



FACULTY OF LAW
Lund University

Stefan Kuipers

The relationship between Domain names and Trademarks/Trade Names

JAEM01 Master Thesis

European Business Law
15 higher education credits

Supervisor: Ulf Maunsbach

Term: Spring 2015

Summary:

The main research question is, how do domain names relate to trademarks/trade names? This main research question will be answered based on the two most relevant aspects regarding this question. The first aspect is whether a domain name can, by itself, be regarded as a trademark/name. Domain names used for commercial purposes have the capability to be regarded as registered/ unregistered trademarks/ trade names and also as well-known trademarks/trade names. Whether the same applies to domain names used for non-commercial purposes cannot be answered conclusively. The second aspect, for answering the main research question, is whether domain names can infringe a trademark/trade name.

Registering a domain name: Registering a domain name cannot infringe a trademark/ trade name. With regard to well-known trademarks/trade name this is different. The conditions for such a domain name to be infringing are that the domain name is (nearly) identical to the well-known trademark/trade name and that this leads to a likelihood of confusion.

Using a domain name for commercial purposes: For this use, the conditions for a domain name to be infringing are that: they are (nearly) identical to the trademark and therefore confusing, they indicate the content of the website (the goods/services), and are be used for the same purpose as the trademark. Domain names infringe a well-known trademark/trade name when they are merely confusingly similar to the well-known trademark/trade name.

Using a domain name for non-commercial purposes: The difference with commercial use is that the burden of proof is higher for domain names used for non-commercial to be infringing. This is especially so with being seen as confusingly similar. The burden of proof here is twofold, it must be confusing and this must also have occurred. Well-known trademarks have to comply with the same conditions as domain names used for commercial purposes to be infringing.

Using in e-mail addresses: Similar conditions apply as to other forms of domain names in order for an e-mail address to be infringing. In other words, there is not a substantial difference between domain names manifested in the form of a website or in the form of an e-mail address.

Cybersquatting: National courts apply criteria similar to those described in UDRP when dealing with cybersquatting. This use has conditions identical to other forms of domain name use, the additional condition is however that the registration/use has to be in bad faith. For regular trademarks this means that there needs to be extensive evidence that the registration was done in bad faith in order to be seen as infringing a trademark/trade name. With regard to well-known trademarks/ trade names bad faith is (almost) implied.

Preface:

The reason why I wrote this thesis comes from my personal interest in trademark law, especially in relation to the internet. During one of my internships I have worked on several aspects related to trademark law, for example the registration of trademarks and trade names. However the most interesting part of this internship was a case related to the possible infringement of a trademark belonging to the company I worked. One of the competitors had registered a domain name which reflected this trademark, as a result of which legal proceedings were started against this competitor for trademark infringement. I have subsequently worked for several months on this case. My internship unfortunately ended before a final conclusion was reached. Therefore, when I had to choose a topic for my thesis as part of the Master of European Business Law, I instantly decided on the relationship between domain names and trademarks.

I would like to thank first of all my supervisor Ulf Maunsbach for helping me during the process of writing this thesis. I would also like to thank my parents for supporting me during my studies which has made it possible for me to follow this master programme.

Lund, May 2015

Stefan Kuipers

List of abbreviations:

CcTLD: Country code Top-Level Domain

ECJ: European Court of Justice

gTLD: generic Top-Level Domain

ICANN: Internet Corporation for Assigned Names and Numbers

SLD: Second Level Domain

TLD: Top Level Domain

TRIPS: The Agreement on Trade-Related Aspects of Intellectual Property Rights

UDRP: Uniform Domain Name Dispute Resolution Policy

WTO: World Trade Organization

WIPO: World Intellectual Property Organization

Table of Contents

1: INTRODUCTION	6
1.1 Hypothesis/Research Questions	6
1.2 Outline	7
1.3 Methodology	8
1.4 Delimitations	10
2. WHAT ARE THE CHARACTERISTICS OF TRADEMARKS/TRADE NAMES?	12
2.1 Trademarks	12
2.1.1 Legal Basis	12
2.1.2 Legal Requirements	13
2.2 Well-known Trademarks	15
2.3 Trademark Rights	17
2.4 Trade Names	18
3: WHAT ARE THE CHARACTERISTICS OF DOMAIN NAMES?	20
3.1 Second Level Domain	21
3.2 Top Level Domain	23
3.2.1 Country code Top Level Domain	23
3.2.2 generic Top Level Domain	23
3.3 UDRP	24
4: CAN A DOMAIN NAME BE REGARDED AS A TRADEMARK/TRADE NAME?	26
4.1. Commercial use of a Domain Name	27
4.1.1. Can a Domain Name be Seen as a Sign?	27
4.1.2. Can a Domain Name be Represented Graphically?	27
4.1.3. Can a Domain Name be distinctive?	27
4.1.4. Can a Domain Name be regarded as a Well-known Trademark/Trade Name?	29
4.2. Non-commercial use of a Domain Name	31
5: UNDER WHICH CIRCUMSTANCES CAN A DOMAIN NAME INFRINGE A TRADEMARK/TRADE NAME?	33
5.1. Registering a Domain Name	33
5.2. Using a Domain Name for Commercial Purposes	36

5.3. Using a Domain Name for Non-Commercial Purposes	39
5.4. Using E-mail Addresses	42
5.5. Cybersquatting	44
6: CONCLUSIONS	47
6.1 Can a Domain Name be regarded as a Trademark/Trade Name?	47
6.1.1. Commercial use of a Domain Name	47
6.1.2. Non-commercial use of a Domain Name	48
6.2 Under Which Circumstances can a Domain Name Infringe a Trademark/Trade Name?	48
6.2.1 Registered Domain Names	48
6.2.2 Using a Domain Name for Commercial Purposes	48
6.2.3 Using a Domain Name for Non-Commercial Purposes	49
6.2.4 Using E-mail Addresses	49
6.2.5 Cybersquatting	49
BIBLIOGRAPHY	51

1: Introduction

1.1 Hypothesis/Research Questions

Domain names are in many ways the sign-board of the modern day organization, this makes the function of domain names similar to that of a trademark/ trade name. As a result of the importance of domain names several issues arise on how domain names relate to trademarks/trade names. The two most relevant aspects, with regard to this relationship, are a direct result of the two most important aspects of trademark/trade name legislation: the establishment of a trademark/trade name and the protection offered to trademark/trade name owners.

The possibility for domain names to be regarded as trademarks/ trade names themselves has, up to now, predominantly been dismissed. However with the internet becoming, or already being, the main outlet for businesses the dismissal of this possibility is debatable because of the function that domain names fulfil in everyday commerce. This is even more so since the recently released generic Top-Level Domain. Generic Top-Level Domain means that the last part of a domain name, the top-level, is not limited anymore to only a few predetermined options. Instead private individuals and organizations can now register an unlimited amount of new top-level domain names. This will lead to increased possibilities for domain names to reflect trademarks/ trade names, and also to be regarded as such.

Domain names are capable of using/reflecting existing trademarks/trade names. When third parties use trademarks/trade names this can, when certain conditions are met, result in infringement. Domain names are therefore, in certain circumstances, also capable of infringing trademarks/trade names.

The hypothesis is that domain names relate to trademarks/trade names because: they can be regarded as trademarks/trade names and have, in certain circumstances, the possibility to infringe existing trademark/trade name rights.

main research question: How do Domain Names relate to Trademarks/Trade Names?

sub-question 1: What are the characteristics of Trademarks/Trade Names.

sub-question 2: What are the characteristics of Domain Names.

sub-question 3: Can a Domain Name be regarded as a Trademark/Trade Name?

sub-question 4: Under Which Circumstances can a Domain Name Infringe a Trademark/Trade Name?

1.2 Outline

The first chapter will focus on the characteristics of trademarks/trade names which will deal, for example, with the criteria for establishing a trademark/trade name. Subsequently the aspect of registered and unregistered trademarks/trade names will be addressed as well as the criteria for establishing a well-known trademark/trade name. The second chapter will focus on the characteristics of domain names which will give a general description of the function and the technical criteria of domain names. Subsequently the distinction between second-level domain names and top-level domain names will be addressed..

The main part of this thesis will consist of an analyses which, as described in the research questions, is twofold. The first part of the analysis will deal with the question to what extent domain names can be regarded as trademarks/ trade names. The main focus will be on the commercial use of a domain name. In this part of the analysis the criteria for establishing a trademark/trade name will be compared to those of domain names in order to identify if domain names have the potential to fulfil those criteria, this includes the aspect of well-known trademarks/trade names. The last part of this analyses will deal with the question whether a domain name, used for non-commercial purposes, can also constitute a trademark/trade name.

The second part of the analyses deals with the question – to what extent a domain name can infringe a trademark/trade name? This analysis will be based on existing trademarks/ trade names, including those that can be regarded as well-known. The research will focus on the most common uses of domain names and investigate whether these can infringe a trademark/trade name. These uses of domain names are: the mere registration of a domain name, using a domain name for commercial purposes, using a domain name for non-commercial purposes, using in e-mail addresses and cybersquatting (domain name theft).

The analyses will hereby first of all focus on the question whether such a specific use of a domain name can constitute trademark/trade name infringement and subsequently under which circumstances that can happen. The last part of this thesis will be used to give conclusions to the research questions.

1.3 Methodology

The research field for this thesis is changing rapidly, predominantly because of the ever greater importance of domain names and the introduction of the generic Top-Level Domain. The research will be based on both qualitative and, to a lesser extent on, quantitative (empirical) research methods. For this thesis, empirical evidence will only consist of case-law. There is (not yet) a uniform interpretation of the research questions which deal with a relatively unknown or undeveloped area of law, therefore empirical data like questionnaires are not beneficial for conducting this research. Case-law is the most prominent source for answering specific aspects related to the research questions. Empirical evidence in the form of case-law implies selecting and studying judgments dealing with specific aspects. For example whether a domain name, in certain circumstances, can be regarded as a trademark/trade name. Standard case-law dealing with questions like the criteria for establishing a well-known trademark in a general sense does not constitute a quantitative (empirical) research method.

The reason for also choosing qualitative research methods is related to the fact that this offers the best insight into standard aspects related to trademarks/trade names and more specific aspects dealing with domain names and trademarks/trade names. The research into standard aspects like the conditions for establishing trademark protection, will be based on reference literature. Specific aspects, for example what circumstances have to be present for cybersquatting, are based on expert sources e.g. academic articles.

This research therefore justifies a combination of both qualitative and quantitative (empirical) research methods. The findings, contained in these sources, offer an accurate insight when dealing with the issues contained in the research questions. The selected research methods will result in a comparative analysis whereby sources, dealing with domain names on the one hand and trademarks/trade names on the other hand, will be compared to each other in the third and fourth research questions.

The strength of choosing these research methods is that the most accurate and relevant sources will be used. The weakness is obviously that the foundation of the research is sometimes limited to relatively few sources, which is however unavoidable because of the research topic. The selection of the material for both the quantitative and the qualitative research methods has been done with great awareness, for example that they are not to one sided or prejudiced towards a specific outcome. Another aspect taken into account is the relevance of the sources. This is a fast changing area of law which can easily lead to sources being outdated because of subsequent developments.

For every part of the research sources based on reports from WTO, WIPO, ICANN and IANA are used. The reason being that these sources deal with many aspects of trademarks and trade names as well as domain names, but more importantly the connection between these two aspects. The main legal basis for this thesis is the TRIPS agreements and the Paris Convention for the Protection of Industrial Property. These treaties are signed by most jurisdictions in the world and are administered by the WTO and WIPO respectively. The European Union is also a member of the WTO and is committed to the principles of both treaties.

