulness and fairness in this cyber-competition and what legal remedies are available for a party harmed by such practice.

### **3.1 Court Protection**

The traditional and most common way of the protection and enforcement of one's rights is the filing of a law suit in a national court. The outcome of such proceeding depends mostly on the applicable national law. In the following part we will focus on two main regional legal systems dealing with this issue and those are the EU and the US.

#### *3.1.1 European Union*

Within the European Union there is still no legal regulation concerned with the internet or domain names. The introduction of the .eu TLD was accompanied by EC Regulation No 733/2002 which dealt with the implementation of the new Community TLD.

The said regulation called for the adoption of a policy preventing abusive domain name registration and protection of intellectual property rights as well as other rights.<sup>89</sup> With regard to this requirement, the Commission of the EU enacted EC Regulation No 874/2004. Domain name based on .eu TLD can be registered by any undertaking or organization established within or with a principal place of business within the Community, or by any natural person resident within the Community<sup>90</sup> on the first-come-first-served principle.<sup>91</sup> The rights in names and marks existing prior to the introduction of .eu TLD were offered protection by the possibility for such rights owners to register domain name corresponding with their prior rights in a stated period.<sup>92</sup> However, this provision does not provide any basis for the settlement of disputes arising from the clash between registered domain name and protected trademark which are to be resolved by the application of existing laws to the on-line environment. In essence, a harmed party can base his claim either on laws regulating trademarks, or unfair competition law.

Trademark law has been harmonized within the EU by the enactment of EC Trademark Regulation. Article 9 (1) of the said Regulation prevents third parties from using in the course of trade any sign identical or similar to registered trademark in relation to identical or similar goods or services if such use can cause the likelihood of confusion on the part of the public.<sup>93</sup> The plaintiff, to be successful, has to prove that the use of domain name corresponding to the protected trademark can be misleading as to the source of origin of goods or services. Particularly, it has to be shown that the domain name is used in the course of business in connection with goods or services that are identical or similar to those of plaintiff. Therefore, the mere registration of a domain name can hardly be seen as ‘the use in course of trade’ and thus is not sufficient to assert infringement on the basis of trademark law.

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<sup>89</sup> EC REGULATION No 733/2002, Article 5 (1)

<sup>90</sup> EC REGULATION No 733/2002, Article 4 (2) (b)

<sup>91</sup> EC REGULATION No 874/2002, Article 2

<sup>92</sup> EC REGULATION No 874/2004, Article 10 (1)

<sup>93</sup> COUNCIL REGULATION (EC) No 40/94, Article 9 (1)

Likewise, since domain name is not attached to any particular goods and services or any particular activity in general, the application of trademark law in these cases is limited in scope.

Law concerning the unfair competition precludes third parties from taking unfair advantage of other competitor's trademark.<sup>94</sup> The rationale of unfair competition laws is to prohibit the dishonest practices – acts that are '*contra bonos mores*'. The concept of unfair competition encompasses "a whole panoply of claims against 'unfair' conduct in business or commercial dealing, such as bribery and different forms of competitive and promotional advertising."<sup>95</sup> The broad construction of the unfair competition doctrine incorporates in itself also the cases of likelihood of confusion; however, it does not extend only to the trademark (or IP rights) infringement, but covers other practices contrary to the principles of good faith and morality used in the course of business. Paris Convention obliges member states to assure effective protection against unfair competition.<sup>96</sup> Unfair competition is defined as "[a]ny act of competition contrary to honest practices in industrial or commercial matters...."<sup>97</sup> These provisions protect the goodwill and reputation of a merchant from its exploitation by other competitors. Whether or not particular behavior amounts to unfair competition is to be examined on the case-by-case basis taking into consideration all the relevant circumstances.<sup>98</sup> The vague wording of unfair competition provisions enables its application, on the one hand, to a variety of different cases of infringement. However, on the other hand, the lack of more specific language leaves the decision-making up to the extensive discretion of the judge. In the UK, for comparison, the prevention of unfair competition relies on three legal doctrines,

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<sup>94</sup> COUNCIL REGULATION (EC) No 40/94, Article 9 (1) (c)

<sup>95</sup> DANIEL C. K. CHOW & EDWARD LEE: INTERNATIONAL INTELLECTUAL PROPERTY PROBLEMS, CASES, AND MATERIALS 705 (2006)

<sup>96</sup> PARIS CONVENTION, Article 10<sup>bis</sup> (1)

<sup>97</sup> PARIS CONVENTION, Article 10<sup>bis</sup> (2)

<sup>98</sup> A non-exhaustive list of examples of acts amounting to unfair competition is provided for in Article 10<sup>bis</sup> (3) of the Paris Convention.

namely passing-off, inducing the breach of contract and defamation.<sup>99</sup> Thus, unfair are practices used to attract costumers by confusing them as to the identity of the merchant who are they dealing with; inducing them to break a contract they concluded with another competitor; or lying to them in order to weaken the reputation and goodwill of other competitors.<sup>100</sup>

We can conclude that the rules governing directly the conflict between rights in trademark and rights in domain name are non-existent. It cannot be said that the harmed party is without any legal means of defense; the available means, however, do not reflect the unique nature of the cyberspace and their use is thus considerably limited. In cases of domain names conflicting with trademarks, traditional protection of trademarks and unfair competition law is to be applied to the on-line environment. The aspect of virtual environment is therefore of no importance and the nature and conditions of protection do not differ from those arising from infringement taking place in the material world.

