

# Shannon Ling - UP822313

*by* Shannon Ling

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# Domain Name Disputes: Is Protection in the UK Sufficient for Trademark Owners?

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Word Count: 1602

### Synopsis:

Domain name disputes have been occurring since the rise of the internet, with individuals purchasing domain names that are potentially affiliated with a brand through a registered trademark. This was the issue in the first case on this issue; *One in a Million v BT Plc and others*.<sup>1</sup> In this case, the domain name purchasers bought reputable trademarks in order to profit off of the companies in question, including BT and Sainsburys. In the UK, there is no statute that specifically deals with domain name disputes, and claimants often find themselves relying on trademark infringement and the tort of passing off in order to obtain a remedy.

There are three main types of domain name disputes: cybersquatting, typosquatting and reverse domain name hijacking. Typically, when a dispute arises, claimants go through the Uniform Dispute Resolution Policy (UDRP) which was established by the Internet Corporation for Assigned Names and Numbers (ICANN), thus offering some protection to UK trademark owners.

However, other jurisdictions such as Australia and America have their own framework for dealing with domain name disputes. Australia for example have the auDRP, which is purely for Australian disputes, and America has the Anticybersquatting Consumer Protection Act which makes cybersquatting prohibited under federal law, making it a criminal offence in the US.

As mentioned above, there is no UK based framework for dealing specifically with domain name disputes, despite it having been a problem for over 20 years. This research will therefore discuss whether the actions in the UK are sufficient compared to the protection other jurisdictions offer through specific domestic frameworks. Concluding comments will consider whether the UK should develop a specific framework in the future or whether the current protection is adequate.

This topic is becoming increasingly relevant with the shift from an analogue world to a digital one, with more and more people commanding an online presence and with more generic top-level domain names being made available. The potential for domain name disputes is thus increasing and therefore consideration needs to be given to assess whether the framework of protection for UK trademark owners is sufficient and adequate within the UK.




### Research Questions:

The overarching question of this dissertation asks whether the protection in the UK concerning domain name disputes is sufficient. To give a complete and analytical answer to this, other questions will be asked in order to give an overall picture.

- 1) How effective is the current protection in the UK?
- 2) Is the protection offered by other jurisdictions effective?
- 3) Should the UK adopt a specific framework for dealing with domain name disputes?

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<sup>1</sup> British Telecommunications Plc and others v One in a Million Ltd [1999] 1 WLR 903

By dealing with these questions, a more comprehensive answer to the overall research question will be achieved, as assessments will be made in order to establish the effectiveness of protection both in the UK and other jurisdictions, thus helping form a solid conclusion.  2

#### Chapter Structure:

##### **Introduction**

The introductory chapter will set out the main arguments and research objectives in question, as well as give a bit of background around the area. The introduction will also set out the main arguments of the dissertation and how it will be structured.

##### **Chapter 1: Trademarks v domain names**

This chapter will consider what constitutes a trademark and what constitutes a domain name. This will include what the statutory requirements are for registering a UK trademark are, and whether a domain name can itself be registered as a trademark. This chapter will also touch on the types of domain names that can be registered.


##### **Chapter 2: What kinds of domain name disputes can arise, and what protection is there currently available?**

This chapter will discuss the three main types of domain name disputes: cybersquatting, typosquatting and reverse domain name hijacking. Once these have been discussed, consideration will be given as to what protection is currently available in the UK, and how effective this protection is. The main types of protection that will be considered are trademark infringement, passing off and the UDRP.

##### **Chapter 3: The future of protection**

This chapter will consider some of the reforms being implemented into the UDRP and will also consider what protection other jurisdictions offer for domain name disputes. This comparative analysis will then form the basis of forming a conclusion as to whether protection in the UK is sufficient when it comes to dealing with domain name disputes.

##### **Conclusion**

Concluding comments will assess whether the UK gives sufficient protection to trademark owners in terms of both the framework available when it comes to a dispute and also in terms of an effective remedy.  3

#### Methodology:

This research will primarily be desk-top based and requires no primary research to be undertaken. Databases such as LexisNexis and Westlaw shall be utilised to find relevant cases, statute and journal articles in order to support arguments and statements, as well as provide up to date and correct information. Library resources including books and online resources will also be utilised to widen the field of research.

