

CONTEMPORARY ISSUES IN TRADEMARK LAWS IN RELATION TO THE INTERNET (DOMAIN NAMES) WITH REFERENCE TO BRITISH JURISDICTION

Nethmie Yuwanika Ranasinghe*

Introduction

The introductory chapter will provide you a basic idea on the definition of Trademarks and its infringements with reference to the British laws. Along with this idea this article will take lead to provide an idea about the contemporary issues raised along with the globalization in relation to the Trademark laws. Further this area is narrated focusing the infringements that happen through the internet (domain names) and the law is based on the British jurisdiction.

‘Trademark’ means any sign which is capable of being represented in the register in a manner which enables the registrar and other competent authorities and the public to determine the clear and precise subject matter of the protection afforded to the proprietor, and of distinguishing goods or services of one undertaking from those of other undertakings. A trademark may, in particular, consist of words (including personal names), designs, letters, numerals, colours, sounds or shape of goods or other packaging.¹ Trademark infringement happens when the trademark is used in the course of trade.² When the competitor’s trademark is identical or similar in the same cause of trade and when the trademark is used for the unfair commercial gain, in

other words the intention of the trader is to confuse an average consumer and to gain unfairly, and then we could say that the trademark of the original owner is infringed.³

Along with this basic idea of infringements of Trademarks laws and policies, this article will further discuss the Trademark infringements that happen through the internet (domain names). The main objective of choosing this area is to make awareness in Sri Lanka where as the author observed that Sri Lankan perspective on Intellectual property rights are not wide as the world sees it along with the digitalization and globalization.

Therefore, this article is based on the British Jurisdiction and will revolve around the area which was chosen by the author specifying the trademark infringements on the internet. For the content of the article, the author will focus on the areas which are connected to internet as trademark infringements through domain names. Under this each topic where the author intendeds to cover, author will focus and discuss about the method of disputes resolutions when a trademark infringement happen through the internet and the relevant case law judgments.

* Final year, Sri Lanka Law College

¹Trademarks Act 1994

²Trademarks Act 1994

³ Waeld,C, Brown,A, Kheria,S, & Cornwell,J, 2013, *Contemporary Intellectual Property Law and Policy*, United Kingdom.

Trademarks and Internet

Author's main focus is the trademarks violations happen through the internet. As you know internet is something which developed drastically throughout the last decade where now there is a grey area in the Intellectual property laws as the laws are not amended as fast as the technology develop. Intellectual property is a wide area where it covers copyrights, trademarks, industrial designs, and patents, geographical indications etc. Therefore our study is narrowed to the trademark infringements through internet (Domain names).

Trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises which are protected through intellectual property rights.⁴This is the basic idea of the trademarks in the World Intellectual Property Organization (WIPO) website. Contemporary issues in trademark laws are connected to the internet and we only focus on the three areas based on the internet as domain names.

There is a common principle in trademark laws which we should always remember throughout the article is that, trademark laws are subjected to the 'principle of territoriality'. The principle of territoriality means, a trademark is protected under a specific class⁵ for goods and services only under the jurisdiction that the trademark is registered. Therefore, any infringement happen outside the registered jurisdiction is not a valid infringement.⁶If the trademark

owner or the businessmen wanted to protect their trademark in other jurisdictions as well, then they have to register their trademark in that jurisdiction as well. This seems to be impractical to some extent and it is very expensive method. Therefore, to overcome this situation there are WIPO treaties such as Madrid protocol, where the jurisdictions that have signed and entered to this protocol are protected accordingly. Therefore, for a person to register his trademark could register under this protocol and he will get his trademark protected in all the jurisdictions where this protocol is applied. In this way the system has become more easy and faster yet, there are disadvantages as well because this is a very expensive method where small scale businessmen face uncomfortable with the situation. Therefore, it is very essential to move forward keeping this principle in our minds since the topic is revolving around trademarks and internet which contradicts with each other.

As you all know, internet is something anyone can access worldwide with the connection and it is a question and a grey area in law to overcome each and every dispute happening across the borders. Therefore, along with this topic, the author will further revolve around the dispute resolution mechanism as well for a better knowledge along with reference to the British jurisdiction and laws.