### 3.1.2 *United States*

The US legislation, unlike the EU law, recognizes specifically cases of infringement of the trademark by the use of a domain name identical or similar to that mark. The new type of protection was introduced by the Anticybersquatting Consumer Protection Act (ACPA) in 1999 incorporated in 15 U.S.C. § 1125 (d). Before the enactment of ACPA, the grounds for protection were laid down in 15 U.S.C. § 1125 (a) and (c) imposing civil liability on third party acting in a manner capable of causing the likelihood of confusion or in a way likely to cause dilution of a famous mark.

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<sup>99</sup> DANIEL C. K. CHOW & EDWARD LEE: INTERNATIONAL INTELLECTUAL PROPERTY PROBLEMS, CASES, AND MATERIALS 707 (2006)

<sup>100</sup> DANIEL C. K. CHOW & EDWARD LEE: INTERNATIONAL INTELLECTUAL PROPERTY PROBLEMS, CASES, AND MATERIALS 707 (2006)

The concept of the likelihood of confusion (passing-off) is the same as in the EU, consisting in the use of any name, term, symbol or other device in connection with goods or services in such a manner that is likely to cause confusion or mistake as to the origin of such goods or services.<sup>101</sup>

On the basis of the likelihood of dilution doctrine in connection with a famous mark, the plaintiff, to succeed in the court action, has to show that he owns a famous mark, the infringer uses the mark in a course of commerce and that such use is likely to cause dilution. There are two main questions arising from the use of a domain name conflicting with a famous mark; first, whether the mere registration can be seen as the use in the course of commerce; second, whether the registration of a domain name itself can cause dilution. As for the first question, the US case law indicates that the mere registration of a trademark does not amount to a commercial use.<sup>102</sup> However, the registration of a domain name with the intention of its resale is a business activity.<sup>103</sup> In resolving the question whether or not a domain name can dilute a famous mark, the court in *Panavision International, L.P. v. Toeppen* answers in affirmative by rejecting the premise that a “domain name is nothing more than an address”<sup>104</sup> and makes clear that “[a] significant purpose of a domain name is to identify the entity that owns the website.”<sup>105</sup>

The situation has changed with the introduction of ACPA, which imposes liability in civil action on anyone who with bad faith intent to profit from another’s protected mark registers, traffics or uses a domain name that is identical or confusingly similar to such mark (or dilutive to a famous mark).<sup>106</sup> Unlike the protection based on the likelihood of confusion

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<sup>101</sup> 15 U.S.C. § 1125 (a) (1)

<sup>102</sup> See e.g. *Panavision International, L.P. v. Toeppen*, 945 F. Supp. 1296; 1996 U.S. Dist. LEXIS 19698; 40 U.S.P.Q.2D (BNA) 1908; *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949; 1997 U.S. Dist. LEXIS 19273; 44 U.S.P.Q.2D (BNA) 1865

<sup>103</sup> *Intermatic, Inc. v. Toeppen*, 947 F. Supp. 1227; 1996 U.S. Dist. LEXIS 14878; 40 U.S.P.Q.2D (BNA) 1412

<sup>104</sup> *Panavision International, L.P. v. Toppen*, 141 F.3d 1316; 1998 U.S. App. LEXIS 7557; 46 U.S.P.Q.2D (BNA) 1511

<sup>105</sup> *Id.*

<sup>106</sup> 15 U.S.C. § 1125 (d) (1) (A)

and dilution, the ACPA does not require the use of a mark in the course of commerce and is independent on goods and services to which the mark is attached to. The mere registration of an identical or confusingly similar to protected trademark is sufficient. The only requirement is the proof of bad faith of the domain name registrant. By the determination of bad faith, the court may take into account, among other factors, the trademark or intellectual property rights of the domain name owner, the similarity between the domain name and such person's name, prior bona fide commercial use of the domain name, the person's bona fide noncommercial use of the domain name, the person's intention to mislead to internet users, intention to resell or otherwise transfer the domain name to the mark owner, the nature of the person's other registered domain names and the like.<sup>107</sup> The listed elements can serve as guidelines that are to be considered among (but not exclusively) the totality of circumstances in every case. The bad faith was alleged for example in *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, where the infringer registered and subsequently transferred to a new established subsidiary a domain name corresponding with a competitor's trademark for the purpose to use the domain name in business, make the domain name unavailable for the trademark owner and to protect itself in a case of claim.<sup>108</sup> In another case, the bad faith consisted in the registration of hundreds of misspellings of the world famous marks and names that redirected the internet user to a number of advertising windows; the registrant was paid by the advertisers by every click on such advertisement.<sup>109</sup>

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<sup>107</sup> 15 U.S.C. § 1125 (d) (1) (B)

<sup>108</sup> *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489; 2000 U.S. App. LEXIS 1246; 53 U.S.P.Q.2D (BNA) 1570

<sup>109</sup> *Electronics Boutique Holdings Corp. v. Zuccarini*, 2000 U.S. Dist. LEXIS 15719; 56 U.S.P.Q.2D (BNA) 1705

### 3.2 Legal Remedies

The available remedies for the injured party depend on the legal system where, and on the type of legal protection on the basis of which, the remedy is sought.

