



## **Internet domain names & Trademark Law: Does the current legal scheme provide an adequate protection to domain names under the US & the UK jurisdictions?**

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### **1. Introduction**

Domain names have acquired a considerable global attention in the last few years. An enormous amount of academic as well as professional papers written concerning the legal issues raised by the different applications of the Internet domain names. What is a domain name? By now, I suppose everyone is familiar or have an idea on what does a domain name concept stand for? Nevertheless, the simple definition is that a domain name (DN) is the human-friendly form of Internet address that is both easy to identify and to remember such as <www.amazon.com> or <www.yahoo.com>. The “real” Internet Protocol address is a string of numbers, which comprise four numbers in the range 0-255 separated by dots, for instance, 123.45.67.89.

As far as the significance of domain names to Internet users is concerned, domain names, generally speaking, play an important role in e-commerce, it is truly the easiest and most convenient way that the technology has provides us with to access any material on the cyberspace. The cyberspace means the world of commerce, social, legal, technology, economic...etc. However, certain domain names have great economic value associated with them, depends on whether this name is easy to remember and easy to type, some generic names have the same value and indeed most of all domain names presenting a trademarks have the same great value depends on

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how famous the mark is. However, broadly speaking, it is believed that this considerable value has undermined by the proliferations of the searching engine tools such as Google or Yahoo, where by the Internet user should only type in the designated box a keyword to the product/website that he/she wishes to find. The search then should be performed within a few seconds to provide the user with the exact domain names, no matters how complicated is the domain name, or an exact link to the desired webpage.

But why domain names need the legal protection? On one hand domain names have great economic value to online businesses, on the other hand, these names exposed to three ways in which it puts domain names at risk. In brief, these includes, a) cybersquatters who “occupy” a name hoping that a trademark owner will make an offer for it; b) activists who register confusingly similar versions of domain names, pointing them to gripe sites that carry propaganda for a cause and against the company; c) typo-Squatter who register domain names incorporating variations of well-known trademarks terms such as misspellings (micr0soft.com) and use them for websites to take advantage of unwary Internet users.

## **2. Legal protection under the US & the UK jurisdictions**

What law governs domain names disputes? There is no separate law governing domain names. This is probably because there isn't yet any global consensus on whether domain names are part of other intellectual property rights and therefore protected by specified law. Judges as well as legal practitioners therefore, should provide an in-depth understanding to the nature of the domain name in question first. Besides other advantages, this analysis would normally direct us to the most appropriate legal instrument to be applied to the disputed domain name. In this analysis, one key factor question has to be answered. Looking at the legal nature of a domain name, what in essence is a domain name?

From a pure technical point of view, a domain name is an Internet address identifying a computer site connected to the Internet in the same way that a telephone number uniquely identifies a telephone line connected to the global telephone network. Therefore a domain name is no more than data, a reference point in a computer

database. No two organisations can have the same domain name and no two people can have the same telephone number.

However, from a legal point of view, it is not clear yet what a domain name is? Broadly speaking, the rights over a domain name arise from either the 'registration agreement' contractual relation with the registrar<sup>2</sup> or from the property right interest over the name itself.

Without going in depth, it is necessary to point out that the legal nature of domain names' registration agreement should be analysed first in order to give a clear comprehensive answer to the rest of the query, identifying the status would direct the decision maker to apply the correct legal instrument to the dispute, (i.e.) domain name representing a trademark, would not be protected under the data protection act. Therefore, a clear analysis would normally assist the decision maker in that sense.

The majority of domain name disputes seem to involve trademarks. Although, it is submitted that disputes may also arise when the registration or use of the domain name infringes any legally recognised right(s), such as trademark rights, common law right in passing off, or any other right.

## **2.1. Trademark law**

Article 15 of TRIPS agreement defines a trademark as “any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks...”<sup>3</sup> In the world of domain names, the only form of trademarks which are capable of being used as a domain name is word marks.

Trademarks serve a variety of important economic functions, most of all, they identify and differentiate products and services (origin function); they indicate consistent source and quality that measure up to the expectations of the customers (quality and

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<sup>2</sup> It is also a debatable issue, whether the registration agreement is actually a service contract, license, indirect government grant or otherwise.

<sup>3</sup> Text of TRIPS agreement can be find at: [http://www.wto.org/english/tratop\\_e/trips\\_e/t\\_agm0\\_e.htm](http://www.wto.org/english/tratop_e/trips_e/t_agm0_e.htm)

guarantee functions); and they also facilitate advertising and sales (advertising or investment function).<sup>4</sup> The creation of trademark rights is depending upon the satisfactory of certain requirements. In brief, these requirements are distinctiveness, functionality, use, and registration.

The purposes of trademark law is to “protect the public so that it may be confident that, in purchasing a product bearing a particular trademark which it favourably knows, it will get the product which it asks for and which it wants to get”<sup>5</sup> and to ensure that “where the owner of a trademark has spent energy, time and money in presenting to the public the product, he is protected in his investment from its appropriation by pirates and cheats”.<sup>6</sup>

Domain names<sup>7</sup> may infringe directly or indirectly the rights of other parties to use registered or unregistered trademark.<sup>8</sup> The direct trademark infringement occurs by the use of the trademark on the second level domain in connection with the sale of a good if it is likely to cause consumer confusion as to the source of those goods or as to the sponsorship or approval of such goods. For instance, the use of identical trademark into a second level domain name on the same product would clearly constitute a direct trademark infringement. The indirect trademark infringement occurs when a party has authority or control over another who commits direct trademark infringement. For example, the registration of a second level domain name infringing directly a trademark owner’s rights by an agent who is in an employment or professional relationship with a third party. In such a situation, responsibility for the agent’s action may be attributed to the employer or supervisor.

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<sup>4</sup> Lynda J Oswald, “Tarnishment” and “Blurring” under the Federal Trademark Dilution Act of 1995; 36 Am. Bus. L.J. 255, at 256, see also W.R. Cornish, *Intellectual Property; Patents, copyright, Trade Marks and Allied Rights*, fourth edition, Sweet & Maxwell, London, 1999, at 612.

<sup>5</sup> S. Rep. No. 1333, 79<sup>th</sup> Cong., 2d Sess. 3 (1946).

