



Domain names and dispute resolution

Ian Tollett

Williams, Powell & Associates, 4 St. Paul's Churchyard, London, EC4M 8AY, UK

Abstract

The nature and types of domain names and methods of registration are outlined. Significant differences between domain names and trade marks, and the conflicts that can arise between holders of these distinct intellectual property rights are discussed. Examples are given of disputes involving cybersquatting, i.e., where domain name registrations including established company names or trade marks have been made with the objective of selling them back to that company. The operation of the Uniform Dispute Resolution Policy (UDRP) is described, including the provisions for transfer of an improperly registered domain name, and the ways in which complainants can invoke those provisions and domain name holders can defend their registrations. Finally, the author outlines the procedures of WIPO, one of the UDRP service providers, in resolving disputes rapidly. © 2001 Elsevier Science Ltd. All rights reserved.

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1. Introduction

It is becoming increasingly important for intellectual property search professionals to be aware of the interaction between domain names and trade marks, when carrying out searches for either or both of these intellectual property rights. This paper outlines the potential conflicts between domain names and trade marks and introduces a relatively new resolution method for dealing with domain names registered in bad faith.

2. What are domain names?

A domain name is a unique identifier for a location on the Internet. The location could be a computer, or a site hosted on a computer. In fact, each location is identified by a string of numbers, which is known as an Internet protocol (IP) address, but since numbers are generally more difficult to remember than names, each IP address is converted to an alpha-numeric code known as a domain name by the domain name system.

3. How are domain names compiled?

Domain names usually comprise a second level domain (SLD) followed by a dot (“.”) and then a top level domain (TLD). A domain name therefore takes the form <SLD.TLD>. Domain names corresponding to sites on the world-wide web are prefixed with “www” followed by a dot before the SLD; thus: <http://www.SLD.TLD>.

The SLD is usually chosen by the owner of the domain name to identify the owner. For example, the SLD could be a company name such as Microsoft (see <http://www.microsoft.com>) or the name of a product such as Coca-Cola (see <http://www.coca-cola.com>).

TLDs (the part of the domain name following the final dot) are divided into two types – generic TLDs (“gTLDs”) can identify the type of domain name, and country code TLDs (“ccTLDs”) which identify the country which administers the TLD.

Examples of gTLDs are:

com	commercial organisation
org	non-profit organisation
net	Internet gateway or administrative host
gov	government body

The country codes for ccTLDs are taken from the ISO 3166-1 country code list which is also used by WIPO to identify countries in the PCT system. Accordingly,

E-mail address: mail@williamspowell.com (I. Tollett).

China is CN, South Africa is ZA, etc. (although the United Kingdom is UK not GB).

A TLD can sometimes be a mixture of a gTLD and a ccTLD, for example, <http://www.cipa.org.uk>.

Generally, gTLDs, and particularly the .com. TLD, are considered to be more attractive to commercial organisations, perhaps because they suggest an international presence rather than one based in a particular country.

4. How are domain names administered?

Domain names are registered on a first-come-first-served basis. The administration of domain names used to be carried out by the Internet Assigned Numbers Authority (IANA); in 1998, IANA was incorporated within an organisation called the Internet Corporation for Assigned Names and Numbers (ICANN). Now there are a number of commercial registrars operating under the aegis of ICANN.

5. How to register a gTLD

Originally, a single private company, Network Solutions Inc., was licensed to deal in gTLDs, but now the market has been deregulated there are more than one hundred accredited registrars. There are currently two functioning accredited registrars based in China, namely OnlineNIC, Inc (<http://www.onlinenic.com>) and Xin Net Corp. (<http://www.chinadns.com>). A full list of registrars is available at the ICANN web site (<http://www.icann.org/registrars/accredited-list.html>).

6. How to register a ccTLD

Each country has a country code administrator which runs the registry of ccTLDs. In China it is the Chinese Academy of Sciences in Beijing. In the UK, the registry is maintained by Nominet Ltd., which is a not-for-profit company, the members of which include commercial organisations which offer a domain name registration service. Thus it is necessary to go to one of these organisations in order to register a ccTLD in the UK.

The country code administrators appear to obtain their authority from IANA rather than from ICANN, and a list can be found on the IANA website <http://www.iana.org>.

7. Conflict between domain names and trade marks

We are all aware of the increasing importance of trade conducted over or by means of the Internet

(“e-commerce”). In order to advertise a commercial presence on the web, domain names often incorporate trade marks, or are themselves used as trade marks. However, although trade mark law has evolved over many years and is relatively sophisticated, the domain name system has, out of necessity, been established over only a few years, and is relatively unsophisticated.

There are broadly three differences between the administration of trade marks and of domain names:

1. The domain name system does not recognise the concept of “confusingly similar” names. Thus a domain name which is only slightly different to an existing domain name can still be registered: a mere difference is all that is required. For example, the domain name <top-company.com> could be registered (if available), even if <topcompany.com> was already taken. By contrast, most trade mark systems take into account the similarity of a mark to existing marks when considering whether it should be registered or whether it is validly registered.

2. Unlike with trade marks, the registration of domain names is not subject to a classification system for goods and services. Consequently, whereas identical trade marks which cover different goods or services can happily coexist on a trade marks register, each domain name is unique and is generally owned by only a single proprietor. Since consumers often search for products on the Internet first by looking for a web site at <<http://www.productname.com>>, there will be a race to be the first to register the domain name corresponding to the product name, and the registering of the name by one company may lead to lost sales on the part of the other, since disaffected consumers might turn to a competing product if they cannot readily access information on the web.

3. The domain name system does not recognise national boundaries. Generic TLDs can be registered and accessed by companies or organisations from any country. Similarly, although ccTLDs are administered from within particular countries and therefore are most commonly registered by companies in that country, there does not seem to be anything to stop their being registered by companies from outside that country, and they can certainly be accessed from outside the country. Consequently, companies which have coexisted for many years using the same trade mark in separate jurisdictions might find themselves competing for the rights to a world-wide domain name incorporating the trade mark.

The above differences can lead to disputes between companies of good faith. An example in the UK is the case *Prince Plc -v- Prince Sports Group Inc.* Prince Plc (a UK based computer company) had used the trade mark PRINCE since 1985 but without a registration. It

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