

Trademark and Domain Name Disputes and Their Resolution Methods

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The electronic domain name registration system is based on the principle of “first come, first served,” whereby the person who first applies for the registration of a domain name is granted priority on the Internet, irrespective of the earlier filing dates of trademarks. Consequently, numerous trademarks, including well-known marks, have been registered as domain names without the knowledge or consent of their rightful owners.

One of the most common forms of disputes between domain name registrants and trademark owners involves the registration of a domain name identical to an existing trademark, particularly a well-known trademark. This practice is known as cybersquatting. It typically involves registering a domain name corresponding to a trademark owned by another party and subsequently demanding substantial sums of money in exchange for transferring the domain name to its legitimate owner.

As a result, affected trademark owners have increasingly resorted to judicial proceedings. Courts have issued judgments condemning cybersquatting and have held that the relevant domain name registrants had infringed the rights of registered trademark owners. Accordingly, trademark owners have been granted the right to bring an action for trademark infringement, an action for unfair competition, or both, depending on the nature of the acts committed.

Through this paper, the various forms of infringement of trademarks over the Internet will be examined, with a view to identifying their different manifestations by reviewing the most common forms of online trademark infringement and outlining the mechanisms available for their protection at both the national and international levels.

First: Infringements Committed by Domain Name Registrants Against Trademark Owners on the Internet

Numerous forms of trademark infringement arise in connection with the registration of domain names. These infringements must be examined by attempting to identify the most widespread practices on the Internet or, at the very least, by highlighting the most significant ones through an analysis of selected real-life cases.

1. Unlawful Registration of a Domain Name Identical to a Trademark

One of the most common forms of infringement involves an individual registering a domain name that is identical to a trademark owned by another party without any legitimate right to

do so. This practice has been the subject of numerous judicial proceedings initiated by trademark owners seeking to recover domain names incorporating their trademarks.

2. Offering to Transfer the Domain Name to the Trademark Owner in Exchange for a Monetary Payment

After registering a trademark as a domain name, certain individuals demand substantial sums of money from the trademark owner, particularly when the trademark is well-known, in exchange for transferring ownership of the domain name to its rightful owner.

The Uniform Domain Name Dispute Resolution Policy (UDRP) stipulates that such conduct may constitute an infringement of the trademark owner's rights. Several companies have successfully recovered their domain names through the application of this policy.

The Harrods Case

The defendant, Anderson Consultants of New York, registered a domain name incorporating the company's trademark and subsequently offered to sell it to the trademark owner.¹ This prompted the company to refer the dispute to the WIPO Arbitration and Mediation Center. The Center established that there was an identity between the trademark and the registered domain name. It also found that the defendant had acted in bad faith, particularly because the domain name containing the company's trademark had been offered for sale to the trademark owner. Accordingly, the Panel ordered the transfer of the domain name to the company that owned the trademark.

The Molson Case

The facts of this case can be summarized as follows: the owner of the trademark brought an action for trademark infringement against the defendant, who had registered a domain name derived from the trademark in the form of:

Molson.com²

3. Registration of a Trademark as a Domain Name for the Purpose of Selling It to a Competitor of the Trademark Owner

Some individuals register trademarks as domain names without any intention of using them in commercial activities. Instead, their primary objective is to resell the domain name to the company that owns the trademark, offer it to one of the trademark owner's competitors, or put it up for public sale to the highest bidder.³

4. Registration of a Trademark as a Domain Name and Its Use to Sell Products of Inferior Quality to Those of the Trademark Owner

The L'Oréal, Cacharel, and Lancôme Case

Another Form of Cybersquatting

This constitutes another form of parasitic conduct, whereby a domain name incorporating a well-known registered trademark is registered with the intention of reselling it to the owner of the trademark. Examples of such domain names include the following:⁴

¹ WIPO Arbitration and Mediation Center, Administrative Panel Decision: Harrods Limited v. Mike Anderson Consultants, Case No. D2003-0813.

² Molson Breweries, A Partnership v. Kuettner (1999), 3 C.P.R. (4th) 479, Federal Court, Trial Division.

³ WIPO Arbitration and Mediation Center, Case No. D2013-1606.

⁴ TGI Nanterre, 30 June 1999, SA L'Oréal, SA Parfums Guy Laroche SNC, Lancôme, available at: www.legalis.net/ju/décisions/marques-300699.htm.

L'OréalParis.com

CacharelParis.com

LancômeParis.com

5. Registration of a Domain Name Containing a Trademark with the Addition of Derogatory Terms

In this form of infringement, the conduct goes beyond merely imitating a trademark and extends to disparaging or damaging its reputation. This practice involves registering a domain name that incorporates a trademark together with offensive or derogatory words intended to denigrate the trademark or its owner.