Within the EU, the EC Trademark Regulation explicitly provides for a sanction consisting in the prohibition of acts which infringed or would infringe the community trademark.<sup>110</sup> Member states' courts are entitled to take such measures in accordance with the national law as to ensure the compliance with the said prohibition.<sup>111</sup> In all other cases of court action based either on national trademark or unfair competition law, courts apply their national law (eventually national law of other state if referred to by the conflict of laws rules), and can consequently impose sanctions foreseen by such law. In general, a court can order the defendant to exercise or, on the contrary, to refrain from doing particular acts. More specifically, the losing party can be obliged to stop and not to continue with infringing activities, to hand over or to destroy infringing goods (or other material), to indemnify the harmed party (i.e. to pay damages) and the like. In case of the violation of someone else's trademark rights by the use of an identical or confusingly similar domain name, the national court can prohibit further use of such domain name, or order the transfer of a domain name to the trademark owner. While the main proceeding is pending, the plaintiff may also file an application for a preventive measure.<sup>112</sup>

In the US, the protection guaranteed by ACPA offers the injured party two separate ways of how to proceed. First, there is an '*in personam*' action against the infringer that enables the recovery of:

- the defendant's profits,
- any damages sustained by the plaintiff, and

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<sup>110</sup> COUNCIL REGULATION (EC) NO 40/94, Article 98 (1)

<sup>111</sup> *Id.*

<sup>112</sup> *See e.g.* COUNCIL REGULATION (EC) NO 40/94, Article 99



- the costs of action.<sup>113</sup>

Alternatively, the injured party can in case of the violation of 15 U.S.C. § 1125 (d) (1) elect “to recover, instead of actual damages and profits, an award of statutory damages in the amount of not less than \$1,000 and not more than \$100,000 per domain name, as the court considers just.”<sup>114</sup> The proprietor of a famous mark can also in accordance to the principles of equity be entitled to an injunctive relief.<sup>115</sup> In addition, in any case involving the registration or use of a domain name, a court may order the forfeiture, cancellation or transfer of the domain name.<sup>116</sup>

The second form of defense is the filing of an ‘*in rem*’ action, provided that the court cannot obtain *in personam* jurisdiction over the domain name registrant, or despite due diligence is not able to find a person that would have been a defendant in the court action.<sup>117</sup> The *in rem* action remedies are limited to the order of forfeiture, cancellation or transfer of the domain name.<sup>118</sup> The *in personam* and *in rem* actions are mutually exclusive<sup>119</sup> where the latter can be exercised only when through due diligence there cannot be established an *in person* jurisdiction.

### **3.3 Jurisdiction, Choice of Law and Enforcement**

Although the substantive rules still do not provide sufficient protection from the infringing acts occurring on-line and do not fully reflect the newly arisen aspects of trademark violation over the internet, the even more controversial part of the legal protection is that of procedural nature. Whereas in the material world the trademark infringement, as a general

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<sup>113</sup> 15 U.S.C. § 1117 (a)

<sup>114</sup> 15 U.S.C. § 1117 (d)

<sup>115</sup> 15 U.S.C. § 1125 (c) (1)

<sup>116</sup> 15 U.S.C. § 1125 (d) (1) (C)

<sup>117</sup> 15 U.S.C. § 1125 (d) (2) (A)

<sup>118</sup> 15 U.S.C. § 1125 (d) (2) (D) (i)

<sup>119</sup> Alitalia v. Casinoalitalia.Com, 128 F. Supp. 2d 340; 2001 U.S. Dist. LEXIS 534; 61 U.S.P.Q.2D (BNA) 1490

rule, occurs within the same territory and thus within the same jurisdiction, the same cannot be said about the harm committed through the use of electronic means. Since any act performed on the internet takes place world-wide, *i.e.* in all the jurisdictions at the same time, there are three main points to be clarified. First, which court has jurisdiction over the matter; second, what law to apply when deciding the case; third, how to enforce a court order across the border.<sup>120</sup>