<sup>6</sup> S. Rep. No. 1333, 79<sup>th</sup> Cong., 2d Sess. 3 (1946).

<sup>7</sup> It is arguably accepted that a domain name, in certain cases, can carry the significance of a trademark or can function as a trademark. However, it is not the purpose of this paper here to investigate on whether or not domain names are eligible to function as a trademark. There is arguably a common understanding that domain name can carry the significance of trademark, so long as it functions as a trademark in its totality. (Spyros Manites) it is not the purpose of this paper, however, to evaluate this statement.

<sup>8</sup> E.g. in the UK, unregistered trademark is totally a creature of common law. They are protected through the tort of passing off. In the US, trademarks rights derive from use and exist even if no registration has ever been obtained.

### **2.1.1. Why trademarks law?**

The history of trademark law to the Internet domain name disputes can be attributed to that the creation of the World Wide Web (www) has fuelled the boom and commercialisation of the Internet medium, thousands of businesses have established storefronts on the Internet to disseminate marketing literature, offer customer service, and sell goods and services online.<sup>9</sup> Not surprisingly and due to this commercialisation, there is a special relation between trademark law and domain names.

A domain names is a name as well as an IP address, thus in the commercial context that would suggest that domain names are capable of protection under trademark law because in this context domain names are mostly trademark. Therefore, it is reasonable for a trademark owner to seek trademark law assistance if a third party uses his trademark or something like it in the Internet medium.

Another justification given to the application of trademark law to domain names, is that most of the plaintiffs are actually trademark owners with business interest who are sufficiently motivated and financially equipped to take such disputes through a conclusion.

### **2.1.2. The failure of trademark law to resolve the disputes**

What precisely is the conflict between domain names and trademarks?

The potential conflict between domain names and trademarks is far broader than the problem of cybersquatting. The domain name system presents a series of conflicts with the basic principles of global trademark law. Conflicts between trademark rights and domain name registrant occur in a number of settings

1. An act of cybersquatting: Cybersquatting occurred when a third party registering else trademark as a domain name with the intention to offer it back to the true owner at a substantial fee. The law of Trademark interferes here to protect the true owner who has the exclusive right to the trademark.

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<sup>9</sup> See, Lisa Katz Jones, "Trademark Law in Cyberspace", 37 Alberta L. Rev. 991 (1999), at 1997.

Cybersquatting acts have been criminalised in many countries in the world. This is to protect the legal owners from

2. Genuine disputes: when two or more parties with independent and legitimate rights for the same trademark in different lines of business or jurisdictions seek the same domain name, disputes occur.<sup>10</sup> This kind of disputes occurred at two different levels, firstly, when the same mark owned and used by different persons in respect of different goods or services “specialty”. Secondly, when the same mark owned and used by different persons in different countries in relation to the same goods or services “territoriality. The case of prince.com is a good example of this. In Prince plc v Prince Sports Group Inc,<sup>11</sup> Prince plc in the UK firstly registered the domain name prince.com and was challenged by Prince Sports Inc. in the US. The court decided that the name to remain with Prince plc.

- The causes of the conflict: Is trademark law truly applicable model to domain name? (inadequacy of traditional trademark law remedies):

Although there are considerable differences and similarities between trademark law model and domain names, domain name literature suggests that trademark law is not fully applicable to domain names disputes. There are some reasons that cause the conflict between domain names and trademark law, this reasons show that trademarks law is inadequate remedy to domain names.

1. Trademark law is limited by geography and open by classification. Hence trademarks are attached to specific jurisdictions and specific goods or services.

First, trademark law is national by nature despite some sort of international or regional harmonisation. Trademarks are registered on a territorial basis. Unregistered trademarks are limited to a particular geographical area within which the marks are actually used.<sup>12</sup> Thus, it is common for a trademark to be

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<sup>10</sup> William A. Tanenbaum. “Rights and Remedies for three common trademark-domain name disputes”, at 9

<sup>11</sup> [1998] FSR 21

<sup>12</sup> Kevin Cheatham, “The impact of E-Commerce on the laws of nations article: negotiating a domain

owned by different, unrelated companies in different countries or regions.<sup>13</sup> Domain names, however, do not respect geographical borders. A domain name user can make a global use of a trademark. It is not clear however, whether the registration of domain name would cause infringement of rights in all countries where the mark is owned by another and the acquisition of rights in all use-based system?

Secondly, the owner of a trademark does not have an absolute monopoly over the mark since a registered trademark in most countries is granted in respect of a certain class of goods or services for which an application has been made. The Nice Classification splits goods and services into, respectively, 34 and 8 classes for the purpose of registering trademarks and service marks.<sup>14</sup> Thus, the owner's exclusive right to use the mark is restricted to the particular goods or services for which the mark is registered. Justice Holmes refused to accept the proposition that a trademark might confer on its owner the "naked right"...to prohibit the defendant from making even a collateral reference to the owner's mark; [Trademark does not confer any right to prohibit the use of the word or words. It is not a copyright....a trademark only gives the right to prohibit the use of it so far as to protect the owner's good will against the sale of another's product as his...when the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth. It is not taboo].<sup>15</sup> The same does not apply to the domain name system because any name has to be absolutely unique and not shared by anyone else across the globe in the TLD. There can only be one Apple.com, should that domain name be granted to the personal computers manufacturer or to the shoes company? Or should prior trademark ownership be irrelevant? How should we deal with the problem at the global level?

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name dispute: problem solving v. competitive approaches", 7 Willamette J. Int'l L & Dispute Res. 33, (2000), at 41.

<sup>13</sup> Graham J H Smith, *Internet law and regulation*, second edition, edited by Graham J H Smith, Bird & Bird, FT Law and Tax at 43

<sup>14</sup> The Nice Agreement concerning the international classification of goods and services for the purposes of the registration of marks (of Jun 15, 1957, as revised at Stockholm on July 14, 1967, and at Geneva on May 13, 1977, and amended on September 28, 1979), which is available at: <http://www.wipo.int/treaties/en/classification/nice/>

<sup>15</sup> See *Anheused-Busch v Budejovicky Budvar*. [2000] R.P.C. 906

2. The registration is another cause of this conflict. Certain facets of domain name registration make domain names a fertile ground for trademark disputes.<sup>16</sup> Domain names are fairly easy to register, the general practice of registries is to check the availability of SLD/TLD combination and ensure no duplicate domain names are allocated, unlike trademarks registries who conduct a full examination process to determine possible conflicts. Thus, it is possible for a third party who has no connection at all with a trademark to register it as a SLD and deprive the rightful owner of the mark the opportunity to register the mark in the same SLD.