⁴<https://www.wipo.int/trademarks/en/>

⁵<https://www.wipo.int/classifications/nice/en/>

⁶ Dinwoodie, G.B, 2005, 'trademarks and Territoriality: Detaching Trademark law from the Nation-state', Journal article in Houston law

review, pp. 891-907, viewed 5th May 2020, Research Gate,

https://www.researchgate.net/publication/228175737_Trademarks_and_Territory_Detaching_Trademark_Law_from_the_Nation-State

Trademarks and Domain Names, Its Disputes, Resolution Methods and Laws

Domain names got its public attention along with the globalization and digitalization. The clash between domain names and traditional intellectual property laws are one of the first ever clashes happened in this field and the rise of new technologies.⁷Therefore there was a clear dispute between the two in cross-border litigation since trademark laws are always bound to the principle of territoriality while the domain names are available global. In this scenario the Alternate dispute resolution methods came up for the dispute resolution mechanisms.⁸

Having this concept in mind, the author will drag your attention to the definition of the domain name. Domain name is part of the address of the location of a site on the internet.⁹And the registration of a domain name could be registered as a trademark. This could be the same word mark of the registered trademark where again conflicts will occur. Therefore for the registration of a domain name is wholly based on first come first serve basis. Yet, for an infringement of a trademark to happen, it should be identical or similar and the class should be same. This is further explained later in this article.

Disputes between Domain names and Trademarks

These disputes between domain names and trademarks happen due to various reasons. As a major dispute, author states that non-internet based businesses or companies are now willing to develop their businesses and they wish to use the same name on the internet; but the issue that will come up is that the domain name will be global where another person can also have a domain name as your business, while the trademark is limited to a specific jurisdiction that it is registered. The case *Prince v. Prince Sports Group Inc.*[1998] FSR 21 showed that as no two domain names could be identical, only business can have a particular name. This means, two domain names cannot be identical, but a domain name and a business name or a registered trademark could be identical. Though a trademark and a domain names are similar or identical, an infringement won't happen. There are other sections and cases laws too where it mentions that we should look in to several other factors too in law before deciding whether a domain name has infringed a trademark. These external factors and laws are discussed later in this article.

Another dispute may occur due to the intention of the competitors are not necessarily to confuse an average person but to drag the internet users to their website. This is commonly known as 'cyber-squatting'¹⁰finally the dispute may

⁷ Waeld,C, Brown,A, Kheria,S, & Cornwell,J, 2013, *Contemporary Intellectual Property Law and Policy*, United Kingdom.

⁸ Waeld,C, Brown,A, Kheria,S, & Cornwell,J, 2013, *Contemporary Intellectual Property Law and Policy*, United Kingdom.

⁹Ibid.

¹⁰<https://en.wikipedia.org/wiki/Cybersquatting>

occur due to ‘reverse domain name hijacking’¹¹

Resolution of the above mentioned disputes could be mainly resolved through ICANN UDRP system.¹² Secondly, through the Judicial system. The case, **BT v. One in a Million** [1999] RPC 1 showed us that the practice of law clearly disapproved the cyber-squatting.

For the disputes mentioned above, it is needed to focus on the British case laws at this stage when discussing dispute resolution method along with the globalization and determine the external factors or other laws specifically before justifying whether a domain name has infringed a trademark.

Resolution of Disputes under the British Laws

Section 10(1) of the Trademarks Act 1994 states that ‘a person infringes a registered trade mark if he uses in the course of trade a sign which is identical with the trade mark in relation to goods or services which are identical with those for which it is registered.’¹³ It was mentioned in the case laws that for anyone who claims that their trademark is infringed through by the use of a domain name and relaying on this section, then the specification of goods and services in connection with the registered trademark is going to have to be identical with that used in the connection with the domain name, and if not there will be no infringement under section 10(1) of the Trademarks Act.¹⁴ According to the case **Avent Inc v Isoact Limited** [1998] FSR 16

it was concluded that ‘it was not providing advertising and promotional service within the class 35, but as class 42.’ Therefore, the services provided were different and therefore, no infringement happened under the section 10(1) of the Trademark Act 1994. As we can see, the infringement of a trademark by a different domain name is not only based on by infringing section 10(1) but, other specified factors too matters in law for an infringement.

Author will now drag your attention to the remaining subsections of the section 10 of the Trademarks Act 1994.