Within the EU, the procedural question are governed by the Regulation (EU) No 1215/2012 of the European Parliament and of the Council on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (hereinafter referred to as “EU Jurisdiction Regulation”). National courts of the member states have personal jurisdiction over persons domiciled in that member state.<sup>121</sup> Persons domiciled in a member state can be sued in another member state only under the conditions laid down in the regulation;<sup>122</sup> a person may be sued, *inter alia*, “in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur....”<sup>123</sup> It is questionable, however, how to determine the place where the harmful event occurred, when it occurs on the internet. Since a web site is accessible from any place, it follows that the detrimental effect is present world-wide. The answer to this question was provided by the European Court of Justice, by stating:

[I]n the event of an alleged infringement of personality rights by means of content placed online on an internet website, the person who considers that his rights have been infringed has the option of bringing an action for liability, in respect of all the damage caused, either before the courts of the Member State in which the publisher of that content is established or before the courts of the Member State in which the centre of his interests is based. That person may also, instead of an action for liability in respect of all the damage caused, bring his action before the courts of each Member State in the territory of

<sup>120</sup> See *e.g.* P.M. NORTH & J.J. FAWCETT: CHESHIRE AND NORTH’S PRIVATE INTERNATIONAL LAW 3 (1992); ALBERT V. DICEY: DICEY, MORRIS & COLLINS ON THE CONFLICT OF LAWS 4 (2006)

<sup>121</sup> REGULATION (EU) No 1215/2012, Article 4 (1)

<sup>122</sup> REGULATION (EU) No 1215/2012, Article 5 (1)

<sup>123</sup> REGULATION (EU) No 1215/2012, Article 7 (2)

which content placed online is or has been accessible. Those courts have jurisdiction only in respect of the damage caused in the territory of the Member State of the court seised.<sup>124</sup>

In the US, the issues of jurisdiction and choice of law are resolved by the application of state law. Though the rules on personal jurisdiction may vary from state to state, the main point remains the same; *i.e.* for a court to exercise personal jurisdiction over a nonresident, the defendant has to have sufficient contacts with the forum state.<sup>125</sup> To determine whether or not the defendant has sufficient contacts with a specific state, the courts established a three-step test, according to which:

1. the defendant must by his conduct purposefully avail himself of the privilege of acting or causing consequence in the forum state;
2. the cause of action has to arise from the defendant's activities in that state; and
3. the exercise of the jurisdiction has to be reasonable; *i.e.* the acts of the defendant or their consequences must have substantial connection with the forum.<sup>126</sup>

After the establishment of a court with jurisdiction over the matter, the question what law to apply in the case arises. The choice of applicable law is regulated by national (eventually regional) rules known as 'conflict of laws' or 'international private law' and by international (bilateral or multilateral) agreements. We are not going to provide further analysis of the choice of law issues, since these questions exceed the purpose and the needs of this thesis.

Lastly, and most importantly, even when the jurisdiction of the court is established and the plaintiff, after prevailing on the merits of the cause, obtains a court decision, the most

<sup>124</sup> EUROPEAN COURT OF JUSTICE: Joint cases C-509/09 and C-161/10 from October 25<sup>th</sup>, 2011

<sup>125</sup> Compuserve, Inc. v. Patterson, 89 F.3d 1257, 65 USLW 2065, 39 U.S.P.Q.2d 1502, 24 Media L. Rep. 2100, 1996 Fed.App. 0228P

<sup>126</sup> *See e.g.* Compuserve, Inc. v. Patterson, 89 F.3d 1257, 65 USLW 2065, 39 U.S.P.Q.2d 1502, 24 Media L. Rep. 2100, 1996 Fed.App. 0228P; Cybersell, Inc. v. Cybersell, Inc., 130 F.3d 414, 44 U.S.P.Q.2d 1928, 97 Cal. Daily Op. Serv. 9006, 97 Daily Journal D.A.R. 14,545

problematic part is yet about to come- the enforcement of a court decision. The enforcement of a judgment brings the theory into practice and provides an actual remedy for the injured party. In the cases of an on-line infringement, the enforcement usually has to take place in another country. The recognition and enforcement of a foreign decision is, nevertheless, often complicated and time consuming process. Within the EU, the enforcement of the member states' court decisions is ensured by the EU Jurisdiction Regulation. Article 36 of the said regulation obliges member states to recognize any judgment given in other member state without the need of any special procedure.<sup>127</sup> As for the enforcement, "[a] judgment given in a Member State which is enforceable in that Member State shall be enforceable in the other Member States without any declaration of enforceability being required."<sup>128</sup>

However, when it comes to the enforcement of court rulings outside the EU, the situation is much more complicated. There is, currently, lack of international regulation governing these issues. Under the administration of the Hague Conference on Private International Law (HCCH), the Convention on the Recognition and Enforcement of Foreign Judgments in Civil and Commercial Matter was enacted in 1971, however, at present only five states are contracting parties to this convention. Therefore, the international cooperation in the foreign judgments enforcement is mostly subject to bilateral and regional agreements.