The Sharp Case

In this case,⁵ the defendant registered the domain name DontDealWithSharp.com, incorporating the Sharp trademark alongside the derogatory phrase “Don’t Deal With,” which conveys a negative message about the trademark owner and its products.

The Philips Case

In this case, the defendant registered a domain name incorporating the trademark of Philips, a globally renowned manufacturer of electrical and electronic equipment, together with the term “Suck,” thereby associating the trademark with a derogatory expression.

The claimant subsequently brought legal proceedings seeking confirmation of its rights in the trademark and an order prohibiting the defendant from using the domain name containing the disparaging expression, which was deemed offensive to the claimant. The court ordered the ⁶ termination of the use of the disputed domain name and its transfer to the claimant.

6. Registering a Domain Name Similar to a Trademark

In this case, a person registers a domain name that is not identical to a trademark but bears a similarity to it, potentially causing confusion among consumers and Internet users.

The Microsoft Case

This case is an example of disputes arising from the unauthorized use of a company's trademark through the registration of a confusingly similar domain name. In this instance, an individual registered the domain name www.microosoft.com, which closely resembled Microsoft's trademark and was likely to cause confusion among users conducting business or other activities on the Internet.

The Air France Case

The facts of this case involved the unauthorized appropriation of a service mark and its registration as a domain name. The domain name Arifrance.com consisted of nine letters, most of which were identical to those of the original mark and written in the same manner, with the exception of two letters. The court considered this practice to constitute cybersquatting, as it involved the unauthorized registration of a domain name resembling a protected mark.⁷

⁵ David Lindsay, *International Domain Name Law: ICANN and the UDRP*, Oxford: Hart Publishing, 2007, p. 459.

⁶ WIPO Arbitration and Mediation Center, Administrative Panel Decision, Koninklijke Philips Electronics N.V. v. Seo Kim, Case No. D2001-1195.

⁷ Commercial Court of Brussels (TCom. Bruxelles), 3 January 1997, Indacome DIT, No. 94/1997, p. 37.

The Magic Corporation Case

The owners of the Magic Corporation trademark, which was registered in January 2003, discovered similarities between their trademark and the domain name Mgccorporation.com, which had been registered in May 2004. The disputed domain name incorporated wording similar to Magic Corporation and was used in connection with the same commercial activity as that of the trademark owner, namely the marketing of Magic games. The court condemned these acts on the grounds of trademark imitation.⁸

7. Acts Likely to Cause Confusion (La confusion)

The seriousness of such acts lies in their potential to divert customers away from the legitimate trademark owner toward competing businesses. Since there is no exhaustive list of acts capable of creating confusion on the Internet, it is sufficient to examine a number of judicial cases to illustrate the types of conduct that may constitute unfair competition against trademark owners in the online environment.

The Marseille Court Decision

In its judgment delivered on 18 December 1998, the Marseille Court of First Instance (Tribunal de grande instance de Marseille) ⁹ruled against a former employee who believed that he could use his former employer's name as a domain name, trademark, and company name. The court held that the employee's conduct constituted unfair competition, as he had used means likely to associate that name with an existing commercial activity and potentially benefit from it at the expense of its rightful owner.

8. Parasitic Competition (Le parasitisme)

Some authors adopt a broad definition of parasitic competition, encompassing conduct that undermines the benefits enjoyed by others, disparages their business activities, exploits third-party investments, or appropriates what constitutes their economic value ¹⁰

There are several types of parasitic conduct (agissements parasitaires), which may aim either to resell a domain name to the trademark owner or to create confusion in the minds of the public. The same applies when the legitimate interests of a trademark owner are harmed by unjustifiably preventing them from registering a domain name corresponding to their trademark ¹¹

The Guy Laroche Case

Parasitic conduct consists of misappropriating the reputation of a trademark or company name, or even diverting customers away from its rightful owner. This is what occurred in the present case ¹²in which the judges held that the use of the trademark constituted parasitic conduct that went beyond mere imitation.

⁸ Tribunal de grande instance of Paris (TGI Paris), 22 March 2006, Magi Corporation.com, available at: <http://domaine.blogspot.com/2006/04>

⁹ TGI Marseille, 18 December 1998, Sté Lumiservice v. Thierry Lamy, Droit de l'informatique, Bulletin d'actualité, No. 111, February 1999, p. 7.

¹⁰ M. L. Zorche, "Le fondement de la sanction de la concurrence déloyale et du parasitisme," Revue trimestrielle de droit commercial (RTDCom), 1998, p. 17.