Section 10(2) of the Trademarks Act 1994 states that ‘A person infringes a registered trade mark if he uses in the course of trade a sign where because; the sign is identical with the trade mark and is used in relation to goods or services similar to those for which the trade mark is registered, or the sign is similar to the trade mark and is used in relation to goods or services identical with or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.’¹⁵ To explain the related laws, author cites the case, **Phones 4U Ltd v Phone4u.co.uk Ltd** [2006] EWCA Civ 244, [2007] RPC 5. In this case as the external specification to decide that the section is not infringed, the judge stated that when registering the relevant domain name, it was subjected to certain limitations. These limitations are subjected to the Trademarks Act 1994.¹⁶ Accordingly, *section 13 of the Trademark Act 1994* states

¹¹https://icannwiki.org/Reverse_Domain_Name_Hijacking

¹²<https://www.icann.org/resources/pages/help/dn-dr/udrp-en>

¹³Trademarks Act 1994, s.10(1)

¹⁴Avent Inc v Isoact Limited [1998] FSR 16

¹⁵Trademarks Act 1994, s.10(2)

¹⁶Trademarks Act 1994, s.13

that, ‘An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may; disclaim any right to the exclusive use of any specified element of the trade mark, or agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation; and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly. Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation.’

Therefore, in the above case they have added a limitation when registering because without a limitation the trademark was not distinctive. Accordingly, the court stated that ‘rights in the logo mark were limited to the colours red, white and blue and as a result there were no infringement in the section 10(2) by the registration of the domain name Phone4u.co.uk Ltd.

The fact we should drag our attention is that if there is no limitation imposed on the trademark when registering, then this section could have been violated by the domain name.

Section 10(3) of the Trademarks Act 1994 states that, ‘A person infringes a registered trade mark if he uses in the course of trade (in relation to goods or services), a sign which is identical with or similar to the trade mark, where the trade mark has a

reputation in the United Kingdom and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.’¹⁷The main landmark cases for this section are ***BT v One in a Million***¹⁸and ***Global Projects management LTD v Citigroup Inc. and others***.¹⁹Author of this article will not go into the deep explanations and discussions of the above cases yet, it is essential to keep in mind that these two cases are a major when discussing the section 10(3) of the Trademarks Act. Accordingly, the proper measurement to identify how this section is infringed is in doubt. Even the above mentioned cases under section 10(3) do not specify clear grounds on what specifications that this section will be infringed. Therefore, is it clear that we could identify this is an area where the laws should be developed with the technology.

Resolution of Disputes under ICANN UDRP system

ICANN UDRP²⁰ is the reason for not having number of cases in the courts. Because most of the disputes are referred and solved through alternative disputes resolution systems.²¹The ICANN UDRP applies to domain names registered in gTLDs.²²*Article 4* of the procedure and rules mentions the important part of dispute resolution when you are a registered domain name owner and that is contested by the complaint.²³Accordingly, the

¹⁷*Trademarks Act 1994*, s.10(3)

¹⁸ [1999] 4 All ER 476, [1999] RPC 1.

¹⁹[2006] FSR 39, [2005] EWHC 2663 (Ch).

²⁰<https://www.icann.org/resources/pages/help/dn-dr/udrp-en>

²¹https://en.wikipedia.org/wiki/Alternative_dispute_resolution

²² Waeld,C, Brown,A, Kheria,S, & Cornwell,J, 2013, *Contemporary Intellectual Property Law and Policy*, United Kingdom.

https://en.wikipedia.org/wiki/Generic_top-level_domain

²³ Waeld,C, Brown,A, Kheria,S, & Cornwell,J, 2013, *Contemporary Intellectual Property Law and Policy*, United Kingdom.

applicable disputes are, if ‘your domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and you have no rights or legitimate interests in respect of domain name; and your domain name has been registered and is being used in bad faith.’

Under the above mentioned applicable disputes, the claimants could go for arbitration under the available procedure on ICANN UDRP system.

Each domain name registered person should sign up for this dispute resolution process. Therefore, when an infringement occurs in between a domain name and a trademark, then the arbitration clause will apply as the domain name owner has signed and agreed on the UDRP.

Conclusion of the article

Accordingly, we could conclude the above facts stating that, the most recommended dispute resolution method when a trademark is infringed from another jurisdiction and through the internet is the online arbitration process by World Intellectual Property Organization (WIPO). As discussed above, the courts too solved the disputes yet; there is a grey area in law where that is doubtful and arguable and the laws should develop more to overcome these gaps that arise due to the rapid development of the technology.