The topic of court jurisdiction, choice of law and the enforcement of foreign court and tribunal decisions is a very extensive one. This thesis is not aimed to deal with these procedural questions; we are therefore not going to provide deeper analysis on this issue. The purpose of this subchapter is only to point at the possible difficulties and obstacles when seeking for legal remedy for the infringing action taking place on the internet. Not only the substantive law inadequately protects the trademark owner against the violation of his rights occurring on-line, furthermore the procedural rules make the defense even less efficient.

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<sup>127</sup> REGULATION (EU) No 1215/2012, Article 36 (1)

<sup>128</sup> REGULATION (EU) No 1215/2012, Article 39

### 3.4 Uniform Domain Name Dispute Resolution Policy

As was already discussed, the former legislation did not provide sufficient protection against trademark infringement through the acts taking place on the internet. In the following part, we will aim the attention to an alternative solution of a problem called cybersquatting—the abusive registration of a domain name identical or confusingly similar to another’s trademark. The problem of cybersquatting stems from the different nature of the two systems: “one system –the DNS—is largely privately administered and gives rise to registrations that result in a global presence, accessible from anywhere in the world[;] [t]he other system—the intellectual property rights system—is publicly administered on a territorial basis and gives rise to rights that are exercisable only within the territory concerned.”<sup>129</sup> The growing impact and importance of cyber-environment called for new legal regulation taking the aspects of cyberspace into consideration. As a response to this need, on the proposal of the Government of the United States, WIPO began the process of consultation with the purpose to make recommendations concerning domain name management taking into account the clash between domain names and intellectual property rights.<sup>130</sup> On the basis of these recommendations, The Uniform Domain Name Dispute Resolution Process (UDRP) was adopted in 1999 by ICANN.<sup>131</sup> For the reason not to expose domain name registrants acting in good faith and to prevent harassment of good faith domain name owners by trademark owners, the UDRP is applicable only in cases of deliberate, bad faith, abusive domain name registration and only in alleged violation of trademark rights (not in respect with other intellectual property rights).<sup>132</sup> All registrars in gTLDs adopted ICANN’s UDRP, which governs the relationship between the registrar and the domain name owner. In cases where

<sup>129</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 7 (1999)

<sup>130</sup> *Id.* at v

<sup>131</sup> WIPO: THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY AND WIPO 3 (2011)

<sup>132</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 45 (1999)

the complainant asserts the abusive registration of a domain name (thus infringing his trademark rights), the domain name owner is obliged to submit to mandatory administrative proceedings conducted before an approved dispute resolution service provider.<sup>133</sup>

The ICANN's Policy defines cybersquatting as an "abusive registration of a domain name"<sup>134</sup>. According to Paragraph 4 (a) of the UDRP, the registration of a domain name is considered abusive when:

1. the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
2. the holder of the domain name has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.<sup>135</sup>

In the following part we will discuss each of the three requirements characterizing a domain name registration as abusive.

### *3.4.1 Likelihood of Confusion*

First thing a complainant has to prove is that the registered domain name is identical or confusingly similar to his trade- or service mark. The situation is simple in the case of identical names. But to establish the line dividing names that are confusingly similar from those which are not is much more complicated. It has to be noted that in determination whether the similarity is confusing, it is purely the name itself that is taken into consideration.

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<sup>133</sup> The Approved Dispute Resolution Service Providers are listed at ICANN webpage <http://www.icann.org/en/help/dndr/udrp/providers>

<sup>134</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 54 (1999)

<sup>135</sup> UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, Paragraph 4 (a); available at <http://www.icann.org/en/help/dndr/udrp/policy>

The content of a web site, disclaimer or other circumstances are of no relevance. In the case *Harry Winston v. Katherman*, the Panel of WIPO Arbitration and Mediation Center concluded that domain name <hairywinston.com> was confusingly similar to the trademark ‘Harry Winston’.<sup>136</sup> Despite the respondent asserted that the nature of her website evidently excludes any association with the trademark owner, the Panel stressed that:

[I]t is now well-established that the content of the Respondent's website is an irrelevant factor when assessing confusing similarity under the first element of the Policy. The test is to be conducted by way of a side-by-side comparison of the Complainants' trade mark and the Domain Name. ... [T]he Panel accepts that anyone aware of the existence of the Complainants and noticing the one letter difference in the names is unlikely to be confused, the Panel believes it quite likely that people (not merely morons in a hurry) glancing at the Domain Name may well not notice the difference and believe that they are looking at ‘harrywinston’.<sup>137</sup>

It follows from the above stated, that a domain name is deemed to be confusingly similar to a protected trademark, regardless of the content of the website established on such domain, when it is reasonable to assume that the internet users may not at first sight realize the difference between the domain name and a trademark.<sup>138</sup> Likewise, domain names consisting of the trademark and an additional (descriptive) expression would not be sufficiently distinctive as to fail to comply with the requirement of confusing similarity:<sup>139</sup> “[i]n order to satisfy the UDRP test, the relevant trademark would generally need to be recognizable, as such, within the domain name, with the addition of common, dictionary, descriptive or negative terms typically regarded by Panels as insufficient to prevent threshold Internet-user confusion.”<sup>140</sup>

<sup>136</sup> *Harry Winston v. Katherman*, WIPO Arbitration and Mediation Center, Administrative Panel Decision, Case No D2008-1267 from October 18<sup>th</sup>, 2008

<sup>137</sup> *Id.*

<sup>138</sup> This confusion is exactly what typosquatting is based on; typosquatters rely precisely on the incautiousness of the internet users and their mistypings and thus unlawfully profit from the reputation of a well-known mark.

