



# Internet Law: Class 7

The Current Reality of the Internet

# Internet Domain Names

# Protection of Words and Short Phrases

- A domain name may be up to 256 characters long.
- But some registries limit domain names to 63 characters.
- Some registries have set a minimum number of characters for a domain name.

# Protection of Words and Short Phrases

- Copyright (generally no protection for short phrases and individual words)
- Trademarks / service marks
  - Registered v. common-law marks
  - Tied to particular goods or services v. famous marks (dilution)
  - Territorial v. well-known marks
- Designation of origin (geographical indications, appellations of origin)
  - Sui generis protection v. unfair competition
- Protection of entity names
- Protection of personal names



# Shared Domain Names



<http://www.scrabble.com/>



# Shared Domain Names

Although we may have a name in common...  
We are two completely separate companies



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<http://www.playtex.com/>

# ICANN Uniform Domain-Name Dispute-Resolution Policy

- What is the nature of the Policy?
- Who are the parties bound by the Policy?
- Disputes:
  - (1) The domain name “is identical or confusingly similar to a trademark or service mark in which the complainant has rights;” and
  - (2) The Registrant has “no rights or legitimate interests in respect of the domain name;” and
  - (3) The Registrant’s “domain name has been registered and is being used in bad faith.”

# ICANN Uniform Domain-Name Dispute-Resolution Policy

- Registrant's "rights and legitimate interests"
- Registrant's registration and use in bad faith

# ICANN Uniform Domain-Name Dispute-Resolution Policy

- Examples:
  - trimble.com
    - Marketa Trimble = registrant (a personal blog)
    - Trimble company = complainant
  - internetlawinmiplc.com
    - Marketa Trimble = registrant (a course website)
    - MIPLC = complainant

# ICANN Uniform Domain-Name Dispute-Resolution Policy

- Some registries have adopted the ICANN Policy as is
- Some registries have modified the ICANN Policy
  - Example:
  - **.ie**
    - Instead of “a trademark or service mark” the .ie Policy lists “a **protected identifier**,” which may be
      - “Trade and service marks protected in the island of Ireland.
      - Personal names (including pseudonyms) in which the Complainant has acquired a reputation in the island of Ireland.
      - Geographical indications that can prima facie be protected in the island of Ireland.”

.ie Dispute Resolution Policy, <https://www.iedr.ie/dispute-resolution/>

## **ICANN Approved Providers for Uniform Domain-Name Dispute-Resolution Policy**

- **Asian Domain Name Dispute Resolution Centre (Beijing, Hong Kong, Seoul)**
- **Canadian International Internet Dispute Resolution Centre**
- **The National Arbitration Forum (U.S.)**
- **WIPO (Geneva)**
- **The Czech Arbitration Court (Prague, Czech Republic)**
- **Arab Center for Domain Name Dispute Resolution (ACDR)**

**<https://www.icann.org/resources/pages/providers-6d-2012-02-25-en>**

# ICANN Uniform Domain-Name Dispute-Resolution Policy

- **Remedies**
  - Cancellation of the domain name
  - Transfer of the domain name
- v. **Uniform Rapid Suspension System**
  - “a lower-cost, faster path to relief for rights holders experiencing the most clear-cut cases of infringement”  
<https://newgtlds.icann.org/en/applicants/urs>
  - Only three providers
  - The only remedy = a temporary suspension of a domain name

# ICANN Uniform Domain-Name Dispute-Resolution Policy

- Examples:
  - trimble.com
    - Marketa Trimble = registrant (a personal blog)
    - Trimble company = complainant
  - munichGW2016.com
    - Marketa Trimble = registrant (a course website)
    - The City of Munich = complainant 1
    - The George Washington University = complainant 2

# ICANN Dispute Resolution v. Court Proceedings

- “Availability of Court Proceedings” under the ICANN Policy
- **U.S. provisions**
  - The Anti-cybersquatting Consumer Protection Act, 15 USC 1125(d) (1999)
    - <https://www.law.cornell.edu/uscode/text/15/1125>
  - The Reverse Domain Name Hijacking provision, 15 U.S.C. §1114(2)(D)(v)
    - <https://www.law.cornell.edu/uscode/text/15/1114>

# Barcelona.com v. Barcelona

- Why did the City want barcelona.com?
- Why didn't the City obtain barcelona.es or barcelona.eu at the time of the dispute?
- ICANN UDRP proceeding outcome
- Lawsuit in the U.S.
- Jurisdiction of the U.S. court over the City of Barcelona
- The reverse domain name hijacking provision
- Legality of the domain name registration under the Lanham Act, 15 USC 1125(d)
- Which law governs whether a trademark exists or not?
- Spanish law v. U.S. law v. the law of the dispute resolution provider v. the law of the registry?