Because this thesis is part of the Master of European Business law, great emphasize has been paid to the legal situation within the European Union, which is to a large extent similar to the aforementioned treaties. The main legislation regarding this topic consists of the EU trademark, e-commerce and unfair advertisement directives which (at the moment this thesis was written) have all been implemented in the respective legislation of the Member States. Trademark law is as a result of the implementation of these directives highly harmonized in the EU. Books and other forms of literature tend to be quickly outdated because of new developments in this research field. One of the primary sources are therefore court judgements, which provide more clear and up-to-date guidelines regarding the way the previously mentioned directives should be interpreted. The judgements used for this research come from the ECJ and from national courts of Member States. Judgements from the United States will be used in order to address two specific issues: first of all whether e-mail addresses can be seen as infringing well-known trademarks and secondly whether domain names used for commercial purposes can be regarded as well-known trademarks/trade names. These judgments are used because there are not yet (proper) judgments from the EU dealing with this topic.

Panel decisions from the aforementioned WIPO are also used, and to a lesser extent those from the WTO. These organizations deal with many domain name related situations, which has led to extensive jurisprudence regarding the way these issues should be dealt with. The panel decisions from WIPO are however not based on trademark law and deal in a purely administrative way with the relationship between domain names and trademarks/trade names. These cases will therefore only be used as supplementary evidence.

With regard to characteristics and criteria of trademarks/ trade names extensive reference literature is used as well as more specific literature in the form of academic articles. Examples of these materials are the books *intellectual property law* and *Intellectual Property: Patents, Copyright, Trade Marks and allied rights*. These materials are used for the fundamental aspects of trademarks/ trade names. Standard jurisprudence is the second main source for conducting research with regard to the fundamental aspects of trademarks and trade names. The research dealing with the characteristics of domain names is predominantly based on academic, and reference, papers, for example the *Berkeley Technology Law Journal*.

1.4 Delimitations

For the purpose of this thesis detailed technical requirements on how domain names work are not necessary for answering the research questions and these will therefore be left out. This thesis, as mentioned above, will investigate the two most relevant aspects related to the main research question.

The first delimitation is that other aspects which might be related to the main research question, but are not directly covered by the second and third research questions, will be left out. Examples of such aspects might be jurisdictional issues related to the relationship between domain names and trademarks/trade names. The reason why other aspects, related to the main research question, are left out is a result of the timeframe for writing this thesis. The inclusion of other, less important, aspects is not possible within the aforementioned timeframe.

The second delimitation has to do with the third research question. The purpose for this question is to analyse whether a domain name, used for a specific purpose, can be regarded as a trademark/trade name. This analysis will however not include the following uses of domain names: the mere registration of a domain name, e-mail addresses and cybersquatting.

Research dealing with the question whether these, previously describe, uses of domain names can be regarded as a trademark/trade name could be relevant for a more comprehensive overview in relation to the third research question but will be left out. The, previously described, uses of domain names will be left out when analysing the third research question, because they are less likely to constitute trademark/trade name rights. This comes from the fact that signs generally need to be used for economic purposes in order to be regarded as trademark/trade names. These, previously describe, uses of domain names are in most cases not by themselves engaged in economic activities and are therefore less likely to be regarded as trademarks/trade names. For example merely registering a domain name, or cybersquatting, in most cases does not lead to them being used for economic purposes. The same is true with regard to e-mail addresses, these are used for communication purposes in support of a business which does, in most instances, not constitute a business by themselves. Because of the limited timeframe for writing this thesis the decision has been taken to focus on the commercial and non-commercial use of a domain name, since they are actually used for economic purposes and are therefore more likely to be regarded as trademarks/trade names.

The third delimitation is that the aspect of when and how a particular domain name is found by a user shall also be left out with regard to the fourth research question, this means in particular the use of metatags. This is a relevant aspect because metatags indicate the content of a particular website and are thereby related to the way domain names are found by users. This is however not the core of this research and shall therefore not be dealt with.

The fourth delimitation has to do with the specific forms of non-commercial use, the question what kind of non-commercial uses are possible will be left out. This non-commercial use of domain names includes aspects like free speech, parody, news and comparative advertisement. For the third and fourth research questions the overall characterization will be used which is, activities not carried out for profit. One of the purposes for writing this thesis is to indicate that for certain uses e.g. non-commercial, a domain name can be seen as infringing a trademark/trade name and that a domain name by itself can be regarded as a trademark/trade name when used for this purpose. What exactly qualifies as non-commercial use of a trademark/trade name is based on trademark law and is not directly related to these research questions. The aspect of what constitutes non-commercial use of a trademark/ trademark is therefore not dealt with in this thesis.

2. What are the characteristics of Trademarks/Trade Names?

2.1 Trademarks

2.1.1 Legal Basis

Trademarks are generally considered to be one of the most valuable assets an organization has.¹ The protection of these trademarks is therefore of great importance to businesses, which is why trademark law has been introduced in basically every jurisdiction in the world. There is an international standard for trademark legislation consisting predominantly of two agreements. The first of these agreements is the Paris convention, which was the first international legislation dealing with trademark law.² This convention, together with other treaties, is administered by WIPO. The Paris convention was subsequently followed by the TRIPS agreement which is the foundation of a universal trademark protection regime. The TRIPS agreement is especially relevant for the determination of an international basis of trademark law because the acceptance is a mandatory requirement for joining the WTO. So far 160 nations have accepted the TRIPS agreement which creates a solid universal basis for trademark law.

This thesis is predominantly based on EU legislation because it is written as a part of the Master European Business Law. EU legislation is closely related to the previously mentioned international agreements regarding trademarks/ trade names. First of all, every Member State is bound by the Paris convention as described in e.g. the trademark directive which states that *It is necessary that the provisions of this Directive should be entirely consistent with those of the said Convention*. Therefore it can be concluded that EU legislation is bound by this convention. This is also the case with regard to the TRIPS agreement. The European Union is in its own right part of the WTO (and is thereby a signatory of the TRIPS agreement). The TRIPS agreement has been created as a result of the desire from e.g. the EU to have better international protection of intellectual property. EU (trademark) legislation outdates the TRIPS agreement but has contributed to its creation.

¹ Kamil Idris, 'Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises' (2006) 4 (1) Intellectual Property for Business Series

<http://www.wipo.int/edocs/pubdocs/en/sme/900/wipo_pub_900.pdf> accessed on April 10, 2015

² Paris Convention for the Protection of Industrial Property 1883

The relevant EU legislation which is currently in force consists of the following directives and regulations:

- The e-commerce directive Directive 2000/31/EC;³
- The trademark Directive 2008/95/EC;⁴
- The unfair Advertising Directive 2006/114/EC;⁵
- The Community Trademark Regulation 207/2009.⁶

The trademark directive is the legal basis within the Member States for trademark law, as a result of which this area of law is almost completely harmonized within the EU. There is subsequently also the trademark regulation, dealing with the community trademark and the criteria for registering such a trademark. The trademark directive and the trademark regulation give an almost identical description with regard to the criteria for establishing a trademark as the previously mentioned international legislation.

2.1.2 Legal Requirements

Trademarks have as their primary function the indication of origin of a particular good or service.⁷ Another function is that of identifying the quality of a good or service, which is indicative to consumers of whether to buy a specific product or service. This in essence comes down to brand attractiveness. Trademarks also have the function of containing extrinsic value.⁸ This is a result of the substantial investment that has gone into most products or services that are offered these days. The goodwill that has been created as a consequence of this investment is invested in the particular trademark. The Benelux trademark legislation was first in accepting this function of a trademark. With regard to the trademark directive there has been a debate whether this legislation should be interpreted as also bestowing this function upon trademarks.⁹ There is however not a clear cut answer yet whether the trademark directive envisages such.

³ Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market [2000] ECR 00000

⁴ DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25

⁵ DIRECTIVE 2006/114/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 12 December 2006 concerning misleading and comparative advertising [2006] OJ L376/21

⁶ COUNCIL REGULATION (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L78/1

⁷ William Cornish and David Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and allied rights* (5th edn, Sweet & Maxwell 2003) 587

⁸ Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008) 189,190

⁹ DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/

The reason why this particular function is important to trademarks is closely related to trademark dilution which shall be addressed later. For now it suffices to say that trademarks in most instances represent significant investments which has (in some jurisdictions) resulted in trademarks having the function of containing extrinsic value.

Having established the main functions of a trademark, the subsequent question is what are the conditions for establishing a trademark? The assessment of whether or not signs qualify as trademarks is objective. Based on the criteria for establishing a trademark contained in article 2 of the trademark directive the conditions can be summarised as follows:

- a) There needs to be a sign;
- b) The sign needs to have the capability of being represented graphically;
- c) The sign needs to be distinctive.¹⁰

Such a sign can be both a word or a letter combination, including personal names, as well as logos and a great variety of other expressions.¹¹ Several jurisdictions allow non-traditional trademarks, for example colour marks, which is for the purpose of this thesis not relevant to be described in-depth. The last requirement of a trademark is probably the most important one. The basic definition with regard to distinctiveness is given in article 15 of the TRIPS, *any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings*. Whether or not a sign can be seen as distinctive is paramount for the potential qualification of that sign as a trademark. The TRIPS agreement does not by itself indicate what the requirements are for a sign to be regarded as distinctive or not, merely that this can be acquired by means of registration or use. The trademark directive gives an almost identical definition. The ECJ has ruled that all signs have in principle the capability of acquiring distinctiveness and that no form of signs is *per se* excluded from this.¹² In practice the burden of proof is placed with the organization, that wishes to register or make use of a trademark, that the sign is actually distinguishing their products or services from those of their competitors.

¹⁰ DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/

¹¹ Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008) 194

¹² Case 299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*. [2002] ECR I-05475

There are several grounds for refusing to register a trademark or qualifying a sign as an unregistered trademark. The TRIPS agreement and the applicable EU legislation describe these in more depth, the most common grounds are that the sign is:¹³

- not distinctive;
- descriptive;
- contrary to public policy or morality;
- likely to mislead the public or the consumer;
- contrary to the provisions of article 6^{ter} of the Paris convention.

Primarily trademarks that violate public policy or public interest may be rejected from the protection of trademark law. However the purpose of this thesis is not to describe what specific sign can be seen as a trademark, the more detailed description of these grounds for refusal are therefore not relevant.

Signs don't need to be registered in order to qualify as a trademark, also unregistered signs can fall qualify as such. The level of protection is the same for registered and unregistered trademarks. The applicable (EU) legislation does not consider this issue, instead it is left up to the Member States to determine legislation to this end.¹⁴ The conditions that have to be fulfilled in order for a sign to be qualified as an unregistered trademark are identical to those for establishing a registered trademarks.

2.2 Well-known Trademarks

Besides the previously mentioned 'regular' trademarks there are also well-known trademarks. Both registered and unregistered trademarks can qualify as well-known. The Paris convention describes well-known trademarks in article 6bis, the TRIPS agreement has also included a description along similar lines in article 16 (3). These treaties state that parties can resist the use of a trademark by a third party if that trademark infringes their well-known mark. This includes all uses, even when they are unrelated to those for which the well-known sign is used.

¹³ Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008) 196-205

¹⁴ DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25: COUNCIL REGULATION (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L78/1

The trademark directive states in article 5 (2) along similar lines that a party can prevent all others from using a sign in relation to goods and services which are not similar when *the latter has a reputation in the Member State 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 trade mark*. In other words, the protection of well-known trademarks is much more qualified than the other ‘regular’ trademarks. What is unique to well-known trademarks is the aspect of trademark dilution, which means that a trademark is used by a third party for other purposes than the trademark which can diminish the distinctiveness of that trademark. Such use is not of a competitive nature and is therefore permissible with ‘regular’ trademarks. Trademark dilution does however violate the more qualified protection offered to well-known trademarks which prohibits such use.

The criteria for establishing well-known trademarks are comparable to those of ‘regular’ trademarks.¹⁵ The added criterion is obviously that the trademark needs to be well-known. The ECJ gives a definition in the *General Motors case* in regard to what constitutes a well-known trademark: ‘(...) *the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark. (...)*’.¹⁶ The court elaborates on the qualification of trademark being regarded as well-known by indicating that ‘(...) *a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it (...)*’.¹⁷ The quality of the goods offered here is not relevant, also poor quality goods can be well-known.¹⁸ The answer to what constitutes a well-known trademark is therefore that it must be known by a large part of the population and is associated with particular goods or services.