<sup>139</sup> Such combination of words deemed to be confusingly similar could be for example: <guccibags.com>; <hugobosssuits.com>; <bmwmotors.eu> or with pejorative terms like <mcdonaldssucks.com>; etc.

<sup>140</sup> WIPO: THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY AND WIPO 7 (2011)

In addition, courts in the US established a doctrine known as ‘initial interest confusion’, meaning that though the internet users are not misled as to the source or identity of the web site proprietor, it might divert them from the internet locality they are looking for to that of a competitor, what results in unfair exploitation of another good will and in unjust commercial gain thus acquired.<sup>141</sup>

### 3.4.2 *Rights and Legitimate Interest in the Domain Name*

Once the deciding Panel concludes there exists similarity between the domain name and a trademark sufficient enough to cause confusion on the side of a web user, it has to examine whether or not the domain name registrant has any lawful interest in the chosen domain name. Especially in case of famous or well-known marks, the domain name registrant should demonstrate particular circumstances that have led him to the choice of the domain name justifying such selection. For example, in the case *Madonna v. Parisi*,<sup>142</sup> the Panel did not find any legitimate interest of the registrant in the selected domain name <madonna.com>. The Panel admitted that the word ‘Madonna’ has an ordinary dictionary meaning, however, nothing in the case supported the conclusion that the domain name was used in a manner corresponding with its ordinary dictionary meaning.<sup>143</sup> Likewise, the possession of a trademark identical to the domain name does not have to mean, *ipso facto*, that the domain name registrant has automatically rights in the domain name. There are other factors that have to be considered, like the time of registration of such trademark, the actual use of the trademark in the business activities, country of registration and the like. In the *Madonna* case, the Panel alleged:

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<sup>141</sup> See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036; 1999 U.S. App. LEXIS 7779; 50 U.S.P.Q.2D (BNA) 1545

<sup>142</sup> *Madonna v. Parisi*, WIPO Arbitration and Mediation Center, Administrative Panel Decision: Case No D2000-0847 from October 12, 2000

<sup>143</sup> *Id.*



[I]t would be a mistake to conclude that mere registration of a trademark creates a legitimate interest under the Policy. ... To establish cognizable rights, the overall circumstances should demonstrate that the registration was obtained in good faith for the purpose of making bona fide use of the mark in the jurisdiction where the mark is registered, and not obtained merely to circumvent the application of the Policy.<sup>144</sup>

The UDRP lists, in a non-exhaustive way, examples of factors that justify the registration and use of a domain name. The legitimate interest can be asserted when the registrant:

1. before any notice of the dispute, used, or can demonstrate his preparation to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
2. has been commonly known by the domain name, even if the registrant acquired no trademark or service mark rights; or
3. is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.<sup>145</sup>

By ascertaining if there is lawful interest of the registrant in particular domain name, all the relevant circumstances have to be taken into account. The domain name registrants often try to justify an abusive bad-faith registration, by creating an illusion of their legitimate interest in the domain name, therefore the examination of the surrounding factors has to be deep enough to reveal such dishonest practices.

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<sup>144</sup> *Id.*

<sup>145</sup> UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, Paragraph 4 (c); available at <http://www.icann.org/en/help/dndr/udrp/policy>

### 3.4.3 Registration or Use in Bad Faith

The UDRP provides further in Paragraph 4 (b) a non-exhaustive list of examples that can constitute an evidence of bad faith, and those are:

1. circumstances indicating the registration or acquirement of the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the registrant's documented out-of-pocket costs directly related to the domain name; or
2. the registration of the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the domain name owner has engaged in a pattern of such conduct; or
3. the registration of the domain name primarily for the purpose of disrupting the business of a competitor; or
4. the use of the domain name, intentionally attempted to attract, for commercial gain, Internet users to one's web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the web site or location or of a product or service on the web site or location.<sup>146</sup>

As was the case in the previous point, also here it is necessary to consider all the facts accompanying not only the registration and use of the domain name, but also the subsequent conduct of the registrant; *e.g.* if the domain name owner offered the domain name for sale; if the registrant carry out business activities in same or similar field as the trademark owner and thus can be seen as a competitor; whether the domain name owner had or reasonably could

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<sup>146</sup> UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, Paragraph 4 (b); available at <http://www.icann.org/en/help/dndr/udrp/policy>

have had the awareness of the conflicting trademark etc. On the other hand, even in case of the registrant actual knowledge of the existence of a trademark and the intentional choice of similar domain name, the bad faith can be excluded. In the Hairy Winston case,<sup>147</sup> despite the fact that the respondent has deliberately chosen her domain name confusingly similar to a well-known mark 'Harry Winston', under the facts of the case with regard to the selection of such name for the purpose of parody, it was concluded that the registrant acted in good faith.

