

Chapter 4. Domain Names

4.1. Registered Trade Marks and other forms of name protection

4.1.1. Registered Trade Marks

What are trade marks? They are an intellectual property right, just like copyright. A trade mark is a distinctive symbol that identifies through established use particular products or services of a trader to the general public. The symbol may consist of a device (in other words, an image, shape or colour), words, or a combination of these¹. The domain name issue is only concerned (at least at present) with words and numbers rather than symbols, images or colours. The owner in general enjoys the exclusive right to use the trade mark in connection with the goods or services with which it is associated. Any person or firm that has a trade connection with the goods or services can obtain a trade mark. For example, he may be the manufacturer, a dealer, importer or retailer. The right may be lost if the trade mark is not used or is misused by others so that it becomes a generic term (for example, Bayer lost the mark 'aspirin' when it became generic). The owner of a trade mark may assign it or allow others to use it. If anyone uses a trade mark without the owner's permission, or uses a mark that is likely to be confused with a trade mark, the owner can obtain an injunction and obtain damages or an account of profits.

Just as with other intellectual property, trade marks give the owner the monopoly right to the mark; in other words, the owner can sue a third party who uses the mark without permission. Marks are used to associate particular goods or services with a particular owner, and, by implication, they give the consumers of the goods or services confidence that those goods and services have a certain minimum quality. There are two types of trade marks: Registered Trade Marks, and Unregistered Trade Marks, often known as trade names. The latter are dealt with in 4.1.2. below. A registered trade mark involves the formal registration of a name or mark that is used to identify a particular product or service. Anyone else who uses the registered trade mark is liable to legal proceedings for infringement. The formalities are complex (rather like obtaining patents), with forms to fill out and fees to be paid.

Obtaining a registered trade mark is therefore a relatively long and expensive process; something not to be undertaken lightly. To obtain a registered trade mark, you must demonstrate that the mark is associated with your goods or services. You must also show that it is not similar or identical to existing reg-

1. In some jurisdictions, smells can be the subject of registered trade marks.

istered trade marks. Finally, you must show that it is not deceptive (in that it implies something that it is not, such as ALLWOOLA for a synthetic fibre). In addition, there are certain marks and symbols for which you cannot obtain registered trade marks (for example, anything obscene, or symbols confusingly similar to the International Red Cross or the Olympic symbols). The cost and time barriers to obtaining registered trade marks are made worse by the fact that little international agreement exists to recognise registered trade marks registered in another country. In other words, unlike copyright where you automatically receive protection worldwide, you will need to go through similar processes for each country in which you want protection. There is a [European] Community trade mark available, but because of the language differences, it is often the case that an organisation wants quite different marks for the same product or service in different countries. After all, a perfectly good registered trade mark in English may turn out to be a rude word in Spanish. That is not a hypothetical example; according to legend, Ford Motor Company fell into that very mistake some years ago. The protection you obtain with a registered trade mark only relates to the class of product or service for which you have registered. Thus, 'food and drink' may be one class, 'dry cleaning services' another. It is therefore perfectly possible that in a given country, you can find several identical registered trade marks, all perfectly valid, but each applying to a particular class of goods or services (for example, 'Apple' computers and 'Apple' records; or 'Swan' kettles and 'Swan'¹ matches).

You also have to pay renewal fees from time to time to keep the registered trade mark in force. You must also keep *using* the mark to keep it in force. Anyone who uses your mark, or something similar, for goods and services you are protected for, can be sued for infringement. It is sufficient to demonstrate that the mark has been used in the course of trade; it makes no difference whether this use was accidental or was deliberate. It is worth stressing again that registration is for the one or more classes of goods or services in which you are active. The regulators rarely approve the granting of monopoly rights for areas of business in which you are not currently active – an important point when it comes to Internet questions. There are certain defences against such an infringement action, but they are limited in scope. Damages can be high. For this reason, if you copy anything from the Internet and then re-dissemi-

1. *It is courteous to acknowledge registered trade marks by putting the names with initial capital letters, in inverted commas, and/or acknowledging the owner of the registered trade mark. I have attempted to do so in this chapter by putting the names, with initial capital letters, in inverted commas.*

nate it, make sure no trade mark or logo is included in what you re-disseminate. Copyright infringement is bad enough, but infringement of registered trade marks can be much more expensive.