¹⁵ Anna Szajna, ‘The high standing of unregistered trademarks’ 2011 World Trademark Review 84-85
< <http://www.worldtrademarkreview.com/Magazine/Issue/28/Country-correspondents/Poland-Patpol-Patent-Trademark-Attorneys> > accessed 20 April 2015

¹⁶ Case 375/97 *General Motors Corporation v Yplon SA* [1999] ECR I-05421

¹⁷ Case 375/97 *General Motors Corporation v Yplon SA* [1999] ECR I-05421 para 28

¹⁸ Nuno Pires de Carvalho, *The TRIPS regime of trademarks and designs* (2nd edn, Wolters Kluwer Law & Business 2011) 364

2.3 Trademark Rights

Having established what the legal requirements are for establishing trademarks protection, the next step is to examine what this protection means. When a sign is registered as a trademark or qualifies as an unregistered trademark this will result in the obtainment of rights by the owner of that trademark. The ownership of a trademark means that the owner can prevent third parties from using this trademark.¹⁹ Such use by a third party can include misrepresentations which affects the distinctiveness of the trademark. This implies for 'regular' trademarks that third parties use it for comparable purposes as the trademark.

There are however limits to the protection offered by trademark protection. For example, trademarks don't give the owner a right to use it, merely to prevent others from doing so. The owner of a trademark cannot use the trademark when it violates applicable legislation, this will in most instances mean that the trademark is used to sell illegal goods or services. Another example of the limits of trademark protection is competition law, which can prevent the extent to which a trademark is protected. What in my opinion is a good illustration is related to a case dealing with (non-traditional) colour marks in the fashion industry. The registration of the red colour shoe sole as a trademark by *Christian Louboutin* was successful. This trademark was subsequently used to sue *Yves Saint Laurent* for also having red sole shoes. The red sole shoe designed by *Yves Saint Laurent* was however in combination with a wholly read shoe. The court argued in its judgment that this extended protection of the trademark would be a disadvantage for their competitors because they cannot come up with their own design. The trademark for the red sole shoe was therefore only limited to the specific combination with a black shoe, the extended protection that was desired by the claimant was limited by competition law. To grant protection to all red sole shoes would have resulted in anti-competitive behavior.²⁰

There are other examples, predominantly, related to non-traditional trademarks which are for the purpose of this thesis not relevant. Overall however it can be said that the limitation of trademarks rights based on competition law means that extended protection of the trademark harms competition on the merits which leads to anti-competitive behavior.

¹⁹ Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008) 189

²⁰ Kexin LI, 'COORDINATING EXTENSIVE TRADEMARK RIGHTS AND COMPETITION POLICY' 2013 BUFFALO INTELLECTUAL PROPERTY LAW JOURNAL 55-59

The last aspect that will be dealt with regarding trademark rights is the territory in which a trademark is used. Well-known trademarks like *Apple* and *Nike* are active worldwide and therefore also enjoy worldwide protection. The majority of smaller trademarks are however active in only one or a few countries. The owners of these trademarks will only be able to enjoy trademark rights in those countries in which there is protection.

2.4 Trade Names

The primary function of a trade name is to distinguish a specific business or company from their competitors.²¹ Trade names fulfil however in many circumstances the same function as a trademarks, namely to identify goods or services. In those situations a trade name can also be regarded as a trademark. For the purpose of this thesis it is however not relevant to look at the situation in which a trade name can be seen as a trademark. Companies and organizations always have a statutory name but don't necessarily operate under this name. Often a different name is chosen to operate under, this is called a trade name or a brand name. The purpose for having a trade name which is different than the statutory name differs from company to company but in general such decisions are taken out of economic or administrative considerations. The company similarly tries to distinguish itself from its competitors by the use of a trade name.

When the trade name is registered the owner has an exclusive right to use this trade name for the specific economic activities where that organization is engaged in. This means that such a name cannot be used in relation to similar services by competitors. Compared to trademarks there is less harmonization when it comes to trade names. The criteria for establishing a trade name are nonetheless similar to trademarks in many jurisdictions. For example in the Netherlands trade names are part of the general trademark law, and have to be registered at the chamber of commerce.²² The criteria for establishing a trade name are that the name must have a certain durability/ reputation and cannot be identical or confusingly similar to an existing trade name.

²¹ Henry Campbell Black, *Black's Law Dictionary* (6th Ed.) (St. Paul, Minn.: West Publishing Co., 1990).

²² WIPO, *Second WIPO Internet Domain Name Process*
<<http://www.wipo.int/amc/en/processes/process2/report/html/annex15.html>>

In Sweden trade names are protected under the trade name act, and have to be registered at the patent office.²³ The criteria for establishing a trade name are that the sign distinguishes the business from others and that it is not confusingly similar to another trade name. Subsequently a trade name cannot be intended to mislead the public, or be against accepted customs or the public order. Trade names are also similar to trademarks in the sense that they can be qualified as well-known. The criteria for a trade name to be qualified as well-known are identical to those that apply for trademarks. The trademark needs to be known by a large part of the population and must be associated with a particular organization.²⁴

Trade names are protected under international intellectual property law. The Paris convention contains a provision about trade names in article 8: *A trade name shall be protected in all the countries of the Union without the obligation of filing or registration, whether or not it forms part of a trademark.* This implies that trade names are protected within the 176 contracting parties, and that trade names don't need to be registered in order to be protected. In the *Havana club case* it was decided that trade names also fall under the TRIPS agreement.²⁵ This has the result that trade names enjoy a level of protection equal to that of trademarks, both with regard to 'regular' and well-known trade names.

To conclude, trade names are in many ways similar to trademarks for example with the level of protection awarded and the fact that they don't need to be registered in order to receive this protection. There is no harmonization with regard to the criteria for establishing trade names, which results in different criteria between jurisdictions. Overall it can however be said that trade names have similar criteria to those of trademarks in order to be protected. Trade names, for example, need to identify the origin of the business and cannot be confusingly similar to other trade names.

²³ WIPO, *Second WIPO Internet Domain Name Process*
<<http://www.wipo.int/amc/en/processes/process2/report/html/annex15.html>>

²⁴ Paul Steinhäuser and Milicia Antic, 'Country correspondance: SteinhäuserVandenBrinkHeeziusRijdsdijk Advocaten' 2008 World Trademark Review 48-49
<<http://www.worldtrademarkreview.com/Magazine/Issue/16/Country-correspondents/Netherlands-SteinhäuserVandenBrinkHeeziusRijdsdijk-Advocaten>> accessed 16 April 2015

²⁵ *Havana Club Holding, S.A. v. Galleon S.A.*, 62 F.Supp.2d 1085 (S.D.N.Y. 1999); *Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116 (2d Cir. 2000)

3: What are the characteristics of Domain Names?

Domain names can be seen as the telephone number of websites or e-mail addresses. They thereby facilitate the means by which others can find your company or organization online. The use of websites and e-mail addresses are two of the most important ways of modern communication which make them to a certain extent similar to trademarks/trade names. Potential customers or stakeholders will have a hard time finding your website and or e-mail address if these don't reflect your trade name/trade mark. To regulate the assignment of domain names, the non-profit organization ICANN has been created. Every website in the world has a unique internet protocol, or IP-address, which consists of a combination of numbers similar to a telephone number.²⁶ To make an IP-address more accessible to the average user it is converted in a domain name through the so called Domain Name System, this system works for both e-mail addresses and websites.

The technical side of a domain name and how it relates to an IP-address is less relevant for the purpose of this thesis. Relevant are the criteria which domain names have to fulfil in order to be registered. First of all it should be pointed out that a domain name consists of two parts, the second level domain (SLD) and the top level domain (TLD).²⁷ To use the following example, *www.icann.org*, *icann* would be the SLD and *.org* the TLD. There are two types of TLD's, the generic TLD (gTLD) which can be created by the applicant, and the country code TLD (CcTLD) which is unique and has been assigned to every country or jurisdiction in the world. The distinction between these two TLD's has become more relevant with the ever increasing amount of gTLD's. An additional note should be made here that with some domain names, for example *www.lunduniversity.lu.se*, there are three parts. Depending on the situation, the *.lu* part should be regarded as part of the SLD and in others, like *.co.uk* the *.co* part should be regarded as part of the TLD. This aspect is however not relevant for answering the research questions and will therefore not be described in depth.

²⁶ Ryan J Gilfoil ' Judicial Safe Harbor under the Anti-Cybersquatting Consumer Protection Act' [200] Berkeley Technology Law Journal, Vol. 20, Issue 1 186

²⁷ Calvin Reid, 'Amazon.book and the New Top-Level Domain Names' 2014

<<http://content.ebscohost.com/ContentServer.asp?T=P&P=AN&K=99473785&S=R&D=lfh&EbscoContent=dGJyMNHX8kSeprA4y9f3OLCmr02ep65SsK64SLSWxWXS&ContentCustomer=dGJyMPGpt0mwqrBRuePfgeyx43zx>> accessed 10 April 2015

There is a risk however that trademark/trade name rights are violated by third parties registering a domain name. To prevent this from happening ICANN has created the Trademark Clearinghouse Rights Protection Mechanism Requirements (TMCH requirements) to protect trademark right holders from such (possible) infringements.²⁸ The idea of this mechanism is to allow right holders to register their trademark/trade name in order to prevent third parties from registering these rights as domain names in the form of an SLD. The second option is that new gTLD's themselves have the potential to be seen as a trademark/trade name, for example the gTLD 'barclays'. The third possibility is that the same SLD, which potentially constitutes a trademark/trade name, can now be used in many different combinations with new gTLD's because of the significant increase of the latter. The combination of the SLD and TLD might reflect a trademark/trade name.

However, the way in which trademarks/ trade names are reflected in a domain name (be it in the SLD, TLD or as a combination of both) is not relevant.²⁹ This is the case for a domain name itself being regarded as a trademark/ trade name and for the possible infringement of a trademark/trade name by means of a domain name. This is underlined by WIPO which stated that new gTLD's have the risk of '*importing to the top level conflicts that already exist on the "second level."*'³⁰

3.1 Second Level Domain

The large amount of both CcTLD's and gTLD's have as a result that a specific SLD can be used in many different combinations, in theory there can be almost unlimited use of an SLD. The differences between trademarks/trade names and domain names are substantial, for example that a domain name always has to be registered in order to be used. This is different compared to trademarks/ trade names which can also exist when they are not registered. The effect of registering an SLD is that the registrar has a monopoly for the use of it as long as the SLD registered under their name. This is an important difference between domain names and trademarks/trade names. Domain names are not an ownership right but a user right. Another difference is that domain names don't have to be used for a specific purpose, the registrar has the right (not the duty) to use a domain name.

²⁸ Trademark Clearinghouse Rights Protection Mechanism Requirements
<<http://newgtlds.icann.org/en/about/trademark-clearinghouse> >

²⁹ WIPO Arbitration and Mediation Center - New Generic Top-Level Domains: Intellectual Property Considerations (2005 Report) <<http://www.wipo.int/amc/en/domains/reports/newgtld-ip/#2>>

³⁰ WIPO Arbitration and Mediation Center - New Generic Top-Level Domains: Intellectual Property Considerations (2005 Report) <<http://www.wipo.int/amc/en/domains/reports/newgtld-ip/#2>> para 16

The domain name registrar operating a particular TLD has to decide whether the desired SLD can be registered. First of all the desired SLD has to be available for registration with no prior user. The decision to register a specific SLD will also potentially be based on the purpose of a particular TLD. For example the gTLD *.edu* is only used by educational institutions within the United States.³¹ The procedure for the registration of an SLD depends therefore primarily on the domain name registrar operating the specific TLD. The technical aspects for registering an SLD are however always the same, regardless if the SLD is registered in combination with a gTLD or CcTLD.