#### Literature Review:

When considering what literature to use for this research, consideration will be given to the validity of sources, and due to this, primarily only peer-reviewed journals will be used. During research, a lot of other research essays were available online that whilst may have been interesting and relevant to the chosen topic, are not published within journals and therefore a conscious choice was made to omit these kinds of sources from any future discussion, in order to maintain the validity of the sources.

When finding sources, the date is also important. Ideally sources from the last 10 to 20 years will be used, although older articles will be used where they discuss older cases or to demonstrate the progression or difference of protection offered to trademark owners. If the content of an article is also mainly factual and has not changed than older sources will also be sufficient to use.

There are a lot of trusted websites from various organisations such as ICANN and the World Intellectual Property Office (WIPO), which will be used in order to give factual information such as statistics as well as guidance on how to file a UDRP complaint for example. These websites are from globally trusted organisations and so the risk of bias or invalidity is minimal making them trusted sources to use for the final dissertation.

In terms of books, there are not many that are specific to the research question, although there is a book by Malin Edmar and Jeanette Soderlund Sause,<sup>2</sup> that explains how the domain name system works as well as considering what protection is available to trademark owners. This literature will therefore be essential when looking at the domain name system and the types of domain names there are.

In regard to academic articles, reputable journals will be considered such as the European Intellectual Property Review, the Denning Law Journal and Information and Communications Technology Law. The majority of the literature will support analysis about how sufficient UK protection is, and there are also articles such as those by Alpana Roy and Althaf Marsoof,<sup>3</sup> which looks at other jurisdictions and how effective the protection is there.

Relevant statute such as the Trademarks Act,<sup>4</sup> will also be looked at to both distinguish what constitutes a trademark and also when trademark infringement has occurred. Alongside this, relevant case law will be cited to show the UK court's stance on domain name disputes and what remedies have been offered to successful claimants.

To show some of the sources available on the topic, a non-exhaustive list has been compiled:

#### *Websites*

<https://www.icann.org/resources/pages/help/dndr/udrp-en>

<https://www.wipo.int/amc/en/domains/guide/>

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<sup>2</sup> Malin Edmar and Jeanette Soderlund Sause, *Domain Names: strategies and legal aspects* (Sweet & Maxwell 2015)

<sup>3</sup> Alpana Roy and Althaf Marsoof, 'A Critical and Comparative Review of auDRP and UDRP Domain Name Decisions' (2016) 19 (5/6) *Journal of World Intellectual Property* 203

<sup>4</sup> Trademarks Act 1994

[https://www.wipo.int/sme/en/e\\_commerce/domain\\_names.htm](https://www.wipo.int/sme/en/e_commerce/domain_names.htm)

<https://www.usenix.org/conference/usenixsecurity14/technical-sessions/presentation/szurdi>

[https://www.americanbar.org/groups/business\\_law/publications/blt/2016/06/cyber\\_center\\_kurtzman/](https://www.americanbar.org/groups/business_law/publications/blt/2016/06/cyber_center_kurtzman/)

#### *Academic Articles*

James Plotkin, 'The Model for a Path Forward. A Proposal for a Model Law Dealing with Cyber-Squatting and Other Abusive Domain Name Practices' (2015) 27 Denning Law Journal 204

Alpana Roy, 'Internet Domain Name Dispute Resolution in Australia' (2014) 36 (8) European Intellectual Property Review 492

Swati Deva, 'What's in a Name? Disputes Relating to Domain Names in India' (2005) 19 (2) 161

Jeffrey M Samuels and Linda B Samuels, 'Internet Domain Names: The Uniform Dispute Resolution Policy' (2003) 40 (4) 885

Christine Haight Farley, 'Confusing the Similarity of Trademark Law in Domain Name Disputes' (2019) 52 (3) Akron Law Review 607

Julien Chaisse, 'The Merging of Two Worlds? Cyber Law and Trade Law Normative Convergence on Internet Domain Names' (2019) 37 (2) Boston University International Law Journal 281

Ian Blackshaw, 'Settling Sports Domain Name Disputes through the World Intellectual Property Organisation' (2009) 10 (1) Business Law International 61

Mindy P Fox, 'Does it Really Suck: The Impact of Cutting-Edge Marketing Tactics on Internet Trademark Law and Gripe Site Domain Name Disputes' (2009) 20 Fordham Intellectual Property, Media & Entertainment Law Journal 225