Another registration issue is that most registries implement “first come, first served” policy. This practice provides another incentive to cybersquatters to register the trademark before the rightful owner of the mark and then offer it later at substantial fee.

One of the reasons on why trademark law is not applicable to domain name system is the registrability requirements: this factor has made the trademark law varnabale to domain name. The registration requirements are one of the major issues in trademarks law. The law of trademarks cannot be applicable. The significance differences between trademark registration requirements and domain name makes the law of trademark not a suitable remedy against trademark infringement. Trademark Infringement caused by domain name should be resolved in different manner.

3. That trademark law has great implication on domain name system:  
Although a domain name is no more than an address but this has acquired trademark implications in reality since consumers always assumes that it has an identifying function. By acquiring a domain name covering its trademark, a company ensures that its promotions, information and

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<sup>16</sup> Dawn Osborne, “Domain Names, Registration & Dispute resolution and recent U.K. cases”, E.I.P.R 11 (1997), at 644.

commercial offerings are easy to be found on the Internet.<sup>17</sup> This implication provides a great incentive for the cybersquatter to grab those domain names that include trademarks. It also explains why trademarks owners are enthusiastically carrying out reverse domain name hijacking.

4. The demand for desirable domain names exceeded supply, as the Internet continues to develop the number of certain desirable domain names continues to drop off. Not surprisingly due to that most of the Internet users prefer to use memorable domain names and most likely to guess these names in the case of trademarks-based-domain names. This demand for desirable domain names exceeds supply and therefore contributed to the main cause of the conflict between domain names and trademarks.

## **2.2. Different ways to resolve the legal conflicts under the US and UK jurisdictions**

Domain names disputes in the context of trademarks arguably can be decided within the legal structure of trademark law. The main role of the courts in addressing these disputes is to determine whether the use of a domain name infringes the trademark registered or used in that jurisdiction.

### **2.2.1. The U.S courts approach**

The early developments of the Internet have always been attributed to the effort of the United States as the vast majority of domain names are registered in the US. Consequently, the majority of disputes have originated there. The courts in the US have struggled to address the disputes of domain names in the context of trademarks law in light of two important policies of trademark law: (1) to prevent confusion in the public and (2) to protect the trademark owner's investment in its mark.<sup>18</sup>

It must be noted that US's trademark system is uniquely a common law use-based system, combined with elective federal registration. Trademarks used in interstate commerce are protected under the Lanham Act, while those used locally are protected

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<sup>17</sup> Harry Small, Mark Weston, "Protection of domain names and trade marks", *Entertainment law review*, (1998), at 287.

<sup>18</sup> *Avery Dennison Corp. v. Jerry Sumpton* 189 F. 3d 868, 873 (9<sup>th</sup> Cir. 1999)

under common law. Nevertheless, both common law and federal law apply the same principles in protecting trademarks and resolving disputes.<sup>19</sup>

### **2.2.1.a Trademark infringement**

Owners of federally registered trademarks can bring actions against trademark infringement under section 32 (1) of the Lanham Act.<sup>20</sup> S32 (1) provides that infringement occurs when one uses a registered mark in commerce or applies it to goods or services without the consent of the trademark registrant, and such use is likely to cause confusion.<sup>21</sup> If trademark were established, monetary damages and/or injunctive relief would be granted.

To prevail under S32 (1), a plaintiff must prove that the defendant's use of a trademark-based domain names results in a likelihood of confusion regarding the origin of the goods and services. The touchstone of liability under this Act is that of confusion. However, given the technical aspects of the Internet, the plaintiff may also prevail if initial interest confusion occurs as a result of the defendant's use of the trademark, via domain or metatags.<sup>22</sup>

- Likelihood of confusion:

“Likelihood of confusion” is crucial standard for trademarks infringement claim. The test for determining the likelihood of confusion in the Internet context is essentially the same, with only slight variations.

Courts look at the totality of factors and circumstances of the case in determining likelihood of confusion. It is important, however, to note that test for likelihood of confusion only applies to goods or services that are “related”. Meaning “those goods or services which would reasonably be thought by the public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the

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<sup>19</sup> David Yan, “Virtual reality: can we ride trademarks law to surf cyberspace?” 10 Fordham I.P., Media & Ent. L.J. 773, (2000).at 782

<sup>20</sup> See Lanham Act s32(1), 15 U.S.C. s 1114(1)(1994)

<sup>21</sup> Ibid.

<sup>22</sup> See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d at 1036, 1062 (9<sup>th</sup> Cir. 1999).

trademark owner.”<sup>23</sup> If the goods or services are totally unrelated, there can be no infringement because consumer confusion is unlikely. This requirement that the goods be “related” may limit the cases in which the mark owner can obtain a legal remedy in domain name disputes.<sup>24</sup>

Considering the specialty and technical quality of numerous novel issues arising out of the domain name-trademark disputes, the inventive US courts developed a flexible approach in analysing likelihood of confusion to reflect the changing circumstances.

- Initial interest confusion

The traditional likelihood of confusion test may be problematic to establish trademark infringement when the violating party diverts consumer initial interest from the trademark owner without causing origin confusion.<sup>25</sup> In these situations the Internet user is likely to enter a trademark as a SLD but get another web page, though he is aware of this fact but he is likely to stay. Therefore, the domain name holder catches a new user by using the goodwill of the trademark. Many courts in the US apprehend the Act in a broad sense and create this new concept, which is actionable under the Act.<sup>26</sup> This concept largely broadens the ambit of traditional test by permitting a finding of a likelihood of confusion even though the consumer immediately knows the source’s actual identity.