The European Union has the *.eu* CcTLD, which is administrated based on regulation 874/2004.³² The previously mentioned regulation is useful when trying to assess what the criteria are for registering a domain name, which in this context means the criteria for registering an SLD. First of all there is the condition that only natural persons, undertakings and other (suitable) organizations can apply for a domain name, additionally the “first come first serve” principle is applicable. The second and third conditions are technical requirements which apply to the registration of every SLD, regardless of the combination with a specific TLD. The second condition is that the domain name should consist at least of 2 characters and can contain the numbers 0-9. The third condition is that a domain name can only contain letters which are included in the UNICODE character table.³³

Besides substantive criteria, there are also procedural requirements that have to be respected. The first of these is basic, in the sense that the provided information needs to be complete and up-to-date. The second is for the purpose of this thesis more relevant, regulation 874/2004 states in article 3 (c) the following: *an affirmation by electronic means from the requesting party that to its knowledge the request for domain name registration is made in good faith and does not infringe any rights of a third party*. In other words parties wishing to register a domain name have to confirm that they are not infringing rights of third parties, and furthermore that they are not using the domain name in bad faith or for illegitimate purposes. The last criteria are of a general nature regarding payments and the termination of the domain name.

³¹ Educause domain name policy <http://net.educause.edu/edudomain/policy_board_9_26_2012.pdf>

³² COMMISSION REGULATION (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the *.eu* Top Level Domain and the principles governing registration [2004] O.J. L162/40

³³ UNICODE character table <<http://unicode-table.com/en/#control-character>>

3.2 Top Level Domain

3.2.1 Country code Top Level Domain

There are a fixed amount of CcTLD's available, based on the number of states or dependant territories that operate a specific CcTLD, which at the moment approximately amounts to 250. Also organizations like the European Union can have a CcTLD, the EU has, as mentioned above, the CcTLD *.eu*. The countries or jurisdictions that operate a specific CcTLD decided the applicable criteria for registering an SLD in combination with their CcTLD. The registration of an SLD in combination with a specific CcTLD can therefore have different criteria based on which country or jurisdiction operates the CcTLD, for example as a result of public policy/morality. The technical requirements for registering an SLD are, as mentioned above, however always the same.

3.2.2 generic Top Level Domain

There is no limit for gTLD's, this is all the more so since the release of gTLD in 2011 after which basically every gTLD is capable of being registered.³⁴ Since 2011 many new gTLD's have been registered, these do not necessarily have to be limited to two or three characters like most CcTLD's. Several examples of newly created gTLD's are 'accountants', 'barclays' and 'berlin'.³⁵ These examples of company (trade) names, cities and professions indicate that there are many possibilities for registering a new gTLD. The gTLD is administered by a so called domain name registrar. The domain name registrar has been accredited by ICANN and often allows third parties to use their gTLD in combination with their own specific SLD. The technical requirements for registering an SLD are, as mentioned above, always the same regardless of the TLD. Similar to the CcTLD is that the domain name registrar decides whether a specific SLD is permitted or not. First of all the SLD has to be available and secondly the domain name registrar can also have criteria of his own to determine whether the TLD will be accepted or rejected. The domain name registrar decides which criteria he uses (as long as they are permitted by law). The previously mentioned gTLD *.edu* is a good example, SLD's in combination with this TLD can only be used by educational institutions within the United States.³⁶

³⁴ Ryan J Gilfoil 'Judicial Safe Harbor under the Anti-Cybersquatting Consumer Protection Act' [200] Berkeley Technology Law Journal, Vol. 20, Issue 1 186

³⁵ Iana <<http://data.iana.org/TLD/tlds-alpha-by-domain.txt>>

³⁶ Educause domain name policy <http://net.educause.edu/edudomain/policy_board_9_26_2012.pdf>

There is not yet a uniform procedure for the registration of gTLD's themselves, instead applications are decided by ICANN on a case by case basis. Equal to the SLD is that the gTLD does not have to be used when registered, it's up to the registrar whether to use it and/or allow third parties to use the gTLD in combination with their specific SLD.

3.3 UDRP

The Uniform Domain Name Dispute Resolution Policy (UDRP) is, as the name suggests, a dispute resolution policy related to domain names. The policy has been created as a result of many disputes regarding domain names in the early years of the internet. ICANN approached WIPO to conduct an investigation into the relationship between domain names and trademarks/trade names.³⁷ As a result of this report the UDRP was created which is applicable to all gTLD's and most CcTLD's.

The actual application of UDRP is not done by ICANN itself but by other organizations, for example the the Asian Domain Name Dispute Resolution Centre, the National Arbitration Forum and WIPO. UDRP is a continuation of the previously described registration of an SLD, the registrar has to confirm that he or she is not violating any third party rights. The UDRP procedure is applicable to most disputes regarding the relationship between domain names and trademarks/trade names, the most common is cybersquatting. Cybersquatting means the registration of a domain name, reflecting trademarks/trade names belonging to third parties, with the intent of making financial gain.³⁸ In the event that the registrar is suspected of violating third party rights he or she has to comply with procedures under UDRP.³⁹ An interesting aspect of UDRP is that most cases result in the transfer or deregistration of the contested domain name, this is however mostly related to well-known trademarks/ trade names. UDRP was, in 2013 alone, applied in 2585 cases related to cybersquatting.⁴⁰

³⁷ WIPO, *THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES* <<http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf>>

³⁸ Aleksey Pavlovich Ryzhenkov Anisimov and Jakovlevich Anatoly and Dmitriy Vladimirovich Kozhemyakin 'Theory and practice of protection of personal names in the domain space or "renewed" cybersquatting' [2015] *Information & Communications Technology Law* Vol. 24 Issue 1 p104

³⁹ ICANN, *Uniform Dispute Resolution Policy* <<https://www.icann.org/resources/pages/help/dndr/udrp-en>>

⁴⁰ WIPO, *Expansion of Domain Name Space May Shift Trademark Protection Strategies* <http://www.wipo.int/pressroom/en/articles/2014/article_0003.html>

Paragraph 4(a) of UDRP contains the criteria that have to be fulfilled in order for a domain name to be qualified as violating third party rights. It is for the complainant to prove that the following criteria are met:

- The domain names are identical or confusingly similar to a trade mark or service mark in which the complainant has rights;
- The respondent has no rights or legitimate interests in respect of the domain names;
- The domain names have been registered and are being used in bad faith.

4: Can a Domain Name be regarded as a Trademark/Trade Name?

This chapter will investigate first of all whether a domain name used for commercial purposes can be regarded as a trademark/trade name and subsequently whether the same can be true for domain names used for non-commercial purposes. When assessing these questions, the first step is to analyse what the similarities and differences are between these two concepts. Legislation dealing with the establishment of a trademark will be used as the primary guideline for this analysis. The criteria for establishing a trademark are: there needs to be a sign, this needs to be capable of being represented graphically and the sign has to be distinctive. The criteria for establishing a trade name are not harmonized and differ between jurisdictions. These criteria are however (as described above) similar to those of trademarks, therefore the analyses with regard to the potential qualification of a domain name as a trade name will be conducted as part of the analyses for trademarks. The analysis dealing with the questions whether domain names, used for commercial purposes, can be regarded as well-known trademarks/ trade names will take place separately.

The primary source of law consists of the relevant EU legislation and subsequent case law from both national courts and the ECJ.⁴¹ Besides these sources, relevant literature and panel decisions from WIPO, based on UDRP, will be used to support the main evidence. As was mentioned above, the distinction between SLD's and TLD's is not relevant for the potential qualification of a domain name as a trademark/ trade name. The analyses with regard to all aspects of this chapter will therefore be based on the domain name as a whole.

⁴¹ DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/25: COUNCIL REGULATION (EC) No 207/2009 of 26 February 2009 on the Community trade mark [2009] OJ L78/1

4.1. Commercial use of a Domain Name

4.1.1. Can a Domain Name be Seen as a Sign?

Trademarks/trade names need to consist of signs, this is the subject matter of the trademark/trade name. Based on literature, a sign may in particular consist of words, letters and e.g. numerals.⁴² This will automatically include all domain names because they may only consist of characters which are contained in the UNICODE character table.⁴³ To conclude, all domain names are eligible to be regarded as signs under trademark law.

4.1.2. Can a Domain Name be Represented Graphically?

Domain names are e.g. displayed on computers, tablets and mobile phones all of which require them to be represented graphically. The question whether a domain name can be represented graphically has therefore the obvious answer that it can be. To conclude, a domain name is in all circumstances eligible to fulfil this criteria.

4.1.3. Can a Domain Name be distinctive?

The most important condition to fulfil for many trademarks/ trade names is whether they are able to indicate the origin of a good or service by distinguishing them from those of their competitors. The ECJ ruled in the case *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd* that all signs are potentially capable of being distinctive.⁴⁴ It is up to the registrar to prove that a trademark qualifies as such, in determining whether a sign is distinctive. The main test to prove distinctiveness is for ‘(...) *the trade mark to enable the public concerned to distinguish the product or service from others which have another commercial origin (...)*’. Several criteria are applicable, for example the market share, what is invested in the mark, geographically widespread and long-standing use of the mark and the amount of people that associate a good or services as originating from a particular firm because of a trademark.⁴⁵ Whether a trademark can be seen as distinctive depends on whether it qualifies with these criteria.

⁴² Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008) 189

⁴³ UNICODE character table <<http://unicode-table.com/en/#control-character>>

⁴⁴ Case 299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd*. [2002] ECR I-05475 para 47

⁴⁵ Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008) 194-195

A good example, in my opinion, to illustrate whether a domain name can be regarded as distinctive is a Dutch case involving the domain name *thuisbezorgen.nl*.⁴⁶ This case was brought forward by the claimant who was the owner of the trademark *thuisbezorgd.nl*. This trademark is descriptive and means home delivery. The claimant considered that the use by the defendant of the domain name *thuisbezorgen.nl* was infringing their trademark because it was confusingly similar and is used for the same business purposes as the trademark. The defendant made the counter claim that the trademark was infringing their unregistered trademark *thuisbezorgen.nl*. The trademark *thuisbezorgd.nl* had been used since 2000 and was subsequently granted trademark protection by the Benelux office for Intellectual Property in 2006.

The claimant informed the defendant at the moment of registration that this domain name infringed their trademark and the use of the domain name should be ceased. This was refused and the case was subsequently brought to court. For this thesis the case is relevant because of the explanation that the court gives with regard to this trademark being distinctive or not. First of all the defendant doesn't contradict that the domain name is confusingly similar but instead argues that the claimant has knowingly taken the risk that others might use their trademark by choosing a descriptive trademark with a weak level of distinctiveness. The court addresses this issue by indicating that a descriptive mark cannot *per se* be excluded from trademark protection. The next issue addressed was whether the trademark *thuisbezorgd.nl* was distinctive or not. The court indicated that the words *thuis* and *bezorgd* were regular Dutch words but that the combination of these two words especially with the CcTLD '.nl' should not be seen as purely descriptive but having a level of distinctiveness.

This was furthermore supported by the fact that the defendant made a counter claim regarding their unregistered trademark *thuisbezorgen.nl*. The court followed this reasoning by indicating that both trademarks could be regarded as distinctive. The subsequent judgement was that, because the trademark *thuisbezorgd.nl* existed before the defendants unregistered *thuisbezorgen.nl*, the latter infringed this trademark. For the purpose of this thesis the judgement is relevant because it can be concluded that a domain name can have the potential to be distinctive.

⁴⁶ *THUISBEZORGD.NL BV* v TJOKKIE E-MARKETING B.V. [2008] ECLI:NL:RBUTR:2008:BG4155 (Rechtbank Utrecht)

There have been other cases involving domain names which were regarded as distinctive to support this. The given example was just one of them but, for the purpose of this question, the mentioned case give a clear answer that domain names can be regarded as distinctive.

4.1.4. Can a Domain Name be regarded as a Well-known Trademark/Trade Name?

Whether a domain name can also be regarded as well-known is for the purpose of this thesis relevant, because the protection of such trademarks/trade names is much more qualified than other trademarks/trade names. The possible qualification of a domain name as a well-known trademark/trade name is thereby an important aspect in answering the question to what extent domain names can be regarded as trademarks/trade names? The main conditions for being regarded as well-known are described above and can be summarized as follows: the trademark/trade name must be known by a large part of the population and is associated with a particular good or service (and in the case of a trade name, with a particular organization).