Michael Karanicolas, 'The New Cybersquatters: The Evolution of Trademark Enforcement in the Domain Name Space' 30 (2) Fordham Intellectual Property, Media and Entertainment Law 399

Isabel Davies, 'Arsenal fall foul of Laddie's unexpected strike' (2001) 9 (1) Journal of Brand Management 63

Jonathan Mayner, 'New search term marketing case' (2014) 15 (4) Journal of Direct, Data & Digital Marketing Practice 344

Alice Blythe, 'Misrepresentation, Confusion and the Average Consumer: To what extent are the Tests for Passing Off and Likelihood of Confusion Within Trade Mark Law Identical?' (2015) 37 (8) 484

Anan Shawqui Younes, 'Trademarks and Domain Names: Exploring the Inadequacy of Existing Protection for the Economic Value of Trade Marks' (2012) 34 (12) European Intellectual Property Review 847



### Research Timetable

Chapter 1 – submit for feedback by June

Chapter 2 – submit for feedback by July

Chapter 3 – submit for feedback by August

Introduction and Conclusion will be completed alongside and submitted when complete and in line with contents of the dissertation itself.





## **Bibliography**

### **Primary Sources**

#### UK Statute:

Trademarks Act 1994

#### UK Cases:

British Telecommunications Plc and others v One in a Million Ltd [1999] 1 WLR 903

### **Secondary Sources**

Alice Blythe, 'Misrepresentation, Confusion and the Average Consumer: To what extent are the Tests for Passing Off and Likelihood of Confusion Within Trade Mark Law Identical?' (2015) 37 (8) 484

Alpana Roy and Althaf Marsoof, 'A Critical and Comparative Review of auDRP and UDRP Domain Name Decisions' (2016) 19 (5/6) Journal of World Intellectual Property 203

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Christine Haight Farley, 'Confusing the Similarity of Trademark Law in Domain Name Disputes' (2019) 52 (3) Akron Law Review 607

[https://www.americanbar.org/groups/business\\_law/publications/blt/2016/06/cyber\\_center\\_kurtzman/](https://www.americanbar.org/groups/business_law/publications/blt/2016/06/cyber_center_kurtzman/)

<https://www.icann.org/resources/pages/help/dndr/udrp-en>

<https://www.usenix.org/conference/usenixsecurity14/technical-sessions/presentation/szurdi>

<https://www.wipo.int/amc/en/domains/guide/>

[https://www.wipo.int/sme/en/e\\_commerce/domain\\_names.htm](https://www.wipo.int/sme/en/e_commerce/domain_names.htm)

Ian Blackshaw, 'Settling Sports Domain Name Disputes through the World Intellectual Property Organisation' (2009) 10 (1) Business Law International 61

Isabel Davies, 'Arsenal fall foul of Laddie's unexpected strike' (2001) 9 (1) Journal of Brand Management 63

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Mindy P Fox, 'Does it Really Suck: The Impact of Cutting-Edge Marketing Tactics on Internet Trademark Law and Gripe Site Domain Name Disputes' (2009) 20 Fordham Intellectual Property, Media & Entertainment Law Journal 225

Swati Deva, 'What's in a Name? Disputes Relating to Domain Names in India' (2005) 19 (2) 161

## Ethical opinion form for Faculty of Business and Law (BAL) taught undergraduate and postgraduate students **(except MRes)**

1. What are the objectives of the dissertation / research project?

**To consider what protection is available to trademark owners in the UK when a domain name dispute that involves a registered trademark or one with confusing similarity. A comparison will be made between protection offered in the UK and other jurisdictions internationally.**

2. Does the research involve *NHS patients, resources or staff*? YES / NO (please delete as applicable).

If YES, it is likely that full ethical review must be obtained from the NHS process before the research can start. Please discuss your proposal with your Supervisor and/or Course Leader and consult the Guidance Notes for this ethics form.

**NO**

3. Does the research involve MoD staff? YES / NO (please delete as applicable).

If YES, then ethical review may need to be undertaken by MoD REC. Please discuss your proposal with your Supervisor and/or Course Leader and consult the Guidance Notes for this ethics form.

**NO**

4. Do you intend to collect *primary data* from human subjects or data that are identifiable with individuals? (This includes, for example, questionnaires and interviews.) YES / NO (please delete as applicable)

If you do not intend to collect such primary data then please go to question 11.