¹¹ TGI Bruxelles, 3 January 1997, Indacome, DIT 94, 1997, p. 37.

¹² TGI Nanterre, interim proceedings, 13 March 2000, Sté Parfums Guy Laroche v. Sté GL, Bulletin Board, Net Promos, available at: www.Legalis.net/cgi-iddn/french/affiche-jnet.cgi, Droit, actualité, March 2000.

Liability Based on Trademark Infringement

The proceedings must be initiated by the claimant, namely the owner of the trademark infringed by the domain name registrant. The claim must be brought in good faith and must be filed promptly, within a short period calculated from the date on which the trademark owner becomes aware of the acts giving rise to the action.¹³

Accordingly, the dispute may be settled through an action for trademark infringement. Most such actions are brought on this basis in order to remedy the harm suffered by the trademark owner, by seeking the cancellation of the domain name registration and its transfer to its rightful owner.¹⁴

2. International Efforts to Protect Trademarks on the Internet

On 30 April 1999, the World Intellectual Property Organization (WIPO) issued its first report, highlighting the seriousness of infringements targeting trademarks as a result of domain name registrations. In response to these concerns, the Internet Corporation for Assigned Names and Numbers (ICANN) adopted the Uniform Domain Name Dispute Resolution Policy (UDRP).

Dispute Resolution under the Uniform Domain Name Dispute Resolution Policy

Trademark owners may also resort to alternative dispute resolution mechanisms in accordance with the policies adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) and the World Intellectual Property Organization (WIPO). These organizations established a set of uniform rules for resolving disputes, commonly known as the Uniform Domain Name Dispute Resolution Policy (UDRP). This policy provides for an arbitration-like procedure involving experts operating within the framework of these organizations.

On 24 October 1999, ICANN adopted these alternative mechanisms for resolving disputes concerning domain names and trademarks. The policy entered into force in December 1999, following a study conducted by WIPO on the challenges associated with applying the domain name system on the Internet in relation to intellectual property rights,¹⁵ particularly trademark rights.

A. The Efforts of the World Intellectual Property Organization (WIPO)

Given the international nature of domain names, the World Intellectual Property Organization (WIPO) has taken the initiative to resolve disputes in this area, particularly since the administration of these domain names falls within the remit of an international organization associated with the management of the Internet domain name system.

WIPO has issued recommendations to the Internet Corporation for Assigned Names and Numbers (ICANN), with the aim of curbing the phenomenon of cybersquatting.

1. Establishment of the WIPO Arbitration and Mediation Center

The WIPO Arbitration and Mediation Center was established in 1994 and is headquartered in Geneva. It was accredited by the relevant authorities on December 1, 1999, to administer domain name dispute resolution proceedings.

¹³ Nadia Mohamed Moawad, *Arbitration and Intellectual Property Rights*, Dar Al-Nahda Al-Arabiya, Cairo, 2009, p. 163.

¹⁴ Sherif Mohamed Ghanem, *Trademark Protection in Its Relationship with the Domain Name*, p. 353.

¹⁵ Talal Abu-Ghazaleh, *Electronic Commerce and Intellectual Property*, Arab Society for Intellectual Property, in cooperation with the International Chamber of Commerce in Jordan, Amman, 8 July 2001.

The Center administers dispute resolution proceedings under the Uniform Domain Name Dispute Resolution Policy (UDRP) ¹⁶applicable to Internet domain names. This policy has gained considerable popularity among trademark owners. It should be noted, however, that it does not in any way preclude the submission of disputes to the competent courts.

The Center's primary functions are arbitration and mediation in disputes involving trademarks and domain names.

2. Issuance of Special Reports

WIPO has issued reports addressing generic and country-code top-level domains. These reports and the associated dispute resolution mechanisms are not binding on trademark owners, who may choose either to resort to these mechanisms or to bring their claims before national courts.

As for domain name registrants, however, the applicable policy is binding upon them when a trademark owner elects to invoke it, thereby requiring them to submit to the dispute resolution procedure in accordance with the relevant rules.

3. Establishment of Administrative Panels

The WIPO Arbitration and Mediation Center examines disputes between domain names and trademarks through administrative panels constituted in accordance with the Center's rules and procedures. These panels issue administrative decisions on the merits of the disputes submitted to them.

The Center has established a set of effective procedures ¹⁷which are published on WIPO's official website to ensure the efficient resolution of domain name disputes.

B. The Efforts of ICANN

The Internet Corporation for Assigned Names and Numbers (ICANN)¹⁸ is responsible for coordinating the allocation of domain names and Internet Protocol (IP) addresses. Its headquarters are located in the State of California, United States.