The question whether a domain name can be regarded as well-known can best be answered by using the example of the trademark *Amazon.com*. This trademark is used for the purpose of promoting the goods and services associated with *Amazon.com Inc.* and its subsidiaries. The service performed by *Amazon.com Inc.* is the selling of products and or services online. The word or name *Amazon* itself is not directly associated with these business activities, at most it can refer to the river in South America. However, through extensive use it has become one of the most well-known trademarks in the world, something that has been confirmed by both national courts as well as panel decisions from WIPO based on UDRP.

There has been much litigation over the years regarding the *Amazon.com* trademark, an example of this comes from the United States.⁴⁷ This case was brought forward by *Amazon.com Inc.* against the defendant who send e-mails that gave the impression they originated from *Amazon.com Inc.*, containing e.g. their trademark, in order to mislead individuals to buy certain products or services. The trademark contained in these e-mails was, according to the court, identical to the one owned by *Amazon.com Inc.* Subsequently the court dealt with the question whether this trademark could be seen as distinctive.

⁴⁷ *Amazon.com, Inc., v Royal responder, Inc.*, [2003] CIVIL ACTION NO. CV'03 1634PHXDKD (United States District Court of Arizona)

The court gave the following ruling on this matter: the trademark is ‘(...) *the most important and easily recognized identifier of the goods and services it offers (...)*’. In other words the criteria for identifying goods and services are met by this trademark which leads to the conclusion that it can be seen as distinctive. For this part of the analyses the main question is however whether a domain name, that is also a trademark, can be regarded as well-known. The court answers this question straightforward by stating that ‘(...) *For millions of consumers the name ‘Amazon.com’ has come to represent wide selection, fast delivery, and excellent security for Internet transactions (...)*’. The conclusion therefore is that domain names also have the potential to be regarded as well-known trademarks/trade names.

The mentioned judgment is supported by several other cases and decisions, including the recent panel decision from WIPO which uses UDRP. This decision revolved around *Amazon.com Inc.* (the online retailer) and a different company with the name Amazon Technologies Inc. which used the domain name *amazonsupport.email*. The domain name used by the defendant was, according to *Amazon.com Inc.*, infringing their trademark. The panel agreed with the complaint made, the following quotes are from this decision ‘(...) *the complainant having a well-known trademark (...)*’ and ‘(...) *The AMAZON Mark has a strong reputation and is widely known (...)*’.⁴⁸ This indicates that the *Amazon* trademark, which is used exclusively in association with online retailing, predominantly by means of the domain names such as *amazon.com*, constitutes a well-known trademark. Examples of domain names that are well-known registered trademarks/trade names include the previously mentioned *Amazon.com* trademark as well as those of *eBay.com* and *google.com*.⁴⁹

The preliminary conclusion therefore is that a domain name has the potential to comply with the three primary criteria for establishing a trademark/trade name. Domain names can be regarded as registered/ unregistered trademarks/trade names. Evidence with domain names being registered as trademarks/trade names can be found in many jurisdictions, for example the United States Patent and Trademark Office has over 60.000 domain names registered as trademarks/trade names.⁵⁰

⁴⁸ *Amazon.com Inc., Amazon Technologies, Inc. v. Giovanni Laporta / Yoyo.Email* (2015)
Case No. D2015-0009

⁴⁹ United States Patent and Trademark Office, *Trademark Electronic Search System* <<http://www.uspto.gov/>>

⁵⁰ United States Patent and Trademark Office, *Trademark Electronic Search System* <<http://www.uspto.gov/>>

4.2. Non-commercial use of a Domain Name

Having concluded that domain names used for commercial purposes can be regarded as trademarks/trade names, the next step is to investigate whether the same is true for domain names that are used for non-commercial purposes. The criteria for establishing a trademark/trade name are the same regardless of the way in which a domain name is used. This research will therefore solely focus on the specific aspects related to the non-commercial use of a domain name. For the purpose of this thesis it is not relevant to look into the characteristics that constitute(s) non-commercial use, the general description will be used which states, all activities which are not carried out for profit are non-commercial.⁵¹

The very limited case law dealing with this topic seems to indicate that domain names used for non-commercial purposes cannot be regarded as a trademark/trade name. The case *EHV PROMOTIONS v VBA EVENTS B.V.* is such an example.⁵² The case revolved around the domain name *www.kroegentocht.nl* which was registered in 2008 by the defendant with the purpose of organizing pub crawl evenings. These pub crawl evenings were initially a non-commercial activity, being non-profit. The defendant however merged in 2010 with the claimant after which these activities were carried out for profit i.e. for commercial purposes. This merger was terminated a year later when the claimant became the registrar of the domain name *kroegentocht.nl* and the related business activities. The domain name was subsequently registered as a trademark at the Benelux office for Intellectual Property. The defendant however registered a similar domain name *www.kroegentochtnederland.nl* and continued the use of the, by now registered, trademark *kroegentocht.nl*. The claimant summoned the defendant to stop the use of this trademark, which was refused.

During the proceedings the defendant argued that he was the rightful owner of the *kroegentocht.nl* trademark, because he had used this trademark between 2008 and 2010. The defendant argued that such use constituted the establishment of an unregistered trademark and that he was the owner of the trademark, having rights that preexisted to those of the claimant. The court however pointed out that the use between 2008 and 2010 was of a non-commercial nature which, based on the applicable trademark legislation, could not result in the establishment of a trademark.

⁵¹ Henry Campbell Black, *Black's Law Dictionary* (6th Ed.) (St. Paul, Minn.: West Publishing Co., 1990).

⁵² *EHV PROMOTIONS v VBA EVENTS B.V.* [2013] ECLI:NL:RBOBR:2013:6092 (Rechtbank Oost-Brabant)

The domain name was after 2010 used for commercial purposes which should be seen as the moment when the trademark was established. The judgment was therefore in favor of the claimant. This would indicate that domain names used for non-commercial purposes cannot result in the establishment of a trademark/trade.

There is however evidence to suggest that domain names used for non-commercial purposes might be seen as trademarks/trade names. There are two examples from the United States where a domain name, used for non-commercial purposes, is registered as trademark.⁵³ These include the popular non-profit blog *about.com* which is registered as a trademark. Another example is the charitable organization *KidsServe.com*, a non-profit organization which aims at providing children with the opportunity to play tennis. This domain name is also registered as a trademark in the United States. The given examples, *about.com* and *KidsServe.com*, have however not (yet) been tested in court. This leads in my opinion to the lack of a conclusive answer, regarding the question, to what extent domain names used for non-commercial purposes can be seen as trademarks/trade names. The last example is related to one of the most well-known registered trademarks currently in existences, *Wikipedia*. This trademark is owned by a non-profit organization and is used to provide a free online encyclopedia. The *Wikipedia* trademark is for many people associated with the domain name *wikipedia.org*. However the trademark itself is not a domain name but could potentially be regarded as an unregistered trademark. There is however no conclusive answer to the question whether the domain name *wikipedia.org* is also a trademark/trade name.

The conclusion with regard to the question whether domain names, used for non-commercial purposes, can be regarded as trademarks/trade names is as follows. At the moment, no definitive answer can be given. There is evidence to suggest that these domain names can be regarded as such but also evidence to the contrary. This question therefore requires further academic research and more jurisprudence in order to be given a definitive answer.

⁵³ United States Patent and Trademark Office, *Trademark Electronic Search System* <<http://www.uspto.gov/>>

5: Under Which Circumstances can a Domain Name Infringe a Trademark/Trade Name?

The second aspect of this thesis deals with the question under which circumstances domain names can infringe trademarks/trade names. The most common forms of domain name use will be the basis for this analysis, which are: merely registering a domain name, domain names used for commercial or non-commercial purposes, e-mail addresses and the practice of cybersquatting. The research will analyse to what extent the previously mentioned uses of domain names can infringe registered/ unregistered trademarks/trade names on the one hand and well-known trademarks/trade names on the other hand.

5.1. Registering a Domain Name

Registering a domain name is a relatively easy process, the conditions are that the registering party has to be a natural person or undertaking, the “first come first serve” principle is applicable, the UNICODE characters have to be used and the domain name needs to consist of at least two characters. From an EU point of view, several directives are relevant in analysing whether a merely registered domain name can infringe a trademark/trade name, the first of which is the unfair advertising directive.⁵⁴ This directive deals with the unfair advertising of trademarks/trade names belonging to a third party, the main question as a result of this directive is whether the mere registration of a domain name can also be regarded as advertising.

The unfair advertising directive replaced the misleading advertising directive in 2006.⁵⁵ The misleading advertising directive is however still relevant for this thesis because of the case law (based on this directive) that deals with the unauthorized use of trademarks/trade names in domain names. As was mentioned above, the ownership of a trademark is not based on the right to use a trademark but to prevent others from doing so. The best way to determine if merely registered domain names can infringe a trademark/trade name is by analysing whether the owner can prevent third parties from registering a domain name reflecting their trademark/trade name.

⁵⁴ DIRECTIVE 2006/114/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 12 December 2006 concerning misleading and comparative advertising [2006] OJ L376/21

⁵⁵ Council Directive 84/450/EEC of 10 September 1984 relating to the approximation of the laws, regulations and administrative provisions of the Member States concerning misleading advertising [1984] OJ L250/17

The leading case on this topic from the ECJ is *Belgian Electronic*, which deals with a company producing laser printers.⁵⁶ Several employees decided to start their own competing company but used very similar forms of advertising. The advertisement consisted of two main forms, first of all the use of a domain name and secondly the use of metatags. For the purpose of this thesis the use of metatags is not relevant, but that of domain names is. The case originated from Belgium and is also based on Belgian trademark law. The Member states have however implemented the applicable EU directives. Trademark law is, as a consequence, almost completely harmonized in the EU. Cases originating from the courts of Member States are therefore mostly applying EU law.

The contested domain name in this case was *bestlasersorter.com*, which was registered on 3 April 2001 by the defendant. The claimant in this case was BEST and BEST was of the opinion that the aforementioned domain name violated its trademark. On appeal the question was referred to the ECJ whether this domain name could fall under the misleading advertisement directive, and thereby infringe trademark rights. Even though the referring court did not directly ask about this, the ECJ first of all addressed the question whether the situation might be covered by the e-commerce directive. This directive has as its objective *the proper functioning of the internal market by ensuring the free movement of information society services between the Member States*. In other words this directive deals with certain specific areas of law in relation to the internet which is not always covered by other legislation. Merely registering a domain name which reflects a trademark/trade name could be such a specific area of law. The unfair advertisement directive has the requirement that the domain names make *a representation*, this qualification might not apply to the situation where they are merely registered. The e-commerce directive is however designed to deal with the specific aspects related to e.g. domain names. This could therefore also apply to the situation where a domain name is merely registered. When the e-commerce directive covers this situation, the outcome could be that merely registered domain names can infringe trademarks/trade names.

The term used for several forms of electronic communication are mentioned in the e-commerce directive is *commercial communication*. Commercial communication is described as follows: *any form of communication designed to promote, directly or indirectly, the goods, services or image of a company*.

⁵⁶ Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV*. [2013] ECR 00000

This description however specifically excludes domain names and e-mail addresses, *information allowing direct access to the activity of the company, organisation or person, in particular a domain name or an electronic-mail address.*⁵⁷ The registration of a domain name can therefore, according to the ECJ, not be seen as a form of commercial communication and such use does not infringe trademark/trade name rights. The court subsequently addressed the two referred questions. The first question was whether the registration of a domain name can infringe trademark/trade name rights and the second whether the actual use of a domain name can infringe trademark/trade name rights. The first question, which is relevant for this part of the analyses, was relatively easy to answer. Based on the unfair advertisement directive the mere registration of a domain name cannot be qualified as advertising and can therefore not infringe trademark/trade name rights.

