

● **Seeing Double – The Challenges of Trade Mark Law on the Internet**

Presented by Janna Lam



Topic

- Trade marks on the internet – Who is in-charge?
- Domain Name System vs Rights of trade mark owners

Contents

- What is a domain name?
- How is domain name related to and different from TM?
- Why register your TM as domain names?
- How to BRAND your domain names?
- Your protection on the internet
- Trade marks on the internet – New gTLD
- Conclusion

What is Domain Name?

www.mybrand.com → **gTLD**
(generic top level domain)

www.mybrand.com.sg → **ccTLD**
(country code top level domain)

- Your identity
- Your brand on the internet



What's in the domain name?

- Your company name?
- Your product name?
- Your service name?
- Your category?
- Your TRADEMARK?

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Why is domain name important?

- twin of trademark (twin rights)
- can mitigate marketing costs
- build brand recognition
- give a web site the early traffic boost
- conveys a strong message about type of content
- arena for trademarks infringement




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How to use your domain name?

- Create online branding
- Create awareness of new products or services
- Gain competitive edge
- Another marketing strategy

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How is domain name related to TM?

- Both are Branding Tools
- Domain Name is the partner to market the Trade Mark in the internet
- Early alerts on Trademark infringements

NO DOMAIN NAME WITHOUT TRADEMARK

NO TRADEMARK WITHOUT DOMAIN NAME


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How is domain name different to TM?

- Registration of descriptive names allowed
- Allow confusingly, similar variations
- Rarely an objection system
- Renewal without proof of use
- No two companies can have the same name under the same top-level
- Limiting registration to locally incorporated entities
- May be limited to one domain name per organization e.g. co.jp

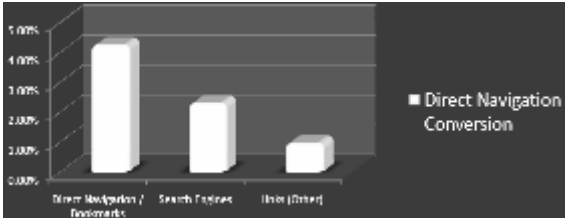
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Why register your TM as domain name?

- Surfer's behaviour – direct navigation and bookmarks


70% of users use direct navigation (survey by WestSideStory)



Method	Direct Navigation Conversion
Direct Navigation / Bookmarks	~4.5%
Search Engines	~2.5%
Links (Other)	~1.5%

- Search Engines – optimize your ranking
- Links (others)


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How to BRAND your domain name?

- Register gTLD/ccTLD in your business zone/interest
- Create traffic to your main website
- Many domain name means better search ranking
- SEO strategy – put yourself on the top 20 organic ranking
- New gTLD branding strategy

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Grounds for Disputes

- Competition between 2 parties with competing rights
- Licensee / distributor disagreements
- Free speech / fair criticism
- Diversion of web traffic e.g. paypal.com vs paypal.com
- Clashes between tradename/trademark and domain names


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Your Protection on the Internet

- Negotiation
- Purchase
- Ambush At Renewal
- Administrative Proceedings
 - UDRP (Uniform Dispute Resolution Policy)
 - Identical or confusingly similar to a TM or SM
 - Absence of rights and legitimate interests
 - Used in bad faith
 - Nominet UK - free mediation, examination by panelist
- The Courts

UDRP – Uniform Dispute Resolutions Policy

1. Domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights
 - Google® loses google.com.cn
 - Superiority of trademarks diminishing?




UDRP – Uniform Dispute Resolutions Policy

2. Respondent has no rights or legitimate interests in respect of the domain name

- Trademarks search of name at issue
- Company registry search of Respondent
- Respondent commonly known by the domain name in the place he/she lives or operates in
- Respondent demonstrates preparations to use the name in connection with a bona fide offering of goods or services
- Respondent making legitimate use of the domain name without intent for commercial gain to misleadingly divert consumers to tarnish the trademark rights

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UDRP – Uniform Dispute Resolutions Policy

3. The domain name has been registered and is being used in bad faith.

Acquire evidence of intention of Registrant to have

- registered the domain name for the purpose of profiting from sale to the trademark owner (Complainant) or to the competitor of the Complainant
- registered the domain name for disrupting the business of a competitor
- used the domain name to confuse consumers with the Complainant's mark as to the source, sponsorship and affiliation of the website


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Preparing Evidential Support


- Find out if the registrant owns a list of domain names which contain trademarked denominations
- Check if these domain names have active websites or passive websites
- Has the registrant been involved in other domain name disputes
- Are the contact information in the registry record correct?

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Trademarks on the Internet

- ICANN – Internet Corporation for Assigned Names and Numbers
 - Non profit organization
 - Overlook the workings of the internet
 - Manage root servers around the world
 - Only ICANN Certified Registrars allowed to register gTLDs
- Introduction of New gTLD




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New gTLD Initiative

- New gTLDs – generic Top Level Domains
 - .web (truly generic)
 - .doctor (specialised community)
 - .paris(geographic)
- Or...