Domain names are not the only places where the Internet interacts with trade mark law. There have been cases of copying registered trade marks from one Web site to another. Linking cases such as *Shetland Times* might in the future involve registered trade mark infringement as well as, or instead of, copyright infringement. Meta-tag cases (see below) do not always involve domain names and can sometimes instead involve registered trade marks. The use of registered trade marks in emails, and especially in spamming, can result in infringement actions. A good example is *Gucci America, Inc vs Hall & Associates*, which was decided in the US Courts in 2001. The court held that neither the Communications Decency Act nor the First Amendment saved an Internet hosting company from potential liability for hosting the website of a third party that allegedly infringed the plaintiff's trademark. As a result, the court allowed Gucci to proceed with its claim that, by hosting a third parties' site containing allegedly infringing materials, despite notice of the same, the defendants were guilty of direct or contributory trade mark infringement and false designation of origin. The defendants, Hall & Associates, operated a Web site in which they advertised for sale jewellery bearing the Gucci mark that infringed the plaintiff's mark.

Comparative advertising is another area where trade marks and the law interact. This is where you compare your product or service to another (whose registered trade mark you name) on a Web site. You should consult a lawyer before doing this. However, in general all these cases can be handled in the same manner as routine 'terrestrial' registered trade mark cases.

4.1.2 Other forms of protection for names

A cheap and simple alternative, which is also the precursor to registration, is simply to highlight the name of your product or service as a trade name. This can be achieved on advertising, headed notepaper, wrappings and in countless other ways. It involves no formal registration or fees; indeed many trade names would be rejected (say for being too similar to another registered trade mark) if a formal application for trademark registration for them were filed. It is worth stressing this point: just because a particular mark cannot in law ever be the subject of a registered trade mark does not mean it cannot be used as a trade name. The advantage of a well established trade name is that it gives you some rights to prevent any other person registering the name later, if you can prove you used it first. It also gives you a case if you sue for damages under 'passing off' or under unfair competition laws (it varies from country to country) in cases of infringement. This means passing off your goods and

services as someone else's. To succeed in such an unfair competition or passing off action, you must show your trade name enjoys some reputation, that you suffered some damage, and you must show that the copying of it by the defendant was deliberate. You can do nothing about non-deliberate unintentional 'copying'. Thus, trade names/unfair competition laws are a weaker, but cheaper and more convenient method of protecting your interests than registered trade marks. It really is a matter of judgment which to go for, but remember you can establish your trade name first, and later, maybe many years later, you can go for the registered trade mark, assuming the rules permit it. In addition to registered and unregistered trade marks, most countries provide for other protection for names under company names rules. Whatever the basis, the outcome is similar in all jurisdictions. Rights are given to prevent others from using a name in such a way as to unfairly draw on an established trader's reputation, to damage his reputation by using it in association with inferior products or services, or simply to confuse customers by a plethora of similar names.

The sort of protection offered by these sets of laws is against the effect of the competitor, rather than in rights to the name as such. It therefore depends on the plaintiff enjoying some form of reputation. In some countries, these cases are dealt with as civil offences (someone sues someone else), but in other countries it can also be a criminal offence to deliberately mislead customers.

4.2. Domain names

4.2.1. Introduction

In the previous edition of this Briefing, I stated "I have little doubt that if there is a fourth edition of this Briefing, the chapter on domain names will be significantly longer!" This chapter fulfils that promise. A domain name is a convenient label for an IP address. Domain names form part of email addresses (*C.Oppenheim@lboro.ac.uk*) and URLs (*http://www.lboro.ac.uk*). They are divided up into segments split by full stops (periods). When you enter a domain name into, say, a browser application, the software sends that domain name to one of a number of Domain Name Server computers. The DNS searches its database and identifies the IP address that matches the domain name. It then sends that IP address, which comprises a series of non-mnemonic numbers, back to the requesting software. Once the browser software has the IP address, it can then communicate with that IP address. All this, in the space of time it takes for you to get an error message telling you that the URL does not exist! Is technology not wonderful?

