

## THE VERDICT IS NOT THE SAME IN THE DOMAIN NAME GAME

**When an organisation registers a domain name with an internet registry such as Nominet or ICAAN, it could potentially open itself up to litigation if an arbitrator subsequently rules that the domain name infringes on the trademark of another company.**

If a company feels that a website domain name registered by a third party infringes on its trademark or identity, it can register a complaint with an arbitration centre through one of the internet registries for adjudication. The Internet Corporation for Assigned Names and Numbers (ICANN) is responsible for all domains that end in, for example, .com, .net, .info, .biz, etc. Nominet UK, however, is responsible for all domain names that end in .uk.

Below are four case studies of UK organisations involved in domain name disputes.

### Scottish & Newcastle

Scottish & Newcastle (S&N) filed a complaint in December 2002, asserting that Mishref, Kuwait, had registered the domain [www.scottishandnewcastle.com](http://www.scottishandnewcastle.com) in bad faith. S&N's lawyers, Linklaters, had previously tried to contact the respondent Mishref but received no answer.

S&N argued that, as a well-known FTSE-100 company that had previously registered several domain names containing its name, Mishref was assuming a business connection with S&N which it did not have and, in the process, infringing S&N's copyright.

**Decision:** As no goods or services were being offered on the site by Mishref, the company was acting in bad faith and would cause confusion among internet users. In addition, as Mishref was found to be "deliberately elusive", the arbitration panel ordered that the

domain name be automatically transferred to S&N.

### The Driver and Vehicle Licensing Agency

The Driver and Vehicle Licensing Agency (DVLA), based in Swansea, brought action against DVL Automation Inc, Pennsylvania, in October 2002. The DVLA asserted that DVL's registration of the domain [www.dvla.com](http://www.dvla.com) in April 1996 would cause confusion. It also asserted that DVL had no legitimate interest in the domain name as it conducted business as DVL Automation, not as DVLA, and that it had been registered in bad faith to capitalise on the famous DVLA trademarks.

**Decision:** DVL Automation did not file a response to the complaint. Nevertheless, the arbiter found that "It is clear that the respondent has every right to the domain name, being the concatenation of DVL and the first letter of Automation." DVL Automation was allowed to keep the domain name.

"The DVLA's final assertion that there 'is no evidence the respondent is making legitimate commercial or fair use of the domain name' is dangerously close to an outright lie," the arbiter stated.

### Six Continents

Six Continents, the FTSE-100 hotel chain operator, brought action against Party Night Inc of Amsterdam in January 2003 for its registration of [www.sixcontinentalhotels.com](http://www.sixcontinentalhotels.com). Six Continents claimed that, although

the domain name did not directly match its own trademarks, the domain name was intended to cause confusion through association with the Six Continents brand and its subsidiary hotel chain Intercontinental. Six Continents also pointed out that Party Night Inc had used the site to direct internet users to a pornography site [www.hanky-panky-college.com](http://www.hanky-panky-college.com) and this was not a site that Six Continents would like to be associated with.

**Decision:** The respondent did not respond to the allegations and was considered in default by the arbiter. Even though the arbiter could not find extra evidence that the site had been used for pornographic purposes, he ruled that in Party Night's absence, Six Continents' allegations should be taken as established. The arbiter said: "In those circumstances, when the respondent clearly has no obvious connection with the disputed domain name, the mere assertion from complainant that respondent has no right is enough to shift the burden of proof to respondent." The domain was transferred to Six Continents.

### Cardpoint

Cardpoint, a Lancashire-based provider of cash machines (or ATMs) registered a complaint with Nominet in August 2002 that Riga Industries of Botswana had registered [www.cardpoint.co.uk](http://www.cardpoint.co.uk) – a site that Cardpoint said should belong to it because it had applied to register its name as a trademark

and had "operations in the UK" for two years. The respondent did not reply to any correspondence.

**Decision:** The arbiter stated that although the complainant's name was identical to the domain name, mere application for a trademark is inadequate for establishing rights to a name. Furthermore, the complainant had not fully established what its "operations in the UK" were and so the arbiter did not have enough evidence. It was also found that Cardpoint had not made a detailed enough case for its assertion that Riga had acted in bad faith or had maliciously registered the domain, backed by the fact that Riga had registered the domain two years before Cardpoint started trading. The arbiter found that Cardpoint was guilty of "Reverse Domain Name Hijacking" in trying to deprive Riga of its domain name.

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A wide range of Briefings can be found at [www.financialdirector.co.uk/briefing](http://www.financialdirector.co.uk/briefing)

### Useful links

All domain judgments, disputes and advice on registering domain names and arbitration procedures are available on the websites of the registration organisations.

● Nominet UK  
[www.nominet.org.uk](http://www.nominet.org.uk)

● ICAAN  
[www.icaan.org](http://www.icaan.org)