- Functional TLDs:

The US courts split on the issue of whether functional TLDs are the contributing factor of finding likelihood of confusion or dilution. The minority of courts, represented by the *Avery Dennison* Court, drew a line between domain names under .com and under .net, and inferred that confusion or dilution arose from a domain registration under .com TLD, but not under .net TLD.<sup>27</sup> However, the majority refused to adopt such differentiation and analysed trademark infringement or

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<sup>23</sup> See, Donna L. Howard, “Trademarks and service marks and Internet domain names: Giving ICANN deference”, 33 *Ariz. St. L.J.* 637 (2001), at 644, quoting *Bally total fitness holiday group v. Faber*, 29 F. Supp. 2d 1161, 1163 (C.D. Cal. 1998).

<sup>24</sup> See, Donna L. Howard, “Trademarks and service marks and Internet domain names: Giving ICANN deference”, 33 *Ariz. St. L.J.* 637 (2001), at 644

<sup>25</sup> *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d at 1036, 1062 (9<sup>th</sup> Cir. 1999).

<sup>26</sup> *Ibid*, at 1062-64

<sup>27</sup> See, *Avery Dennison Corp v. Jerry Sumpton*, 189 F.3d 868, 880-81 (9<sup>th</sup> Cir. 1999).

dilution regardless of .com or .net.<sup>28</sup> In effect, the addition or deletion of TLDs in domain named marks does not materially alter the mark.<sup>29</sup>

### **2.2.1.b Unfair Competition**

The Lanham Act goes beyond trademark infringement and creates a federal statutory tort, which provides wide protection against various aspects of unfair competition. Causes of action for unfair competition can be brought under section 43(a) of the Lanham Act<sup>30</sup> for all marks, registered or not, as well as trade names. S43(a) is often referred to as the Federal Unfair Competition Law and provides another channel to deal with domain name-trademarks disputes.

### **2.2.1.c Trade Mark Dilution**

The Federal Trade Mark Dilution Act of 1995 (“FTDA”), signed into law in 1996, amended the Lanham Act to create a federal cause of action for the dilution of famous marks.<sup>31</sup> The Act affected domain name disputes in that famous marks were automatically protected, and unlike infringement or unfair competition claims, likelihood of confusion is not a requirement.<sup>32</sup>

The FTDA defines “dilution” as the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and the other parties, or (2) likelihood of confusion, mistake or deception.<sup>33</sup> Thus, it provides for claims against non-competing and non-confusing uses if they diminish or dilute the effectiveness or distinctiveness of the mark.

Dilution of trademarks by domain name has been considered by US courts. Historically, three types of dilution have been recognised; blurring, tarnishment, and

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<sup>28</sup> For example, the court in *playboy enters. Int’l, Inc. v. Global Site Design, Inc.*, 1999 WL 311707, at 2 (S.S. Fla. May 15, 1999) found trademark infringement, unfair competition and dilution occurred with a <trademark.net> registration.

<sup>29</sup> See U.S Patent and Trademark Office, Examination guide No. 2-99 (Sept. 29 , 1999), VIII, Marks Composed, in whole or in part, of domain names.

<sup>30</sup> Lanham Act s43(a), 15 U.S.C. s1125 (a)(1994).

<sup>31</sup> See Lanham Act 43©, 45; 15 U.S.C 1125)©, 1127

<sup>32</sup> *Avery Dennison Corp v. Jerry Sumpton*, 189 F. 3d at 873, 879.

<sup>33</sup> 15 U.S.C. 1127 (1996)

disparagement. Dilution by blurring anticipates the ‘whittling away...the selling power and value’<sup>34</sup> of an original mark by using a similar mark even if on dissimilar products or services and thereby creating in the consumer’s mind a new association with the original mark. Dilution by tarnishment occurs when a mark is used by a third party in a manner that is inconsistent with the use of the mark by its original owner such that the goodwill associated with the original owner’s mark becomes degraded or ‘tarnished’.<sup>35</sup>

Although the FTDA has been applied in a number of domain name disputes because of its advantages, there are two principle weaknesses constrains FTDA’s application to resolve domain name disputes. Firstly, the threshold that the mark must be famous is hard to meet. The second limitation is the requirement of “commercial use in commerce”.

As to the first limitation, the FTDA lists eight non-exclusive factors for evaluating whether a mark is famous.<sup>36</sup> The standard for fame is very high and the evaluation is often subjective. Federal courts have concluded that to be “famous, under dilution” a mark [must] be truly prominent and renowned, and therefore most likely to be adversely affected by dilution”.<sup>37</sup> However, this limitation seems to have been ameliorated by some recent cases in which the courts have adopted a relatively lower threshold in favour of finding trademark dilution in the Internet context.<sup>38</sup>

“Commercial use in commerce” requirement involves two-steps analysis. First, the defendant must meet the definition of ‘use in commerce’, i.e. use in the regular course of interstate trade. This means the domain name must be attached to some commercial goods and services of the registrant. Second, the defendant’s use must be ‘commercial’; i.e. proposes ‘ a commercial transaction’. Mere registration of a domain name without more does not constitute a commercial use.<sup>39</sup> The non-commercial use of a domain name that hinders a trademark owner’s exploitation of the value of its

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<sup>34</sup> *Panavision Int’l, L.P. v Toepfen*, 141 F3d 1316, 1324 (9<sup>th</sup> Cir. 1998)

<sup>35</sup> See *Toys R Us v Akkaoui*, 1996 U.S. Dist. Lexis 17090 (N.D.Cal. Oct.29,1996)

<sup>36</sup> 15 USC s1125 © (1) (a)-(h) (1996)

<sup>37</sup> *Avery Dennison Corp. v. Jerry Sumpton* 189 F. 3d 868, 873 (9<sup>th</sup> Cir. 1999)

<sup>38</sup> See *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 308 (D.N.J. 1998); *Playboy Enterprises, Inc. v. Asiafocus International, Inc.* 1998 U.S. Dist. Lexis 10359, (E.D. Va. Feb. 2, 1998) at 20, and *Playboy Enterprises International, Inc. v Global Site designs, Inc.* 1999 WL 311707, at 2.

<sup>39</sup> *Jews for Jesus v. Brodsky*, 993 F. Supp. At 307

trademark on the Internet will not cause dilution.<sup>40</sup> Therefore, in cases where there are no goods or services sold or advertised on the Internet, the courts have to stretch the meaning of the statute so as to find commercial use and thus establish dilution. Moreover, if the cybersquatter does not attempt to sell trademark-based domain names to the rightful trademark owner, but rather sits on it to curtail the trademark owner's use, it seems that the cybersquatter can avoid commercial use, and escape liability under dilution.