The registration of a domain name is, as the advocate general points out in this case ‘(...) *merely a formal act to include a certain domain name into a data base (...)*’.⁵⁸ The court followed this analyses in the judgement by stating that ‘(...) *such a purely formal act which, in itself, does not necessarily imply that potential consumers can become aware of the domain name and which is therefore not capable of influencing the choice of those potential consumers (...)*’.⁵⁹ The registration of a domain name can only result in limitations on the way of communication which do not fall under the unfair advertisement directive. The mere registration of a domain name can therefore, according to the ECJ, not infringe trademarks/trade names.

The *Belgian electronics* case dealt with a trademark which was not qualified as well-known. Domain names that are merely registered, and not used for any purpose, can however infringe a well-known trademark/trade name. A good example of such a situation is the case *Reservierung des Domain-Namens »Rolls-Royce«* from the higher regional court of Munich.⁶⁰ The case revolved around the *Rolls-Royce* trademark which is in Germany, as in most jurisdictions, a protected trademark. This trademark is well-known by many people and is associated with luxury cars.

⁵⁷ Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market [2000] ECR 00000

⁵⁸ Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV*. [2013] ECR 00000, Opinion of AG Mengozzi, para 48

⁵⁹ Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV*. [2013] ECR 00000 para 43

⁶⁰ *Reservierung des Domain-Namens »Rolls-Royce«* [1999] U 4484/98 (Oberlandesgerichts München)

The trademark *Roll-Royce*, was registered as a domain name by the defendant who was active in the healthcare industry. The defendant merely registered the domain names *rollsroyceboerse.de* and *rolls-royce-boerse.de* but did not use these domain names for any purpose. The court however recognized the importance of this well-known trademark because of its superior reputation. The conclusion was therefore that the registration of these domain names, by the defendant, was infringing the *Rolls-Royce* trademark. The reason being that the domain name was (nearly) identical to the trademark which leads to a likelihood of confusion.

The preliminary conclusion is that ‘regular’ domain names cannot infringe a trademark/trade name when they are merely registered. This is however different when a trademark/trade name can be qualified as well-known. In the event a trademark/trade name is well-known, even a domain name which is merely registered can be seen as infringing when this domain name is confusingly similar.

5.2. Using a Domain Name for Commercial Purposes

Even though a domain name that is merely registered cannot infringe a ‘regular’ trademark/trade name, this might be different when domain names are also used, e.g. for commercial purposes. The previously mentioned case *Belgian Electronic* also addresses this question.⁶¹ Commercial purposes means in this context the advertisement of goods or services. This scenario is covered by the previously mentioned unfair advertising directive which describes advertising as follows: *the making of a representation in any form in connection with a trade, business, craft or profession in order to promote the supply of goods or services, including immovable property, rights and obligations.*⁶² This is a very broad definition and can potentially be applied to any situation. What in my opinion is of interest here is the following phrase, *a representation in any form*, which would indicate that domain names are potentially included. In the *Belgian electronic* case the purpose why that particular domain name was chosen had to do with generating more sales of the goods and services offered. This is similar to the purpose of a trademark, the court agrees with this reasoning by stating that ‘(...) *such use of a domain name (...) constitutes a form of representation (...)*’.⁶³

⁶¹ Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV*. [2013] ECR 00000

⁶² DIRECTIVE 2006/114/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 12 December 2006 concerning misleading and comparative advertising [2006] OJ L376/21 (art 2 (a))

⁶³ Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV*. [2013] ECR 00000 para 48

This would seem to significantly differ from the previously mentioned e-commerce directive which makes clear that domain names ‘do not in themselves constitute commercial communications’. Commercial communication is different from advertising, in the e-commerce directive it is stated that this directive doesn’t prejudice the unfair advertisement directive.⁶⁴ Being the primary legislation when a domain name is used as a trademark, the e-commerce directive becomes irrelevant because it cannot prejudice this directive. The court also makes this distinction between the terms *advertising* and *commercial communication*: (...) *the exclusion (...) of commercial communication does not mean that that information and those communications are also excluded from the concept of ‘advertising’ within the meaning of (...) Directive 2006/114, that concept being defined by expressly including any form of representation (...)*.⁶⁵ From this judgement it becomes clear that a domain name can be infringing when it reflects a trademark/trade name and is subsequently used for commercial purposes. Advertisement is a very broad concept and can include many different scenarios, based on the *Belgian electronic* case the conclusion can be that any form of advertisement would fall under this definition.

Case law from the Benelux countries (Belgium and the Netherlands) and Germany give several criteria to determine when domain names, that reflect a trademark/trade name, can be qualified as advertising. One of the most clear cut cases from the Netherlands dealing with this topic is *A.M. ZEGERS BEVEILIGINGSSYSTEMEN v ZEGERS B.V.*⁶⁶ The court reaffirms in this case that a domain name cannot by itself infringe a trademark/trade name, only in the event that it is used as such. The conditions for a domain name to be regarded as infringing a trademark/trade name are that the domain name indicates the activities of the company i.e. the goods or services they offer and that the domain name indicates what the content of the website is.

Similar judgements can be found from other jurisdictions within the EU, for example the *Life Style* case from Belgium.⁶⁷ This is also a case in which a registered trademark from one company has been used by one of their competitors as a domain name.

⁶⁴ Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market [2000] ECR 00000 (recital 11)

⁶⁵ Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV*. [2013] ECR 00000 para 50

⁶⁶ *A.M. ZEGERS BEVEILIGINGSSYSTEMEN v ZEGERS B.V* [2008] ECLI:NL:RBROT:2008:BC5696 (Rechtbank Rotterdam)

⁶⁷ *LIFESTYLE CASE* [2004] Arrest nr. 2002/AR/1848 (Hof van Beroep, Gent)

The court came to the same conclusion that a domain name, which is used for commercial purposes, can infringe a trademark if it fulfils the following conditions. First of all the domain name should be (nearly) identical to the trademark, secondly the domain name should be used for the same business activities as the trademark. The third condition is that both parties operate through use of the internet and the fourth, and last, condition is that the risk of confusion (for the consumer) is real.

The previously mentioned case law deals with trademarks/trade names which are not qualified as well-known. The case *Rechtswidrige Verwendung der Domain »shell.de*, illustrates the situation where a domain name is used for commercial purposes and reflects a well-known trademark/trade name.⁶⁸ This case comes from Germany and the presiding court was the Bundesgerichtshof. The dispute revolved, as the name suggests, around the well-known trademark *Shell* which belonged to the claimant and is used for commercial purposes in the form of selling and refining petroleum products. This trademark is in Germany owned by *Shell GmbH*, the contested domain name *shell.de* was however registered and used by a private individual with the surname *Shell*. The domain name was used for commercial purposes which involved the preparation of press releases by the defendant. The demand from *Shell GmbH* that the defendant deregistered or transferred the domain name to them which was refused.

The court first of all pointed out that, based on customary law, the use of one's name cannot be seen as infringing a trademark/trade name. The defendant had the right to use his name also as a domain name and acted in good faith. The court thereafter pointed out that ordinarily the contested domain name cannot be seen as constituting the *Shell* trademark, which would have meant that the defendant could use the domain name because the principle of "first come first serve" is applicable. The court however continued the analyses of this situation by indicating that both the defendant and *Shell GmbH* have rights to this domain name. In this judgement the court indicated that the impossibility of using this domain name by *Shell GmbH* can be confusing for her customers and can therefore result in the exploitation of the trademark by the defendant.

⁶⁸ *Rechtswidrige Verwendung der Domain »shell.de«* [2001] I ZR 138/99 (Bundesgerichtshof)

The court subsequently made the decision that the interests of *Shell GmbH* outweighed those of the defendant and the domain name should be deregistered or handed over.⁶⁹ In other words this domain name, which was used in good faith, for a different purpose than the trademark and according to the principle of “first come first serve” should belong to the defendant, was still infringing the *Shell* trademark. The conclusion is that domain names used for commercial purposes can in the following circumstances be seen as infringing a well-known trademark: the domain name must have a likelihood to be confusing and to exploit the trademark. In my opinion these criteria indicate that almost every domain name should be seen as infringing a trademark when they are used for commercial purposes and contain a well-known trademark/trade name.

To conclude, based on national case law from Belgium, The Netherlands and Germany dealing with this topic, there are several conditions that have to be fulfilled in order for a domain name to be regarded as infringing a trademark/trade name. First of all that the domain name and the trademark/trade name have to be (nearly) identical and thereby have the result of confusing the (potential) customers. The second condition is that the domain name must indicate the content of the website, which is basically the goods and services sold by the organization. The third and last condition is that the domain name is used for the same business purposes as the trademark. With regard to domain names reflecting a well-known trademark/trade name this is however very different. These domain names can in almost all situations be seen as infringing a trademark/trade name. The conditions are that the domain name has the potential to be confusing and therefore exploit the trademark/trade name.

5.3. Using a Domain Name for Non-Commercial Purposes

The use of domain names for non-commercial purposes is a recurring aspect with regard to domain name disputes. This is both the case with ‘regular’ and well-known trademarks/trade names. The non-commercial use of a trademark/trade name is in many cases closely linked to the freedom of expression, which can be a legitimate use of a trademark. Also other forms of non-commercial use are possible, for example comparative advertising. For the purpose of this thesis it is however not relevant to look into the specifics of what constitutes non-commercial use.

⁶⁹ *Rechtswidrige Verwendung der Domain »shell.de«* [2001] I ZR 138/99 (Bundesgerichtshof, para 4 sub 2b)

The main question is whether a domain name which is used for non-commercial purposes can infringe a trademark/trade name. Therefore the general description will be used, which describes non-commercial as follows, activities not carried out for profit.⁷⁰ There are several cases originating from Member States which deal with the question whether domain names used for non-commercial purposes can infringe a trademark/trade name, for example the case regarding the domain name *digid.nl*.⁷¹ This domain name was used with the purpose to create an online communication platform between the Dutch government and her citizens, for example when applying for benefits. The dispute resulted from the fact that an organization had registered the trade name *DigiD* and was of the opinion that this domain name infringed their trade name.

The court first of all pointed out that such use, by the Dutch government, should be qualified as non-commercial. The judgement subsequently focused on several aspects why there was no infringement of the trade name in this situation. The non-commercial use of a domain name could, according to the court, infringe a trademark/trade name when there is a real risk of confusion. The court made clear that only potential confusion is not sufficient, there has to be proof that this has actually happened in the past. In the case regarding the domain name *digid.nl* these conditions were not fulfilled, this domain name therefore didn't infringe the trade name *DigiD*.

There are several rulings dealing with the question whether domain names, used for non-commercial purposes, can also infringe well-known trademarks/trade names. What, in my opinion, is a good example of such a ruling is a case from the higher regional court of Stuttgart regarding the trademark *Steiff*.⁷² This case revolved around the registration of the domain name *steiff.com* by the defendant. The purpose for registering this domain name was to create an online fan club, on a non-profit basis, for enthusiast of the stuffed animals to which the well-known trademark *Steiff* refers. The judgment first of all pointed out that the trademark should be regarded as well-known and that the domain name reflected this trademark.

⁷⁰ Henry Campbell Black, *Black's Law Dictionary* (6th Ed.) (St. Paul, Minn.: West Publishing Co., 1990).

⁷¹ de vennootschap onder firm DIGI-D tegen stiching ICTU [201] zaaknummer 371238/KG ZA 10-891 (rechtbank 's-Gravenhage)

⁷² *Namensrechtsverletzung durch Domain-Namen* [1998] 2 W 77/97 (Oberlandesgerichts Stuttgart)

The court subsequently focused on the question if such use should be qualified as infringing the trademark. The domain name was found to be confusingly similar to the trademark for the average consumer which leads to the risk of exploiting the trademark. The court indicated that this likelihood of confusion should have been known to the defendant when the domain name was registered. The conclusion was that this domain name, which was used for non-commercial purposes, infringed the well-known *Steiff* trademark and should be handed over or deregistered.

