

Protection of innovation in the Net
- 6/7 May 2002

Trade Marks and Internet Domain Names

Jeff Watson

Senior Policy Advisor

UK Patent Office





History

UK Trade Marks Registration Act of 1875
established first Trade Marks Registry
in the world (opened in 1876)

In 1992 commercial operations allowed
to join the Internet

Nominet founded in 1996 as the manager
of .uk (operating from August 1996)



The UK Patent Office

Sir Reader Lack
First Registrar of Trade Marks
1875-1897



Sir Reader Lack, First Registrar of Trade Marks 1875-1897



Volumes

Trade Marks Registry

- 36,338 marks registered in 2000/2001
- about 700,000 current registrations

.uk

- 60,000 registrations per month
- 3,295,442 registered at end of 2001



Process

Trade Marks Registry

-Substantive examination report issued within 2 months for 93% of applications

.uk

-95% of applications registered automatically



Use of trade marks on the Internet

Some natural conflicts between trade marks and the Internet

Trade marks - territorial and classified to particular goods

Internet - no boundaries or classification except perhaps new domain spaces



Use of trade marks on the Internet

Solution perhaps new definitions and interpretations rather than new law

WIPO Joint recommendations concerning the protection of marks and other industrial property rights in signs, on the Internet



Use of trade marks on the Internet

WIPO recommendations list factors to:

- Determine whether the use of a sign on the Internet has a commercial effect.
- Measures that can be taken to reduce or avoid infringement.
- For further details see www.wipo.int



Domain names as trade marks

Domain names can be part of trade marks

Apply the usual tests - what is distinctive ?

Elements such as .co.uk not distinctive and
tm test applied to rest of mark



Domain names as trade marks

Practice likely to evolve with Internet

Current practice notice

www.patent.gov.uk/tm/reference/pan/pan1400.htm



Dispute resolution

UDRP (Uniform Domain Name Dispute Resolution Policy)
an international success story

For .uk, Nominet introduced revised Dispute resolution policy in Sept 2001.

It follows UDRP, but includes informal mediation as first stage (successful in 30% of cases)



How has the law developed ?

Trade mark law and the common law of passing off have been used to resolve domain name/trade mark disputes

Consistent trade mark principles apply to domain names/Internet

Use should not confuse or mislead, or take advantage of another's reputation



BT plc v. One in a Million (Nov 97)

Defendants offered “prestigious” domain names for sale, which incorporated many famous trade marks. Permanent injunctions granted and defendants ordered to transfer domain names.



EasyJet v. easyrealestate.co.uk (Feb 01)

Defendant argued that the claimant should not be entitled to appropriate the word 'easy' and although the judge agreed with this position, found for the claimant on the grounds that the overall look of the website mirrored that of the claimant's.



WHOIS information

Best practices and accurate contact details important (WIPO guidance)

Need to investigate and avoid IPR disputes in a timely and cost-effective manner.

14million WHOIS enquiries per month for .uk



WHOIS information

Important and difficult balance to be struck between privacy/ data protection concerns and interests of IPR owners.



Conclusion

Internet likely to continue to develop and evolve, but greater understanding

Cybersquatting - abusive registration of a domain name by a third party

Cyber smearing - a website designed deliberately to portray an organisation in a bad light

WHAT NEXT ?