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New gTLD: pTLDs

- *proprietary Top Level Domains for use on the Internet “pTLDs”*
 - .mycompany
 - .ibm, .nike, .gucci, .sony, .pepsi, .google

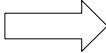
An exclusive and authoritative TLD managed by your company for your external and/or internal use

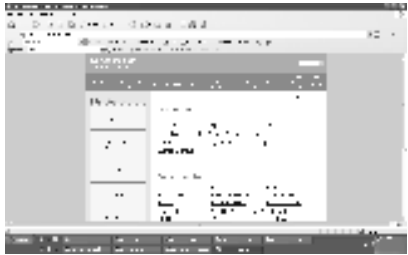
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New gTLD: TLD Statistics

- 70% of users use direct navigation
- Up to 14% (approx 100,000 per week) of new registrations in .com and .net are registered for 'pay per click' advertising

<http://www.sonystore.com> 



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New gTLD: pTLD Opportunities

- Streamlined internet presence
 - Direct navigation
 - Intuitive for end users
- Exclusivity and differentiation
 - Separation in a saturated market
- Enhanced marketing and product segmentation capabilities
 - Product / brand driven
- "Globalisation" of your brand

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New pTLD: Maximizing Your Brand

- A superior marketing and online brand tool
- Reflects the image of the organization
- Significant benefits for your clients
 - Direct Navigation
 - Authoritative namespace
 - You own 'the' place for your brand... forever
 - May be gradually integrated into online strategy
 - Perception of being an innovative organization


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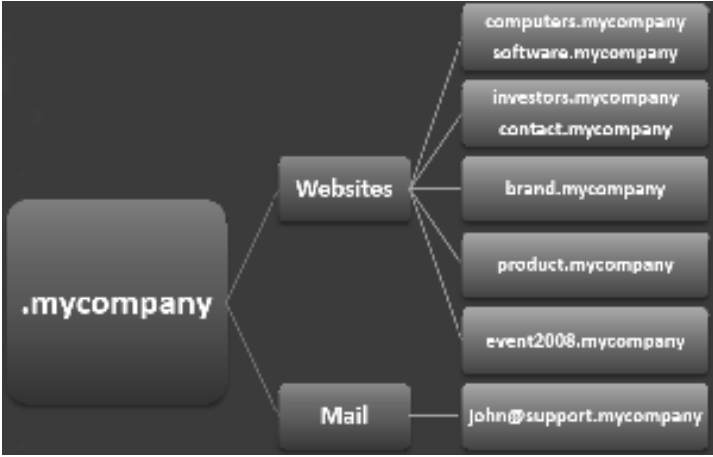
New pTLD: Search Engine Optimization

- Impact from new TLDs
 - Will place pTLD's higher in search rankings
 - Commercial interest to provide authoritative results for their users
- Reduce your SEO expenditure
 - pTLD's will be higher in rankings
- Missing this opportunity may require increased SEO expenditure
 - Likely to be 500+ new TLDs from this process
 - There will be increased reliance on Search Engines

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New pTLD: Potential Uses



.mycompany


Websites

- computers.mycompany
- software.mycompany
- investors.mycompany
- contact.mycompany
- brand.mycompany
- product.mycompany
- event2008.mycompany

Mail

- John@support.mycompany


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New pTLD: Protecting Your Brand

- This may be a once off opportunity
- Other participants in your industry will almost certainly take this opportunity
- You may lose your TLD
 - Do you have to buy it back later?
 - Legal battles
- You are already losing traffic
 - Domain name monetization
 - Difficulties in getting clear message to your clients

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New pTLD: How to get one?

- ICANN released a draft application process for new TLDs in October 2008
- Most recent rounds
 - 2000 (gTLDs) - .info, .biz, .aero
 - 2004 (sTLDs) - .asia, .mobi, .jobs & the failed .xxx
- The parameters around how these new TLDs will be provisioned is now open for comment
- There will be a limited application period

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New pTLD: Timeline

Q4 2008
Draft RFP Posted

↓

Q1 2009
Final RFP Approved


↓

Q2 2009
Applications Accepted

↓

Q3 2009
Successful TLD Applications Approved


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New pTLD: Why Act Now?

- Limited window of opportunity
 - Application period will be opening soon
 - Not sure when it may open again (if ever!)
- If not you... Someone else!
 - Competitors
 - Acronyms


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New pTLD: Legal Benefits

- Domain Name Dispute Resolution Process –WIPO
- Control over the TLD
 - Delegation of responsibility
 - Development of policy
- Enhances your trademarks and patents
 - brand.mycompnay
 - product.mycompany
- Your future trademarks and brands will be available for your use on the Internet


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New pTLD: Financial Benefits

- Comparatively low investment required to protect / develop your online brand
- Comparatively high risk of not investing
 - Someone else may take it
 - Your competition may utilise this opportunity
 - Monitoring of the process to protect your brand
- May incur substantial costs and it may not be possible to obtain the TLD at a later date
- Focus on building your home on the internet and enhancing online brand equity

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New pTLD: Technical Benefits

- Faster DNS resolution
- Reduced reliance on policies of TLD operators
- Build your own set of rules and policies that meet your needs
- Implement new technologies approved by ICANN as and when you wish
 - DNSSEC
 - IDNs
 - And other emerging technologies

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New pTLD: ICANN Requirements

- Receipt of data from Registrars
- Operation of TLD's zone servers
- Must be secure and stable

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TradeMark Implication on New gTLD

ICANN Sydney 2009 – 24 June

- trademark protection; and
- potential for malicious behavior

<http://syd.icann.org/node/3788>



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CONCLUSION

- Trademarks & Domain Names: Megatrend of Naming
- Corporate domain name strategy implies at trademark level and corporate identity level
- Costs of protecting against potential harm vs costs of taking action
- Operational efficiencies:
 - access to effective technical management tools (CCTLD BOX)
 - early awareness (domain newsletters)
 - experienced legal practitioners

Contact Us

IP Mirror Pte Ltd
47 Duxton Road
Singapore 089511
<http://www.ipmirror.com>
Email: sales@ipmirror.com

Thank You