ICANN-Accredited Centers for Resolving Disputes Concerning Trademarks and Domain Names

Several organizations are accredited by ICANN for this purpose, and they are listed on its official website. It is worth noting that the scope of these organizations' activities is limited to cases involving disputes relating to country-code top-level domains (ccTLDs).¹⁹

1. The Asian Domain Name Dispute Resolution Centre (ADNDRC)²⁰

The Asian Domain Name Dispute Resolution Centre was accredited by ICANN on December 13, 2001. It comprises several institutions, including the China International Economic and Trade Arbitration Commission (CIETAC)²¹ which was established in 1956 and is

¹⁶ Available

at: <http://www.wipo.int/amc/en/processes/process1/report> and <http://www.wipo.int/amc/en/processes/process2/report>.

¹⁷ Internet Corporation for Assigned Names and Numbers (ICANN).

¹⁸ Rami Mohamed Alwan, "Disputes Concerning Trademarks and Internet Domain Names," Journal of Sharia and Law, United Arab Emirates University, No. 22, January 2005, p. 292.

¹⁹ Asian Domain Name Dispute Resolution Centre (ADNDRC): <http://www.adndrc.org>

²⁰ China International Economic and Trade Arbitration Commission (CIETAC).

²¹ Hong Kong International Arbitration Centre (HKIAC).

headquartered in Beijing; the Hong Kong International Arbitration Centre (HKIAC)²² established in 1985; and the Korean Internet Address Dispute Resolution Committee (KIDRC).

The Asian International Arbitration Centre (AIAC)²³ is another institution involved in resolving electronic domain name disputes. It operates through several regional centres, including those located in Kuala Lumpur, Hong Kong, Beijing, and Seoul.

2. The CPR Institute for Dispute Resolution (CPR)²⁴

The CPR Institute for Dispute Resolution was accredited by ICANN on May 15, 2000, and is headquartered in New York. It handles electronic domain name disputes in accordance with the Uniform Domain Name Dispute Resolution Policy and the rules established by ICANN.

3. The National Arbitration Forum (NAF)²⁵

The National Arbitration Forum is a leading American institution specializing in arbitration and the resolution of electronic domain name disputes. It was accredited by ICANN on December 23, 1999.

4. The Czech Arbitration Court (CAC)²⁶

The Czech Arbitration Court was established in 1949 in Prague and was accredited by ICANN on January 12, 2009.

5. The Arab Center for Dispute Resolution (ACDR)²⁷

The Arab Center for Dispute Resolution was established by the Arab Intellectual Property Mediation and Arbitration Society and was accredited by ICANN on May 18, 2013.

C. The Basis of Liability under the Uniform Domain Name Dispute Resolution Policy (UDRP) Adopted by ICANN

1. Establishing the Registrant's Bad Faith

The Uniform Domain Name Dispute Resolution Policy (UDRP) sets out several indicators that may be used to establish a registrant's bad faith, including the following:²⁸

The registrant registered the domain name primarily for the purpose of selling or renting it to the trademark owner for an excessive price that is disproportionate to the registration costs.

The domain name was registered in order to prevent the trademark owner from registering the trademark as a domain name.

The domain name was registered for the purpose of disrupting the business activities of a competitor.

The domain name was registered in a manner likely to create confusion among individuals associated with the registered trademark.

²² Asian International Arbitration Centre (AIAC).

²³ CPR Institute for Dispute Resolution: www.CPRDR.org

²⁴ National Arbitration Forum (NAF).

²⁵ Czech Arbitration Court (CAC).

²⁶ Arab Center for Dispute Resolution (ACDR).

²⁷ By way of example, as provided for under Article 4(b) of the Uniform Domain Name Dispute Resolution Policy.

²⁸ Article 4(b) of the Uniform Domain Name Dispute Resolution Policy adopted by ICANN.

2. Identity or Similarity between the Domain Name and the Trademark

The registration of a domain name that is highly similar to a well-known trademark is considered evidence of bad faith under the provisions of the Uniform Domain Name Dispute Resolution Policy adopted by ICANN.²⁹ This is primarily because such registration aims to prevent the complainant from registering its trademark as a domain name.

2. Identity or Similarity between the Domain Name and the Trademark

The registration of a domain name that is highly similar to a well-known trademark is considered evidence of bad faith under the provisions of the Uniform Domain Name Dispute Resolution Policy adopted by ICANN.³⁰ This is primarily because such registration aims to prevent the complainant from registering its trademark as a domain name.