If you do intend to collect such primary data then please respond to ALL the questions from Q5 onwards. If you feel a question does not apply then please respond with 'n/a' (for 'not applicable').

**NO**

5. How will the primary data contribute to the objectives of the dissertation / research project?

**N/A**

6. What is/are the *survey population(s)*?

**N/A**

7. a) How big is the *sample* for each of the survey populations, and b) how was this sample arrived at? (Please answer *both* parts of this question.)

**N/A**

8. How will respondents be a) *recruited* and b) *selected*? (Please answer *both* parts of this question.)

**N/A**

9. What steps are proposed to ensure that the requirements of *informed consent* will be met for those taking part in the research? If an Information Sheet for participants is to be used, please attach it to this form. If not, please explain how you will be able to demonstrate that informed consent has been gained from participants.

**N/A**

10. How will *data* be *collected* from each of the sample groups?

**N/A**

11. a) How will *data* be stored and b) what will happen to the data at the end of the research? (Please answer *both* parts of this question.)

**N/A and N/A**

12. What measures will be taken to prevent unauthorised persons gaining access to the data, and especially to data that may be attributed to identifiable individuals?

**N/A**

13. What steps are proposed to safeguard the *anonymity* of the respondents?

**N/A**

14. Are there any *risks* (physical or other, including reputational) to *respondents* that may result from taking part in this research? YES / NO (please delete as applicable).

If YES, please specify and state what measures are proposed to deal with these risks.

**N/A**

15. Are there any *risks* (physical or other, including reputational) to *the researcher or to the University* that may result from conducting this research? YES / NO (please delete as applicable).

If YES, please specify and state what measures are proposed to manage these risks.

**N/A**

16. Will any *data* be obtained from a company or other organisation? YES / NO (please delete as applicable) For example, information provided by an employer or its employees.

If NO, then please go to question 19.

**N/A**

17. What steps are proposed to ensure that the requirements of *informed consent* will be met for that organisation? How will *confidentiality* be assured for the organisation?

**N/A**

18. Does the organisation have its own ethics procedure relating to the research you intend to carry out? YES / NO (please delete as applicable).

If YES, the University will require written evidence from the organisation that they have approved the research.

**N/A**

19. Will the proposed research involve any of the following (please put a ✓ next to 'yes' or 'no'; consult your supervisor if you are unsure):

- Vulnerable groups (e.g. children and adults unable to consent)? YES  NO
- Particularly sensitive topics? YES  NO

- Access to respondents via 'gatekeepers'? YES  NO
- Use of deception? YES  NO
- Access to confidential personal data (names, addresses, etc)? YES  NO
- Psychological stress, anxiety, etc.? YES  NO
- Intrusive interventions? YES  NO

If answers to any of the above are "YES", please explain below how you intend to minimise the associated risks.

20. Are there any other ethical issues that may arise from the proposed research?

**NO**

	Print name	Signature	Date signed
Student	Shannon Ling	S.Ling	29/02/2020

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I / we grant a favourable ethical opinion:

Supervisor	Joe Sekhon	<i>J.S. Sekhon</i>	02/03/2020
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Peer reviewer (where applicable)	<i>Fang Ma FM</i>		
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*08/04/2020*

# Shannon Ling - UP822313

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## GRADEMARK REPORT

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FINAL GRADE

67 /100

GENERAL COMMENTS

### Instructor

The student has submitted a strong proposal.

The student has demonstrated a clear understanding of the law relating to domain name disputes and understands there are a number of methods that can be deployed to deal with such disputes.

The methodology and literature review comments are also appropriate as is the proposed timeline.

I would suggest the student make an appointment with me once all the TB2 assessments have been submitted to discuss a roadmap for the dissertation over the summer.

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### Comment 1

I think your synopsis makes a number of appropriate observations. The UK does have specific process by which to deal with UK domain disputes (<https://www.nominet.uk/domain-support/uk-domain-disputes/>); however your question is still valid; is it sufficient to deal with the volume of and the international nature of such disputes?

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### Comment 2

Yes your research objectives are clear; perhaps reference to critically evaluating the IPRs that may also be relevant such as trade mark law?



### Comment 3

Your chapter framework is also appropriate. Perhaps consider a chapter on the approach taken in one other jurisdiction?

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### Comment 4

Your methodology and literature review comments are also appropriate.

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### Comment 5

OK.

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**Text Comment.** Fang Ma FM 08/04/2020