A key consequence of this idea is that each domain name *must* be unique – it can only refer to one IP address. In theory one IP address can correspond to several domain names, but one domain name must always correspond to just one IP address.

For users, domain names are particularly attractive because they are memorable, and tell you a bit about the organisation you are contacting. Names such as *harvard.edu*, *yahoo.co.uk*, *amazon.com*, *dti.gov.uk* and *ibm.com* immediately tell you a lot about where you are heading. My employer, Loughborough University, has a domain name. It is: *www.lboro.ac.uk*. The ground rules for domain names are well known. The first characters after the ubiquitous *www* is the full or shorthand name for the organisation; the next characters (*ac*, *org*, *com*, *edu*) give you a clue of the type of organisation in question (these will shortly expand to others, such as *shop*, *arts*, *firm*, *web*, *info*...); and the final characters (*uk*) gives you the geographic location of the organisation. The lack of any such geographic marker means, by default, we are dealing with the USA. This is a not dissimilar situation to that of postage stamps where the first country in the world to develop them (Britain) has, by international agreement, retained the unique right of not having to identify itself on its stamps.

Domain names are sufficiently memorable that many individuals know a large number of their favourite domain names off by heart. They are often similar to trade marks and/or registered company names associated with the organisation in question. Thus, 'Microsoft' is the registered trade mark, and *microsoft.com* is the company's domain name.

It is these key features – the fact that there can only be one domain name in the entire Internet, and that it is associated with company, product and trade mark names – that makes for a potent legal brew. An enormous, and increasing number of organisations have put up home pages to advertise themselves and their services, including all of the blue chip companies of the world. All these WWW pages, as well as email addresses, involve domain names.

4.2.2. Obtaining a domain name

To obtain a domain name, an organisation undertakes a simple registration with one of the domain name registration bodies. The server owner suggests the domain name he wishes to use, and checks to see if that name has already been taken. Although an enormous number of names have been taken, it is surprising that not all the 'obvious' names have been. For example, until recently, no-one had taken *portfolio.com* or similar names. If the name is not already assigned, it is given to the applicant immediately. It is a case of 'first come, first served' on a worldwide basis. Domain name registration is not just a technical operation on the Internet; it is a key part of the management process. Nowadays, the name of a new company name, or major new product or

service line would not be approved without first checking if the domain name were available. Businesses expect that their registration will be kept intact, and that no identical or confusingly similar domain names will crop up in the future. (There are commercial firms that offer a domain name watching service for a fee, precisely to alleviate fears of such an occurrence). So there are clear rules about obtaining a domain name rapidly but fairly. Unfortunately, though, the system is flawed. No effort is made to check if the proposed domain name is identical to any other name around (such as company name or trade mark), or whether it is confusingly similar to an existing domain name.

This is a crucial difference from registered trade marks. You cannot obtain a registered trade mark if the proposed mark is the same, or confusingly similar, to any existing mark, or company name (unless, of course, it is *your own* company's name!) In a nutshell, the checks associated with trade marks do not occur with domain names, and so the chances of problems arising are that much greater.

4.2.3. *The problems caused by domain names*

The problem arises because domain names are based on addresses that are strings of numbers that have been converted, for human convenience, into memorable mnemonics. This has led to an international race to acquire and become the unique owner of convenient or prized domain names, not unlike the competition in some countries to acquire personalised car registration number plates. The fundamental nature of domain names gives rise to inevitable conflicts. Domain names must be unique worldwide, whereas trade marks need only be unique within a particular class of goods or services and within a particular country. So it is perfectly possible to have multiple identical trade marks in one country (see the 'Swan' and 'Apple' examples noted earlier), and even more multiple marks in many countries. In other words, the same mark can be used in the same country for *different* classes of goods or service. It is not uncommon for different companies *in the same business* to use similar or identical trade marks in different countries. In trade mark law, this is not a problem, for in any one country, one of the marks will be the dominant well-known mark, and other(s) simply cannot be used.