#### 3.4.4 Procedure and Nature of the Decision

The trademark owner alleging the infringement of his trademark by the use of a domain name can choose to submit a complaint and invoke the procedure under UDRP. The complaint has to be submitted electronically and in hard copy to the WIPO Center. The copy of the complaint is also sent to the respondent and the domain name registrar. Following the submission, the complaint is checked whether it complies with the administrative requirements. WIPO then notifies the respondent about the complaint, who in turn has 20 days to respond. The next step is the appointment of a single-member or three-member panel, which has 14 days to submit the decision to WIPO center. The reasoned decision is issued on the basis of submitted complaint and the response to it without any oral hearing being carried out. The complainant, respondent, domain name registrar and ICANN are thereafter notified about the panel decision.<sup>148</sup>

The whole proceedings and the decision itself are of administrative nature. The UDRP procedure is optional for trademark owners (that may always opt for court action instead), but

<sup>147</sup> Harry Winston v. Katherman, WIPO Arbitration and Mediation Center, Administrative Panel Decision, Case No D2008-1267 from October 18<sup>th</sup>, 2008

<sup>148</sup> For the UDRP procedure *See e.g.* WIPO: THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY AND WIPO (2011); WIPO ARBITRATION AND MEDIATION CENTER: GUIDE TO WIPO DOMAIN NAME DISPUTE RESOLUTION (2008)

mandatory for all gTLD domain name registrants and some ccTLD registrants.<sup>149</sup> The WIPO Internet Domain Name Process final report states that “[w]hile it is desirable that the use of the administrative procedure should lead to the construction of a body of consistent principles that may provide guidance for the future, the determinations of the procedure should not have (and cannot have) the effect of binding precedent in national courts. It would be up to the courts of each country to determine what weight they wish to attach to determinations made under the procedure.”<sup>150</sup> Being of administrative nature, the UDRP process provides only for two available remedies. The complainant can demand either the transfer of the domain name to him, or its cancellation. If the complainant does not prevail in the proceeding, the panel denies the complaint. No monetary or injunctive remedies are available for either party, however.<sup>151</sup>

Upon the panel decision, the registrar is obliged to its implementation.<sup>152</sup> Hence, the enforcement is much easier than in the case of a court decision. No formal requirements and no procedure of recognition or enforcement are needed. However, the respondent can prevent the decision from entering into force by filing a lawsuit in a court within 10 business days from the notification of the decision.<sup>153</sup> In the case of submission of such dispute in the competent court with jurisdiction, the court is not bound by the panel decision. In *Weber-Stephen Products v. Armitage*, the court stressed that the court was not bound by the outcome of ICANN administrative proceedings and that the UDRP does not dictate to courts what weight should they give to a panel’s decision.<sup>154</sup> Likewise, the court in *Barcelona.com v. Excelentísimo Ayuntamiento de Barcelona* alleged that “while a decision by an ICANN-

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<sup>149</sup> WIPO: THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY AND WIPO 5 (2011)

<sup>150</sup> THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES, FINAL REPORT OF THE WIPO INTERNET DOMAIN NAME PROCESS 49 (1999)

<sup>151</sup> WIPO ARBITRATION AND MEDIATION CENTER: GUIDE TO WIPO DOMAIN NAME DISPUTE RESOLUTION 14 (2008)

<sup>152</sup> WIPO: THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY AND WIPO 6 (2011)

<sup>153</sup> UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY, Paragraph 4 (k); available at <http://www.icann.org/en/help/dndr/udrp/policy>

<sup>154</sup> *Weber-Stephen Products v. Armitage*, 2000 U.S. Dist. LEXIS 6335; 54 U.S.P.Q.2D (BNA) 1766

recognized panel might be a condition of, indeed the reason for, bringing an action under 15 U.S.C. § 1114(2)(D)(v), its recognition *vel non* is not jurisdictional.”<sup>155</sup>

In conclusion, the dispute settlement under the UDRP is a very effective way providing defense against cybersquatting. In this type of proceeding no questions concerning jurisdiction, applicable law or the process of enforcement arise. On the other hand, however, the use of the ICANN administrative procedure is restricted only to clear and straightforward cases of abusive domain name registrations. In addition, and even more importantly, the decision can be anytime objected by filing a lawsuit in a national court. In those cases, the panel decision loses its force and has no binding effect on the competent court. Thus, the whole procedure under UDRP seems worthless and all the issues described in previous part concerning the jurisdiction, choice of law or enforcement come into question again.