#### **2.2.1.d State Causes of Action**

Besides the federal law, there are basic state law causes of action available for domain name-trademark disputes;

- Common law trademark infringement;
- state anti-dilution statutes;
- Unfair competition and deceptive trade practices under common law and state statutes;
- Claims under other state laws.<sup>41</sup>

Perhaps the biggest problem in these causes is that before the court can approach the underlying issues, personal jurisdiction over the defendant must be established. Jurisdiction must satisfy the forum state's long arm jurisdiction statute ("LAJS") and meet certain minimal constitutional thresholds under the Due Process Clause of the Fourteenth Amendment.<sup>42</sup>

Establishing personal jurisdiction in domain name disputes can be a difficult issue due to the global character of the Internet and a lack of any calculated activity targeting

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<sup>40</sup> See 28 U.S.C. 1125 (c)(4)(supp. IV 1998)

<sup>41</sup> Some states have made efforts to propose solution of disputes. Cit California for example. a state senator in California introduced a bill to protect trademarks used in electronic mail user names, which addresses the unreachability of pseudo domain names under unfair competition. <sup>41</sup> se, Joan Meadows, "Trademark protection for trademark used as Internet domain names", 65 U. Cin. L. Rev. 1323, at 1355.

<sup>42</sup> Personal jurisdiction may be established either by finding general jurisdiction or specific jurisdiction. See; Mark C. Dearing, 'Personal Jurisdiction and the Internet: Can the traditional principles and landmark cases guide the legal system in the 21<sup>st</sup> century?' 4 j. Tech L. & Pol'y 4 (1999) at 16. See also; Ira S. Nathenson, "SHOWDOWN AT THE DOMAIN NAME CORRAL: PROPERTY RIGHTS AND PERSONAL JURISDICTION OVER SQUATTERS, POACHERS AND OTHER PARASITES" 58 U. PITT. L. REV. 991 (1997).

the forum state. It is interesting to note that recently a so-called ‘sliding scale’ approach based mainly on the degree and type of interactivity on the Web site at issue has been developed by the US courts in addressing personal jurisdiction issues in Internet trademark cases.<sup>43</sup>

### **2.2.1.e Anticybersquatting Consumer Protection Act**

Whether the enactment of cybersquatting specific laws is an appropriate response?

In late 1999, the US congress enacted the Anticybersquatting Consumer Protection Act ACPA. The legal remedies available for victims of cybersquatting before the enactment of the ACPA were viewed by the Congress as “expensive and uncertain”.

The ACPA amends the trademark act of 1946, creating a specific federal remedy for cybersquatting<sup>44</sup>.

In the leading *Sporty’s Farm v. Sportsman’s Market*,<sup>45</sup> the second circuit outlined a five-step process for the ACPA analysis. The first issue before the court is the applicability of the ACPA to the case in question and whether the court can exercise personal jurisdiction over the defendant or if an in rem jurisdiction over the domain name itself can be obtained. Secondly, the court must decide whether the plaintiff’s trademark is famous or distinctive and thus entitled to the protection under ACPA. Thirdly, the court must determine whether the defendant’s domain name is “identical or confusingly similar” to the plaintiff’s trademark. The fourth step is to identify whether the defendant has acted with “bad faith intent to profit” at the time of registration. And finally, the court must grant proper remedy.

One of the most significant aspects that the ACPA adds to the traditional trademark law is the establishment of in rem jurisdiction. Meaning that it is now possible for a legitimate mark owner to file an in rem action against the domain name itself rather than the registrant when the domain name infringes or dilutes the owner’s trademark

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<sup>43</sup> For detail see David Yan, “Virtual reality: can we ride trademarks law to surf cyberspace?” 10 Fordham I.P., Media & Ent. L.J. 773, (2000).at 850-858

<sup>44</sup> See 15 U.S.C. §1125 (d)(2)(a)

<sup>45</sup> 202 F.3d 489 (2<sup>nd</sup> Cir. 2000)

and the registrant is not subject to personal jurisdiction or cannot be located with “due diligence”.<sup>46</sup>

The ACPA also creates a specific civil cause of action by the trademark owner against any person who registers, traffics in or uses a domain name that is identical or confusingly similar to or dilutive of a trademark (on the condition that the trademark was distinctive or famous at the time of registration) where the domain name is registered with a bad faith intent to profit.<sup>47</sup>

The creation of a separate and unique cause of action for living individuals to recover domain names containing their personal names where the name is registered with bad faith intent to profit.<sup>48</sup>

However, the ACPA is by no means beyond criticism and further improvements need to be made. The Act firstly fails to effectively curb reverse domain name hijacking by large corporations. Mark Grossman argues, “the act has little to do with consumer protection, and more to do with protecting the behemoth companies who want to protect every conceivable variation of their name.”<sup>49</sup> To solve this public policy problem, steeper punishments for plaintiffs that exercise such practices are suggested.<sup>50</sup> Secondly, it fails to address the disputes of two or more legitimate owners of the same trademark in different classes or courtiers seeking the same domain name. ACPA should be amended to indicate whether a first come, first served rule or some other rules would apply. Thirdly, the issue of whether the trademark owner should sue possible infringers so as to reduce the risk of weakening or abandoning the mark as a result of “failure to police” it remains unclear.<sup>51</sup> Thus, the boundaries of “failure to police a mark” need to be clarified under ACPA.

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<sup>46</sup> 15 U.S.C.S s 1125(d)(2)(A)

<sup>47</sup> 15 U.S.C.S s 1125 (2000)

<sup>48</sup> 15 U.S.C.S s 1125 (2000)

<sup>49</sup> Mark Grossman, New Year brings new laws on cybersquatting, Broward daily bus. Rev. (January 11, 2000), at A1.

<sup>50</sup> Jason H. Kaplan, “The Anticybersquatting Consumer Protection Act: will it end the reign of the cybersquatter?” 8 UCLA Ent L. Rev. 43, (2000) At 78.

<sup>51</sup> The seriousness of this risk is left to the discretion of the courts. In *University Bookstore v. Board of Regents*, 1994 TTAB Lexis 8 (1994), the TTAB said that distinctiveness could vanish by failing to file action against infringers.