But a quite different problem arises when we come to domain names. Whilst there are no doubt thousands of companies worldwide with the name 'Smith', and hundreds of trade names and registered trade marks worldwide with the name 'Smith', there can only be one *smith.com*, only one *smith.co.uk*, and so on. The law has come to terms with, and works reasonably well at, partitioning the numerous companies and marks with the name 'Smith'. It cannot handle domain names, though. This would not matter if a domain name had little or no commercial value, but as we know, a good memorable domain name can

have considerable value. If you are forced out, it can be costly. For example, consider the Library Association of the UK. It has the awkward domain name *la-hq.org.uk* rather than the intuitive *la.org.uk* no doubt because someone else had already used it.

Imagine there is a small shop in mid-town USA, founded many years ago, which uses the trade mark *Liberty*. It now decides it is time to go into the twentieth century and have an Internet presence. It creates a home page using the domain name *www.liberty.com*. There is a well-known London-based shop known as *Liberty & Co*. The presence of these similar names in two different countries has hitherto caused no problems or confusion for shoppers. No one assumes they are part of the same chain. Now let us assume the British shop decides it will develop a home page, and decides that its domain name shall be called *www.liberty.co.uk*¹. By definition, anyone anywhere in the world can access these URLs using the domain names. So both URLs are available to users in Britain. Can one of the companies sue the other for passing off or for infringement of registered trade marks?

To add to the confusion, there are now many companies whose registered names are, or look like, a domain name (such as *Scoot.com*), and increasingly URLs appear in advertising materials produced by large companies, so are becoming trade names. No doubt many domain names, in addition to being registered with a DNS, have also become registered trade marks.

In a nutshell, in the good old days before the Internet, the coexistence of similar or identical trade marks around the world but each in their geographic compartment where they were dominant was possible, and indeed was common. It is no longer possible due to the global nature of the Internet.

4.2.4. *The types of dispute*

Domain name disputes can be local, or international. In any one country, several organisations may wish to have the same name, such as *infonortics.co.uk*. In such cases, as already noted, it is a case of 'first come, first served'. However, this general principle has been, and can be challenged if it is shown that one organisation is far more prestigious, enjoys a better or better-known name than the first one to claim that domain name. So, the general rule appears to be 'first come, first served, unless you are a small guy, in which case, domain name assignment favours the big battalions'.

1. *This example is purely hypothetical; I have no idea whether there is a Liberty in the USA, or whether Liberty & Co has an Internet presence.*

Even if you have established your domain name in a country, and seen off the competition, that is not an end to the possible disputes. The second type of dispute is where the same, or confusingly similar name, has also been registered in another country. In addition to this national/international dimension, domain name disputes can be broadly classified into a number of headings:

- In some cases, this dispute results from two or more *bona fide* organisations quite legitimately claiming, owning or using the same or similar name or brand.
- Some people have opportunistically claimed a valuable name knowing it would inconvenience a well-known large corporation. They may well then demand large sums of money from the company to assign the domain name to them. A good example is the *Marks and Spencer vs One in a Million* case in Britain.
- Unofficial fan clubs that wish to adopt the name of their hero, team, etc.
- Disgruntled people who have chosen to use well-known names: for example, the disgruntled customer of British Telecom who registered *www.britishtelecom.co.uk* and uses it to spread negative publicity about BT.
- Deliberately misleading domain names, such as the *www.princessdiana* name which was a pornographic site, the Hatewatch group, an anti-racist group whose URL is *www.hatewatch.org*, that has found a racist group using the URL *www.hatewatch.com*, or Ringling Brothers, a well known circus, who found that *www.ringlingbrothers.com* was being used by an animal welfare group, PETA. Oddly enough, PETA had a while ago been at the receiving end of such treatment, finding *www.peta.org* had been taken by an avowed carnivore to promote his belief that eating meat was good.

Metatags are indexing terms added to Web sites by the creator to ensure that the site is noted as a 'hit' when a search strategy is run on one of the Internet search engines. It does not, however, necessarily appear in the title or the text of the Web page. There have been two notable cases involving *Playboy*. In *Playboy vs Calvin Designer Label*, *Playboy* won an injunction to stop a designer jeans shop from using the word 'playboy' as a metatag as it had no connection with the jeans in question. On the other hand, in *Playboy vs Terri Welles*, it failed in a similar attempt because Ms Welles was indeed an ex-*Playboy* model, and she was therefore entitled to use the word as a metatag. Meta tagging may also be used to deliberately divert custom from a well-known company to another one.