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<sup>155</sup> Barcelona.com v. Excelentísimo Ayuntamiento de Barcelona, 330 F.3d 617, 67 U.S.P.Q.2d 1025

## Conclusion

This study analyzed the possible means of trademark infringement through the use of the internet, and possible defenses against such infringements. It was clarified that a trademark fulfils several functions. It is a valuable instrument in business practice, particularly in marketing and advertising. Besides being of great importance to the merchant, it also protects the public from being misled, guaranteeing the authenticity of purchased products as to the source of their origin. Lastly, trademarks ensure the exercise of business activity in accordance with the requirements of fairness and morality. The acquirement of a trademark is not an easy process; the registration has to meet a number of conditions. Even upon the registration, the protection is limited to the territory where the registration was granted and to the goods or services that bear such mark. The principle of territoriality is thus the core element characterizing the whole field of intellectual property.

The internet, by contrast, gives rise to a global presence of its content. The unrestricted flow of information in cyber-space extends the scope of the infringement to a world-wide platform. Particular attention in the analysis of trademark infringement through the use of the internet was paid to the cases of so called ‘cybersquatting’ consisting in the abusive registration of a domain name corresponding to another’s trademark. Since the registration of a domain name is an easy and fast process that does not impose any formal requirements on the registrant, there have been a significant number of cases involving collisions between the registered domain name and trademarks. The question of whether or not such use of a domain name is lawful was first examined from the perspective of legal regulation on a regional level. In the EU, there is still lack of adequate rules governing the clash of domain names and trademarks. In those cases, traditional trademark law is to be applied; however, we concluded that such

protection does not fully reflect the global nature of the internet. Thus, the mere registration of a domain name identical or substantially similar to someone else's trademark cannot be seen as trademark infringement. The plaintiff has to prove that there exists a likelihood of confusion on the side of the public. The doctrine of unfair business practices can, in those cases, provide broader possibilities for the injured party. The vague concept of unfair competition, nevertheless, hinders the efficiency of legal protection based on unfair competition law. The court's discretion is too large to guarantee a sufficient level of foreseeability and consistency in judgments. It is necessary, therefore, to enact new legislation that would provide effective and straight-forward protection against the acts of cybersquatting.

The situation is easier in the US. The ACPA introduced a new form of defense available to a trademark owner. To find registration or use of a domain name illegitimate, two conditions must be met. First, the domain name must be identical or confusingly similar to another's protected mark; second, the registration or use of the domain name must be exercised in bad-faith, with the intention to profit from such registration or use.

The most effective trademark protection against cybersquatting is provided by the ICANN's Uniform Domain Name Dispute Resolution Policy. The Policy is *ex ante* made mandatory for the domain name registrants, by virtue of the registration agreement concluded between the registrar and domain name registrant. UDRP deals specifically with cases of cybersquatting defined as abusive registration of a domain name. For a registration to be deemed abusive, three conditions are to be fulfilled: first, a domain name has to be identical or confusingly similar to a protected trademark; second, there is no legitimate interest of the domain name

registrant in the domain name; third, the registration of the domain name and its use has been made in bad-faith.

The ICANN Policy not only defines the abusive use of an internet domain name and lists the elements to be proved by the complainant, but offers a system of protection supplemented by procedural rules. This makes trademark protection very efficient and apparently also popular, since 2012 alone saw 2884 filed (and decided) complaints.<sup>156</sup> UDRP provides an adequate solution for the problem of cybersquatting and satisfies the need for legal regulation concerning trademark infringement occurring online. However, there are two flaws in the application of the Policy.

First problem is connected to the relatively narrow scope of protection. The use of the UDRP is restricted only to the cases of clearly abusive practice related to the registration and use of domain names. In many cases, it is not easy to establish a bad-faith intention on behalf of the registrant, since the concept of '*mala fide*' itself represents a state of mind that cannot be measured or objectively established beyond reasonable doubt.

The second inconvenience of the UDRP process is found in its administrative nature. As such, it has no binding effect on courts and in the case of opposition of a panel decision, the whole UDRP dispute settlement appears to be of little benefit, and may even be a waste of money. UDRP surely is an important and effective instrument, particularly in respect of the easy implementation of decisions made on its basis. However, it should be considered only as a supplementary (or alternative) solution process. The core protection should rely on the court, which is not the case on the EU level. The harmed party has basically two possibilities; either

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<sup>156</sup> WIPO Arbitration and Mediation Center: Total Number of Cases per Year, at <http://www.wipo.int/amc/en/domains/statistics/cases.jsp>



to commence a court action with questionable and unforeseeable results and problematic enforcement, or to file a complaint under UDRP and risk the objection of the other party in the national court involving the same issues as the former option.

To summarize the stated arguments, it can be said that, despite the increasing use and growing importance of the internet, the legal regulation as yet does not fully cover the possible problems associated with cyber-space, nor offers adequate protection to trademark owners. In the US, there is legislation solving directly the collisions of domain names and trademarks that is continuously supplemented by the case law facilitating the application of the pertinent rules. Within the EU, however, the current situation calls for the enactment of new rules dealing with the problems of cybersquatting.

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