### 2.2.2. The UK courts approach

There have only been a handful of cases in relation to domain name and trademark disputes that have appeared before the courts in the UK. In comparison with the US courts, UK courts have fewer opportunities than their counterparts in US in developing the approach of resolving trademark issues in the context of cyberspace.

There are three possible legal grounds on which the courts in the UK may rely in addressing domain name/trademark disputes: the law of registered trademarks, passing off, and common law conspiracy.

#### 2.2.2 a Trademark Infringement

There is no simple answer to the question whether the registration of a domain name incorporating a registered trademark amounts to trademark infringement under The Trade Marks Act 1994(hereinafter TMA). The outcome may well depend upon the intended use of the domain name.

- A. S10 (1) of TMA states that trademark infringement occurs if a person uses in the course of trade a sign that is identical with the trademark in relation to ‘goods or services which are identical with those for which it is registered’.

Accordingly, there is no likelihood of confusion requirement needed under this section. However, the relevant questions here are whether the domain name in question is identical to the registered trademark? Whether the use of the domain name is ‘in the course of trade’? And whether such use is in relation to identical goods or services for which the trademark is registered?

- Identical with the trademark means that in order to prevail under this, the domain name in question has to be identical to the trademark. However, it should be borne in mind that the established principle is that identical does not amount to absolutely identical.<sup>52</sup>

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<sup>52</sup> Thus, it is possible that the court would adopt the approach in *Origins Natural Resources Inc v. Origin Clothing LTD* ([1995] FSR 280) and discount external added matter or circumstances in comparison.

- ‘Use in the course of trade’: In the Internet context, many questions remain unclear regarding the ‘use in the course of trade’. Cybersquatters usually do not make significant ‘use’ of the domain name once it is reserved, the law does not tell us whether mere registration of a domain name in the absence of a website providing goods and services is sufficient to satisfy the test of ‘use in the course of trade’. However, the court of appeal made such decision in the landmark case of *British telecommunications Plc and others v. one in a Million Ltd and others*,<sup>53</sup> where it was held that the use of a trademark-based domain name in the course of the business of a professional dealer for the purpose of making it more valuable and extracting money from the trademark owner amounts to ‘use in the course of trade’. In short, the cybersquatter’s activity of offering to sell names to trademark owners constitutes use in the course of trade but it is still unclear whether the use in the course of trade would be found if the cybersquatter does not actively offer to sell it.

“In the course of trade”, websites ending with ‘.com’ suffix are presumably commercial sites as the .com top level domain dedicated but unrestricted to commercial organisations. It is likely that trademark infringement would be established if a trademark registered as .com domain names. However, the Internet contains many other non-commercial top level domains such as .org or .edu. In such a situation, it is not clear whether infringement would be established when trademark is registered and used as a domain name.

- Under s 10 (1) It is also necessary to consider the essential content of the specification. The typical case is *Avnet v. Isoact*<sup>54</sup>. In this case, the plaintiffs argued that the defendants’ activities of using the word ‘Avnet’ in the domain name in relation to identical services amounted to trademark infringement under s 10 (1) of the TMA and applied for summary judgment. It was decided that since the services provided by the

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<sup>53</sup> [1999] E.T.M.R.

<sup>54</sup> [1998] F.S.R. 16

defendants were quite different from those of the plaintiffs, there was no infringement of the trademark established on the ground of s10(1).

This case is significant in two aspects. Firstly, it reflects the attitude of UK courts to set up reasonable boundary of monopoly conferred by registered trademarks, by explaining that in order for allegations under the s 10(1) to succeed, the infringing use must fall exactly within the particular class specified by the registration otherwise no infringement would be found. Secondly, though Avnet Inc was the registered proprietor of the trademark 'Avnet', its right cannot prevail over an unregistered right where the respective right holders provide different services without 'overlap'. In other words, the ownership of a registered trademark does not necessarily give rise to a domain name incorporating the same mark unless the goods or services covered in the registration are the same as those trading online. Thus, this case demonstrates that even though the court did not treat the domain name as a trademark, the specification of goods or services in the registered trademark is still closely related to the trademark based domain name disputes.<sup>55</sup>

**B.** S 10 (2) of the TMA provides that a person may infringe a registered trademark if he or she uses in the course of trade of identical or similar sign in relation to identical or similar goods or services which results in 'a likelihood of confusion on the part of the public, which includes the likelihood of association with the trademark'.<sup>56</sup>

Compared with s10 (1), this type of infringement extends to 'similar sign' and 'similar' goods or services, provided that the public is likely to be confused.

Applying this section to trademark-based domain name disputes involves four steps. First, is the domain name identical or similar to the registered trademark?

If so, is it used in the course of trade? The third step is to consider whether the

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<sup>55</sup> Charlotte Waelde, Chapter 7: 'Trademark and Domain Names; There's a lot in a name' in Law & the Internet A framework for Electronic Commerce, second edition edited by Lillian Edwards & Charlotte Waelde, Hart Publishing, Oxford-Portland Oregon, 2000. at 139

<sup>56</sup> The test of 'likelihood of confusion including likelihood of association' has been considered in *Wagamama Limited v. City Centre Restaurants plc* and others [1995] F.S.R 713.

goods or services provided under the domain name are identical or similar<sup>57</sup> to those undertakings specified in trademark registration. If not, no infringement will be established under this section. If the similarity is found, the final step is to examine whether the public is likely to be confused.<sup>58</sup>

As far as goods or services provided on the Internet under the trademark-based domain name is concerned, the finding of confusion depends partially on the technical feature of the Internet and the unique character of the domain name. It needs to be clarified whether the domain name is viewed as associated with the website only, or the underlying goods and services. In addition, if the domain name is deemed to infringe the trademark, where is the point of confusion? Whether at the point of access to the web page or at the point of finding out the goods or services offered at the site?. After raising these issues, Charlotte Waelde draws analogy with non-Internet related cases and indicates confusion occurs at the point when the surfer actually reaches the website and makes his or her decision as a purchaser. However, she further points out that applying this approach to the question of confusion, confusion is arguably unlikely to occur.<sup>59</sup>

C. Where a trademark has a reputation in the UK, Section 10 (3) states it is an infringement for a person to use in the course of trade an identical or similar sign for dissimilar goods or services, where “the use of the sign”, being without due cause, takes unfair advantages of, or is detrimental to, the distinctive character or the repute” of the trademark.