4.2.5. How might the disputes be decided?

It has been suggested, and would be acceptable, if there were some cheap, agreed method of arbitration that avoids domain name disputes going to the courts. Maybe one day we shall achieve that laudable aim, perhaps through the World Intellectual Property Organisation, but at present disputes can only be resolved through litigation through national courts – and indeed, they may have to run in several courts in several countries if need be. The Internet Corporation for Assigned Names and Numbers, ICANN, has indeed produced a Dispute Resolution Policy that many organisations have signed up to. Another possible mechanism for avoiding the many disputes would be to permit owners of servers to decide their own suffixes, thereby releasing in principle many domain names. For example, I could set up *oppenheim-company.loughborough* if I wanted. This would not solve the problem, as someone else could (and probably would) set up *oppenheim-compny.loughborough* and my customers would still be confused. Such a system would certainly reduce the number of disputes, albeit at the cost of weakening the well-structured system of domain names that exists at present.

4.2.6 Defences

There appears to be little in the way of formal defence for a ‘bad faith’ registration; it is up to the plaintiff to demonstrate how the defendant had broken the law. In other cases, there may be genuine defences, such as honest concurrent use – “I was already using this name in the course of trade for many years”. In the USA, a defence of non-commercial freedom of speech, and of the right to parody, have been invoked many times. There may be a defence under special circumstances that it was necessary to use the domain name in order to carry out a legitimate business because that business is so closely tied into the domain name in question. A particular problem arises in the use of common personal names; the use of the name for this reason may carry some weight with the courts. This is a particular problem if your name happens to be the same as that of a well-known company, say Krupp, Liberty, McDonald, etc.

4.2.7. What the courts have decided

This is an area that, like Internet libel, has seen a sudden growth in legal cases. Of course, the courts consider the case under their local laws and rules, and this raises the interesting question: what country shall we sue in? This is a topic that is beyond the scope of this Briefing; if you are caught up in a domain name dispute, discuss the matter with a lawyer! Despite the plethora of different legal systems, the results of the major court cases have been fairly consistent, so some general guidance can be provided as to what the courts are likely to say. Virtually all courts, no matter where the case was heard in the

world, have decided on certain common principles in cases where the owner of a mark or domain name has complained that a third party has obtained a domain name that damages their reputation or dilutes their trade mark or domain name. These can be summarised as follows:

- The first come, first served policy in general, but not always, over-rides everything else.
- The odd pieces (*www, com, org, uk* etc) in a domain name are irrelevant when considering a case; the key is the organisation name and it is on that name that the dispute centres. This is because the characters before and after the company name are standard and do not form part of the sign or mark.
- A proprietor of a registered trade mark who makes a complaint regarding a 'bad faith' (see below) registration of a domain name usually wins.
- A proprietor of a registered trade mark who makes a complaint regarding a registration of a domain name where the defendant has an appropriate registered trade mark will not win his case.
- The question of whether the domain name and/or the registered trade mark is actually being used is important. If it is not used, the case being made by the person with the unused trade mark or domain name is severely weakened.
- The length of time of use is also important. If it has taken a long time for the complaint to be made, and in the meantime the defendant's use of the domain name has been heavy, then the complaint is unlikely to succeed.
- The greater the reputation of the registered trade mark, the greater the likelihood of success.
- On the other hand, if the domain name comprises generic or common words, it is less likely that the plaintiff will succeed.

It is also worth noting that whereas in most registered trade mark infringement cases the plaintiff seeks damages and wants the defendant to cease and desist from repeating the offence, in domain name cases, sometimes the plaintiff wants to *acquire* the name from the defendant, or wishes that the third party stops using the name, and rarely wants damages.