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# About us

## About the Barcelona.com's team

### Barcelona.com "Best travel services since 1996"

- The relevance and the simplicity of the Barcelona.com domain name
- Attend to information and requests that net surfers send us.
- A very reactive structure
- The net surfer being confident while he is offered the best services
- The selection of services being regularly verified by our editors
- The daily objective being to simplify and prepare a visit to Barcelona

**Barcelona.com** has become the world leader Barcelona website of travel information, travel services and bookings.

1996: Creation of the Barcelona.com website

2019: Objective: **3.700.000 Unique visitors**

#### The team:

**Joan Nogueras**, President - Founder & Partner

**Hugo Palomar**, CEO

**Larry Kriv**, Content & development - Founder & Partner

**Joan Gaudel**, CTO & Partner



ajuntament.barcelona.cat



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# Barcelona



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## .CAT Registry Agreement, Specification 12

“The TLD will be established to serve the needs of the Catalan Linguistic and Cultural Community on the Internet (the "Community"). The Community consists of those who use the Catalan language for their online communications, and/or promote the different aspects of Catalan culture online, and/or want to specifically address their online communications to that Community.”

### Examples:

- “Universities, schools, research institutions and other academic entities that use Catalan in their academic activities or teach/promote aspects of Catalan culture
- public or private entities whose aim is promoting the Catalan culture ...
- media using the Catalan language for their communications
- individuals, groups, businesses, organizations, entities or initiatives, however constituted, carrying online communications in Catalan ...”

# Gibson Brands v. zong wen

- Trademark “Epiphone”
- Domain name <http://epiphoneamps.com/>
- Who owns the domain name today?
  - <https://whois.icann.org/en>
  - <http://www.kingssz.com/>
- Who owns the trademark “Epiphone” in the U.S.? Who in China? For which classes of goods?
- What is the result of the UDRP proceeding? Who gets the domain name?
- What is the decision concerning the claim of the reverse domain name hijacking?

# **The DNS and Its Territorialization**

- a) Choice of Law in UDRP**
- b) Registration Eligibility**
- c) Dispute Resolution**

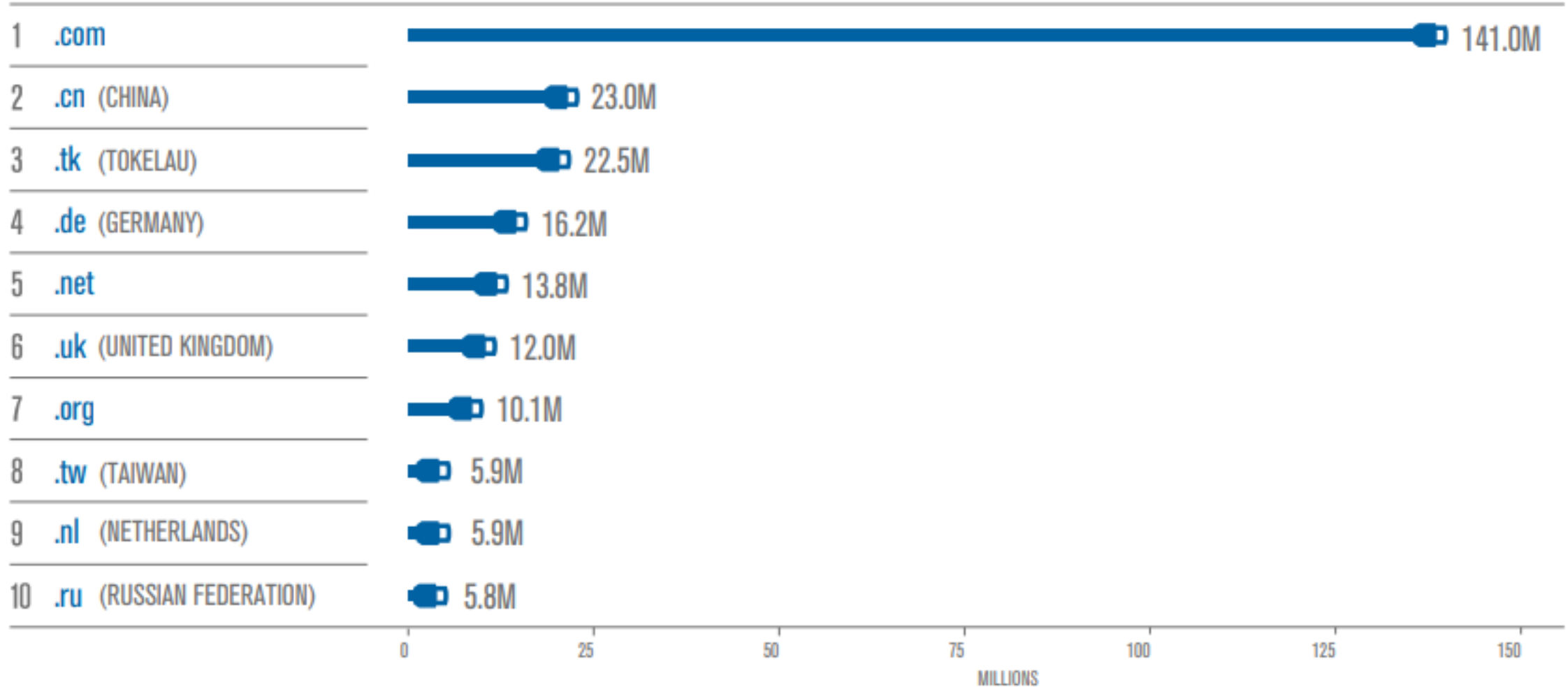
**Choice of law** was always present in UDRP cases, to some extent.