The previous judgment is supported by a WIPO decision, based on UDRP, regarding the well-known *Porsche* trademark.⁷³ This dispute revolved around the use of the domain names *porsche-buy.com* and *porschebuy.com*. These domain names were registered by a private individual for the purpose of allowing users e.g. to post advertisements for the sale of second hand cars. These advertisements were free of charge and the defendant made no financial gain by operating these websites. The panel pointed out that the way in which these domain names were used should be characterized as being of a non-commercial nature.

The decision was reached that, when used in such a way, domain names should nonetheless be regarded as being capable of violating trademark/trade name rights. There were several reasons why the panel came to this decision, first of all that the domain names were (nearly) identical to the well-known trademark, the addition of the word 'buy' and the gTLD '.com' did not change this. Subsequently that the contested domain names were '*(...) confusingly similar (...)*' and that they were therefore violating the *Porsche* trademark. The panel concluded by indicating that it is '*(...) not of relevance if the websites under the disputed Domain Names are used for a commercial or a noncommercial purpose(...)*'. This indicates, in my opinion, that the violation of a well-known trademark/trade name by a domain name used for non-commercial purposes has the same criteria as domain names used for commercial purposes.

The conclusion is that 'regular' trademarks/trade names that are reflected in a domain name which is used for non-commercial purposes can be infringing. The burden of proof is very high and requires that there is not only a risk of confusion but proof that this has actually occurred.

⁷³ Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent [2004] Case No. D2004-0481 (WIPO Arbitration and Mediation Center)

Domain names can also infringe well-known trademarks/trade names when they are used for non-commercial purposes. The burden of proof is hereby less strict, there merely has to be a risk of confusion.

5.4. Using E-mail Addresses

For businesses, and other organizations, the sending of e-mails is one of the most widely used forms of communication. E-mail addresses are also seen as domain names, typically an e-mail address consists of two parts. The first part, before the @ sign, identifies the user and the part after the @ sign is the domain name.⁷⁴ For this thesis the relevant part of an e-mail address is therefore the part after the @ sign. With regard to this aspect it is important to note that there are two kinds of domain names with regard to e-mail addresses. The first one is a disposable address for example *hotmail.com* or *gmail.com*. The second, and for this thesis more relevant, domain name is the traditional one which has to be created and registered in a way similar to domain names used for websites. The reason why organizations choose to register their own e-mail addresses is closely related to the reason why they register trademarks/trade names, to distinguish themselves from their competitors.

The question if an e-mail address, by itself, can infringe a trademark/trade name is perhaps not very often raised but nonetheless still relevant. Based on the previously mentioned e-commerce directive it can be concluded that there can be no infringement of a trademark/trade name when the e-mail address is merely registered. Based on national case law from, amongst others from, the Netherlands and the United States, it becomes clear that domain names used in the form of e-mail addresses are, in principle, linked to domain names in the form of websites. In other words, domain names used for an e-mail address have to fulfil the same criteria in order to be seen as infringing a trademark/trade name. This applies to 'regular' and to well-known trademarks/trade names.

⁷⁴ Kirk McElhearn 'SET UP YOUR OWN E-MAIL DOMAIN' [2011] Macworld Vol. 28 Issue 8 p 34-35

Whether an e-mail address can infringe a trademark/trade name was one of the central aspects in the case *Rieberjo B.V. v Dutch Research & Innovations B.V.*⁷⁵ In this judgement the central question was whether the trademark reflected in i.e. the e-mail addresses of the defendant are infringing the trademark rights belonging to the claimant. The court conducted an analyses similar to the case law dealing with domain names in the form of a websites, first of all whether the domain name reflects the trademark resulting in possible confusion. The second aspect was if the domain name/e-mail address was used for similar business purposes as the trademark. The judgment resulted in the decision that the e-mail addresses were infringing the trademark. It can therefore be concluded that similar criteria apply for a domain name to infringe trademarks/trade names, regardless whether the domain name is in the form of an e-mail address or in the form of a website.

What in my opinion is a relevant case dealing with the infringement of a well-known trademark/trade name by an e-mail address, is *Bear Stearns Cos., Inc. v Lavalle*.⁷⁶ This case originates from the United States and revolves around the well-known trademark *Bear Stearns*, which by many people is associated with the services offered by the financial institution *Bear Stearns*. The defendants were activists critical of this financial institution and, as part of their activities, incorporated e.g. the trademark into their e-mail addresses. The court approached this question identical to situations where a domain name is part of a website. The conclusion was that these e-mail addresses were confusing for the average user and that they were infringing the *Bearn Stearns* trademark.

To conclude, the question whether an e-mail address containing a specific trademark/trade name can also be infringing is not very often raised but nonetheless still relevant. In the light of the limited case law dealing with this topic it can be concluded that domain names, contained in e-mail addresses, need to fulfil similar criteria as those contained in websites in order for an infringement to be established. This applies to ‘regular’ and well-known trademarks/trade names.

⁷⁵ *Rieberjo B.V. v Dutch Research & Innovations B.V.* [2013] zaaknummer / rolnummer: C/05/248707 / KG ZA 13-451 (rechtbank Gelderland)

⁷⁶ *Bear Stearns Cos., Inc. v Lavalle* [2002] CIVIL ACTION NO. 3:00-CV-1900-D (UNITED STATES DISTRICT COURT, N.D. TEXAS)

5.5. Cybersquatting

The most common form of disputes regarding domain names is cybersquatting. Cybersquatting means the registration of a domain name, reflecting trademarks/trade names belonging to third parties, with the intent of making financial gain.⁷⁷ In most cases there is no connection between the domain name, which reflects a trademark/trade name, and the registrar. The most common form of dispute resolution regarding cybersquatting are panel decisions from WIPO based on UDRP. The criteria for establishing cybersquatting, described in UDRP, are similar to other forms of trademark/trade name violation, the added criteria is that the registration of the domain name has to be done in bad faith. Disputes involving cybersquatting deal in most cases with domain names that are identical or nearly identical to a certain (well-known) trademarks/trade names.

The research will however not focus on cybersquatting from the UDRP perspective because this is merely an administrative procedure, not based on trademark legislation. Such procedures are not designed to determine whether domain names are infringing trademarks/trade names in the form of cybersquatting, but merely that a certain domain name is, under these rules, not permitted. The purpose for this research is to investigate how national courts, based on trademark legislation, deal with cybersquatting and which criteria they apply. This issue has become more prevalent with the introduction of many new gTLD, which have created more opportunities to register new domain names.

With regard to ‘regular’ trademarks/ trade names, the burden of proof is strict. The case regarding the domain names *nopeisdope.nl* and *nopeisdope.com* is a good example.⁷⁸ This case originates from the Netherlands and revolves around several aspects related to a licensing agreement for e.g. the trade name *nope is dope*. The claimant owned this trade name and licensed it to the defendant who in turn registered the contested domain names. The defendant however refused to hand over these domain names when the licensing agreement was terminated by the claimant. The court applied similar criteria as those described in UDRP even though this case was based on national law and not on UDRP.

⁷⁷ Aleksey Pavlovich Ryzhenkov Anisimoy and Jakovlevich Anatoly and Dmitriy Vladimirovich Kozhemyakin ‘Theory and practice of protection of personal names in the domain space or “renewed” cybersquatting’ [2015] Information & Communications Technology Law Vol. 24 Issue 1 p104

⁷⁸ NOPE IS DOPE B.V. [2012] ECLI:NL:RBROT:2012:BX2445 (rechtbank Rotterdam)

First of all the court addressed the question whether the domain names could be regarded as constituting the trade name *nope is dope*. The criteria for the domain names to be regarded as this ‘regular’ trade name are that the defendant has to be engaged in the same business activities and that the domain names are confusingly similar. These conditions were, according to the court, fulfilled by the contested domain names. The next aspects that were addressed reflect the last two conditions of UDRP, the user has no rights to the domain name and the registration/use has to be in bad faith. The answer to these questions was affirmative in this situation because the defendant used these domain names, knowing that he was not supposed to do so (the licensing agreement had ended). The court concluded that the defendant knew he had no rights to these domain names and that they were therefore used in bad faith. The judgment was that these domain names infringed the trade name *nope is dope* by means of cybersquatting.⁷⁹ Based on this case it can be concluded that national courts apply criteria similar to those described in UDRP when dealing with cybersquatting.

The previous conclusion is supported by the case *Marks & Spencer PLC v One in a Million Ltd.*⁸⁰ This case comes from the United Kingdom and revolved around several domain names reflecting the well-known trademark *Marks & Spencer*, including *marksandspencer.co.uk*. These domain names were registered by the defendants with the intent of selling them at a later point. *Marks & Spencer* went to court demanding that the domain names were handed over or deregistered. The presiding judge first of all concluded that the domain name(s) were identical to the *Marks & Spencer* trademark. The judgment subsequently focused on the question whether the defendants had a legitimate interest in respect to these domain names. Four possibilities were given by the presiding judge on how these domain names could potentially be used by the defendant. These were to prevent the trademark/ trade name holder from using this domain name, to sell it to third parties bent on gaining an advantage of this domain name, to sell it to the trademark/trade name owner and to sell it to a person or organization who has the same trademark/ trade name.

⁷⁹ NOPE IS DOPE B.V. [2012] ECLI:NL:RBROT:2012:BX2445 (rechtbank Rotterdam) para 73

⁸⁰ *Marks & Spencer PLC and Others v One in a Million Ltd and Others* [1998] F.S.R. 265, The Times, December 2, 1997, at 8.

The court continued by stating that the only explanation why anyone, not part of *Marks & Spencer*, would register this domain name was '(...)to pass himself off as part of that group or his products of as theirs (...)'.⁸¹ The registrar was therefore thought to have acted *per se* in bad faith when registering these domain names. The court indicated that with a well-known trademark/ trade name there can be only one organization to which this domain name refers to. The judgment resulted in the conclusion that the registration of these domain names constituted trademark infringement in the form of cybersquatting.

To conclude, national courts apply criteria similar to those described in UDRP when dealing with cybersquatting. These criteria are to a large extent identical to other forms of domain name use, the main difference is that with cybersquatting the registrar has to act in bad faith. For regular trademarks/ trade names this has to be proven based on the specific circumstances in which the alleged cybersquatting takes place. Bad faith is however almost automatically proven when cybersquatting involves a well-known trademark/ trade name.

⁸¹ *Marks & Spencer PLC and Others v One in a Million Ltd and Others* [1998] F.S.R. 265, The Times, December 2, 1997, at 8 page 271

6: Conclusions

6.1 Can a Domain Name be regarded as a Trademark/Trade Name?

6.1.1. Commercial use of a Domain Name

The main research question, how do domain names relate to trademarks/trade names, will be answered based on the two most relevant aspects regarding this question. The first aspect is to what extent can domain names be regarded as trademarks/trade names? Based on the analyzed information several conclusions can be made with regard to this question. The first conclusion is that domain names, used for commercial purposes, are capable of fulfilling the conditions required by trademark legislation. This results in domain names, used for commercial purposes, having the possibility of being regarded as trademarks/trade names. Domain names first of all have the potential to be registered as a trademark/trade name which, for example, in the United States alone has been done over 60.000 times. The second conclusion has to do with the qualification of domain names as unregistered trademarks/trade names. When domain names, used for commercial purposes, fulfil the conditions for establishing trademarks/trade names they can also be regarded as unregistered trademarks/trade names.

The last conclusion has to do with well-known trademarks/trade names. Domain names, used for commercial purposes, have the potential to be regarded as well-known trademarks/trade names. The condition for this to happen is that these domain names must be known *by a significant part of the public concerned*. With regard to some of the most well-known trademarks, for example *Amazon.com*, this has proven to be the case. Subsequently this domain name was qualified as a well-known trademark.

The overall conclusion to the question whether a domain name used for commercial purposes can be regarded as a trademark/trade name is affirmative. Domain names, used for such purposes, are capable of being regarded as registered/ unregistered trademarks/ trade names and also as well-known trademarks/trade names.