Legitimate ownership of similar names

Consider the first type of dispute, with two organisations legitimately owning or using the same or similar name or brand in different countries. A good example is the *Prince plc vs Prince Sports Group plc* case, which was heard in both Britain and America in separate hearings. The decision is, in essence, *the organisation that first uses the name in a domain name usually wins*. So,

despite what was said about taking your time to register a trade mark, you should get in early using your mark in a URL – in other words, get yourself on the Internet as soon as possible! It is clear that there will be more disputes with common names than with unusual names; if you have a common name such as ‘Smith’ or ‘Shah’, the chances are that someone already has your domain name sewn up. If you have a common surname and have a company under that name, you will be in a weak position. The system favours the Oppenheims (and Infonortics) of the world. Note, too, in the *Prince* case, the two companies were in quite different areas of business (computer services and sports, respectively). Thus, not merely are we getting problems because of two companies with the same name in different countries, but they were two companies in quite different fields of business in two different countries.

Cybersquatting, or ‘bad faith’ registrations

What about the second type of case, where some people have opportunistically claimed a valuable name knowing it would inconvenience a well-known large corporation? They may well then demand large sums of money from the well-known company to assign the domain name to them. Such cases, known as ‘cybersquatting’ or ‘bad faith’ registrations have probably received the most publicity. In some jurisdictions, a bad faith registration is now an offence – see, for example, the US Anticybersquatting Consumer Protection Act of 1999. This creates a civil liability for bad faith registrations with intent to profit from domain names that are identical or confusingly similar to registered trade marks or personal names. Large companies, such as Yahoo, Marks & Spencer, Glaxo-Wellcome¹, MTV, Panavision, Lufthansa, British Telecom, Virgin and Delta Airlines have all been targeted. In most of these cases, the courts have ruled in favour of the large well-established companies. McDonalds is probably kicking itself. It paid thousands of dollars to a charity nominated by one Joshua Quittner to acquire the rights he had gained to *www.mcdonalds.com* when it probably would have done better to have taken him to court. Why have the courts ruled in favour of large companies? They have assumed that even if the bad faith domain name had never been used, had it been used it would have damaged the reputation of the large company. Indeed, if the bad faith domain name had not been used, that demonstrated the bad faith nature of the registration, as it clear it was never intended to be used for bona fide business purposes. Demands for money for transfer add to the

1. *Strictly speaking this was a dispute about company names; an entrepreneur had registered the company name Glaxo-Wellcome Ltd. on learning that Glaxo plc was to merge with Wellcome plc, and demanded £100,000 for the assignment of the name. However, the identical principles, and court thinking, apply, and so most commentators have described it in terms of a domain name dispute.*

weight of evidence that the registration was in bad faith. Other courts have decided that the bad faith registration was an instrument of deception. In fact, courts have struggled to get to grips with a legal basis for objecting to cybersquatting. They conclude the person who registers a bad faith domain name is up to no good, but struggle to identify what offence the person has committed.

Cybersquatting has in recent years extended from large companies to well-known individuals, such as actors, actresses, prominent writers and the like. This time, the courts have been less helpful, in the sense that sometimes the famous personalities win and sometimes they do not. There seems to be little rhyme or reason in these decisions, at it appears to be much more of a lottery, dependant upon the particular facts and circumstances. (Such cybersquatting cases are similar to, but not identical to, cases where a well-known person's name has been incorporated into the URL of a pornographic Web site. These are discussed below). All the court cases I know about in this area have involved living individuals. What if the individual is dead, but well-known, such as Princess Diana or Winston Churchill? Would their heirs have any rights to stop cybersquatting on their names? I have no idea.

In one respect, the judgments have been controversial; it is sometimes not clear under what law the judgment has been made. Is the taking of a domain name and then asking for money to assign it, trade mark infringement, theft, demanding money with menaces (blackmail) or what? What is the ethical or legal difference between me having a bright idea ("I've found the cure for the common cold; I'll visit Glaxo Wellcome and see how much it will pay for the patent to be assigned", or "I've just learned that IBM is to build a big factory in Smalltown; I'll open a fast food outlet down the road from their factory and gain from the custom of the IBM employees") and another bright idea ("I'll take out the domain name *www.glaxowellcome.co.uk*: I'll visit Glaxo Wellcome and see how much it will pay for the name to be assigned")?