- Disagreements exist among UDRP panelists about the role, if any, that **national law** should play in UDRP cases.
- National law is applied to determine the **existence, validity, and ownership of trademarks**.
  - Barcelona.com showed that choice of law does matter in UDRP cases.
- Some panels have applied national law to determine **other issues** in UDRP cases.
  - E.g., non-commercial fair uses of trademarks.
- The **methods** through which UDRP panels select applicable national law have varied.

- The registries for some top-level domains have adapted the text of the UDRP or have adopted a different dispute resolution policy to give **preference to national or local rights**.
- Listing preferred national rights
  - E.g., .br (Brazil), .eu (European Union), .ie (Ireland), .se (Sweden)
- Listing applicable law
  - E.g., .de (Germany), .dk (Denmark), .eu (European Union)

## TOP 10 LARGEST TLDs BY NUMBER OF REPORTED DOMAIN NAMES

Source: Zooknic, Q1 2019; Verisign, Q1 2019; Centralized Zone Data Service, Q1 2019



## Largest ccTLDs by Number of Reported Domain Names

1	2	3	4	5	6	7	8	9	10
									
.cn	.tk	.de	.uk	.tw	.nl	.ru	.br	.eu	.fr
(CHINA)	(TOKELAU)	(GERMANY)	(UNITED KINGDOM)	(TAIWAN)	(NETHERLANDS)	(RUSSIAN FEDERATION)	(BRAZIL)	(EUROPEAN UNION)	(FRANCE)
23.0M	22.5M	16.2M	12.0M	5.9M	5.9M	5.8M	4.0M	3.7M	3.3M