This section introduces into English trademark law the concept of dilution that has been pioneered in US. The fundamental prerequisite is the reputation of the trademark. Whether S 10 (3) is breached or not depends heavily on this requirement. In Harrods case, it was clear that Harrods marks have a reputation in the UK. Since the registered mark is the name itself, the

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<sup>57</sup> The test of ‘similarity’ was considered by the court in *British Sugar v. James Robertson* [1996] R.P.C. 281, six factors may need to be considered in determining similarity of the goods and services.

<sup>58</sup> The issue of similarity of goods and services and likelihood of confusion was considered by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* C39/97 [1998] All E.R. (EC) 934

<sup>59</sup> Charlotte Waelde, Chapter 7: ‘Trademark and Domain Names; There’s a lot in a name’ in *Law & the Internet A framework for Electronic Commerce*, second edition edited by Lillian Edwards & Charlotte Waelde, Hart Publishing, Oxford-Portland Oregon, 2000. at 139

reputation attached to the name also extends to the marks. Gardener argues that it is difficult to find a clearer example of marks that has such a reputation.<sup>60</sup> Nevertheless, a mark has a reputation does not need to be “well known” or “famous”.<sup>61</sup>

The second bit of establishing a successful case under S10 (3) is to show that the use of the domain name is without due course and takes unfair advantage of or is detrimental to the distinctive character of the trademark. This is not an easy task. In Harrods case, Harrods argued that the use of the domain name was without due cause. The defendants gave a misrepresentation when they registered the domain name. The intention of the activity is to make profit on the back of the well-known name “Harrods”. Further, the use would harm the distinctive character of the mark because it would dilute the strength of the Harrods mark. This would result in a third party presenting itself to the world under the sign ‘Harrods’. Consequently, Harrods would be prevented from using the domain name itself and building up a further reputation.<sup>62</sup>

### **2.2.2.b Passing off**

If the party claiming to use and ownership of the domain name does not have a registered trademark, he may turn to the common law tort of passing off. The classic trinity of passing off is goodwill of the plaintiff, misrepresentation by the defendant and consequent damage.<sup>63</sup> In judgments, courts usually look at the five essential requirements enumerated by Lord Diplock in *Erven Warnink BV v. J. Townsend & Sons (Hull) Ltd*<sup>64</sup> as follows:

- There must be a misrepresentation;

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<sup>60</sup> Nick Gardner, “The Harrods Case: protecting your name on the Internet; SCL Electronic Magazine Apr/May 97 Vol 8 Issue 1, original source: [www.scl.org](http://www.scl.org)

<sup>61</sup> W.R. Cornish, *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights*, Fourth Edition, London, Sweet & Maxwell, 1999, at 726, 629. Cornish observed the limitation of ‘well known’ in the Paris International Convention sense, i.e. it ‘requires proof of a substantial degree of recognition, though how high a degree is not defined’ he further points out in the footnote that the aim of the convention to give well known but unregistered marks protection is largely fulfilled by passing-off in U.K.

<sup>62</sup> Nick Gardner, “The Harrods Case: protecting your name on the Internet; SCL Electronic Magazine Apr/May 97 Vol 8 Issue 1, original source: [www.scl.org](http://www.scl.org)

<sup>63</sup> *Reckitt & Colman v. Borden* [1990] R.P.C. 340, HL, at 499

<sup>64</sup> [1979] A.C. 731 at 742

- The misrepresentation must be made by a trader in the course of trade;
- The misrepresentation must be made to prospective customers of his or ultimate consumers of goods or services supplied by him;
- The misrepresentation must be calculated to injure the business or goodwill of another trader; and
- The misrepresentation must cause actual damage to a business or goodwill of the trader by whom the action is brought or will probably do so.

An early case in relation to domain name disputes and passing off is *Pitman Training Limited and PTC Oxford v. Nominet UK Ltd and Person Professional Ltd*<sup>65</sup>. Since neither party had a registered trademark, this dispute was addressed under the common law tort of passing off. Pitman Training Limited and Pearson Plc were the legitimate owners of the same trade name 'Pitman' in the UK within their respective classes of business. Pearson plc was the first to register the domain name 'pitman.co.uk'. Unfortunately, this domain name was reallocated in error by Nominet to Pitman Training Limited. As a result, Pearson Plc was deprived of its registration. After discovering the error, Pearson Plc complained to Nominet and made Nominet reallocate the domain name to it. Pitman Training Limited's argument that the reversion of the domain name to Pearson Plc would constitute passing off was rejected by the court. It was held that no evidence showed that the general public has associated the domain name with PTC Oxford since Pitman Training Limited only received two emails during the period of ten months' operation. Though this case highlights the importance of early registration in situations of competing legitimate rights, the rulings does not mean that passing off will never succeed against someone who registered the name first in time but has no connection with or real interest in the domain name.

Passing off in its traditional form arguably has limits in addressing domain name disputes of cybersquatting if the cybersquatter does not threaten to use to permit others to use the domain name in a manner that is misleading and would cause damage to the business or goodwill of the plaintiff.<sup>66</sup> The issue of whether or not the

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<sup>65</sup> High Court Ch D 22 May 1997

<sup>66</sup> Rembert Meyer-Rochow, The application of passing off as a remedy against domain name piracy, E.I.P.R. 1998, 20(11), at 408

requirements of passing off can be adapted so as to provide a proper remedy against cybersquatter has significant implications.

The landmark case in the evolution of tort of passing off against cybersquatting is *British Telecommunications Plc and Others v. One in a Million Ltd and Others*.<sup>67</sup> The defendants registered many famous trademarks of British companies as domain names, such as markandspencer.com, burger-king.com, britishtele.com and etc. it attempted to sell them to the plaintiffs. There was no direct infringing use of the trademarks in association with the plaintiff's goods and services. The plaintiff sought injunctive relief, alleging passing off and infringement of their trademarks and applied for summary judgment. The court granted injunctive relief against the defendant on the basis of passing off, because the motive of the defendants was to use the plaintiff's goodwill, the defendants made explicit threats to sell the domain name to others who might use it for passing off, and any future use of a domain name which was similar or identical to 'household names' would inevitably amount to passing off.