Despite the clear-cut nature of the decisions so far, sooner or later someone is going to appeal and query the fundamental basis of the courts favouring the big boys against small entrepreneurs who have noted a market opportunity.

Unofficial fan clubs

The third type of dispute, with unofficial fan clubs who wish to adopt the name of their hero, team, etc, have not to my knowledge been heard by a court, and tend to be resolved by a threatening letter. There is little doubt that the unofficial club would lose if a case came to court.

Disgruntled clients

The next type of dispute, involving disgruntled people who have chosen to use well-known names to spread negative publicity about a company, has reached the courts. These so far have found in favour of the companies.

Misleading domain names

The next type of dispute, deliberately misleading domain names, falls into two types. There are the domain names that seem intuitively likely, but lead you to a pornographic site. These seem to be accepted as one of the irritations of the Internet. On the other hand, the second type, the Hatewatch and Ringling Brothers type of cases, have reached the courts, and the decisions usually favour the aggrieved organisations.

Meta tagging

The final type of dispute, on meta tags, depends on whether the courts consider the use of the particular tag were justified. If it were, the aggrieved party is unable to stop this apparent dilution of its mark. Curiously, the most common plaintiff in these cases appears to be Playboy Inc, which is most anxious to ensure that words like 'Playboy' and 'Playmate' do not appear in meta tagging of sites not associated with the company.

4.2.8. The fundamental problem

The fundamental problem is that the Internet is no respecter of national boundaries, and takes no account of the traditional way of carving up business activities that trade mark owners are used to. The problem is exacerbated by the fact that there is no single central worldwide provider or assignor of such domain names that does a check before granting the name. Each country is largely responsible for its own activities, and even in one country, you may find competing services offering domain-naming services.

The problem is also exacerbated because of the natural tendency by the courts to favour the large organisations and those with high reputations over individuals and small and medium sized enterprises. Until WIPO sets up a central domain name issuing authority, which charges significant fees for its services but in return checks that the proposed name is unlikely to confuse or mislead, we will get more court cases and arbitration. What should the prudent manager do in the meantime?

4.2.9. Some advice for the perplexed

My advice is as follows:

- Firstly, make sure you protect all possible relevant names by taking out registered trade marks on them and/or frequently using the unregistered trade names in all business activities. Consider protecting all possible recognisable permutations of well-known names.
- Check whether any names you plan to use are already the subject of registered trade marks or domain names worldwide (or at least, in the major economies of the world). This is expensive, but is a worthwhile investment. Assuming the coast is clear, get the domain registration *quickly* – and in every country in which you plan to do business. Register plausible permutations and variations as well.
- Obtain permissions if you use any third party trade marks on your Web site.
- Avoid using a third party's trade mark in any hyperlinks.
- Never frame a third party's trade mark in your frame.
- Avoid the use of third party trade names in meta tags you use.
- Use the TM mark to indicate your mark is a trade name, or use the ® to show you have a registered trade mark (but do not use the latter mark as a 'frightener' if it is not registered; that could be a criminal offence).¹
- Maintain records on when you started using the marks, and where.
- Do not hesitate to remind people who use your mark casually that the particular mark is a registered trade mark owned by so and so.
- Register appropriate domain names in all the major countries of the world and do a regular search for any sites that use similar or identical marks.
- Do not give in if someone offers to sell you a name you want; consider taking them to court for cybersquatting.
- Keep track of significant court decisions on domain name disputes.

1. *For names and trade marks registered in America, the use of the ® and TM symbols is mandatory when the marks or names are used in America; registrants can lose their protection if they do not display the symbols. Outside America, there is no requirement to use such symbols, though it can be useful in warning others that marks and names are registered. In many countries, it is a criminal offence to claim you have a registered trade mark when you do not, or to make threats of a trade mark infringement action when they are unjustified. So be careful about any warning letters you send out!*

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- Wait patiently for international bodies, such as the World Intellectual Property Organisation, to address the problems.

In the meantime, you can be sure this area is going to continue to represent fertile territory for unscrupulous traders and legal disputes.