## Top 30 new gTLDs

TLD

1.  .top

2.  .xyz

3.  .club

4.  .loan

5.  .site

6.  .online

7.  .icu

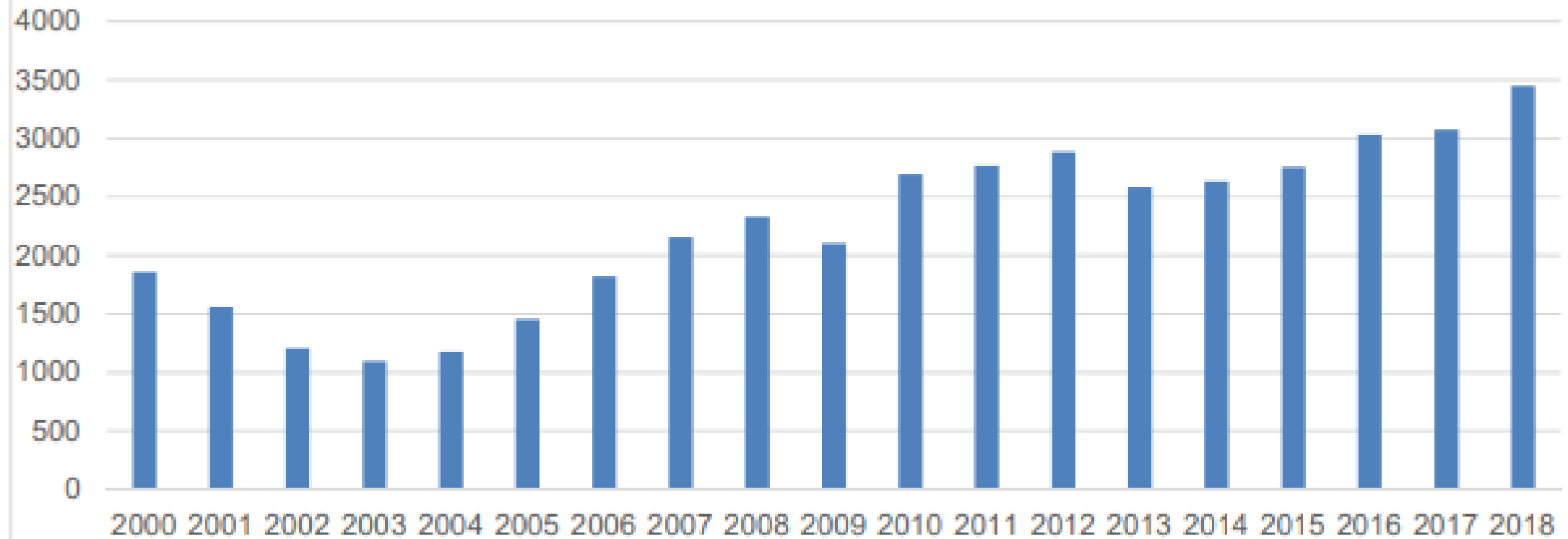
8.  .vip

9.  .shop

10.  .work

<https://ntldstats.com/>

### Total Number of WIPO Domain Name Cases by Year



[https://www.wipo.int/export/sites/www/pressroom/en/documents/pr\\_2019\\_829\\_annex.pdf#annex1](https://www.wipo.int/export/sites/www/pressroom/en/documents/pr_2019_829_annex.pdf#annex1)

## Top 40 gTLDs (Ranking) in WIPO Cases (2018)

	Legacy gTLDs	New gTLDs	Number of domain names	Percentage (%) of all gTLD disputed domain names
1.	.com		3660	72.88%
2.	.net		232	4.62%
3.	.org		176	3.50%
4.	.info		112	2.23%
5.		.online	78	1.55%
6.		.life	58	1.15%
7.		.app	57	1.14%
8.		.xyz	55	1.10%
9.	.pro		44	0.88%
10.		.top	38	0.76%
11.		.site	34	0.68%
12.		.store	30	0.60%
13.		.shop	29	0.58%
14.		.website	28	0.56%
15.	.biz		24	0.48%
16.		.club	22	0.44%
17.		.online	21	0.42%
18.		.life	20	0.40%
19.		.app	19	0.38%
20.		.xyz	18	0.36%
21.		.top	17	0.34%
22.		.site	16	0.32%
23.		.store	15	0.30%
24.		.shop	14	0.28%
25.		.website	13	0.26%
26.		.biz	12	0.24%
27.		.club	11	0.22%
28.		.online	10	0.20%
29.		.life	9	0.18%
30.		.app	8	0.16%
31.		.xyz	7	0.14%
32.		.top	6	0.12%
33.		.site	5	0.10%
34.		.store	4	0.08%
35.		.shop	3	0.06%
36.		.website	2	0.04%
37.		.biz	1	0.02%
38.		.club	1	0.02%
39.		.online	1	0.02%
40.		.life	1	0.02%

**What do you think will be the most pressing or important legal issue on the internet  
in the next three years?**

# Compliance with national laws

- The multiplicity of national laws on the internet is not as large a problem for actors on the internet as is assumed
- Through localization, courts and agencies often limit the territorial scope of prescriptive and adjudicatory jurisdiction
- Practical limitations on litigation reduce the number of jurisdictions where an actor might be sued and the number of national laws that might be raised against the actor
- The multiplicity of national laws may in fact make it easier for actors who want to comply with laws on the internet

# Compliance with national laws

- Is there a need for better enforcement on the internet?
- Effective laws require the possibility of effective enforcement
  - Skepticism about enforceability on the internet clouds policy debates
  - Alternative enforcement mechanisms (against intermediaries) create their own problems
  - Border measures might be ineffective or not available
  - Enforcement assistance from other countries is not always available

# Compliance with national laws

- Other means exist that may compel parties to comply with national laws
  - Long-term business prospects in the jurisdiction
  - Investor pressure
  - The need to work with local businesses that want to be legally compliant (industry initiatives)
  - Change in business model
  - Use of national laws to compel compliance abroad
    - E.g., the Washington State law capturing foreign IP infringements
    - E.g., some gambling regulators' provisions requiring compliance with foreign laws in foreign jurisdictions

# Summary

- A clash exists between the territoriality of most national laws and the global nature of the internet
- Some global norms for the internet have developed, but they must co-exist with national legal systems
- The architecture of the internet has affected the functioning of national laws on the internet (e.g., the scope of prescriptive and adjudicatory jurisdiction)
- National laws have affected the functioning and the architecture of the internet (e.g., the development of geoblocking)

# Marketa Trimble

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- <https://law.unlv.edu/faculty/marketa-trimble>
- <http://ssrn.com/author=635886>
- <http://law.unlv.edu/faculty/publications/marketa-trimble>



# Internet Law: Class 7

Marketa Trimble, June 5, 2019