Thus the systematic registration of well-known trademarks as domain names with a view to blocking true owners' registration and threat to sell them to others are sufficient to convince the court that ingredients needed to establish passing off were met. Rochow argues that the court's statement recognising the flexibility of passing off indicates a welcome message that passing off may develop to provide remedies in disputes in relation to alleged misappropriation of reputation without exactly meeting Lord Diplock's five requirements and the court's decision may lay the foundation for the modification of the requirement of passing off that a risk of misrepresentation to consumers and damage to a plaintiff's business or goodwill would suffice.<sup>68</sup>

As admitted by Aldous L.J. the ambit of passing off set out in the Avocaat case and Jif lemon case was expanded in order to reach the decision. He argued that the five characteristics set by Lord Diplock should not be used to improperly constrain the action, but rather must develop so as to tackle changes in methods of trade and communication. He stressed the concept of the registration of a domain name being an instrument of fraud and that the court had the right to infer this form of evidence.

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<sup>67</sup> [1999] E.T.M.R. 61.

<sup>68</sup> Rembert Meyer-Rochow, The application of passing off as a remedy against domain name piracy, E.I.P.R. 1998, 20(11), at 408

However, Gordon-Pullar submits that it is difficult to see how registering domain name would become ‘instrument of deception’ and consequently the legal reasoning behind the case in finding passing off may be doubtful.<sup>69</sup> There are also suspicions that the result of the case was out of a policy consideration due to great commercial pressure rather than a straight application of the law of passing off.<sup>70</sup>

Despite the controversies, the decision of the court of appeal demonstrates that the UK courts will not condone the practice of cybersquatting and it brings English law into line with the international position of battling against cybersquatters. The court did whatever it could to stop the cybersquatters from sitting on the registered domain names incorporating famous marks or names with the intention of offering those domain names for sale at a premium. However, it is noteworthy that not every registration of a domain name would constitute ‘instrument of fraud’. Further, by reference to the judgment in *Glaxo Plc v. Glaxowellcome limited*<sup>71</sup> judge Sumption pointed out that mere registration of a deceptive Internet domain name does not constitute passing off. Thus, the outcome depends on the facts of particular case. For the courts to follow the One in a Million in assessing the establishment of passing off, the goodwill, ‘the similarity of the names, the intention of the defendant, the type of trade and all the other surrounding circumstances’<sup>72</sup> should be taken into consideration.

### 2.2.2.c Common Law Conspiracy

The common law conspiracy may be a peripheral action available for domain name disputes as raised in the Harrods case.

*Lonrho v Fayed*<sup>73</sup> sets forth the ingredients of conspiracy as a tort in civil law. Two distinct forms are actionable. Firstly, it constitutes a civil tort if there is an agreement between two or more persons to carry out an illegitimate act, which caused harm to the plaintiff. Secondly, it also suffices if there is an agreement between two or more

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<sup>69</sup> Gordon-Pullar, ‘One in a Million? –The Not Uncommon Practice of Domain name Grabbing Finally Gets Its Come Uppance’, Computer & Telecommunications law review (1998).

<sup>70</sup> Clive D. Throne and Simon Bennett, ‘Domain Names-Inetrnet Warehousing: Has Protection of Well-Known Names on the Internet Gone Too Far’, EIPR, 20 (12), 1998, at 468.

<sup>71</sup> [1996] F.S.R. 388 in this case, it was held “the mere creation of an ‘instrument of deception’ without either using it for deception or putting it into the hands of someone else to do so, is not passing off”.

<sup>72</sup> British Telecommunications Plc and Others v. One in a Million Ltd and Others, [1999] E.T.M.R. 61 at 63

<sup>73</sup> [1992] AC 448

persons to carry out an act which itself is legitimate but primary purpose is to injure the plaintiff.

In Harrods case, Harrods argued that the purpose of the agreement between the defendants to register the name was either to extract financial compensation for its return or allow unrelated third parties to operate the website using Harrods name, both of which were intended to harm Harrods.<sup>74</sup> However, since the defendants did not turn up, no reasoned judgment was given in the case. Whether common law conspiracy would be appropriate action for trademark owner in domain name disputes remains to be seen.

### **3. Conclusion:**

One of the major issues tackled in this paper is whether the current legal scheme in the United Kingdom and the United States provide an adequate protection to Internet domain names in the context of trademarks. It showed that in certain domain name cases, an effective remedy can be obtained through the British and American courts. However, examining the legislations in these two jurisdictions, suggest that certain aspects of domain names have a very little protection and in some cases no protection at all. The paper also explained due to the significant differences between trademark law and domain names, how these aspects lie beyond the reach of trademark law.

To protect domain names more adequately and accurately, it should be noted that just as no one single type of dispute exists, there is no one single model to solve the problem. It may be naïve and impractical to conceive a single dispute resolution for all kinds of domain name and trademark disputes because of the numerous technical, legal and factual issues involved. Due to their corresponding strengths and weakness, I am of the opinion that the court system and the regulatory system should go hand in hand and supplement each other in dealing with these disputes. A combination of reshaping domain name system, developing traditional trademark law, enacting special legislation and improving current alternative dispute resolution proceedings are key to achieve positive results. But even this, has to be implemented carefully, For example, changing the nature of the domain name registration system would probably

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<sup>74</sup> Nick Gardner, "The Harrods Case: protecting your name on the Internet; SCL Electronic Magazine Apr/May 97 Vol 8 Issue 1, original source: [www.scl.org](http://www.scl.org)

eliminate part of the cybersquatting problem. However, Spyros Maniates, stresses that changing the nature may cause distortion to the nature of the Internet as the cost of registration will rise accordingly.<sup>75</sup>

It is also believed that a global domain name convention, through a universal body such as the UN would partly achieve this purpose. This global convention will simply ensure that member states offer “basic” domain name protection. However, implementation of that protection will remain a matter of national law, and there exists wide disagreement over the appropriate scope of protection for domain name beyond very basic notions.

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<sup>75</sup> Spyros M. Maniatis, “TRADE MARK LAW AND DOMAIN NAMES: BACK TO BASICS”  
E.I.P.R. 2002, 24(8), 397-408)