6.1.2. Non-commercial use of a Domain Name

The second question, whether domain names used for non-commercial can also be regarded as trademarks/trade names, does not have a conclusive answer. There is evidence to suggest that these domain names can be regarded as such but also evidence to the contrary. This question therefore requires further academic research and more jurisprudence before a definitive answer can be given.

6.2 Under Which Circumstances can a Domain Name Infringe a Trademark/Trade Name?

As was described before, the main research question will be answered based on the two most relevant aspects regarding this question. The second aspect deals with the question under which circumstances domain names can infringe a trademark/trade name? This question has been analyzed based on the most common forms of use for domain names.

6.2.1 Registered Domain Names

With regard to merely registered domain names the analyses has resulted in only one conclusion, domain names that are merely registered cannot be regarded as infringing a trademark/ trade name. This is however not true when dealing with well-known trademarks/ trade names. Domain names that reflect a well-known trademark/trade name can, even when they are merely registered, be infringing. The conditions for this to occur are that the domain name is (nearly) identical to the well-known trademark/trade name and secondly that this therefore leads to a likelihood of confusion.

6.2.2 Using a Domain Name for Commercial Purposes

In the event that domain names are used for commercial purposes they can infringe a trademark/trade name when they fulfill the following three conditions. The first condition is that the domain name has to be (nearly) identical to the trademark/trade name, which results in confusing the (potential) customers. The second condition is that the domain name must indicate the content of the website which is basically the goods and services sold by the organization. The third, and last, condition is that the domain name is used for the same business purposes as the trademark/trade name.

With regard to well-known trademarks/trade names the qualification is much simpler, the domain name only needs to be confusingly similar in order to infringe the trademark/ trade name.

6.2.3 Using a Domain Name for Non-Commercial Purposes

Non-commercial use can imply several scenarios, for the purpose of this thesis the general description will be used, being non-profit. When used for non-commercial purposes a domain name has, in principle, to comply with the same conditions as with commercial use in order to infringe a trademark/trade name. The main difference has to do with the burden of proof, which is much higher. This is especially the case with regard to the question whether a domain name is confusingly similar to a trademark/ trade name. The evidence that needs to be provided here is twofold, first of all that the domain name is confusing and subsequently that this has actually occurred already. With regard to well-known trademarks/trade names the same definition as with commercial use is applicable, the domain name needs to be confusingly similar. The burden of proof is much lower than with regular trademarks/trade names in order to be regarded as infringing.

6.2.4 Using E-mail Addresses

Domain names in the form of an e-mail address are closely related to those that are merely registered. In principle, having merely registered a domain name as an e-mail address does not make it possible for that e-mail address to infringe a trademark/ trade name. When this e-mail address is also used however, there is the potential that an e-mail address can be seen as infringing a trademark/ trade name. Similar conditions apply as for other types of domain name use. In other words, the infringement of a domain name should be judged based on similar conditions when dealing with an e-mail address as when dealing with e.g. a website. This applies to both 'regular' and well-known trademarks/trade names.

6.2.5 Cybersquatting

Cybersquatting is the practice of registering a domain name in bad faith with the intend of gaining financial benefit in the knowledge that they are of value to third parties. These practices come close to the definition of infringement by merely registered domain names. Domain names are not used for any purpose other than to be sold to a third party. National courts apply conditions similar to those described in UDRP when dealing with cybersquatting.

These conditions are to a large extent similar to other forms of domain name use, the main difference is that with cybersquatting the registrar has to act in bad faith. For regular trademarks/ trade names this has to be proven based on the specific circumstances in which the alleged cybersquatting takes place. Bad faith is however almost automatically proven when cybersquatting involves a well-known trademark/ trade name.

The overall conclusion with regard to the question, under which circumstances domain names can infringe trademark/trade name rights, is that with most uses of domain names this can be the case. The conditions however differ somewhat based on the way a domain name is used. The main conditions are that the domain name has to be, (nearly) identical and thereby confusing, that the domain name indicates the content of the website and that the domain name is used for the same business purpose as the trademark/trade name. With regard to well-known trademarks/trade names infringement is possible in all forms of domain name use, including when a domain name is merely registered. The conditions that have to be met in order for a domain name to be infringing a well-known trademark/trade name are less strict. The domain name has to be confusingly similar, which is however almost implied when they reflect a well-known trademark/trade name.

Bibliography

Literature:

- Henry Campbell Black, *Black's Law Dictionary* (6th Ed.) (St. Paul, Minn.: West Publishing Co., 1990)
- Nuno Pires de Carvalho, *The TRIPS regime of trademarks and designs* (2nd edn, Wolters Kluwer Law & Business 2011)
- William Cornish and David Llewelyn, *Intellectual Property: Patents, Copyright, Trade Marks and allied rights* (5th edn, Sweet & Maxwell 2003)
- Jennifer Davis, *Intellectual Property Law* (3d edn, Oxford university press 2008)

Articles:

- Ryan J Gilfoil ' Judicial Safe Harbor under the Anti-Cybersquatting Consumer Protection Act' [200] Berkeley Technology Law Journal, Vol. 20, Issue 1
- Kamil Idris, 'Making a Mark: An Introduction to Trademarks for Small and Medium-sized Enterprises' (2006) 4 (1) Intellectual Property for Business Series <http://www.wipo.int/edocs/pubdocs/en/sme/900/wipo_pub_900.pdf>
- Kexin LI, 'COORDINATING EXTENSIVE TRADEMARK RIGHTS AND COMPETITION POLICY' 2013 BUFFALO INTELLECTUAL PROPERTY LAW JOURNAL
- Kirk McElhearn 'SET UP YOUR OWN E-MAIL DOMAIN' [2011] Macworld Vol. 28 Issue 8
- Aleksey Pavlovich Ryzhenkov Anisimoy and Jakovlevich Anatoly and Dmitriy Vladimirovich Kozhemyakin 'Theory and practice of protection of personal names in the domain space or "renewed" cybersquatting' [2015] Information & Communications Technology Law Vol. 24 Issue 1
- Paul Steinhauser and Milicia Antic, 'Country correspondance: SteinhauserVandenBrinkHeeziusRijsdijk Advocaten' 2008 World Trademark Review <<http://www.worldtrademarkreview.com/Magazine/Issue/16/Country-correspondents/Netherlands-SteinhauserVandenBrinkHeeziusRijsdijk-Advocaten>>
- Anna Szajna, 'The high standing of unregistered trademarks' 2011 World Trademark Review 84-85 <<http://www.worldtrademarkreview.com/Magazine/Issue/28/Country-correspondents/Poland-Patpol-Patent-Trademark-Attorneys>>

Legislation:

- Paris Convention for the Protection of Industrial Property 1883

- Council Directive 84/450/EEC of 10 September 1984 relating to the approximation of the laws, regulations and administrative provisions of the Member States concerning misleading advertising [1984] OJ L250/17
- The Agreement on Trade-Related Aspects of Intellectual Property Rights 1994
- Directive 2000/31/EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market [2000] ECR 00000
- COMMISSION REGULATION (EC) No 874/2004 of 28 April 2004 laying down public policy rules concerning the implementation and functions of the .eu Top Level Domain and the principles governing registration [2004] O.J. L162/40
- DIRECTIVE 2006/114/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 12 December 2006 concerning misleading and comparative advertising [2006] OJ L376/21
- DIRECTIVE 2008/95/EC OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 22 October 2008 to approximate the laws of the Member States relating to trade marks [2008] OJ L299/

Case Law:

ECJ:

- Case 375/97 *General Motors Corporation v Yplon SA* [1999] ECR I-05421
- Case 299/99 *Koninklijke Philips Electronics NV v Remington Consumer Products Ltd.* [2002] ECR I-05475
- Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV.* [2013] ECR 00000

Opinion of the Advocate General:

- Case 657/11 *Belgian Electronic Sorting Technology NV v Bert Peelaers and Visys NV.* [2013] ECR 00000, Opinion of AG Mengozzi,

Belgium:

- *LIFESTYLE CASE* [2004] Arrest nr. 2002/AR/1848 (Hof van Beroep, Gent)

Germany:

- *Namensrechtsverletzung durch Domain-Namen* [1998] 2 W 77/97 (Oberlandesgerichts Stuttgart)
- Reservierung des Domain-Namens »Rolls-Royce« [1999] U 4484/98 (Oberlandesgerichts München)

- *Rechtswidrige Verwendung der Domain »shell.de«* [2001] I ZR 138/99 (Bundesgerichtshof)

The Netherlands:

- *A.M. ZEGERS BEVEILIGINGSSYSTEMEN vs ZEGERS B.V* [2008] ECLI:NL:RBROT:2008:BC5696 (Rechtbank Rotterdam)
- *THUISBEZORGD.NL BV v TJOKKIE E-MARKETING B.V.* [2008] ECLI:NL:RBUTR:2008:BG4155 (Rechtbank Utrecht)
- de vennootschap onder firm DIGI-D tegen stiching ICTU [2010] zaaknummer 371238/KG ZA 10-891 (rechtbank 's-Gravenhage)
- NOPE IS DOPE B.V. [2012] ECLI:NL:RBROT:2012:BX2445 (rechtbank Rotterdam)
- *Rieberjo B.V. v Dutch Research & Innovations B.V.* [2013] zaaknummer / rolnummer: C/05/248707 / KG ZA 13-451 (rechtbank Gelderland)
- *EHV PROMOTIONS v VBA EVENTS B.V.* [2013] ECLI:NL:RBOBR:2013:6092 (Rechtbank Oost-Brabant)

The United Kingdom:

- *Marks & Spencer PLC and Others v One in a Million Ltd and Others* [1998] F.S.R. 265, The Times, December 2, 1997

The United States:

- *Bear Stearns Cos., Inc. v. Lavalley* [2002] CIVIL ACTION NO. 3:00-CV-1900-D (UNITED STATES DISTRICT COURT, N.D. TEXAS)
- *Amazon.com, Inc., v Royal responder, Inc.,* [2003] CIVIL ACTION NO. CV'03 1634PHXDKD (United States District Court of Arizona)

WIPO:

- *Amazon.com Inc., Amazon Technologies, Inc. v. Giovanni Laporta / Yoyo.Email* (2015)Case No. D2015-0009

WTO:

- *Havana Club Holding, S.A. v. Galleon S.A.,* 62 F.Supp.2d 1085 (S.D.N.Y. 1999)
- *Havana Club Holding, S.A. v. Galleon S.A.,* 203 F.3d 116 (2d Cir. 2000)

Other Sources:

- Educause, *domain name policy*,
<http://net.educause.edu/edudomain/policy_board_9_26_2012.pdf>
- Iana, *top-level domain name list* <<http://data.iana.org/TLD/tlds-alpha-by-domain.txt>>
- ICANN, *Uniform Dispute Resolution Policy*
<<https://www.icann.org/resources/pages/help/dndr/udrp-en>>
- ICANN < <http://newgtlds.icann.org/en/applicants/customer-service/faqs/faqs-en>>
- Trademark Clearinghouse Rights Protection Mechanism Requirements
<<http://newgtlds.icann.org/en/about/trademark-clearinghouse>>
- UNICODE character table <<http://unicode-table.com/en/#control-character>>
- United States Patent and Trademark Office, *Trademark Electronic Search System*
<<http://www.uspto.gov/>>
- WIPO, *Expansion of Domain Name Space May Shift Trademark Protection Strategies*
<http://www.wipo.int/pressroom/en/articles/2014/article_0003.html>
- WIPO, *THE MANAGEMENT OF INTERNET NAMES AND ADDRESSES: INTELLECTUAL PROPERTY ISSUES*
<<http://www.wipo.int/export/sites/www/amc/en/docs/report-final1.pdf>>
- WIPO, Second WIPO Internet Domain Name Process
<<http://www.wipo.int/amc/en/processes/process2/report/html/annex15.html>>
- WIPO Arbitration and Mediation Center - New Generic Top-Level Domains: Intellectual Property Considerations (2005 Report)
<<http://www.wipo.int/amc/en/domains/reports/newgtld-ip/#2>>