



WIPO wipes out squatters
rights to domain names

Julia Roberts sitting pretty as she wins back her domain name



The stars come
out to fight for
Domain Names

Cybersquatters evicted from website homes...

DOMAIN NAMES & TRADE MARKS



What is a domain name?

Domain names create a unique address allowing one computer to be distinguished from millions of others connected to the internet enabling users to send and receive email, to access web pages, to establish an on-line identity.

Domain names are the familiar, easy to remember names for computers connected to the internet such as itma.org.uk. They correspond to Internet Protocol numbers, for example, 194.88.77.97, that serve as routing addresses on the internet but are difficult for people to remember.

What is the domain name system?

The domain name system is a hierarchical directory of all the domain names in the world and the computers with which they correspond. Thus a domain name is an internet address in the same way that a telephone number uniquely identifies a telephone line connected to the global telephone network. No two organisations can have the same domain name in the same way that no two people can have the same telephone number.

How many domains are there?

As of November 2002 there were over 50 million registered domain names in the world of which some 30 million were generic Top Level Domains (gTLDs) and the remainder country code Top Level Domains (ccTLDs). To put the growth of the domain name system into perspective, the first domain name was registered as recently as 1985.

What can be registered?

In addition to the dot (.), only the letters A-Z in upper or lower case, the numbers 0-9 and the hyphen or dash (-) may be used in domain names. A few very old registrations contain an underscore (_). Other symbols, including the ampersand (&) and the 'at' sign (@), cannot be used in domain names, though the @ sign does feature in email addresses before the domain name such as ken.storey@btinternet.com. The number of letters that can be used in a domain name is set by the administrator of the top level domain. Under the gTLDs, it has been possible to register a name with up to 66 characters since early 2000.

Who administers the domain name system?

The domain name system is administered by ICANN, the Internet Corporation for Assigned Names and Numbers. ICANN is a not-for-profit corporation based in the US that ensures technical standards are maintained and uniform protocols developed.

What can be done with domain names?

Once a domain name is active – meaning a text entry called a Zone File has been entered onto a Name Server – domains can be used:

To point to a website: Technically, this involves adding one or more lines (called A or Address Records) to the Zone File, listing the web site address(es). (Note that pointing a domain name to a website does not mean that the website will appear in the search engine rankings. This depends upon submitting the website to the search engine operators through a submission programme, and designing and updating the site in the right way).

For email: Domain names can feature in email addresses. Most companies prefer to own all of the email addresses that employees use. info@itma.org.uk is much more attractive than info.itma@aol.com.

To assign: The process of transferring ownership usually involves the registration authority deleting a name before re-registering it the moment afterwards to the third party. Assigning a domain name varies from jurisdiction to jurisdiction but can involve:

- applying to the registration authority for a unique number, sometimes called the tracking number;
- supporting this application with the submission of a signed form that features this tracking number and the contact details of the assignor and assignee. Sometimes the signatures have to be witnessed by a Notary Public or Commissioner of Oaths;
- paying a fee which is often in excess of a registration fee;
- supplying written letters of confirmation on company letterhead.

What is a good domain name?

The right domain name for a business has three features:

- it locates a website where commerce can be carried out;
- it promises the type of content that

will be found at the website;

- it reinforces market positioning by being memorable and/or informative.

It is possible to register trade marks, brand names and company names as domain names. Most people have a clear idea of what their key marks or “crown jewel” names are and it is sensible to secure these as soon as possible. Some people extend this policy to include nicknames or slogans that appear in advertising campaigns.

What is the interaction between trade marks and domain names?

It is reasonable for internet users to expect that a domain name consisting of a trade mark in use in the real world is associated with the owner of this trade mark, not another party. This natural assumption has led to much of the controversy over domain names because:

- domain names are sold on a first come, first served basis;
- no two companies can have the same name under the same top level domain though it is possible for the same name to be registered by different entities under other top level domains. Thus, itma.org.uk co-exists alongside the International Twelve Metre (Yachting) Association's itma.org.
- confusingly similar variations are allowed because the computers map the alpha-numeric string itma.com to the string of IP numbers underneath it. Therefore, they see a great deal of difference between, for example, itma.com and it-ma.com or itma.com.ar;
- there is rarely an objection system – though in many jurisdictions you must show that you have a right to a name before you can register it.

Where can names be registered?

Domain name registries may be run by government officials, by academics, by business people or volunteers. Each registry creates its own policies. Some open registries allow anyone to register any number of names through a web interface with a credit card without showing they have a right to a name. Others restrict registration to active companies locally incorporated that must provide hard-copy evidence of status.

There is little conformity even across Europe where a Community Trade Mark exists. For example, whilst

Germany, Belgium, Denmark, Italy, the United Kingdom and several smaller jurisdictions such as Jersey and Guernsey are unrestricted, welcoming applications from anyone, Spain, Germany and France are semi-restricted in that there is a local presence requirement whilst Portugal, Greece and Sweden each demand documentary proof of a right to use a name as well as local residency.