3. The Respondent's Inability to Refute the Allegations or Demonstrate Good Faith

Arbitration panels consider the respondent's failure to refute the allegations made against them as an indication of bad faith in the registration of the domain name.³¹

4. The Respondent's Failure to Reply to the Complainant's Initial Correspondence

Arbitration panels have considered the respondent's failure to reply to the complainant's correspondence as a clear indication of bad faith, regarding such silence as an implicit acknowledgment of the allegations.³²

5. Registration of Domain Names Incorporating Trademarks Registered by Third Parties

The Guerlain.net Case

In this well-known case, the arbitration panel found that the respondent owned more than 24 domain names, 14 of which were derived from trademarks belonging to third parties.³³

The KRUPP Case

In this case, the respondent registered the domain name Krupp.de using his family name. The company that owned the well-known trademark brought legal proceedings against him,³⁴ alleging that he had infringed its rights.

The Meridien Case

The Court of First Instance ruled that the keyword tool available on Google France's website, through which the well-known Meridien trademark could be selected as a keyword, should be discontinued.³⁵

The Court of Appeal reached the same conclusion, holding the defendant liable for registering the domain name hotel-meridien. The defendant had offered the domain name for sale shortly after registering it. The intermediary involved in the sale was also held liable.

²⁹ Alaa Al-Tamimi Abdo, *The Legal Regulation of the Domain Name as an Element of Industrial Property*, Dar Al-Nahda Al-Arabiyya, publication year not specified, p. 232.

³⁰ CIGNA Corp. v. JIT Consulting, Decision No. AF 00174. Available at: <http://www.disputes.org/decisions/0174.htm>.

³¹ WIPO Arbitration and Mediation Center, Case No. D2000-0003.

³² Available at: www.arbiter.wipo.int/domains/decisions/12003.0004.htm.

³³ TGI Nanterre, interim relief order of 16 December 2004, *Société des Hôtels Meridien v. Société Google France*, RTDI, February 2005/2, No. 55.

³⁴ Alaa Al-Tamimi Abdo, previously cited reference, p. 239.

³⁵ CIGNA Corp. v. JIT Consulting, Decision No. AF-00174, available at: <http://www.disputes.org/decisions/0174.htm>.

The judges considered this conduct to constitute an unlawful and unjustified use of the well-known trademark. Furthermore, the defendant had failed to establish that he had any legitimate right to the disputed term, including in the hotel industry.

Liability of the Domain Name Registrar

In the absence of explicit provisions addressing this issue in the Uniform Domain Name Dispute Resolution Policy (UDRP), opinions have differed as to whether domain name registrars should be held liable.

1. Arguments in Favour of Establishing the Registrar's Liability

The liability of the registrar may be justified by its ability to compensate the injured party (the trademark owner) for the damage suffered, as well as its ability to cancel the domain name registration or transfer it to the trademark owner, given that the registrar retains all data relating to the domain name registrant.

Furthermore, registrars receive fees and charges for their services, which may be considered grounds for treating them as participants in the infringement of the trademark, in a manner comparable to the registrant themselves.³⁶

2. Arguments Against Establishing the Registrar's Liability

The Uniform Domain Name Dispute Resolution Policy requires the registrant to submit to mandatory administrative proceedings when a complaint is filed by a trademark owner. Under the same policy, the registrant is required to comply with the decisions issued by the adjudicators in disputes concerning domain names.

Accordingly, the decisive factor is the use of the domain name rather than its registration. Consequently, liability should not be imposed on the registrar but rather on the registrant who uses the domain name.

This position was also adopted by the International Trademark Association (INTA), which emphasized that the role of registrars is limited to registering domain names. It further maintained that any dispute arising in this context should be resolved before the competent courts.³⁷

Disputes without the Need to Resort to the Courts.

Conclusion

There is no doubt that infringements of trademarks on the Internet provide grounds for bringing an action for trademark infringement, just as they do for an action based on unfair competition or parasitic competition. Both actions may also be brought simultaneously where a domain name registrant infringes a trademark and engages in acts of unfair competition. In addition to judicial proceedings, there is also a dispute resolution system made available to the injured party by the relevant international organizations.

Trademark and domain name disputes may be resolved in accordance with the policies adopted by the authorities responsible for registering national domain names. Where a dispute arises between a trademark and a national domain name, the holder of the infringed trademark may seek to resolve the dispute in accordance with the policies established by the relevant

³⁶ INTA: International Trademark Association.

³⁷ Available at: <http://www.lectlaw.com/files/elw09.htm>.

registration authorities. Some authorities responsible for national domain names have developed specific procedures for resolving such disputes

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