Wise companies base domain registration strategy upon their trade mark strategy, relying on trade mark law to support them in any conflicts over domain names. It is usually possible to create a matrix based around trade mark policy, proceeding through a staged process moving from the gTLDs that are appropriate for a business to ccTLD jurisdictions where the applicant is based and where it has established trade mark rights to countries where it has customers or commercial interests.

Finally, companies must consider locking up jurisdictions where domain name infringers are most active.

How are names registered?

Although it is possible to register domain names directly at registries or by going to internet naming companies which are often called registrars or registration agents, registrants with intellectual property concerns can receive impartial and expert advice and direct services from many members of the Institute of Trade Mark Attorneys – see www.itma.org.uk.

Once a domain name has been registered, information about who owns it and sometimes the details of the person responsible for the technical management of the name will be made available to the public through a “Whois” programme. Most registries operate free Whois servers that may be consulted literally thousands of times an hour. See <http://www.nic.uk/index.html> for access to the Nominet UK whois.

Members of ITMA can help provide you with a consolidated domain name search report provided by specialist search agencies covering every Whois programme and jurisdiction in the world.

How long does a domain name registration last for?

Domain names are registered for one or more years, according to where you are registering and the policy of that registry. Often, there is an initial two year period followed by annual renewal. It is vital

What kind of domains are there?

The domain name system features top, second and third level domains.

Top-level domains are divided into:

(i) two-letter country codes according to the ISO 3166 standard (such as **.ar** for Argentina, **.be** for Belgium, **.cn** for China, **.de** for Germany, **.es** for Spain, **.fr** for France; etc.). 239 countries have been allocated country code domain names by IANA, the Internet Assigned Numbering Agency.

(ii) generic top level domains (gTLDs) of which there are 13:

.com for commercial organisations;

.org for not-for-profit organisations;

.net for internet network providers;

.biz for bona-fide business use;

.info for information on anyone or anything

.aero for the aviation industry;

.coop for the co-operative movement;

.museum for the museum community;

.name for personal name use;

.pro for professionals

.edu for full-time, degree-granting educational establishments;

.mil for military establishments and organisations; and

.int for international treaty organisations such as the United Nations

Under gTLDs, second level domains are chosen by the applicant (for example, ITMA has registered the second level term “ITMA” under the **.info** top level so that it has **itma.info**).

However, country code top level domain (ccTLD) administrators may create mandatory second level domains. For example, in the United Kingdom, the national registration authority Nominet U.K. offers 12 second level domains under **.uk**:

.co.uk for commercial enterprises;

.org.uk for organisations;

.ltd.uk for U.K. limited companies;

.plc.uk for U.K. public limited companies;

.net.uk for Internet Service Providers;

.sch.uk for U.K. schools;

.ac.uk for academic establishments;

.gov.uk for government bodies;

.nhs.uk for NHS organisations;

.police.uk for U.K. police forces;

.mod.uk for Ministry of Defence establishments

.me.uk for personal name use

It is therefore only possible to register at the third level in the UK – such as **patent.gov.uk**, the domain name used by the UK’s Patent & Trade Mark Office.

that you monitor renewal dates otherwise you might lose your name. Members of ITMA can provide the monitoring and renewal service.

How much does a domain name cost?

This also depends on where you are registering. Official registry fees vary from a few pounds to several hundred whilst the registration agent you are using will also charge a fee for servicing your order. To register a **.co.uk** name through a registration company that specialises in business and can manage renewals is likely to cost between £20–£40 including registry fees.

How are domain name disputes settled?

All gTLD registrations are governed by the Uniform Dispute Resolution Procedure (UDRP) or a variation on it. Devised by the World Intellectual Property Organisation, this offers trade mark owners the ability to challenge bad faith registration (often known as

cybersquatting or domain name piracy) through an expedited administrative procedure that costs in the region of \$1500 in official fees and takes no more than three months. Neutral panellists have decided over 2,500 cases since the UDRP was introduced in 2000.

An increasing number of ccTLDs are adopting the UDRP or their own version of it. Nominet UK, for example, has a Dispute Resolution System that starts with a period of free mediation before a panellist is appointed.

Disputes between trade mark owners with competing rights are ordinarily resolved through negotiation or, if that fails, through court litigation.

See www.icann.org/udrp and <http://www.nic.uk/ref/drs-policy.html>.

ITMA participated in the consultation process when both the UDRP and the Nominet UK Dispute Resolution Service was drawn up. Many members serve as panellists or provide services to settle domain name disputes.



This briefing paper is intended as guidance only and no legal liability can be accepted in relation to the information given above. For further information contact a trade mark attorney or contact the Institute office at:

The Institute of Trade Mark Attorneys
2-6 Sydenham Road
Croydon
Surrey
CR0 9XE

Tel: 020 8686 2052
Fax: 020 8680 5723
E-mail: tm@itma.org.uk
Website: www.itma.org.uk

